CONFUSION LIKELY: STANDING REQUIREMENTS FOR LEGAL REPRESENTATIVES UNDER THE LANHAM ACT

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When a trademark registered with the Patent and Trademark Office is infringed, section 32 of the Lanham Act provides the trademark registrant the opportunity to seek remedies in federal court. Thanks to a broad definition of "registrant," the Act in fact extends standing beyond the registrant herself to her "legal representatives," among others. This language has prompted courts to puzzle over the proper definition of a "legal representative." Through their varying interpretations, they have erected unpredictable barriers to standing in the trademark-infringement context. Affording most attention to the Second Circuit's recent decision to deny standing to a claimed legal representative of the Russian Federation, this Note critically examines the different "legal representative" definitions proffered by the courts in light of standing doctrine and the Lanham Act's history. Concluding that the proper "legal representative" definition reflects the goals of the Lanham Act's architects and, to best do so, is bound only by constitutional standing constraints, this Note advocates for a low barrier to third-party standing.

INTRODUCTION

Over the course of forty years, district courts worked to interpret a seemingly innocuous provision of the Lanham Act, the principal federal statute offering protections for trademarks.[1] Section 32 of the Lanham Act affords a trademark registrant the opportunity to bring a civil suit for trademark infringement, but the term "registrant" in fact encompasses a wide range of parties—namely, "legal representatives, predecessors,

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1. A trademark serves "to identify the source of one seller's goods and distinguish that source from other sources." 1 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 3:1 (4th ed. 2014), available at Westlaw MCCARTHY. The Lanham Act offers the following definition:

> The term "trademark" includes any word, name, symbol, or device, or any combination thereof—
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> (1) used by a person, or
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> (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,
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> to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

15 U.S.C. § 1127 (2012).

successors and assigns of such applicant or registrant."[2] The simple term "legal representative" prompted a number of dramatically different interpretations from the courts.[3] While some have interpreted the phrase in accordance with its dictionary definition to simply mean one who stands in the place of another, other courts have imposed a much narrower meaning and have required that, in order to serve as a legal representative in a trademark-infringement suit, either the plaintiff must be the exclusive licensee of the trademark owner or the trademark owner must be unable to bring suit itself.[4]

On August 5, 2013, the Second Circuit became the first court of appeals to weigh in on the debate.[5] In *Federal Treasury Enterprise Sojuzplodoimport v. SPI Spirits Ltd.*, the court invoked constitutional standing requirements and prudential considerations in fashioning an uncommonly narrow definition of "legal representative."[6] In doing so, the Second Circuit placed substantial obstacles in the path of public entities, foreign governments, and others who seek to delegate trademark use and enforcement to other organizations better equipped to exploit and protect the mark.

To ensure its continued value, a trademark must be used[7] and, if necessary, enforced.[8] A trademark owner, wishing to capitalize on the

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2. 15 U.S.C. § 1127. The Lanham Act's protections are not confined to marks registered under section 32. Section 43(a), for example, has been interpreted by the Supreme Court to provide a remedy for false advertising, as well as for the infringement of unregistered trademarks or trade dress. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 776–77 (1992) (Stevens, J., concurring). While standing under section 43(a) has garnered significant attention from the Court, see Lexmark Int'l, Inc. v. Static Control Components, Inc., 134 S. Ct. 1377 (2014), this Note focuses on parties asserting claims under section 32 specifically, and "trademark infringement" is thus used to refer to the infringement of *registered* trademarks in this piece.

3. See infra Part II.A (detailing district courts' interpretations of "legal representative").

4. See infra Part II.A.1 (categorizing court opinions according to rigor of "legal representative" requirements imposed).

5. Fed. Treasury Enter. Sojuzplodoimport v. SPI Spirits Ltd., 726 F.3d 62, 73 (2d Cir. 2013), cert. denied, 134 S. Ct. 1291 (2014) ("[W]e address the meaning of the phrase 'legal representative' as used in the Act—an issue that appears to be one of first impression among federal courts of appeals . . . .").

6. See infra Part II.B (explaining Second Circuit held standing as legal representative to be contingent upon trademark owner's inability to bring suit itself).

7. Indeed, a trademark cannot exist in isolation, divorced from its use in commerce. See United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90, 97 (1918) (explaining, while copyrights and patents are rights in gross, "[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"). In order to register a trademark with the Patent and Trademark Office, one must submit a verified statement asserting that "the mark is in use in commerce" or declaring "the applicant's bona fide intention to use the mark in commerce." 15 U.S.C. § 1051(a)(3), (b)(3). Subsequent nonuse of the trademark can give rise to a presumption of abandonment and the registrant's loss of rights to the mark. 3 McCarthy, supra note 1, § 17:9.

good will her brand has engendered in the minds of the public, may seek to prevent others from improperly benefiting from or diluting the distinctiveness of her mark by initiating litigation.[9] Failure to bring suit, in fact, can contribute to loss of the mark, as its unchecked, widespread use in the marketplace may result in purchasers discounting its value as a source identifier and may suggest that the owner has abandoned the mark.[10] Generally barred from bringing trademark-infringement suits themselves,[11] members of the public also have an interest in trademark owners ensuring that trademarks remain strongly linked to particular sources of goods.[12] "In this sense," writes one trademark expert, "protection of trademarks is merely a facet of consumer protection."[13]

Because trademark enforcement is important to a well-functioning marketplace, the producers of goods, and the public at large, a determination of who has standing to bring suit for trademark infringement has consequences that ripple beyond any potential plaintiff. Clear criteria for standing make certain that, in a global economy, a producer of goods can enter American markets with confidence that, should the need arise, her trademark can be enforced in the country's courts. In *Sojuzplodoimport*, the stakes may in fact be higher. On its face, the outcome in *Sojuzplodoimport* would seem to impact little more than the labels of vodka bottles crowding shelves of American liquor stores. But through its stringent "legal representative" definition, the Second Circuit has, during a period of tense United States–Russia relations,[14] denied the Russian Federation the ability to assert trademark rights through its ex-

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8. See 3 McCarthy, supra note 1, § 17:17 (explaining failure to sue infringers may result in trademark losing strength and becoming merely "generic" or "descriptive").

9. See 15 U.S.C. § 1114 (detailing legal remedies available to trademark registrant whose mark is infringed); id. § 1125(c) (providing owner of famous trademarks legal remedy for dilution).

10. See 3 McCarthy, supra note 1, § 17:17 ("[I]f, through failure to prosecute, a mark continually loses 'strength' and 'distinctiveness,' it will eventually hemorrhage so much that it dies as a mark.").

11. See supra note 2 and accompanying text (explaining only "registrants" may bring suit for infringement of registered trademarks); see also 1 McCarthy, supra note 1, § 2:33 (explaining, even where consumers are afforded standing under state fraud statutes, their financial interest is "too small to justify expensive litigation," and "[t]he consumer's interest would never be adequately protected by individual consumer lawsuits").

12. 1 McCarthy, supra note 1, § 2:33 ("When a business sues for trademark infringement 'the plaintiff is acting, not only in its own interest, but in the public interest.'" (quoting Gen. Baking Co. v. Gorman, 3 F.2d 891, 893 (1st Cir. 1925))).

13. Id.

14. See Anne Gearan, Sour U.S.-Russia Relations Threaten Obama's Foreign Policy Agenda, Wash. Post (Jan. 13, 2013), http://www.washingtonpost.com/world/national-security/sour-us-russia-relations-threaten-obamas-foreign-policy-agenda/2013/01/13/acf3856a-5b62-11e2-88d0-c4cf65c3ad15_story.html (on file with the *Columbia Law Review*) (describing "poisonous unraveling of U.S. relations with Russia" in final months of 2012).

pressly authorized representative,[15] and the proper construction of "legal representative" has thus taken on new importance.

Given this development, this Note evaluates the courts' various interpretations of "legal representative" in light of the Lanham Act's text and history, the public policy goals underlying trademark law, and the constitutional and prudential requirements for standing. Part I provides an overview of standing doctrine and traces the evolution of trademark law and its statutory standing requirements during the early twentieth century. Part II analyzes the wide-ranging definitions of "legal representative" proffered by federal courts, the policy considerations and interpretive techniques emphasized in those decisions, and whether or not the Second Circuit's recent decision represents a significant departure from the reasoning offered by lower courts. Finally, Part III suggests that courts considering this matter in the future should adopt an expanded definition of "legal representative"—naturally constrained by the Supreme Court's standing jurisprudence—in order to best serve the interests of consumers and trademark owners, the intended beneficiaries of trademark law, both in the United States and abroad.

I. STANDING REQUIREMENTS AND THE LANHAM ACT

This Part introduces the standing requirements articulated by the Supreme Court, as well as those standing requirements specific to trademark-infringement suits under the Lanham Act. Part I.A describes the history of trademark law in the United States, the genesis of the standing provisions therein, and the objectives and concerns that motivated the statutes' drafters. Part I.B examines the doctrine of standing, encompassing Article III standing requirements, judicially imposed prudential considerations, and statutory standing restrictions.

A. *Lanham Act's History and Statutory Standing*

Trademark law's "legal representative" language did not appear in our country's earliest trademark statutes but was instead first codified by the Lanham Act in 1946. Part I.A.1 broadly surveys the historical context that gave rise to the Lanham Act, while Part I.A.2 traces the evolution of trademark law's standing provisions throughout the early twentieth century.

1. *History of the Lanham Act's Enactment.* — Trademark legislation has generally been described as serving both consumer protection and antipiracy functions; it "protect[s] the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get" and protects a trademark owner's "investment from its misappropriation by pirates and cheats" given her expenditures of time, money, and energy in

15. See infra Part II.B–C (analyzing *Sojuzplodoimport* decision and its ramifications).

bringing the product to market.[16] The Lanham Act, beyond furthering these broad goals, was intended to remedy three primary deficiencies of existing trademark law.

First, legislators described the need to implement already-ratified "international conventions dealing with trade-marks, commercial names, and the repression of unfair competition."[17] The House Report accompanying the Lanham Act explained, "Industrialists in this country ha[d] been seriously handicapped in securing protection in foreign countries due to our failure to carry out, by statute, our international obligations."[18] Because there had been "no serious attempt fully to secure to nationals of countries signatory to the conventions their trade-mark rights in this country and to protect them against the wrongs for which protection ha[d] been guaranteed by the conventions," foreign countries "[n]aturally" refused American citizens their rights under the same conventions.[19] Second, trademark law had become a "confused situation," resulting from multiple amendments to earlier-enacted legislation and trademark provisions "widely scattered" throughout the U.S. Code.[20] Finally, the law had failed to keep pace with forty years of economic development in the United States.[21]

Prior to 1870, trademarks were afforded protection by the common law exclusively.[22] Spurred by the need to give effect to trademark treaties the United States had entered into with foreign countries and to support burgeoning trade in American goods, Congress passed the first federal trademark statute in 1870.[23] Close on its heels was the Act of 1876, which imposed criminal sanctions for the sale of counterfeit merchandise[24] and thus provided reciprocal protections to those afforded American manufacturers and merchants in French markets.[25] Though the Supreme

16. H.R. Rep. No. 79-219, at 2 (1945).

17. Id. at 3.

18. Id.

19. Id. at 3–4. In particular, the Report notes, "Although it has solemnly pledged at inter-American conventions to do so, the United States has failed adequately to protect owners of trade-marks in the other American countries doing business with this country." Id. at 4.

20. Id. at 3. In addition to these structural concerns, legislators decried ingrained constructions of existing trademark acts that had "obscured and perverted" the original intent of those acts and could only be eradicated by new legislation. Id. at 4.

21. Id. at 3.

22. See Daphne Robert, The New Trade-Mark Manual 225–28 (1947) (explaining trademarks received common law protection prior to Congress's enactment of legislation).

23. Keith M. Stolte, A Response to Jerome Gilson's Call for an Overhaul of the Lanham Act, 94 Trademark Rep. 1335, 1341–42 (2004). The first trademark treaty the United States entered into was with Russia in 1868. Zvi S. Rosen, In Search of the *Trade-Mark Cases*: The Nascent Treaty Power and the Turbulent Origins of Federal Trademark Law, 83 St. John's L. Rev. 827, 835 (2009).

24. Stolte, supra note 23, at 1343.

25. Trade-Mark Cases, 100 U.S. 82, 88–89 (1879).

Court declared these laws unconstitutional, by virtue of Congress exceeding the bounds of its Commerce Clause authority,[26] the legislature subsequently passed a number of similar statutes that remedied this defect.[27]

The early twentieth century's most expansive, sweeping reforms of trademark law arrived in 1905[28] and 1920.[29] These statutes broke new ground by offering detailed descriptions of the categories of marks that could and could not be registered, providing for both injunctive and monetary relief for infringement, and offering a remedy for "false designation of origin,"[30] but they were met with substantial criticism. Edward Rogers, who would become the principal architect of the Lanham Act, branded the 1905 law "a slovenly piece of legislation, characterized by awkward phraseology, bad grammar and involved sentences."[31] With apparent exasperation, he asked "Who is the owner of a trade-mark?" and noted that neither "owner" nor "trade-mark" was defined by the statute.[32] The 1905 Act's drafters, Rogers proclaimed, "had a talent for obscurity amounting to genius."[33]

In response to an invitation from the American Bar Association, trademark practitioner Rogers drafted a new trademark statute which, in slightly varying forms, was introduced in the House and Senate numerous times between 1924 and 1932.[34] In 1937, the cause was adopted by the Chairman of the House Patent Committee, Congressman Ernest Lanham, who requested of Rogers a "skeleton draft of a new act that could be used as a sort of clotheshorse to hang things on."[35] The skeleton provided by Rogers was introduced in 1938 as H.R. 9041, the

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26. Id. at 96–99.

27. Stolte, supra note 23, at 1344.

28. Act of Feb. 20, 1905, ch. 592, 33 Stat. 724, repealed by Lanham Act, Pub. L. No. 79-849, 60 Stat. 427 (1946). The purpose of the 1905 Act, as declared in the title of the bill itself, was "[t]o authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same." Id.

29. Act of Mar. 19, 1920, ch. 104, 41 Stat. 533, repealed by Lanham Act, 60 Stat. 427. Stolte notes that, "[l]ike the Acts of 1870, 1881 and 1905, the Act of 1920 was enacted to give force to certain treaty obligations." Stolte, supra note 23, at 1347. More circumscribed than that of the Act of 1905, the declared purpose of the 1920 Act was "[t]o give effect to certain provisions of the convention for the protection of trade-marks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes." 41 Stat. 533.

30. Stolte, supra note 23, at 1345–46.

31. Edward S. Rogers, The Expensive Futility of the United States Trade-Mark Statute, 12 Mich. L. Rev. 660, 665 (1914).

32. Id.

33. Id.

34. See Stolte, supra note 23, at 1347–49 & n.59 (discussing origin and early history of Rogers's statute).

35. Edward S. Rogers, The Lanham Act and the Social Function of Trade-Marks, 14 Law & Contemp. Probs. 173, 180 (1949).

first version of the Lanham Act.[36] Introduced, debated, and amended many times after 1938, the Lanham Act was ultimately enacted in 1946.[37]

2. *The Genesis of Trademark Standing Provisions.* — The specific language used to convey standing for a trademark-infringement suit has not remained static but has instead changed substantially over time. The 1870 and 1905 statutes both provide that an infringer shall be liable to an action "at the suit of the owner" of the trademark.[38] The first piece of legislation to define "owner," perhaps thanks to the draftsmanship of Rogers, appeared in 1926 as H.R. 13486.[39] The legislation does not clearly define the individuals who may bring suit, but it does indicate that an infringer may be liable "to pay to the owner . . . damages."[40] In turn, the bill stated that

> [t]he terms "person" and "owner" and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this Act, include a firm, corporation, or association, or any *legal representative* or entity capable of possessing and transferring title, as well as a natural person.[41]

The bill similarly provides that "the terms 'applicant' and 'registrant' embrace the legal representatives, successors, and assigns of such applicant or registrant."[42]

Though the term "legal representative" thus appears in trademark legislation beginning in the 1920s, the Lanham Act was the first piece of *enacted* legislation to bear this phrase. Unlike H.R. 13486 and H.R. 13109, discussed above, the Lanham Act made explicit that trademark registrants—rather than "owners"—could bring suit for trademark infringement[43] and defined "registrant" as encompassing a legal representative.[44]

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36. Id.

37. Beverly W. Pattishall, The Lanham Trademark Act—Its Impact over Four Decades, 76 Trademark Rep. 193, 196 (1986).

38. Act of Feb. 20, 1905, ch. 592, § 16, 33 Stat. 724, 728, repealed by Lanham Act, Pub. L. No. 79-489, 60 Stat. 427 (1946); Act of July 8, 1870, ch. 230, §§ 77–84, 16 Stat. 198, 210–12.

39. H.R. 13486, 69th Cong. (as introduced in House, Dec. 6, 1926).

40. Id. § 18.

41. Id. § 31 (emphasis added).

42. Id. Though H.R. 13486 was not enacted, the purposes behind the bill may nonetheless offer a glimpse into the reasoning behind the expansive definitions of "owner" and "registrant." The House Report accompanying H.R. 13109, a subsequently introduced version of the bill containing the same definitions, explained the bill's aims as reducing inconsistencies among the various trademark acts and "carrying into effect the convention signed at Santiago, Chile, on April 28, 1923." H.R. Rep. No. 70-1368, at 2 (1928).

43. Lanham Act § 32(1) (codified as amended at 15 U.S.C. § 1114(1) (2012)). The Lanham Act provided:

The hearings and committee reports related to the Lanham Act contain no discussion of the phrase "legal representative" or standing to sue for infringement. It may have been the case that affording standing to a legal representative was perceived as no great departure from historical practice. Under this view, the Lanham Act merely served as codification of long-established standing rules in trademark law. Alternatively, this language—having appeared in at least a half-dozen pieces of legislation over the course of two decades[45]—may have been thoroughly considered, debated, and agreed upon long before the Lanham Act was signed into law. If this latter view is to be credited, then the most telling moment of the "legal representative" provision's history may in fact lie many years before the Lanham Act's enactment, when the committee led by Rogers

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> (1) Any person who shall, in commerce, (a) use, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of any registered mark in connection with the sale, offering for sale, or advertising of any goods or services on or in connection with which such use is likely to cause confusion or mistake or to deceive purchasers as to the source of [sic] origin of such goods or services; or (b) reproduce, counterfeit, copy, or colorably imitate any such mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended to be used upon or in connection with the sale in commerce of such goods or services, shall be liable to a civil action by the registrant for any or all of the remedies hereinafter provided . . . .

Id. In the nearly seventy years since the Lanham Act's enactment, the text of section 32 has undergone only minor revision:

> (1) Any person who shall, without the consent of the registrant—
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> (a) use 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; or
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> (b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,
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> shall be liable in a civil action by the registrant for the remedies hereinafter provided.

15 U.S.C. § 1114(1).

44. Lanham Act § 45 (codified as amended at 15 U.S.C. § 1127). The Lanham Act provided, "The terms 'applicant' and 'registrant' embrace the legal representatives and successors and assigns of such applicant or registrant." Id. This provision was amended by Act of Oct. 9, 1962, Pub. L. No. 87-772, § 21, 76 Stat. 769, 774 (codified at 15 U.S.C. § 1127), to include "predecessors" and is presently codified as: "The terms 'applicant' and 'registrant' embrace the legal representatives, predecessors, successors and assigns of such applicant or registrant." 15 U.S.C. § 1127.

45. H.R. 82, 78th Cong. § 45 (1943); S. 895, 77th Cong. § 45 (1941); H.R. 102, 77th Cong. § 45 (1941); H.R. 6618, 76th Cong. § 45 (1939); H.R. 4744, 76th Cong. § 46 (1939).

sought to create a clear, coherent body of law from a muddled mess,[46] and the United States sought to fulfill its treaty obligations to its commercial partners abroad.[47] These aims, coupled with the Supreme Court's modern constitutional and prudential standing requirements, serve as the appropriate backdrop for evaluating the "legal representative" definitions imposed by the courts.

B. *Sources of Standing Requirements*

Like any other party seeking access to federal courts, a trademark registrant who wishes to assert her rights under section 32 of the Lanham Act must meet standing requirements imposed by the Constitution, the Supreme Court, and Congress. Constitutional standing requirements, described in Part I.B.1 below, are considered mandatory foundational requirements for standing in all federal cases; in contrast, prudential and statutory standing requirements, described in Parts I.B.2 and I.B.3, are additional filters that may or may not be imposed by the Court and Congress, respectively.

1. *Constitutional Constraints on Standing*. — Standing doctrine, which springs from Article III's limitations on the jurisdiction of the federal courts,[48] seeks to define the outermost bounds of justiciable cases and controversies.[49] Very simply, it "asks whether a litigant is entitled to have a federal court resolve his grievance."[50] The Supreme Court has declared standing doctrine to be "founded in concern about the proper—and properly limited—role of the courts in a democratic society"[51] and thus instrumental in defining the separation of powers among the judicial, legislative, and executive branches.[52] Looking beyond broad structural concerns to the practical realities of judicial administration, standing doctrine aims to ensure that the Court hears a specific controversy,

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46. See supra notes 31–33 and accompanying text (discussing Rogers's criticisms of previous formulations of trademark law).

47. See supra note 42 and accompanying text (noting legislative aim to reconcile trademark law with international agreements).

48. U.S. Const. art. III, § 2.

49. See Whitmore v. Arkansas, 495 U.S. 149, 154–55 (1990) ("Article III, of course, gives the federal courts jurisdiction over only 'cases and controversies,' and the doctrine of standing serves to identify those disputes which are appropriately resolved through the judicial process.").

50. Kowalski v. Tesmer, 543 U.S. 125, 128 (2004).

51. Warth v. Seldin, 422 U.S. 490, 498 (1975).

52. See Lujan v. Defenders of Wildlife, 504 U.S. 555, 559–60 (1992) ("[T]he Constitution's central mechanism of separation of powers depends largely upon common understanding of what activities are appropriate to legislatures, to executives, and to courts."). According to the Court, the "standing inquiry has been especially rigorous when reaching the merits of the dispute would force us to decide whether an action taken by one of the other two branches of the Federal Government was unconstitutional." Raines v. Byrd, 521 U.S. 811, 819–20 (1997).

presented by those who have a personal stake in the matter, and avoids adjudicating matters unnecessarily.[53]

The Court in *Lujan v. Defenders of Wildlife* explained that "the irreducible constitutional minimum of standing contains three elements": injury in fact, causation, and redressability.[54] For a plaintiff to have standing, she must suffer harm which is both "concrete and particularized"[55] and "actual or imminent,"[56] rather than merely "'conjectural' or 'hypothetical.'"[57] Additionally, there must be a "causal connection" between the defendant's complained-of action and the plaintiff's injury, with a favorable decision of the court likely to redress that harm.[58] While the Supreme Court had previously acknowledged the complexity and even the inconsistency of standing doctrine generally,[59] the Court in *Lujan* explained that this "*core component* of standing is an essential and unchanging part of the case-or-controversy requirement of Article III."[60]

In *Sprint Communications Co. v. APCC Services, Inc.*,[61] a case involving assigned claims, the Supreme Court demonstrated the flexibility of the Article III requirements for standing. The dispute in *Sprint* stemmed from long-distance communications carriers' failure to compensate

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53. See Massachusetts v. E.P.A., 549 U.S. 497, 517 (2007) ("'[T]he gist of the question of standing' is whether petitioners have 'such a personal stake in the outcome of the controversy as to assure that concrete adverseness which sharpens the presentation of issues upon which the court so largely depends for illumination.'" (quoting Baker v. Carr, 369 U.S. 186, 204 (1962))); Singleton v. Wulff, 428 U.S. 106, 113–14 (1976) ("[T]he courts should not adjudicate such rights unnecessarily, and it may be that in fact the holders of those rights either do not wish to assert them, or will be able to enjoy them regardless of whether the in-court litigant is successful or not.").

54. *Lujan*, 504 U.S. at 560–61.

55. Id. at 560.

56. Id. (quoting Whitmore v. Arkansas, 495 U.S. 149, 155 (1990)) (internal quotation mark omitted).

57. Id. (quoting *Whitmore*, 495 U.S. at 155) (internal quotation marks omitted).

58. Id. at 560–61. More recently, in *Lexmark International, Inc. v. Static Control Components, Inc.*, the Court summarized the constitutional standing requirements as follows: "The plaintiff must have suffered or be imminently threatened with a concrete and particularized 'injury in fact' that is fairly traceable to the challenged action of the defendant and likely to be redressed by a favorable judicial decision." 134 S. Ct. 1377, 1386 (2014) (quoting *Lujan*, 504 U.S. at 560).

59. Valley Forge Christian Coll. v. Ams. United for Separation of Church & State, Inc., 454 U.S. 464, 475 (1982) ("We need not mince words when we say that the concept of 'Art. III standing' has not been defined with complete consistency in all of the various cases decided by this Court which have discussed it . . . ."); see Christian B. Sundquist, The First Principles of Standing: Privilege, System Justification, and the Predictable Incoherence of Article III, 1 Colum. J. Race & L. 119, 120 (2011) ("The murky waters of standing doctrine have been criticized for their indeterminacy, political undercurrents, and even 'apparent lawlessness.'" (footnotes omitted) (quoting William Fletcher, The Structure of Standing, 98 Yale L.J. 221, 223 (1988))).

60. 504 U.S. at 560 (emphasis added).

61. 554 U.S. 269 (2008).

payphone operators for customer calls, as required by law.[62] A number of payphone operators assigned their claims to third-party "aggregators" who, in turn, filed suit on behalf of the payphone operators.[63] While the aggregators received a fee for their services, they agreed to remit all compensation recovered to the payphone operators.[64]

The *Sprint* Court concluded that—although it was the payphone operators who originally suffered injury and would ultimately receive the proceeds of the litigation—the aggregators nonetheless met Article III's requirements of injury in fact and redressability.[65] With respect to the injury-in-fact requirement, the Court concluded simply that "an assignee can sue based on his assignor's injuries."[66] The Court also explained that the redressability inquiry "focuses . . . on whether the *injury* that a plaintiff alleges is likely to be redressed through the litigation—not on what the plaintiff ultimately intends to do with the money he recovers."[67] Because "[l]awsuits by assignees, including assignees for collection only, are 'cases and controversies of the sort traditionally amenable to, and resolved by, the judicial process,'" the Court concluded that the plaintiffs were properly granted standing.[68] Although *Lujan* purportedly declared the bare minima for standing, *Sprint* suggests that *Lujan*'s injury-in-fact and redressability requirements may be flexibly interpreted where history and tradition so require.

2. *Prudential Considerations.* — Confusion in standing doctrine can also stem from prudential considerations that further constrain who may bring suit. The Supreme Court has explained, "[O]ur standing jurisprudence contains two strands: Article III standing, which enforces the

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62. Id. at 271.

63. Id. at 272; see Spinedex Physical Therapy USA Inc. v. United Healthcare of Ariz., Inc., 770 F.3d 1282, 1291 (9th Cir. 2014) (labeling *Sprint*, decided by 5–4 vote, a "difficult case" as "aggregators were not assigned an interest in the claims" but were instead "assigned the claims for the sole purpose of collection").

64. *Sprint*, 554 U.S. at 271.

65. Id. at 287. Unlike injury in fact and redressability, causation was not contested. See id. at 286–87 (presenting petitioners' arguments with respect to redressability and causation alone).

The court also dismissed the "practical problems" petitioners raised against third-party standing in this case—namely, that "the payphone operators may not comply with discovery requests served on them, that the payphone operators may not honor judgments reached in this case, and that petitioners may not be able to bring, in this litigation, counterclaims against the payphone operators." Id. at 291. In doing so, the Court relied on its long history of allowing assignee lawsuits and an assertion that "courts are not helpless in the face of such problems." Id. at 291–92.

66. Id. at 286.

67. Id. at 287.

68. Id. at 285 (quoting Vt. Agency of Natural Res. v. United States ex rel. Stevens, 529 U.S. 765, 777–78 (2000)). In its subsequent examination of the *Sprint* decision, the Fourth Circuit observed that, "in the assignee/assignor context at issue in *Sprint*, the interests of the assignee and assignor in pursuing a claim to recover damages are fully aligned." David v. Alphin, 704 F.3d 327, 336 (4th Cir. 2013).

Constitution's case-or-controversy requirement; and prudential standing, which embodies judicially self-imposed limits on the exercise of federal jurisdiction."[69] The Court has articulated three prudential constraints: "the general prohibition on a litigant's raising another person's legal rights, the rule barring adjudication of generalized grievances more appropriately addressed in the representative branches, and the requirement that a plaintiff's complaint fall within the zone of interests protected by the law invoked."[70] Invoking ideas of institutional competence and judicial economy, the Supreme Court has indicated that, absent these prudential limitations, "the courts would be called upon to decide abstract questions of wide public significance even though other governmental institutions may be more competent to address the questions and even though judicial intervention may be unnecessary to protect individual rights."[71]

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69. Elk Grove Unified Sch. Dist. v. Newdow, 542 U.S. 1, 11–12 (2004) (citations omitted) (quoting Allen v. Wright, 468 U.S. 737, 751 (1984)) (internal quotation marks omitted), abrogated by Lexmark Int'l, Inc. v. Static Control Components, Inc., 134 S. Ct. 1377 (2014); see Tax Analysts & Advocates v. Blumenthal, 566 F.2d 130, 137 (D.C. Cir. 1977) ("Prudential limitations, on the other hand, are not constitutional requirements; these limitations are developed and imposed by the Supreme Court in its supervisory capacity over the federal judiciary.").

70. *Elk Grove*, 542 U.S. at 12 (quoting *Allen*, 468 U.S. at 751). Recently, the Court denied that the zone-of-interests requirement is properly classified as a "prudential" consideration, despite the Court's long history of doing so. See *Lexmark*, 134 S. Ct. at 1387 ("Although we admittedly have placed that test under the 'prudential' rubric in the past, it does not belong there . . . ." (citation omitted)). According to the Court, the presumption that "a statutory cause of action extends only to plaintiffs whose interests 'fall within the zone of interests protected by the law invoked'" is instead intertwined with the question of whether the plaintiff has a cause of action under a statute. Id. at 1388. In a footnote, the Court acknowledged that, in comparison with the prohibition on generalized grievances and the zone-of-interests requirement, "[t]he limitations on third-party standing are harder to classify" and concluded that "consideration of that doctrine's proper place in the standing firmament can await another day." Id. at 1387 n.3.

More broadly, the *Lexmark* Court explained that declining to adjudicate a claim "on grounds that are 'prudential,' rather than constitutional" would be "in some tension with . . . the principle that 'a federal court's "obligation" to hear and decide' cases within its jurisdiction 'is "virtually unflagging."'" Id. at 1386 (quoting Sprint Commc'ns, Inc. v. Jacobs, 134 S. Ct. 584, 591 (2013)); see also id. at 1388 ("Just as a court cannot apply its independent policy judgment to recognize a cause of action that Congress has denied, it cannot limit a cause of action that Congress has created merely because 'prudence' dictates." (citation omitted)). According to a recent piece, "*Lexmark* calls the future viability of prudential standing into question" and "leaves little room for courts to refuse to adjudicate a case for lack of standing based on *prudential* considerations." The Supreme Court, 2013 Term—Leading Cases, 128 Harv. L. Rev. 191, 330 (2014). Surveying *Lexmark* and other standing cases recently decided by the Court, a second commentator declared, "Prudential principles are flexible until they are deemed inflexible; and seemingly constitutional principles are unchanging until they are changed." S. Todd Brown, The Story of Prudential Standing, 42 Hastings Const. L.Q. 95, 127 (2014). Nonetheless, for the time being, the Court has left third-party standing uneasily seated within the "prudential" standing category.

71. Warth v. Seldin, 422 U.S. 490, 500 (1975).

Expounding upon the first of the prudential limitations, the prohibition of third-party standing, the Supreme Court explained that "the plaintiff generally must assert his own legal rights and interests, and cannot rest his claim to relief on the legal rights or interests of third parties."[72] This prohibition reflects the beliefs that only a person asserting her own rights will have proper incentive to bring suit and to zealously advocate her position, and that the Court ought not adjudicate the rights of a third party who may in fact be satisfied with the status quo.[73]

Unlike the Article III standing requirements, application of prudential considerations is not mandatory.[74] The Supreme Court has indicated that third-party standing may indeed be permissible where "the party asserting the right has a 'close' relationship with the person who possesses the right" and "there is a 'hindrance' to the possessor's ability to protect his own interests."[75] Although it has offered no precise definition of the requisite "closeness," the Court has examined both the plaintiff's degree of interest and the nature of the relationship between the plaintiff and the party possessing the allegedly infringed rights,[76] including whether the relationship presently exists or is instead a hypothetical, future relationship.[77] With regard to the "hindrance" requirement, the

72. Id. at 499.

73. See Kowalski v. Tesmer, 543 U.S. 125, 129 (2004) ("This rule assumes that the party with the right has the appropriate incentive to challenge (or not challenge) governmental action and to do so with the necessary zeal and appropriate presentation."); Duke Power Co. v. Carolina Envtl. Study Grp., Inc., 438 U.S. 59, 80 (1978) ("There are good . . . reasons for this prudential limitation on standing when rights of third parties are implicated—the avoidance of the adjudication of rights which those not before the Court may not wish to assert, and the assurance that the most effective advocate of the rights at issue is present . . . .").

74. See Craig v. Boren, 429 U.S. 190, 193 (1976) ("[O]ur decisions have settled that limitations on a litigant's assertion of *jus tertii* are not constitutionally mandated, but rather stem from a salutary 'rule of self-restraint' designed to minimize unwarranted intervention into controversies where the applicable constitutional questions are ill-defined and speculative."); see also Bennett v. Spear, 520 U.S. 154, 162 (1997) ("[U]nlike their constitutional counterparts, [prudential standing requirements] can be modified or abrogated by Congress."). With respect to its prudential rule against third-party standing, the Court has explained that, "[l]ike any general rule, . . . this one should not be applied where its underlying justifications are absent." Singleton v. Wulff, 428 U.S. 106, 114 (1976); see also Sec'y of State v. Joseph H. Munson Co., 467 U.S. 947, 956 (1984) ("[T]here are situations where competing considerations outweigh any prudential rationale against third-party standing, and . . . this Court has relaxed the prudential-standing limitation when such concerns are present.").

75. *Kowalski*, 543 U.S. at 130 (quoting Powers v. Ohio, 499 U.S. 400, 411 (1991)); see also *Joseph H. Munson Co.*, 467 U.S. at 956 (explaining Court has recognized third-party standing where "obstacles prevent a party from asserting rights on behalf of itself" and considers "whether, as a prudential matter, the third party can reasonably be expected properly to frame the issues and present them with the necessary adversarial zeal").

76. *Joseph H. Munson Co.*, 467 U.S. at 973 (Stevens, J., concurring).

77. See *Kowalski*, 543 U.S. at 130–31 (finding closeness requirement was not met where plaintiffs "rel[ied] on a future attorney-client relationship with as yet unascer-

Court has indicated that impediments to the injured party asserting her own rights need not be "insurmountable";[78] instead, obstacles need only be "genuine"[79] and "practical."[80] The Court has proclaimed itself "quite forgiving with these criteria" when First Amendment rights are at issue or denying standing would indirectly violate the third party's rights.[81]

Breaking with its prudential constraints, the Supreme Court has routinely permitted third-party standing where various legal relation-

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tained . . . criminal defendants," rather than an existing attorney–client relationship). The Court has explained that the closeness inquiry seeks to ensure that, first, "the enjoyment of the right is inextricably bound up with the activity the litigant wishes to pursue" such that "construction of the right is not unnecessary in the sense that the right's enjoyment will be unaffected by the outcome of the suit" and, second, that "the relationship between the litigant and the third party may be such that the former is fully, or very nearly, as effective a proponent of the right as the latter." *Singleton*, 428 U.S. at 114–15; see also *Powers*, 499 U.S. at 414 (permitting criminal defendant standing to sue on behalf of excluded jurors where "congruence of interests" existed between petitioner and jurors and "there c[ould] be no doubt that petitioner w[ould] be a motivated, effective advocate for the excluded venirepersons' rights").

78. *Singleton*, 428 U.S. at 117. In *Powers v. Ohio*, for example, the Court acknowledged that "individual jurors subjected to racial exclusion have the legal right to bring suit on their own behalf," but it explained that "these challenges are rare" and excluded jurors face various structural and practical barriers to bringing suit. 499 U.S. at 414. Among these barriers, "[p]otential jurors are not parties to the jury selection process and have no opportunity to be heard at the time of their exclusion." Id. Additionally, "because of the small financial stake involved and the economic burdens of litigation," an improperly excluded juror "will leave the courtroom possessing little incentive to set in motion the arduous process needed to vindicate his own rights." Id. at 415. The Court found these hurdles, though surmountable, a sufficient hindrance to allow a criminal defendant standing to bring suit on the jurors' behalves. Id. at 416.

In *Singleton v. Wulff*, the Court permitted physicians standing to challenge a state law that interfered with their female patients' decision to have an abortion. 428 U.S. at 108. Among the obstacles the women faced in asserting their own rights, the Court noted a desire to maintain the privacy of their medical decisions and the "imminent mootness" of their suits. Id. at 117. Although the Court explained that "these obstacles are not insurmountable" and indeed offered its own solutions, including formation of a class action, the Court nonetheless found the obstacles sufficient to allow third-party standing in this case. Id. at 117–18.

Though the Court has indicated that both a close relationship and hindrance to the assertion of rights are conditions required for third-party standing, the Court has sometimes foregone discussion of the latter "hindrance" requirement altogether. In *Pierce v. Society of Sisters*, for example, the Court concluded that a parochial school had standing to challenge a state law that required parents to send their children to public schools. 268 U.S. 510, 535–36 (1925). The Court described the injury to the legal rights of parents as being closely interwoven with the financial injury the parochial school could incur, but the Court did not discuss whether any barriers existed to the parents asserting their own rights. See id. at 536 ("Plaintiffs asked protection against arbitrary, unreasonable and unlawful interference with their patrons and the consequent destruction of their business and property."). Indeed, it is difficult to imagine any real hurdle, insurmountable or not, to the parents bringing suit.

79. *Singleton*, 428 U.S. at 116.

80. *Joseph H. Munson Co.*, 467 U.S. at 956.

81. *Kowalski*, 543 U.S. at 130.

ships—like that of trust and trustee—are present[82] and, in a handful of cases, has allowed third-party standing even when such legal relationships were absent.[83] In *Craig v. Boren*, for example, beer vendors were allowed standing on behalf of male customers to challenge a state law that allowed women to purchase beer at a younger age than men.[84] Similarly, in *Caplin & Drysdale, Chartered v. United States*, a law firm was permitted standing on behalf of its client to challenge a statute relating to drug forfeiture.[85]

3. *Statutory Standing*. — Statutes may also impose more tailored standing requirements beyond the broad constitutional requirements articulated in *Lujan* and the Court's prudential considerations.[86] In enacting laws, Congress cannot alter or diminish Article III's standing requirements.[87] However, while Congress cannot *remove* the injury-in-fact requirement,[88] it can nonetheless define or broaden a category of injury that may be alleged in support of standing[89] and "grant an express right of action to persons who otherwise would be barred by prudential standing rules."[90] Accordingly, as long as the Article III requirements are met, "persons to whom Congress has granted a right of action . . . may have standing to seek relief on the basis of the legal rights and interests of

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82. See Sprint Commc'ns Co. v. APCC Servs., Inc., 554 U.S. 269, 287–88 (2008) (explaining "federal courts routinely entertain suits" by third parties, as where "[t]rustees bring suits to benefit . . . trusts; guardians ad litem bring suits to benefit . . . wards; receivers bring suit to benefit . . . receiverships; assignees in bankruptcy bring suit to benefit bankrupt estates; [and] executors bring suit to benefit testator estates").

83. See *Pierce*, 268 U.S. at 535–36 (permitting parochial school to assert constitutionally protected rights of schoolchildren's parents where state law required public school attendance).

84. 429 U.S. 190, 192–95 (1976).

85. 491 U.S. 617, 623 n.3 (1989).

86. See, e.g., Ross v. Bank of Am., N.A., 524 F.3d 217, 224–25 (2d Cir. 2008) ("Antitrust standing demands a much more detailed and focused inquiry into a plaintiff's antitrust claims than constitutional standing.").

87. Valley Forge Christian Coll. v. Ams. United for Separation of Church & State, Inc., 454 U.S. 464, 488 n.24 (1982) ("Neither the Administrative Procedure Act, nor any other congressional enactment, can lower the threshold requirements of standing under Art. III."); see Marbury v. Madison, 5 U.S. (1 Cranch) 137, 138 (1803) ("An act of congress repugnant to the constitution cannot become a law.").

88. Warth v. Seldin, 422 U.S. 490, 501 (1975).

89. Linda R.S. v. Richard D., 410 U.S. 614, 617 & n.3 (1973) ("Congress may enact statutes creating legal rights, the invasion of which creates standing, even though no injury would exist without the statute."); see also Lujan v. Defenders of Wildlife, 504 U.S. 555, 578 (1992) ("'[Statutory] broadening [of] the categories of injury that may be alleged in support of standing is a different matter from abandoning the requirement that the party seeking review must himself have suffered an injury.'" (alterations in original) (quoting Sierra Club v. Morton, 405 U.S. 727, 738 (1972))).

90. *Warth*, 422 U.S. at 501.

others, and, indeed, may invoke the general public interest in support of their claim."[91]

Trademark law defines the trademark-registration process and provides a registrant with remedies should her statutory rights be infringed. Section 32 of the Lanham Act, for example, imbues the trademark registrant with a cause of action against anyone who, without her permission,

> 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.[92]

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91. Id.; see also Gladstone Realtors v. Vill. of Bellwood, 441 U.S. 91, 100 (1979) ("Congress may, by legislation, expand standing to the full extent permitted by Art. III . . . .").

92. 15 U.S.C. § 1114(1) (2012). Though this Note focuses on the remedies afforded trademark registrants under section 32 of the Lanham Act, trademark law's remedies are not solely open to those with registered marks, and the Supreme Court recently analyzed statutory standing under section 43(a) in Lexmark International, Inc. v. Static Control Components, Inc., 134 S. Ct. 1377 (2014).

Section 43(a) of the Lanham Act provides that "[a]ny person" may bring suit for false association or false advertising. 15 U.S.C. § 1125(a). In determining whether the party could bring a false advertising claim, the Supreme Court noted that "any person" could not be given its literal meaning; instead, statutory standing must be cabined by the zone-of-interests and proximate-cause requirements. *Lexmark*, 134 S. Ct. at 1388. Explaining that, presumptively, "a statutory cause of action extends only to plaintiffs whose interests 'fall within the zone of interests protected by the law invoked,'" the Court parsed the purpose of the Lanham Act, as conveyed in section 45 of the Act:

> The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.

Id. at 1388–89 (quoting 15 U.S.C. § 1127) (internal quotation marks omitted). The Supreme Court's precise articulation of the proper parties to bring suit under section 43 is of little assistance in defining "legal representative" given the differences between sections 43 and 32. Compare id. at 1395 ("To invoke the Lanham Act's cause of action for false advertising, a plaintiff must plead (and ultimately prove) an injury to a commercial interest in sales or business reputation proximately caused by the defendant's misrepresentations."), with La Quinta Worldwide LLC v. Q.R.T.M., S.A. de C.V., 762 F.3d 867, 874 (9th Cir. 2014) ("To show trademark infringement, a plaintiff must establish ownership of a trademark and a likelihood of consumer confusion."). Nonetheless, the *Lexmark* Court's determination that a party must fall within the zone of interests protected by the Lanham Act—and that those protected interests reside in section 45 of the Act—does serve as an important limitation on who can bring suit under the Lanham Act generally. See Ahmed v. Hosting.com, No. CIV.A. 13-13117-WGY, 2014 WL 2925292, at *6 (D. Mass. June 27, 2014) ("As the Supreme Court noted, the Lanham Act's thorough

By defining registrant to encompass a legal representative and others,[93] Congress extended this remedy for trademark infringement to parties other than the registrant herself and, in doing so, laid a path for third parties to appear before federal courts.

II. HERE, THERE, AND EVERYWHERE—COURTS' VARIOUS INTERPRETATIONS OF "LEGAL REPRESENTATIVE"

While Part I explained the Lanham Act's statutory standing requirements and the historical context in which they emerged, Part II explores the federal courts' often ambiguous, and sometimes conflicting, conceptions of a legal representative. Following an examination of district court decisions in Part II.A, this Note turns to the Second Circuit's decision in *Federal Treasury Enterprise Sojuzplodoimport v. SPI Spirits Ltd.* in Part II.B. Finally, Part II.C critically examines the Second Circuit's "legal representative" definition and considers ramifications for rightsholders.

A. *District Courts' Interpretation of "Legal Representative"*

In 1975, district courts first began to wrestle with the meaning of "legal representative" and, in doing so, to determine how constrained standing in trademark law ought to be. This Part begins with a broad examination of the relevant district court opinions in Part II.A.1, while Part II.A.2 explores the evolution of case law in the Ninth Circuit specifically and considers whether these opinions served as bellwethers, signaling a larger national movement toward stricter standing requirements. Finally, Part II.A.3 dissects the reasoning espoused by the district courts.

1. *Survey of District Court Opinions.* — The question of who ought to fall within the confines of a "legal representative" has been answered in a variety of ways by district courts, ranging from the permissive definition afforded the State of Idaho in 1975 to the extremely inflexible and demanding definition imposed on a nonpracticing "collective enforcement" entity in 2004.

a. *Broadest Interpretation of "Legal Representative": Trademark Owner's Authorization Sufficient.* — The earliest exploration of "legal representative" by the courts produced an exceedingly broad and inclusive definition. In *Idaho Potato Commission v. Washington Potato Commission*, the Idaho Potato Commission, a state agency, brought suit for infringement of the trademark "Idaho," owned by the State of Idaho.[94] Though the State of Idaho had also been joined as a plaintiff, diversity jurisdiction

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statement of purpose leaves little question as to the protected interests under the statute . . . .").

93. See supra note 44 (explaining Lanham Act's "registrant" definition included "legal representatives").

94. 410 F. Supp. 171, 173 (D. Idaho 1975).

turned on whether or not the Idaho Potato Commission itself possessed the right to sue for infringement on the state's behalf.[95] The court looked to a state statute that empowered the Commission to "define and designate . . . distinctive marks under which said potatoes may be marketed" and "[w]henever and wherever [the Commission] deems it to be necessary . . . prevent the misrepresentation or misbranding of Idaho potatoes."[96] Relying upon *Black's Law Dictionary*, the court noted, "In its broadest sense, 'legal representative' means one who stands in the place of and represents another."[97] Because the statute delegated supervision and control of the mark's use and protection, the Idaho Potato Commission "st[ood] in the place of and represent[ed] the interests of the State of Idaho in guarding against infringement of the trademark 'Idaho'" and thus constituted a legal representative according to the district court.[98]

Following the 1976 *Idaho Potato Commission* decision, a handful of other courts showed similar flexibility in defining a trademark owner's legal representative, though they offered limited insight into their reasoning. In both *Schweitzz Distribution Co. v. P & K Trading Inc.*[99] and *Pelc v. Nowak*,[100] the courts appeared to rely upon the close relationship of the plaintiff and trademark owner, as well as the latter's clear authorization. In *Schweitzz Distribution*, the trademark owner was Kyung Yong Ho, a South Korean citizen who served as president of Schweitzz Distribution Company.[101] "It is undisputed that Ho is the president of SDC," the court declared, and "[a]lthough there is no evidence that Ho has formally assigned the URUSO mark to SDC, there is no basis whatever for concluding that SDC should not be considered Ho's legal representative."[102] Offering no further analysis, the court concluded that the plaintiff was entitled to bring suit to protect the trademark.[103]

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95. See id. at 173–74 (explaining "state is not a citizen for diversity purposes" and diversity jurisdiction thus turned on whether agency constituted "real party in interest").

96. Id. at 174 (quoting Idaho Code § 22-1207). The *Idaho Potato Commission* court noted that Federal Rule of Civil Procedure 17(a) bolstered its conclusion since "[a] party authorized by statute may sue in its own name without joining the party for whose benefit the action is brought." Id. Although the Idaho Potato Commission could bring suit independently of the state, joinder offered defendants "protection from a subsequent suit arising from the same set of facts." Id.

97. Id. (citing Black's Law Dictionary 1041 (rev. 4th ed. 1966)).

98. Id. This broad definition has been embraced by courts outside of the trademark context as well. For example, in *Mobay Chemical Co. v. Hudson Foam Plastics Corp.*, the court explained that "[a] 'legal representative' is one 'who stands in the place and stead of' another, such as an heir at law." 277 F. Supp. 413, 416 (S.D.N.Y. 1967) (quoting Ingerton v. First Nat'l Bank & Trust Co. of Tulsa, 291 F.2d 662, 664 (10th Cir. 1961)).

99. No. 93 CV 4785(NG), 1998 WL 472505 (E.D.N.Y. July 16, 1998).

100. No. 8:11-CV-79-T-17TGW, 2011 WL 4481571 (M.D. Fla. Sept. 27, 2011).

101. *Schweitzz Distribution*, 1998 WL 472505, at *1.

102. Id. at *2.

103. Id.

Similarly, in *Pelc v. Nowak*, neither plaintiff corporation Advantage Trim & Lumber of Florida, Inc. nor the individual plaintiffs, Betty and Robert Pelc, owned the trademarks at issue.[104] The registered owner of the marks was in fact Advantage Trim Lumber Company, Inc., a distinct New York corporation[105] also operated by the Pelcs.[106] Noting simply that "Plaintiffs have filed an affidavit attesting that Plaintiffs are legal representatives of Advantage Trim & Lumber Company, Inc.," the court found adequate basis for standing and denied the defendant's motion to dismiss.[107]

Though the rationale underpinning these decisions is unclear, in both *Schweitzz Distribution* and *Pelc* the interests of the trademark owner and the declared legal representative are unquestionably aligned. There is, however, no evidence that necessity—rather than convenience, choice of forum, and the depth of the plaintiff's pockets—prompted the strategic decision for the legal representative to bring suit in lieu of the mark's owner.

b. *Narrowing the Focus: Requiring Contractual Conveyance of Rights to Legal Representative.* — The most common setting for a "legal representative" analysis to arise, however, is where the plaintiff and the trademark owner have entered into a licensing agreement that affords the ostensible representative rights to the mark shy of a full assignment.[108] In the 1980s and 1990s, district courts in the Second, Fifth, and Ninth Circuits offered definitions of "legal representative" which turned on the rights expressly afforded the plaintiff by contract, but they did not appear to require the contracts to convey *exclusive* enforcement rights.

In *Silverstar Enterprises, Inc. v. Aday*, a case arising in the Second Circuit, a license agreement between the trademark owner and the plaintiff provided that the "Licensor hereby grants to Licensee the right to institute legal proceedings in the name of Licensor" in order "to prevent

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104. *Pelc*, 2011 WL 4481571, at *2.

105. Id.

106. Motion to Dismiss or to Transfer Venue or in the Alternative a Motion for More Definite Statement and Incorporated Memorandum of Law at 4, *Pelc*, 2011 WL 4481571 (No. 8:11-CV-79-T-17TGW), 2011 WL 882187.

107. *Pelc*, 2011 WL 4481571, at *2.

108. An assignment of rights takes place when a trademark owner, divesting itself of ownership, transfers ownership of the mark to another who is thereby empowered to exercise all of the rights and duties that accompany full ownership. 2 Anne Gilson Lalonde & Jerome Gilson, Gilson on Trademarks § 6.01[2] (2014). In contrast, a license simply grants the licensee permission to use the mark in a manner that would otherwise infringe the trademark owner's rights; it does not transfer the entire interest in the trademark. Id. Although "[o]ne might assume that an exclusive licensee would be equivalent to an assignee where the parties' agreement excluded even the licensor from using the licensed mark," an exclusive license will not be regarded as an assignment where certain restraints on the licensee's ability to use the mark (such as restricting the licensee to a particular geographic territory) exist or where certain duties remain with the licensor (such as maintaining the trademark's registration). Id.

the unauthorized sale or distribution" of licensed products, with such litigation financed by the licensor.[109] Though the court's holding did not ultimately turn on this provision, the court acknowledged in a footnote that the contract "does place certain rights to sue with the Licensee" and, therefore, "it is remotely conceivable that [trademark owner] MLE designated [plaintiff] Silverstar as its legal representative, as defined in [section 45], for the purposes of bringing an action under the Lanham Act."[110]

While the *Silverstar Enterprises* court offered only a tepid endorsement of nonexclusive enforcement rights justifying a "legal representative" finding, a district court in the Ninth Circuit found the plaintiffs to be legal representatives on just such grounds. In *Quokka Sports, Inc. v. Cup International Ltd.*, the court determined that "Quokka, by virtue of its license with [trademark owner] AC 2000, and with AC 2000's consent, has the authority to maintain this action and to act as the legal representative of ACPI and AC 2000."[111] Specifically, the Amended Complaint explained that the mark's owners "granted to Quokka the right and authority, subject to [the trademark owners'] prior approval, to take all necessary actions, including legal action, to prevent any third party from using the Marks as an Internet domain name or claiming to be an official America's Cup web site" and to represent the trademark owners' interests in the process.[112] Though Quokka was granted the exclusive license to *use* the marks in establishing the official America's Cup website,[113] neither the court's decision nor the Amended Complaint suggests that Quokka was granted an exclusive right to *enforce* the trademarks or that the trademark owner divested itself of the same right.[114] Though the trademark owners continued to exert control over enforcement, the court nonetheless found that Quokka had standing.[115]

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109. 537 F. Supp. 236, 240 n.4 (S.D.N.Y. 1982).

110. Id.

111. 99 F. Supp. 2d 1105, 1115 (N.D. Cal. 1999).

112. First Amended Complaint ¶ 19, *Quokka Sports*, 99 F. Supp. 2d 1105 (No. C-99-5076-DLJ), 1999 WL 33644473 [hereinafter *Quokka Sports* Complaint].

113. See id. ("ACPI and the organizer of the America's Cup 2000 race, AC 2000 Limited ('AC 2000'), have granted Quokka the exclusive license to establish and operate the official Internet website for the America's Cup and to use the Marks as an Internet domain name for the official website.").

114. See *Quokka Sports*, 99 F. Supp. 2d at 1115 ("Quokka, by virtue of its license with AC 2000, and with AC 2000's consent, has the authority to maintain this action and to act as the legal representative of ACPI and AC 2000."); *Quokka Sports* Complaint, supra note 112, ¶ 19 ("ACPI and AC 2000 have granted to Quokka the right and authority, subject to ACPI's and/or AC 2000's prior approval, to take all necessary actions, including legal action, to prevent any third party from using the Marks as an Internet domain name . . . .").

115. *Quokka Sports*, 99 F. Supp. 2d at 1114–15.

A third case of note is *National Football League Properties v. Playoff Corp.*[116] In its brief refutation of the defendant's challenge to standing, the court explained that the plaintiff had standing thanks to a license agreement which rendered the plaintiff the exclusive licensing representative of the trademarks and "clearly contemplate[d] that Plaintiff *may* bring suit against infringers of [such] marks."[117] The court's language suggests that, even where a contract does not expressly convey enforcement rights to a plaintiff—let alone *exclusive* enforcement rights—a licensee may nonetheless have standing where other trademark rights are provided by contract.

c. *Raising the Bar: Requiring Contractual Conveyance of Exclusive Enforcement Rights to Legal Representative.* — Other district courts have imposed more stringent requirements upon plaintiffs declaring themselves legal representatives by virtue of their contractual arrangements with trademark owners. In the Eighth Circuit, a district court concluded that a plaintiff could not be considered the trademark owner's legal representative because its agreement did "not give [plaintiff] the *exclusive right* to sue for infringement" of the trademarks; "rather, the agreement require[d] [plaintiff] to pursue enforcement in accordance with [the trademark owner's] instructions."[118] The court thus cabined the "legal representative" designation to situations where the trademark owner divested itself of enforcement rights and control over litigation, with both granted exclusively to the legal representative.

In *Visa U.S.A., Inc. v. First Data Corp.*, the court similarly voiced a requirement that a legal representative be expressly granted exclusive enforcement rights amid concern that the defendant could otherwise face multiple suits for the same actions.[119] The plaintiff in *Visa* claimed standing on several grounds, including that it was a licensee of the marks and had received written authorization from the trademark owner to file the suit at hand.[120] Citing *Silverstar Enterprises* and *Idaho Potato Commission*, the court asserted that "[a] licensee may be considered a legal representative where the agreements between the parties expressly provide the licensee with a right and duty to sue on all issues relating to the trade-

116. 808 F. Supp. 1288 (N.D. Tex. 1992). Although the court never explicitly invokes the "legal representative" language of the Lanham Act, the court's conclusion that standing exists nonetheless springs from the term, as the relationship between plaintiff and the trademark owner falls within no other category of "registrant." See id. at 1291 n.2 (finding standing exists without invoking "legal representative" language).

117. Id. at 1291 n.2 (emphasis added). According to the court, "[t]he member clubs of the NFL, owners of the marks, have granted to the NFL Trust *all* rights to the use of the NFL marks." Id. (emphasis added). In contrast, the court asserts no comparable exclusive right with respect to enforcement of the marks and notes simply that "Plaintiff has the right to enforce the marks pursuant to a license agreement with the NFL Trust." Id.

118. Kia Motors Am., Inc. v. Autoworks Distrib., No. 06-156 DWF/JJG, 2007 WL 4372954, at *3 n.4 (D. Minn. Dec. 7, 2007).

119. No. C 02-01786 JSW, 2005 WL 6271242, at *4, *6 (N.D. Cal. Aug. 16, 2005).

120. Id. at *2, *4.

mark."[121] Noting that "Visa International ha[d] not relinquished its . . . enforcement rights to Visa, U.S.A.," the court found that the plaintiff could not "maintain standing to sue as a legal representative because it d[id] not have exclusive enforcement rights to the disputed marks."[122] Moreover, the court declared that the plaintiff could not maintain legal representative status solely to ensure itself standing in such a limited circumstance.[123]

d. *Erecting a Formidable Obstacle: Demanding the Trademark Owner Be Unable to Enforce Its Own Rights.* — A different, but equally restrictive, definition of "legal representative" was forged by a district court in the Ninth Circuit in *National Licensing Ass'n v. Inland Joseph Fruit Co.*[124] A self-described "collective enforcement" entity, National Licensing Association had been assigned the right to sue for infringement of various patents and trademarks, while others retained the remaining rights of ownership.[125] Without acknowledging the unusual circumstances of the case, the *National Licensing Ass'n* court declared that the "ordinary meaning of the term" "legal representative" is "one who appears on behalf of a party *who is otherwise unable or incapable of doing so*, for example by a guardian of a minor or an administrator of an estate."[126] Although the trademark owners had irrevocably assigned to National Licensing Association (rather than merely licensed) the right to sue for infringement, the court nonetheless concluded that the plaintiff failed to meet this definition.[127] Accordingly, the definition of "legal representative" imposed by *National Licensing Ass'n* appears even more stringent than those requiring that a legal representative be afforded exclusive enforcement rights.

Of the many cases evaluating "legal representative," *National Licensing Ass'n* appears to be the only one in which a trademark-infringement suit was brought by a nonpracticing entity—one that merely aggregates intellectual-property rights for the sake of licensing the intellectual property or enforcing their rights against others.[128] Despite

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121. Id. at *4.

122. Id.

123. Id.

124. 361 F. Supp. 2d 1244 (E.D. Wash. 2004).

125. Id. at 1246.

126. Id. at 1255.

127. Id. The court additionally concluded that a "recipient of nothing more than the bare claims for trademark infringement cannot bring suit for trademark infringement" under section 32 of the Lanham Act; to do so, the plaintiff must instead have some ownership interest in the trademark. Id. at 1256.

128. Sannu K. Shrestha, Note, Trolls or Market-Makers? An Empirical Analysis of Nonpracticing Entities, 110 Colum. L. Rev. 114, 115 (2010) (defining nonpracticing entities (NPEs) as "firms that rarely or never practice their patents, instead focusing on earning licensing fees" and explaining "NPEs may have patented these inventions on their own or may have bought the patents from other inventors"). As Shrestha explains, NPEs have generated fierce debate about whether such firms damage or drive innovation:

the case's unusual facts and the novelty of imposing such a stringent definition of "legal representative" in the Lanham Act context, the court clothed its reasoning in language that evoked normalcy and historical grounding. It rooted its legal representative definition in the "*obvious* intention to limit trademark infringement suits" to those with ownership interests in the mark, the "*historically* restrictive interpretation given to 'registrant,'" and "the *ordinary* meaning of the term" legal representative.[129] In contrast, it deemed the plaintiff's argument for broad standing as a legal representative "unique" and requiring a "novel construction of the term."[130] Noting that "unusual facts sometimes demand unusual approaches," the court in fact cited *Idaho Potato Commission* as one such aberration.[131]

Subsequently, a district court in the Second Circuit appeared to construct a bridge between *National Licensing Ass'n* and those cases requiring that a legal representative be granted exclusive enforcement rights to a mark. In *Krasnyi Oktyabr, Inc. v. Trillini Imports*, plaintiff Krasnyi Oktyabr had assigned trademarks to United Confectioners; in turn, United Confectioners had provided Krasnyi Oktyabr with oral authorization to bring infringement claims on its behalf.[132] After acknowledging *National Licensing Ass'n*'s interpretation of a legal representative's "ordinary meaning," the *Krasnyi Oktyabr* court immediately departed from it by declaring the ordinary meaning of legal representative to simply be one who "act[s] 'on behalf' of another."[133] However, because a legal representative may only recover for damages incurred by a trademark owner and because the plaintiff failed to adequately allege such harm, the court found that the plaintiff did not meet the constitutional injury-in-fact requirement for standing.[134]

> Critics have labeled NPEs "patent trolls" and claim that they use weak and vague patents to threaten product manufacturers and extract excessive licensing fees or engage in frivolous infringement litigation. On the other hand, these firms and their supporters claim that NPEs enhance innovation and competition by providing capital to independent inventors and creating an efficient market for trade in technological information.

Id. at 115–16.

129. *Nat'l Licensing Ass'n*, 361 F. Supp. 2d at 1255 (emphasis added).

130. Id.

131. Id. & n.11.

132. 578 F. Supp. 2d 455, 462, 466 (E.D.N.Y. 2008).

133. Id. at 464.

134. As the court in *Silverstar Enterprises, Inc. v. Aday* explained, where a plaintiff's "interest in the trademark arises solely from the contractual relationship between it and [the trademark owner], . . . such interest is secondary to the registrant's. Any right [the plaintiff licensee] may have to sue under the Lanham Act, *a fortiori*, is derivative of the rights of the registrant . . . ." 537 F. Supp. 236, 240–41 (S.D.N.Y. 1982). A plaintiff's "only standing under the Lanham Act would be on behalf of [the trademark owner] to enforce the trademark owner's proprietary rights." Id. at 241. Therefore,

Though it was unnecessary for the *Krasnyi Oktyabr* court to further expound upon "legal representative" requirements, it nonetheless offered an alternative reason that the plaintiff failed to meet statutory standing requirements. Channeling *National Licensing Ass'n*, the *Krasnyi Oktyabr* court explained that, "[e]ven if plaintiff could demonstrate damages incurred by United Confectioners, its standing claim still fails because it has not provided a reason why United Confectioners, the real party at interest, cannot participate in the litigation."[135] Contrary to *National Licensing Ass'n*, however, the *Krasnyi Oktyabr* court suggested that the grant of exclusive enforcement rights to the plaintiff is sufficient to render the trademark owner unable to participate in litigation and thus to empower the plaintiff to bring suit as a legal representative.[136] In contrast, mere authorization to bring suit, as claimed by plaintiff Krasnyi Oktyabr, "does not prevent United Confectioners from bringing a further claim against defendants or any subsequent infringers" and was deemed inadequate for purposes of standing by the court.[137]

2. *A Closer Look at the Ninth Circuit.* — Although the law surrounding the meaning of "legal representative" suffers from disparate definitions, the four influential district court cases of the Ninth Circuit—*Idaho Potato Commission*, *Quokka Sports*, *National Licensing Ass'n*, and *Visa*—suggest an increased willingness to cabin the "legal representative" definition over time and perhaps served as a harbinger of the Second Circuit's decision in 2013. In 1976, *Idaho Potato Commission* posited the widest possible definition of legal representative: "one who stands in the place of and

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> [t]o the extent that [an agreement] confers upon Plaintiff the right to bring an infringement claim with respect to the licensed marks . . . [as] in the capacity of [trademark owner's] "legal representative," Plaintiff may do so only insofar as such a claim is consistent with [trademark owner's] asserted interest in the licensed marks.

G & F Licensing Corp. v. Field & Stream Licenses Co., No. 09 Civ. 10197(LTS)(GWG), 2010 WL 2900203, at *4 (S.D.N.Y. July 16, 2010) (citation omitted).

In keeping with this reasoning, where a licensee has claimed standing as a trademark owner's legal representative in order to bring suit against the trademark owner itself, the court will dismiss the claims as contrary to the trademark owner's interests. See id. ("'It strains credulity that [the trademark owner] intended to [facilitate] a lawsuit by [the licensee] against itself' or its (other) licensees, on behalf of itself as the owner of the marks at issue." (second alteration in *G & F Licensing*) (quoting *Silverstar*, 537 F. Supp. at 240 n.4)); *Silverstar*, 537 F. Supp. at 240 ("Even assuming Silverstar has standing to maintain an infringement action under [section 32 of the Lanham Act], it does not have standing to maintain such an action against the registrant.").

135. 578 F. Supp. 2d at 465.

136. See id. at 466 ("[W]hile at one time plaintiff may have had exclusive rights to sue for infringement against the Krasnyi Oktyabr trademarks, it is undisputed that in 2005 plaintiff assigned the trademarks including all potential infringement claims for the Krasnyi Oktyabr trademarks to United Confectioners.").

137. Id.

represents the interests of another."[138] In 1999, *Quokka Sports* adopted a similarly accommodating "legal representative" definition in entertaining the idea that a contract's nonexclusive enforcement right provided the plaintiff with sufficient authority to act as legal representative.[139] Responding to claims of a nonpracticing entity, *National Licensing Ass'n*, in 2004, rejected third-party representation of a trademark owner unless the owner itself was unable to bring suit, a status which was not satisfied even by assignment of the trademark owner's enforcement right.[140] *Visa*, however, seemed to represent a moderating step back in the other direction, as the court determined that grant of an exclusive enforcement right would suffice to render the trademark owner unable to represent itself and thus afford its licensee the opportunity to sue as a legal representative.[141]

The shift in the Ninth Circuit between 1999 and 2004 resonated throughout the federal courts, with all but one district court thereafter requiring that a plaintiff—at minimum—be granted exclusive enforcement rights in order to proceed as a legal representative.[142] Perhaps not coincidentally, the term "patent troll" was coined during the same period and reflected growing concern over the harm nonpracticing entities posed to potential innovators, as they sought to exploit intellectual-property enforcement rights while yielding no benefit to the public.[143]

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138. 410 F. Supp. 171, 174 (D. Idaho 1975) (citing Black's Law Dictionary 1041 (rev. 4th ed. 1966)).

139. See 99 F. Supp. 2d 1105, 1114–15 (N.D. Cal. 1999) (finding licensee, acting with permission of trademark owner, could bring suit as legal representative).

140. 361 F. Supp. 2d 1244, 1255 (E.D. Wash. 2004).

141. No. C 02-01786 JSW, 2005 WL 6271242, at *4 (N.D. Cal. Aug. 16, 2005).

142. See supra notes 104–107, 118–123, 132–137 and accompanying text (describing post-2004 decisions in *Pelc, Kia Motors*, *Visa*, and *Krasnyi Oktyabr*); infra notes 166–175 and accompanying text (detailing district court opinion in *Sojuzplodoimport*).

143. See Mark A. Lemley, Are Universities Patent Trolls?, 18 Fordham Intell. Prop. Media & Ent. L.J. 611, 613 n.2 (2008) ("The term 'patent troll' was coined in the late 1990s by Peter Detkin, then assistant general counsel at Intel, to refer to patent owners who hide under bridges they did not build to pop out and demand money from surprised passers-by."). There are, of course, notable differences between a patent troll and an ostensible legal representative; in particular, a patent troll that is assigned the intellectual property at issue is unquestionably afforded standing to sue for patent infringement. See Steven Walker, Challenging a Plaintiff's Right to Sue for Patent Infringement: The Affirmative Defense of Standing, 20 Intell. Prop. & Tech. L.J. 17, 17 (2008) ("If a patentee transfers the patent's legal title to a third party by assignment, the third-party assignee has standing because it is deemed the 'effective patentee' under 35 U.S.C. § 281.").

However, the suggestion above is not that *National Licensing Ass'n* mistook the plaintiff for a patent or trademark troll. Indeed, there are convincing arguments that trademark trolls cannot actually exist. See e.g., David H. Bernstein & Andrew Gilden, No Trolls Barred: Trademark Injunctions After *eBay*, 99 Trademark Rep. 1037, 1064–65 (2009) (arguing "there is no such thing as a 'trademark troll'" and "[i]f a trademark owner were to engage in the activities associated with patent trolls—non-use or naked licensing of the mark—it likely would result in the forfeiture of all trademark rights"); Thomas J. Speiss, III & Cary Tope-McKay, Taking a Page from the "Patent Troll" Playbook, Leo Stoller

The *National Licensing Ass'n* court confronted a particularly brazen breed of nonpracticing entity; the plaintiff wished to assert both patent- and trademark-infringement claims without even offering the pretense that it might put to productive use the intellectual property at issue, as it had been assigned only enforcement rights.[144] Reacting—or perhaps overreacting—to the facts before it, the *National Licensing Ass'n* court crafted a definition which unequivocally foreclosed trademark-infringement suits by nonpracticing entities granted only the right to sue.[145] In doing so, the court may have placed restrictions on the "legal

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Attempted to Invent a Similar Trademark-Based Business Model, IPL Newsl., Spring 2007, at 1, 6 ("Although there is no theoretical barrier to the creation of a trademark-based trolling model analogous to that used by 'patent trolls,' U.S. trademark law presents a substantial legal hurdle that is not present in U.S. patent law: the requirement of actual use.").

Instead, this Note suggests that increasingly vocal concerns about patent-troll litigation in the late 1990s and early 2000s may have inspired an unusually strong reaction by the *National Licensing Ass'n* court against the plaintiff's assertion of standing. This idea finds support in the court's statement that "the court is not convinced . . . Congress ever intended the scope of the term 'legal representative' in this context to embrace *an entity such as the NLA*." 361 F. Supp. 2d at 1255 (emphasis added).

144. 361 F. Supp. 2d at 1246.

145. Id. at 1256 ("Given the nature of trademarks, the statutory provisions on assignment of trademark rights, and the analogous rules in patent law described above, the court finds that NLA as the recipient of nothing more than the bare claims for trademark infringement cannot bring suit for trademark infringement.").

In considering the appropriate definition for "legal representative" generally, patent law may serve as a useful foil. Though broadly classified as "intellectual-property law," patent, copyright, and trademark statutes define standing to bring a suit for infringement differently. Title 35 provides that "[a] patentee shall have remedy by civil action for infringement of his patent." 35 U.S.C. § 281 (2012). The law's definition of "patentee" encompasses "not only the patentee to whom the patent was issued but also the successors in title to the patentee." Id. § 100(d). Meanwhile, copyright law provides that "[t]he legal or beneficial owner of an exclusive right under a copyright is entitled . . . to institute an action for any infringement of that particular right committed while he or she is the owner of it." 17 U.S.C. § 501(b) (2012). In contrast, trademark law offers standing to a conspicuously greater range of persons by providing that infringers "shall be liable in a civil action by the registrant," 15 U.S.C. § 1114(1) (2012), with "registrant" broadly drawn to include the registrant's "legal representatives, predecessors, successors and assigns," id. § 1127.

National Licensing Ass'n explains that, despite the Patent Act's language granting standing to "the patentee," courts have concluded that the patentee's assignees fall comfortably within this definition. 361 F. Supp. 2d at 1250. In very particular situations, licensees may also be afforded standing:

> [T]he Federal Circuit has held one to whom *all* substantial rights under the patent have been transferred in the form of an exclusive license qualifies as a "virtual assignee," and is permitted to bring an infringement suit in its own name. An exclusive licensee *without* all substantial rights in the patent has standing to sue third parties only as a co-plaintiff with the patentee. Finally, one with no interest in the patent or a nonexclusive licensee (otherwise known as a "bare licensee") has no constitutional standing under the Patent Act to bring suit or even join a suit with the patentee because this party suffers no legal injury from infringement.

Id. (footnotes omitted) (citations omitted). For a nuanced discussion of the evolution of patent law's standing requirements and licensee standing specifically, see Roger D. Blair &

representative" term that, when applied universally and beyond the unique facts of *National Licensing Ass'n*, are in fact in tension with the goals of the Lanham Act's framers.[146]

3. *The Rationale Undergirding the District Court Opinions.* — Those courts applying definitions of "legal representative" that afford broad

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Thomas F. Cotter, The Elusive Logic of Standing Doctrine in Intellectual Property Law, 74 Tul. L. Rev. 1323, 1336–65 (2000).

If patent law's standing rules applied in the trademark context, a legal representative with nothing more than the trademark owner's authorization to sue or a nonexclusive license to the mark could not bring claims. An exclusive licensee, with insufficient rights to claim an assignment of the mark, could indeed bring suit under the patent regime—but only if the trademark owner were joined.

While at first blush the patent regime would seem to condemn a broad "legal representative" definition, it is important to remember that the Patent Act—unlike the Lanham Act—does not expressly afford standing to the legal representative of a rightsholder. See 35 U.S.C. § 281 (affording "patentee" standing). The circle of parties who may bring trademark-infringement claims is, by definition, much wider.

The divergent purposes of patent and trademark law similarly support the conclusion that trademark standing should not be so circumscribed. See Bernstein & Gilden, supra note 143, at 1038–39 ("Although trademark, patent and copyright laws are all forms of rights in intangible property, the rationales underlying trademark protection are sufficiently distinct from those motivating patent and copyright protections that principles applicable in one type of intellectual-property law are not necessarily appropriate in another."); Blair & Cotter, supra, at 1380 ("[P]atent and copyright laws are usually viewed as means for achieving a socially optimal level of innovation, whereas the principal goal of trademark law is to lower consumer search costs."). The patent monopoly and right to bring suit for infringement is limited to a period of years, with the benefit to the public principally accruing after the patent owner's monopoly has ended and the work enters the public domain. See Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 429 (1984) (explaining patent owner's limited monopoly "is a means by which an important public purpose may be achieved" as it stimulates inventors' creativity and "allow[s] the public access to the products of their genius after the limited period of exclusive control has expired"). The public's interest in a patent-infringement suit is, therefore, quite limited. While protection of a patent owner's monopoly may indirectly encourage more investment in innovation and thus benefit the public in an attenuated manner, the public may in fact *benefit* from infringement of a patent in the short term as the invention becomes more widely available at a lower cost.

In stark contrast, trademark law's primary purpose is consumer protection—namely, to "protect[] the public against the confusion and deception of unfettered use of similar marks by competitors." Jay Dratler, Licensing of Intellectual Property § 1.02[1], at 1–10 (2014); see Bernstein & Gilden, supra note 143, at 1038–39 ("Patent and copyright protections are designed to be a trade-off between incentivizing innovation and creativity on one hand, and public access to the fruits of such labor on the other. Trademark law does not entail such a direct balance between individual gain and the public interest . . . ."). The trademark owner's suit functions as a public service, as the registrant—but not the consumer—is granted the opportunity to bring suit and enjoin the infringer's unlawful actions. Permitting a broader definition of "legal representative" in section 32 would thus more clearly serve the public's interest. See Blair & Cotter, supra, at 1380 ("Since the ultimate beneficiaries of trademark rights are not trademark owners, a somewhat looser application of standing rules may fit the law of trademarks and unfair competition better than it would the law of patents and copyrights.").

146. See infra Part III.C (discussing Lanham Act framers' focus on international comity).

protection, regardless of exclusivity of enforcement rights or ability of the trademark owner to bring suit itself, offer little insight into the rationale behind their decisions and the benefits of flexible standing requirements in trademark law.[147] In contrast, those courts that impose more stringent "legal representative" definitions—and almost universally deny standing to plaintiffs—cite various concerns prompting their decisions.[148]

The most oft-cited concern is the potential for the defendant to face duplicative suits if both the trademark owner and its legal representative are empowered to bring infringement claims.[149] One court raised the related concern of the trademark owner being shielded from discovery where a legal representative is permitted to bring suit on its behalf.[150] These concerns, rather than being unique to trademark-infringement suits, could arise in any context where third-party standing is contemplated[151] and simply reflect courts' interest in prudent judicial administration.[152] Surprisingly, however, none of the district court opinions described above—whether offering broad or narrow "legal representative" definitions—indicated that constitutional or prudential standing requirements informed the contours of their definitions. This would change in 2011, as courts in the Second Circuit evoked the constitutional

147. See supra notes 94–107 and accompanying text (detailing courts' sparse analysis of "legal representative" meaning and application).

148. See supra notes 118–137 and accompanying text (cataloguing district court decisions in which application of "legal representative" required defendant to have exclusive right to commence infringement suits).

149. See Krasnyi Oktyabr, Inc. v. Trilini Imports, 578 F. Supp. 2d 455, 466 (E.D.N.Y. 2008) ("The authorization does not prevent United Confectioners from bringing a further claim against defendants or any subsequent infringers."); Visa U.S.A. Inc. v. First Data Corp., No. C 02-01786 JSW, 2005 WL 6271242, at *4 n.3 (N.D. Cal. Aug. 16, 2005) ("Visa International has not relinquished its rights to sue First Data for the same conduct upon which Visa, U .S.A. [sic] maintains its trademark infringement cause of action."); see also Idaho Potato Comm'n v. Wash. Potato Comm'n, 410 F. Supp. 171, 174 (D. Idaho 1975) (explaining joinder of trademark owner—while unnecessary under Federal Rules of Civil Procedure and Lanham Act—"provides defendants with protection from a subsequent suit arising from the same set of facts"). In both *Krasnyi Oktyabr* and *Visa*, this concern about subsequent, duplicative actions appeared to fuel the court's determination that plaintiff was not an "exclusive licensee" with respect to trademark-enforcement rights.

150. See *Krasnyi Oktyabr*, 578 F. Supp. 2d at 465 ("Plaintiff has neither demonstrated that defendants' case has not been impaired by their potential difficulty in obtaining discovery from United Confectioners, a foreign third-party, nor shown that United Confectioners cannot bring subsequent infringement claims against defendants.").

151. See, e.g., Sprint Commc'ns Co. v. APCC Servs., Inc., 554 U.S. 269, 291 (2008) (describing plaintiffs' concerns that affording standing to assignee could hinder discovery efforts and result in assignor failing to honor judgments of present action).

152. See supra notes 52–53 and accompanying text (outlining Supreme Court's justifications for standing doctrine, including importance of federal courts avoiding unnecessary adjudication of rights).

and prudential standing considerations in constructing their own "legal representative" requirements.[153]

B. *Second Circuit's Interpretation of "Legal Representative"*

The first circuit court to address the meaning of "legal representative" did so in *Federal Treasury Enterprise Sojuzplodoimport v. SPI Spirits Ltd.*, a suit resulting from the contested ownership of trademarks related to Stolichnaya vodka.[154] The Second Circuit explained that the Soviet Union had registered a trademark in "Stolichnaya" with the U.S. Patent and Trademark Office in the 1960s.[155] Amidst the collapse of the Soviet Union, Stolichnaya-related marks transferred hands numerous times, with the Russian Federation in the early 2000s—"through manifold legal and bureaucratic maneuvers"—assuming its rights to the Stolichnaya marks once again.[156] Because Russian law bars governmental bodies from conducting business activities, the Russian Federation subsequently chartered the Federal Treasury Enterprise Sojuzplodoimport ("FTE") to exploit the Stolichnaya trademarks on its behalf.[157]

Through FTE's charter and numerous decrees, the Russian Federation conferred rights upon FTE.[158] Without specifically citing the Stolichnaya marks, its charter authorized FTE to use, protect, and restore trademarks associated with Russian-manufactured alcoholic products.[159] Two later orders clarified the nature of FTE's authority.[160] A July 2002 decree authorized the state-chartered entity to "use and dispose (without the right to assign), in accordance with the procedure established by the Ministry of Agriculture, certain listed alcoholic and spirituous marks, including the Stolichnaya Mark."[161] A January 2005 decree, which responded to queries from foreign courts, sought to "confirm[] FTE's right to sue in foreign courts in its own name to protect or recover the Russian[] Federation's rights to trademarks for alcoholic products

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153. See infra notes 173–175 and accompanying text (noting district court's reliance upon constitutional standing principles); infra notes 185–188 and accompanying text (explaining Second Circuit's invocation of constitutional standing doctrine and injury-in-fact requirement in particular).

154. 726 F.3d 62, 67 (2d Cir. 2013), cert. denied, 134 S. Ct. 1291 (2014).

155. Id. McCarthy notes, "The connection between product quality and source identifying marks was impressed upon Soviet Union economic planners when they found that when consumer goods were sold without a 'production mark' the quality of the goods tended to decline." 1 McCarthy, supra note 1, § 2:4.

156. *Sojuzplodoimport*, 726 F.3d. at 67–68.

157. Id. at 68.

158. Id.

159. Id.

160. Id.

161. Id. at 69 (quoting July 2002 Decree) (internal quotation marks omitted).

[abroad]."[162] It explained that FTE was charged with representing "the interests of the Russian Federation in the courts on matters of recovery and protection of the rights of the Russian Federation to the marks for alcoholic products abroad, and . . . realiz[ing] registration of the rights of the Russian Federation to the mentioned trademarks abroad."[163]

In 2004, FTE initiated an infringement suit which, broadly, claimed that the defendants had misappropriated and made unauthorized commercial use of its registered Stolichnaya-related trademarks in the United States.[164] Though both the district court and the Second Circuit issued a number of intervening opinions in the case,[165] it was not until September 2011 that the district court first tackled the question of whether or not FTE had standing to bring trademark-infringement claims on behalf of the Russian Federation as its legal representative.[166]

In deciding whether or not FTE ought to be considered a legal representative, the district court examined the definitions of the term proposed by the parties. Echoing *National Licensing Ass'n*, the defendants argued that "legal representative" "should be limited to the ordinary meaning of the term of one who appears on behalf of a party who is otherwise unable or incapable of doing so."[167] Invoking instead *Idaho Potato Commission*, the plaintiff insisted that a legal representative "should include any legally authorized agent."[168]

Adopting the defendant's narrow interpretation of "legal representative," the district court concluded that

> a party qualifies as a legal representative under Section 32(1) of the Lanham Act if the party has the authority to appear on behalf of the registrant/owner with respect to the registrant/owner's legal interests *and* the registrant/owner is unable or incapable of representing itself and enforcing its own rights.[169]

Explaining that the trademark owner's permission to pursue the litigation was insufficient to render the plaintiff a legal representative, the court stated that "Plaintiff FTE must provide—and yet has failed to do

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162. Id. (alterations in original) (quoting Third Amended Complaint ¶ 140, Fed. Treasury Enter. Sojuzplodoimport v. Spirits Int'l B.V., No. 04 CV 08510(GBD) (S.D.N.Y. Feb. 22, 2011), 2011 WL 1230789) (internal quotation marks omitted).

163. Id. (quoting January 2005 Decree) (internal quotation marks omitted).

164. Id. at 66, 69.

165. Fed. Treasury Enter. Sojuzplodoimport v. Spirits Int'l N.V., 400 F. App'x 611 (2d Cir. 2010); Fed. Treasury Enter. Sojuzplodoimport v. Spirits Int'l N.V., 623 F.3d 61 (2d Cir. 2010); Fed. Treasury Enter. Sojuzplodoimport v. Spirits Int'l N.V., 425 F. Supp. 2d 458 (S.D.N.Y. 2006).

166. Fed. Treasury Enter. Sojuzplodoimport v. Spirits Int'l B.V., No. 04 CV 08510(GBD), 2011 WL 4005321 (S.D.N.Y. Sept. 1, 2011), aff'd, *Sojuzplodoimport*, 726 F.3d 62, cert. denied, 134 S. Ct. 1291 (2014).

167. Id. at *5.

168. Id.

169. Id.

so—an explanation of the need for it to pursue this litigation in its own name on behalf of the Russian Federation, which is the real party in interest whose alleged ownership rights are implicated by this action."[170] Being given no reason why the Russian Federation was unable to enforce its own rights, the court held that the plaintiff did not have standing as a legal representative.[171]

In justifying its "legal representative" interpretation, the court borrowed language from *National Licensing Ass'n* and claimed that its narrow "legal representative" definition was nothing more than "the plain and ordinary meaning of the term."[172] The court also justified its decision on constitutional grounds, as adoption of the "broad approach advocated by Plaintiff FTE would render superfluous the well-established legal distinction for standing purposes between an agent or representative and a legal representative."[173] In a footnote, the court explained that "[i]t is well-established law that a legal representative is different from a mere agent," with a simple agency relationship failing to satisfy the injury-in-fact requirement.[174] Citing the Second Circuit's decision in *W.R. Huff Asset Management Co. v. Deloitte & Touche LLP*, the court indicated that satisfaction of the injury-in-fact requirement required that, "at a minimum, 'the plaintiff have legal title to, or a property interest in, the claim.'"[175]

In 2013, the Second Circuit affirmed the district court's decision and largely adopted its "legal representative" definition.[176] The Second Circuit explained that, while "the phrase 'legal representative' may refer simply to '[o]ne who stands for or acts on behalf of another,'" its meaning is often more narrowly tailored, as where "a trustee [is] named to act on behalf of a party who, by law or agreement, is unauthorized to represent his own interests."[177] Grounding its decision in the Lanham Act's text and history, as well as constitutional standing requirements, the Second Circuit presented a narrow construction of "legal representative": "We thus conclude that to serve as a 'legal representative' entitled to bring suit under Section 32(1) on behalf of a trademark holder, a putative plaintiff must demonstrate *both* its legal authority to represent the owner and that the trademark holder is legally incapable of representing itself."[178]

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170. Id.

171. Id.

172. Id.

173. Id.

174. Id. at n.13.

175. Id. (quoting W.R. Huff Asset Mgmt. Co. v. Deloitte & Touche LLP, 549 F.3d 100, 108 (2d Cir. 2008)).

176. Fed. Treasury Enter. Sojuzplodoimport v. SPI Spirits Ltd., 726 F.3d 62, 66 (2d Cir. 2013), cert. denied, 134 S. Ct. 1291 (2014).

177. Id. at 80.

178. Id. at 80–82.

The Second Circuit drew support for its narrow "legal representative" definition from the text and structure of the Lanham Act.[179] The court contrasted section 32 of the statute, which empowers "registrant[s]" to bring trademark-infringement suits,[180] with section 43, which affords standing to "*any person* who believes that he or she is likely to be damaged" by a good or service's false description or designation of origin.[181] "To interpret the phrase 'legal representative' broadly would permit both the registrant of the trademark and his putative 'legal representative' to file separate suits against the same defendant for the same infringing act," the court explained.[182] Because this "result . . . seems inconsistent with Congress's stated intention to limit standing to the single 'registrant' of the trademark under Section 32(1) as opposed to the broad standing afforded plaintiffs suing under Section 43,"[183] the court determined that only a narrow interpretation would be in accordance with the language and intent of the Act.[184]

Similarly, the Second Circuit concluded that a broad definition, which granted standing to "'parties like FTE that have been given rights conferring control over trademarks ultimately owned by others,'" would prompt constitutional concerns.[185] The court's explanation of the constitutional injury-in-fact requirement for standing consisted of two sentences:

> In Huff we recognized that, consistent with Supreme Court precedent in *Sprint Communications Co. v. APCC Services,* . . . the "minimum requirement for an injury-in-fact is that the plaintiff have legal title to, or a proprietary interest in, the claim," even if that title was not originally held by the plaintiff but was received through an assignment made by the initial holder of the claim. We also recognized "a few . . . prudential exceptions to the 'injury-in-fact' requirement," . . . and we explained that these "exceptions permit third-party standing where the plaintiff can demonstrate (1) a close relationship to the injured party and (2) a barrier to the injured party's ability to assert its own interests" . . . .[186]

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179. Id. at 80 ("We must . . . look to the language and purposes of the Lanham Act to construe the phrase 'legal representative' for present purposes.").

180. Id. (alteration in original) (quoting 15 U.S.C. § 1127 (2012)) (internal quotation marks omitted).

181. Id. (quoting 15 U.S.C. § 1125(a)(1)) (internal quotation mark omitted).

182. Id.

183. For additional information about section 43, see supra note 2 (explaining section 43 provides remedy for false advertising and infringement of unregistered trademarks and trade dress); supra note 92 (detailing Supreme Court's determination of who may bring suit for false advertising under section 43).

184. *Sojuzplodoimport*, 726 F.3d at 80.

185. Id. (quoting Reply Brief for Plaintiffs-Appellants at 1, *Sojuzplodoimport*, 726 F.3d 62 (No. 11–4109–CV), 2012 WL 1573536).

186. Id. at 80–81 (citations omitted) (quoting W.R. Huff Asset Mgmt. Co. v. Deloitte & Touche LLP, 549 F.3d 100, 108–09 (2d Cir. 2008)).

According to the Second Circuit, the plaintiff's proposed definition of legal representative "would extend standing to parties whose sole interest in a trademark-infringement action is a contractually-derived right to bring the claim, without owning the claim or having been assigned the claim, even if the actual trademark owner is capable of bringing suit on her own behalf."[187] The requirement of a "trademark holder's legally-recognized inability to assert a claim for infringement," the court claimed, is thus necessary to "avoid[] a possible conflict with the requirements of Article III."[188]

C. *Ramifications of the Second Circuit Decision*

1. *Deviation from and Conformity with District Court Definitions.* — In offering this strict definition, the Second Circuit broke with those district courts that found the trademark owner's authorization sufficient for the plaintiff to have standing as a legal representative.[189] The difference in approach is evidenced by the opposite outcomes in *Quokka Sports* and *Sojuzplodoimport*, despite the fact that the Russian Federation's charter and decrees mirror the *Quokka Sports* license agreement in several respects.[190] In each case, for example, written documents conveyed to the plaintiff the right to bring suit—without affording the plaintiff an *exclusive* enforcement right—and established that the trademark owner retained ultimate control over the litigation.[191] The Second Circuit's decision in *Sojuzplodoimport* thus makes clear that a nonexclusive enforcement right, while enough for the *Quokka Sports* district court, is insufficient to grant a licensee standing under its newly crafted definition.

The question is then whether the Second Circuit's definition comports with those lower court decisions requiring legal representatives to be granted exclusive enforcement rights or whether the bar is in fact higher, as *National Licensing Ass'n* proposed.[192] The district courts in *Krasnyi Oktyabr* and *Visa* suggested that a licensee's exclusive enforcement

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187. Id. at 81.

188. Id.

189. See supra notes 94–107 and accompanying text (providing overview of *Idaho Potato Commission*, *Schweitzz Distribution*, and *Pelc* decisions).

190. See supra notes 112–114 and accompanying text (describing *Quokka Sports* agreement); supra notes 158–163 and accompanying text (detailing decrees issued by Russian Federation).

191. See *Sojuzplodoimport*, 726 F.3d at 69 (explaining decree authorized FTE to use trademarks "'in accordance with the procedure established by the Ministry of Agriculture'" (quoting July 2002 Decree)); *Quokka Sports* Complaint, supra note 112, ¶ 19 ("ACPI and AC 2000 have granted to Quokka the right and authority, *subject to ACPI's and/or AC 2000's prior approval*, to take all necessary actions, including legal action, to prevent any third party from using the Marks as an Internet domain name . . . ." (emphasis added)).

192. See supra notes 125–127 and accompanying text (describing *National Licensing Ass'n* court's determination that even assignment of trademark owner's right to sue for infringement is insufficient to render owner incapable of bringing suit).

right afforded the party standing as a legal representative.[193] In contrast, the *National Licensing Ass'n* court found that even the trademark owner's assignment of the right to sue was insufficient to render the trademark owner incapable of appearing on its own behalf.[194] Although the Second Circuit does not precisely define the legal incapacity required of the trademark owner, its opinion does offer some clues.

Responding to the plaintiff's assertion of a patent-related standing decision as support for a broad "legal representative" definition, the Second Circuit explained that the patent case simply illustrated the principle that "a third party may serve as a 'legal representative,' even where the represented party is physically present, so long as the represented party is somehow disabled from asserting the rights at issue."[195] In support of this proposition, the court cited *Sprint* and construed it as a case in which the Supreme Court granted standing to a party that had a "'contractual obligation' to litigate [the] claim"[196] and had been "assigned title to the claim."[197] The Second Circuit thus equates assignment of enforcement rights to a third party with a trademark owner's inability to assert claims herself. In doing so, the court extends the bounds of "legal representative" beyond the definition imposed by the *National Licensing Ass'n* court and contemplates circumstances in which the trademark owner's inability to bring suit itself is contractually imposed, rather than limited to factors like death, minority, or mental incompetence that lie outside the trademark owner's control.

Even though a license is revocable, and a licensor of enforcement rights could thus regain its right to sue a defendant for infringement, the Second Circuit's opinion suggests that a license may be sufficient to render a trademark owner "legally incapable of representing itself."[198] As noted above, the Second Circuit found that requiring the "trademark holder's legally-recognized inability to assert a claim for infringement" ameliorated the problem of allowing standing to "parties whose sole interest in a trademark-infringement action is a contractually derived right to bring the claim, without owning the claim or having been assigned the claim, even if the actual trademark owner is capable of bringing suit on her own behalf."[199] Accordingly, the court indicates that a party "whose sole interest in a trademark-infringement action is a *contractually-derived* right to bring the claim"—even where it amounts to less than an

193. Krasnyi Oktyabr, Inc. v. Trilini Imports, 578 F. Supp. 2d 455, 466 (E.D.N.Y. 2008); Visa U.S.A. Inc. v. First Data Corp., C 02-01786 JSW, 2005 WL 6271242, at *4 (N.D. Cal. Aug. 16, 2005).

194. 361 F. Supp. 2d 1244, 1255 (E.D. Wash. 2004).

195. *Sojuzplodoimport*, 726 F.3d at 81.

196. Id. (quoting Sprint Commc'ns Co. v. APCC Servs., Inc., 554 U.S. 269, 288 (2008)).

197. Id. (emphasis omitted).

198. Id. at 82.

199. Id. at 81.

assignment, as where a plaintiff is a licensee—is properly permitted standing as long as the trademark owner is unable to bring suit herself.[200] One can infer that the Second Circuit envisions a legal instrument that secures the legal representative's right by simultaneously disabusing the trademark owner of her own enforcement powers—namely, a license agreement that provides a plaintiff the exclusive right to bring suit.

This interpretation of the Second Circuit definition—which is in accordance with *Visa* and *Krasnyi Oktyabr*[201]—is further bolstered by the court's parsing of FTE's Charter and the Russian Federation's decrees that followed. The court explained, albeit in its discussion of the Lanham Act's "assignee" language, that "plaintiffs' complaint does not allege facts plausibly showing that FTE was granted an *exclusive* license to use or enforce the Marks, and none of the relevant documents suggest the Russian Federation's intent to grant such an exclusive license."[202] As support for this assertion, the court indicated that "the complaint does not appear to suggest that FTE could exclude the Russian Federation from using the Marks, since FTE acknowledges that its rights are limited by the Russian Federation's 'ultimate ownership.'"[203] The same reasoning presumably applies to FTE's inability to prevent the Russian Federation from enforcing (rather than merely using) the marks at issue.

2. *An Uncertain Path Forward for Trademark Owners.* — While certain inferences may be drawn from the Second Circuit's opinion, the circumstances in which the court would find a trademark owner legally incapable of bringing suit remain ambiguous. Amplifying this uncertainty for trademark owners and their representatives, just one appellate court has weighed in on the "legal representative" debate at present,[204] and there remains substantial room for courts of other circuits to interpret the term broadly.

Given this hodgepodge of case law,[205] a foreign government that wishes to use and enforce its trademarks in the United States must comply with the most demanding of the "legal representative" definitions offered by the courts. Accordingly, a foreign government that

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200. Id. (emphasis added).

201. See Krasnyi Oktyabr, Inc. v. Trilini Imports, 578 F. Supp. 2d 455, 466 (E.D.N.Y. 2008) (indicating plaintiff lacked standing to sue as legal representative because trademark owner's "authorization fails to grant exclusive enforcement rights to plaintiff"); Visa U.S.A. Inc. v. First Data Corp., No. C 02-01786 JSW, 2005 WL 6271242, at *4 (N.D. Cal. Aug. 16, 2005) (explaining plaintiff "cannot maintain standing to sue as a legal representative because it does not have exclusive enforcement rights to the disputed marks").

202. *Sojuzplodoimport*, 726 F.3d at 78.

203. Id. (quoting Third Amended Complaint ¶ 136, Fed. Treasury Enter. Sojuzplodoimport v. Spirits Int'l B.V., No. 04 CV 08510(GBD) (S.D.N.Y. Feb. 22, 2011), 2011 WL 1230789).

204. See supra note 5 (explaining issue is one of first impression among circuit courts).

205. See supra Part II.A–B (surveying interpretations of "legal representative" by district courts and Second Circuit).

wishes to delegate use and enforcement of its trademarks to an entity specifically chartered for that purpose must completely divest itself of the right to sue.[206] Once the legal representative has broadly been granted authority to act on the trademark owner's behalf, the foreign government may be unable to restrain the third party from bringing suit in a particular instance. At present, then, a foreign entity wishing to ensure its enforcement rights in the United States must either accept the burden of appearing in court itself[207] or divest itself of important rights.[208]

The Second Circuit's narrow definition and its resulting determination that FTE lacked standing prompt concerns about international harmonization of our trademark laws and possible retaliation by foreign nations denied rights in the United States.[209] Such retaliation may in-

206. Such a divestiture of rights would thus bring a legal representative in line with the strict requirements imposed by the *National Licensing Ass'n*, *Visa*, *Krasnyi Oktyabr*, and *Sojuzplodoimport* courts, though these courts may nonetheless differ in how they define those circumstances in which the trademark owner has adequately deprived itself of the right to bring suit. See supra Part II.C.1 (comparing and contrasting cases in which courts required trademark owner be unable to sue itself).

207. Where a government pools expertise and creates a specialized body to administer and enforce its trademarks, a requirement that the government itself bring suit likely introduces costly inefficiency.

208. Indeed, this is the path that the Russian government chose to take following the Second Circuit's decision. In February 2014, the Russian Federation entered into an assignment agreement with FTE. See Complaint at exh. A, Fed. Treasury Enter. Sojuzplodoimport v. SPI Spirits Ltd., No. 14-cv-0712 (SAS) (S.D.N.Y. Feb. 4, 2014). With this document, the government sought to confirm that FTE "already ha[d] exclusive rights to (i) hold, use and exploit the Trademarks in the U.S.; (ii) enforce its rights in the Trademarks in the U.S.; and (iii) bring suit to recover damages and other relief for past or present infringements or dilutions of the Trademarks in the U.S." Id. Beyond mere clarification of preexisting rights, the Russian Federation, with this instrument, purportedly "sells, conveys, transfers, assigns and sets over its entire right, title and interest in and to the Trademarks in the U.S.," along with the necessary goodwill, and "expressly relinquishes any and all right, title, and interest in and to the Trademarks in the U.S." Id. The agreement similarly provides that the Russian Federation "sells, conveys, transfers, assigns and sets over the right to sue and collect damages for past, present and future infringements, all related preexisting or current legal and equitable claims against third parties." Id.

Subsequently, FTE filed a new lawsuit and claimed that this agreement allowed it standing to sue as an "assign"—rather than a legal representative—of the Russian Federation. Spirits Int'l B.V., No. 14-cv-0712 SAS, 2014 WL 6655861, at *1 (S.D.N.Y. Nov. 24, 2014). Curiously, even this assignment failed to secure FTE standing in the district court. Id. at *13. The district court, noting "the murkiness of Russian law regarding these questions of first impression"—acknowledging its decision was "undoubtedly a close call," and expressly inviting de novo appellate review—found that FTE failed to qualify as an "assign" for purposes of the Lanham Act and dismissed the case for lack of subject matter jurisdiction. Id. at *6, *12–*13.

209. See Robert C. Bird & Elizabeth Brown, The Protection of Well-Known Foreign Marks in the United States: Potential Global Responses to Domestic Ambivalence, 38 N.C. J. Int'l L. & Com. Reg. 1, 25 (2012) ("Foreign governments might not sit idly by if well-known marks from their countries do not receive full protection in the United States."); Lee Ann W. Lockridge, Honoring International Obligations in U.S. Trademark Law: How

clude adjudications before the World Trade Organization; weak or nonexistent enforcement of trademarks owned by American individuals, companies, or states in foreign jurisdictions; and foreign laws that diminish the protection of such marks.[210]

Given the ramifications of restricting third-party standing in trademark cases, a determination of which version of "legal representative" best comports with the trademark law's text and history, constitutional standing doctrine, and international treaties is deserving of greater attention from the legal community. As it stands, both foreign and domestic entities wishing to delegate enforcement of trademark rights to third parties, whether for purposes of convenience or necessity, confront significant uncertainty in the legal relationship that must be in place prior to initiating suit.

III. GROUNDING "LEGAL REPRESENTATIVES" IN TEXT AND HISTORY

Although the Second Circuit concluded that constitutional standing rules and the Lanham Act demand a narrow interpretation of "legal representative," Parts III.A and III.B argue that this interpretation is not the obvious product of either the Lanham Act's text and history or the Supreme Court's standing doctrine, respectively. Part III.C recommends that, in keeping with the Lanham Act framers' concerns for reciprocity of trademark protections abroad and for consumer welfare, a broad reading of the term may in fact be most faithful to the legislature's original intent.

A. *Drawing Definition from the Lanham Act's Text and Purpose*

As the Tenth Circuit noted in *Security Insurance Co. v. White*, "It is the general rule that the term 'legal representative' has no fixed and unyielding meaning in law . . . ."[211] Given this elasticity, its definition for purposes of section 32 is properly informed by the history and text of the Lanham Act, as well as the constitutional standing principles articulated by the Supreme Court.

The Supreme Court has explained that a "fundamental canon of statutory construction [is] that the words of a statute must be read in their context and with a view to their place in the overall statutory

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the Lanham Act Protects Well-Known Foreign Marks (and Why the Second Circuit Was Wrong), 84 St. John's L. Rev. 1347, 1348–49 (2010) (explaining, where foreign companies expanding into U.S. market are not assured protection of marks, "foreign support for enforcement of [protections for well-known marks] may wane," and "[d]ecreased international enforcement . . . would be very costly for U.S. businesses").

210. See Bird & Brown, supra note 209, at 25–37 (explaining "responses by nations affected by weak U.S. trademark protection may not simply be limited to formal adjudicative procedures before the WTO" but may also encompass "local actions that threaten the economic well-being of global U.S. firms").

211. 236 F.2d 215, 219 (10th Cir. 1956).

scheme."[212] In keeping with this canon, the Second Circuit in *Sojuzplodoimport* relied on the distinctions between section 32 and section 43's standing provisions to interpret the meaning of "legal representative" in the former.[213] The court's requirement that the trademark owner be unable to bring suit flowed from its conclusion that a contrary result would be "inconsistent with Congress's stated intention to limit standing to the single 'registrant' of the trademark under section 32(1) as opposed to the broad standing afforded plaintiffs suing under section 43."[214]

This conclusion, however, does not inevitably result from the differences between the two standing provisions. Section 43's standing provision contemplates suits by "any persons" as standing in this section is defined by the injured parties, who may be numerous.[215] In contrast, section 32 defines standing in terms of the procedural rights and remedies which spring from the trademark owner's (singular) registration of a trademark.[216] Whether narrowly or broadly defined, a legal representative seems to comfortably fit among those parties explicitly provided standing by the Lanham Act since a legal representative, predecessor, successor, and assignee each, through their particular grants of authority or ownership, use and enforce the rights afforded by the trademark's registration.[217] Furthermore, the inclusion of "successors" as parties who may bring suit seems somewhat contrary to the idea that a "legal representative" definition must be so restricted as to allow stand-

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212. Davis v. Mich. Dep't of Treasury, 489 U.S. 803, 809 (1989).

213. Fed. Treasury Enter. Sojuzplodoimport v. SPI Spirits Ltd., 726 F.3d 62, 80 (2d Cir. 2013), cert. denied, 134 S. Ct. 1291 (2014) (explaining "only registrants—as statutorily defined—have 'statutory standing' to bring an action under Section 32(1)" while "Section 43 of the Act . . . allows suits 'by *any person* who believes that he or she is or is likely to be damaged' by the defendant's actions").

214. Id.

215. 15 U.S.C. § 1125(a)(1) (2012) (providing violators "shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act"). Although the Second Circuit has limited section 43(a) standing to "parties with a reasonable commercial interest to protect" rather than mere consumers, Waldman Publ'g Corp. v. Landoll, Inc., 43 F.3d 775, 784 n.6 (2d Cir. 1994), courts have broadly permitted "a plaintiff [to] assert a claim under section 43(a) not only for the infringement of registered marks . . . but also for the infringement of unregistered marks, including source-identifying trade dress; for false advertising and product disparagement; and, on occasion, for the vindication of moral rights," Blair & Cotter, supra note 145, at 1378.

216. 15 U.S.C. § 1114(1) (providing violators "shall be liable in a civil action by the registrant for the remedies hereinafter provided").

217. A party's ability to sue for infringement under section 32 of the Lanham Act, as well as the availability of statutory and treble damages outlined in section 35, is predicated upon the trademark's federal registration. See id. (providing cause of action to registrant for infringement of registered mark); id. § 1117(a)–(b) (outlining damages available for "violation of any right of the registrant of a mark registered in the Patent and Trademark Office"). By definition, then, any plaintiff bringing a claim under section 32—whether the mark's original registrant, an assignee, or a legal representative—does so on the basis of the mark's registration.

ing to only one party at a time. Though "successors" may refer to a succession of individuals or companies, the term may also denote multiple parties who have contemporaneously succeeded the original rightsholder.[218]

Relatedly, the Second Circuit suggested that historical interpretation of the terms "registrant" and "legal representative" require a narrow reading of the latter. Specifically, the court explained that "concern for international comity does not . . . counsel the judicial creation of an exception to the Lanham's Acts express requirements as *consistently construed* over time."[219] The history of cases interpreting "legal representative" in divergent ways, however, seems to belie the court's assertion of consistent interpretation of that term,[220] and "registrant" fares no better. In *National Licensing Ass'n*, the court in fact catalogued cases in which exclusive licensees had been permitted standing to sue as "assignees" because the licenses, according to the courts, amounted to de facto assignments.[221] Though the *National Licensing Ass'n* court and respected legal minds have bemoaned these cases as the "exceptions that prove the rule,"[222] these decisions nonetheless call into question the *National Licensing Ass'n* court's assertion—echoed by the Second Circuit—that "registrant" bears a "historically restrictive"[223] and consistent interpretation.

B. *Properly Placing "Legal Representatives" in Standing Doctrine*

Declaring it a "cardinal rule" of statutory construction, the Supreme Court has explained that "where an otherwise acceptable construction of a statute would raise serious constitutional problems, the Court will construe the statute to avoid such problems unless such construction is plainly contrary to the intent of Congress."[224] In accordance with this principle, the Second Circuit purported to shape its "legal represen-

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218. See, e.g., Miller v. Glenn Miller Prods., 318 F. Supp. 2d 923, 938 (C.D. Cal. 2004) (describing plaintiffs as contemporary—rather than successive—"successors to their mother," owner of trademark at issue).

219. *Sojuzplodoimport*, 726 F.3d at 82 (emphasis added).

220. See supra Part II.A (describing wide range of "legal representative" requirements imposed by district courts prior to *Sojuzplodoimport*).

221. Nat'l Licensing Ass'n v. Inland Joseph Fruit Co., 361 F. Supp. 2d 1244, 1254 (E.D. Wash. 2004) (citing appellate and district court cases in which courts found "exclusive licensee has standing to sue under § 32 where the agreement grants to an exclusive licensee a property interest in the trademark, or rights that amount to those of an assignee").

222. 6 McCarthy, supra note 1, § 32:3 ("No amount of judicial interpretation or manipulation of words can turn an exclusive licensee into an assignee . . . . I believe that the minority view cases which allow an exclusive licensee to sue because it is 'almost like' or 'tantamount to' an assignee are not following the statute.").

223. *Nat'l Licensing Ass'n*, 361 F. Supp. 2d at 1255.

224. Edward J. DeBartolo Corp. v. Fla. Gulf Coast Bldg. & Constr. Trades Council, 485 U.S. 568, 575 (1988).

tative" definition so as to avoid Article III conflicts.[225] An important question, then, is whether or not a broad definition of "legal representative" indeed conflicts with the injury-in-fact requirement articulated in *Lujan* and invoked by the Second Circuit.[226]

In *Sojuzplodoimport*, the Second Circuit explained that its *Huff* decision had "recognized a few . . . prudential exceptions to the 'injury-in-fact' requirement" which "permit third-party standing where the plaintiff can demonstrate (1) a close relationship to the injured party and (2) a barrier to the injured party's ability to assert its own interests."[227] The *Huff* court had explained, "[C]ourts historically have permitted '[t]rustees [to] bring suits to benefit their trusts; guardians ad litem [to] bring suits to benefit their wards; receivers [to] bring suit to benefit their receiverships; assignees in bankruptcy [to] bring suit to benefit bankrupt estates; [and] executors [to] bring suit to benefit testator estates.'"[228] The Second Circuit determined that its "legal representative" definition, to avoid conflict with the injury-in-fact requirement, must therefore require that the trademark owner be legally incapable of asserting an infringement claim itself.[229]

This explanation of the Supreme Court's standing doctrine, however, appears to depart somewhat from the Supreme Court's own decisions. As explained in Part I, the Supreme Court has defined the injury-in-fact requirement as a constitutional or an "Article III" requirement for standing.[230] In contrast, the prohibition against third-party standing constitutes a *prudential* rule, subject to exceptions and abrogation by Congress.[231] The criteria of close relationship and hindrance, articulated by the Second Circuit in *Huff* and *Sojuzplodoimport*, in fact define situations in which the Supreme Court has found an exception to the prudential prohibition on third-party standing—not exceptions to the injury-in-fact requirement.[232] In conflating the injury-in-fact requirement with the prudential rule barring third-party standing, the

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225. See Fed. Treasury Enter. Sojuzplodoimport v. SPI Spirits Ltd., 726 F.3d 62, 81 (2d Cir. 2013), cert. denied, 134 S. Ct. 1291 (2014) ("To ensure that our construction of the term 'legal representative' avoids a possible conflict with the requirements of Article III, we read it as requiring the trademark holder's legally-recognized inability to assert a claim for infringement.").

226. See id. at 80 ("It is well established that a party must demonstrate 'injury-in-fact' to have constitutional standing and that such injury must be particular to the claim raised and the relief sought." (citation omitted)).

227. Id. at 81 (quoting W.R. Huff Asset Mgmt. Co. v. Deloitte & Touche LLP, 549 F.3d 100, 109 (2d Cir. 2008)) (internal quotation marks omitted).

228. *Huff*, 549 F.3d at 109–10 (quoting Sprint Commc'ns Co. v. APCC Servs., Inc., 554 U.S. 269, 287–88 (2008)).

229. *Sojuzplodoimport*, 726 F.3d at 81.

230. Lujan v. Defenders of Wildlife, 504 U.S. 555, 560–61 (1992).

231. Warth v. Seldin, 422 U.S. 490, 499–501 (1975).

232. See supra notes 75–81 and accompanying text (describing exceptions to prudential rule against third-party standing where closeness and hindrance found).

Second Circuit appears to have effectively made mandatory the exceptions to a prudential requirement.[233]

For the sake of determining who may bring suit as a legal representative, it may be helpful to parse the Article III and prudential standing requirements separately. The Supreme Court in *Sprint* explained that trustees, guardians, receivers, assignees, and executors had Article III standing because they had been historically permitted to bring suit.[234] Although some courts have construed an exclusive licensee as an "assignee,"[235] on its face a mere agent or licensee seems to fall outside the list of parties historically granted Article III standing, regardless of injury asserted. Accordingly, it seems necessary for a party purporting to be a legal representative to *personally* suffer an injury in fact to have standing. Especially where the legal representative has been afforded the exclusive right to use the mark, an injury to the legal representative that is causally related to the alleged infringement and particular to the party is easily envisioned.[236]

The question then becomes whether or not a legal representative, having sustained an injury, can assert the rights of the trademark owner in light of the Court's prudential rule against bringing claims on behalf of a third party. The Second Circuit's definition of "legal representative"

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233. The district court in *In re Vivendi Universal, S.A. Securities Litigation* proposed that, in *Huff*, the "Court of Appeals was not using the word 'prudential' as it is frequently used to distinguish the 'judicially self-imposed limits on the exercise of federal jurisdiction' from the constitutional limits that cannot be abrogated by Congress." 605 F. Supp. 2d 570, 576 (S.D.N.Y. 2009) (quoting United Food & Commercial Workers Union Local v. Brown Grp., 517 U.S. 544, 551 (1996)). Instead, the district court explained, the Second Circuit sought to define characteristics which permitted Article III standing to "certain plaintiffs . . . despite not having personally suffered an injury-in-fact." Id. at 576–77. Assuming the district court correctly interprets *Huff*, the Second Circuit's reliance on these exceptions to inform its "legal representative" definition in *Sojuzplodoimport* nonetheless poses difficulty.

234. See 554 U.S. 269, 274, 285, 287–88 (2008) (explaining "history and tradition offer a meaningful guide to the types of cases that Article III empowers federal courts to consider" and "historical tradition of suits by assignees, including assignees for collection" existed).

235. See Ultrapure Sys., Inc. v. Ham-Let Grp., 921 F. Supp. 659, 665–66 (N.D. Cal. 1996) (concluding, where contract gave licensee exclusive use of trademarks and did not restrict licensee's ability to enforce marks, "exclusive licensee[] does have a property interest in the trademark and qualifies as an assignee or successor of the registrant"); Etri, Inc. v. Nippon Miniature Bearing Corp., No. 85 C 615, 1989 WL 99575, at *3 (N.D. Ill. Aug. 18, 1989) (granting plaintiff standing as "assignee" of mark where agreement provided exclusive right to use mark, as well as right to enforce contractual rights).

236. In *Quokka Sports, Inc. v. Cup International Ltd.*, for example, the plaintiff claimed that the defendant's trademark infringement impaired the value of the marks. 99 F. Supp. 2d 1105, 1115 (N.D. Cal. 1999). The plaintiff also claimed harm stemming from "diversion of traffic away from [its] official website," which employed the licensed trademarks. Id. This latter injury, which is particular to the plaintiff and prompted by the defendants' alleged infringement, would seem to satisfy the requirement that a legal representative sustain an injury in fact.

suggests that, in order to demonstrate hindrance sufficient to justify third-party standing, the trademark owner must be unable to bring suit itself.[237] Even assuming that the prudential standing requirements ought to restrict a legal representative's standing to bring trademark-infringement claims, such a strict interpretation of the necessary hindrance is not in keeping with Supreme Court precedent, which demands only that obstacles be "genuine"[238] and "practical."[239] What constitutes a genuine, practical obstacle to a trademark owner's suit is a question to which there is no clear answer, as the circumstances prompting suit by the legal representative and the relationship between the trademark owner and purported legal representative may vary substantially. Accordingly, evaluation of whether the closeness and hindrance requirements are met, so as to exempt a plaintiff from the prudential bar against third-party standing, may be more aptly suited for a case-by-case determination rather than a blanket requirement imposed on legal representatives.

As explained previously, however, where Article III standing requirements are met, "persons to whom Congress has granted a right of action . . . may have standing to seek relief on the basis of the legal rights and interests of others, and, indeed, may invoke the general public interest in support of their claim."[240] Many so-called "citizen-suit" cases involve statutes affording "any person" who has suffered injury standing to challenge the government.[241] A more apt illustration of how a legal representative might meet the injury-in-fact requirement, while simul-

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237. See supra notes 229–233 and accompanying text (explaining Second Circuit's reliance on constitutional standing requirements in shaping "legal representative" definition).

238. Singleton v. Wulff, 428 U.S. 106, 116 (1976).

239. Sec'y of State v. Joseph H. Munson Co., 467 U.S. 947, 956 (1984); see Powers v. Ohio, 499 U.S. 400, 415 (1991) (finding hindrance where "there exist[ed] considerable practical barriers to suit . . . because of the small financial stake involved and the economic burdens of litigation"); Pa. Psychiatric Soc'y v. Green Spring Health Servs., Inc., 280 F.3d 278, 290 (3d Cir. 2002) ("The stigma associated with receiving mental health services presents a considerable deterrent to litigation.").

240. Warth v. Seldin, 422 U.S. 490, 501 (1975); see also Braden v. Wal-Mart Stores, Inc., 588 F.3d 585, 591 (8th Cir. 2009) ("Some elements of [standing] doctrine are prudential, involving self imposed limits on judicial power. These limits may be 'modified or abrogated by Congress.'" (quoting Bennett v. Spear, 520 U.S. 154, 162 (1997))).

241. For a prominent example of a citizen-suit case, see *Lujan v. Defenders of Wildlife*, which "involved a challenge to a rule promulgated by the Secretary of the Interior interpreting § 7 of the Endangered Species Act of 1973 (ESA)." 504 U.S. 555, 557–58 (1992). The *Lujan* Court explained that the "ESA provides, in pertinent part, that 'any person may commence a civil suit on his own behalf (A) to enjoin any person, including the United States and any other governmental instrumentality or agency . . . who is alleged to be in violation of any provision of this chapter.'" Id. at 571–72 (quoting 16 U.S.C. § 1540(g)).

taneously asserting another's rights, may lie in *Braden v. Wal-Mart Stores, Inc.*[242]

In *Braden*, the Eighth Circuit evaluated the plaintiff's standing where a statute permitted an insurance plan participant to bring suit "'in a representative capacity on behalf of the plan as a whole.'"[243] The court found that the plaintiff satisfied the constitutional standing requirements since he "alleged injury in fact that is causally related to the conduct he seeks to challenge on behalf of the Plan."[244] Because the statute provided that "a plaintiff may seek relief . . . that sweeps beyond his own injury,"[245] the court concluded that "a plaintiff with Article III standing may proceed under [the statute] on behalf of the plan or other participants," regardless of the prudential rule against third-party standing.[246] As in *Braden*, where a legal representative satisfies the Article III standing requirements and sustains injury, no prudential barricade to standing ought to be erected by the courts since representation of the trademark owner stems from the express authorization of Congress.[247]

The Supreme Court has emphatically declared that Congress can both define categories of injury that afford parties standing and abrogate the Court's prudential standing requirements[248] and, in the Lanham Act,

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242. In *Braden*, as in the trademark-infringement suits described in Part II, the plaintiff asserted claims against a private party that had allegedly violated his statutory rights. See 588 F.3d at 589–90 (describing plaintiff's claims against private employer Wal-Mart). The statute at issue in *Braden*, like the Lanham Act's provision of standing, also expressly provides standing to a representative of injured parties. See id. at 593 (explaining statute explicitly allows claims "'brought in a representative capacity on behalf of the plan as a whole'" (quoting 29 U.S.C. § 1132(a)(2))).

243. Id. at 593 (quoting Mass. Mut. Life Ins. Co. v. Russell, 473 U.S. 134, 142 & n.9 (1985)).

244. Id.

245. Id.

246. Id.

247. One could argue that the prudential rule against third-party standing is intimately tied to the constitutional standing requirements, such that the Court, through its closeness and hindrance criteria, has defined those limited situations in which a third party satisfies the injury-in-fact requirement. It would follow that Congress's ability to convey standing to third parties, within the bounds of the Constitution, is limited to those who meet the closeness and hindrance tests. But this argument finds little support in the Court's opinions, which treat the questions of whether a party has satisfied the injury-in-fact requirement and whether the party may bring suit as a third-party representative as wholly distinct inquiries. See Warth v. Seldin, 422 U.S. 490, 500–01 (1975) ("Congress may grant an express right of action to persons who otherwise would be barred by prudential standing rules. Of course, Art. III's requirement remains: the plaintiff still must allege a distinct and palpable injury to himself . . . ."). Such constraint would also seem counter to the idea that "Congress may enact statutes creating legal rights, the invasion of which creates standing, even though no injury would exist without the statute." Linda R.S. v. Richard D., 410 U.S. 614, 617 n.3 (1973). If Congress has the power to define an injury, logic suggests that Congress also has the power to define the injured.

248. See supra notes 74, 87–91 and accompanying text (describing Congress's ability to abrogate prudential—but not constitutional—standing requirements).

Congress merely exercised those powers by unequivocally granting legal representatives access to the federal courts.[249] The Supreme Court's concern that other branches may be better suited to resolving particular disputes—a primary driver of its standing doctrine[250]—is not a persuasive reason to deny parties standing where Congress has so clearly sanctioned the federal courts to act.

Moreover, the Supreme Court has explained that its prudential rule against third-party standing is not to be applied rigidly and in situations "where its underlying justifications are absent."[251] In *Sojuzplodoimport*, the Second Circuit was not faced with the problematic possibility that, by allowing a third party standing, it would adjudicate rights the Russian Federation did not wish to assert. Instead, the close relationship between the trademark owner and the third party suggests congruent interests and a high likelihood that the third party would serve as a zealous advocate of the Russian Federation's rights. Accordingly, the Second Circuit's decision is not in keeping with either the spirit or the letter of the Supreme Court's standing decisions but instead seems a problematic shirking of its duty to adjudicate trademark disputes.[252]

C. *Channeling the Framers' Concern for Comity*

Though neither the Lanham Act's history and text nor the constitutional and prudential standing requirements mandate a narrow reading of "legal representative," courts may nonetheless be wary of applying the expansive definition offered by *Idaho Potato Commission*.[253] The most common concern posed by district courts interpreting "legal representative" was that a broad interpretation could force the defendant to respond to multiple suits if a legal representative and trademark owner both have the ability to sue.[254] Nonetheless, the Supreme Court in *Sprint* demonstrated a distinct lack of concern for the "practical problems" of duplicative suits and discovery difficulties.[255] Though district and appellate courts carry the burden of managing and dismissing such duplicative

249. See Bennett v. Spear, 520 U.S. 154, 163 (1997) ("Congress legislates against the background of our prudential standing doctrine, which applies unless it is expressly negated.").

250. See supra notes 71–73 and accompanying text (detailing Court's justifications for standing doctrine).

251. Singleton v. Wulff, 428 U.S. 106, 114 (1976).

252. As the Court explained in *Lexmark International, Inc. v. Static Control Components, Inc.*, "Just as a court cannot apply its independent policy judgment to recognize a cause of action that Congress has denied, it cannot limit a cause of action that Congress has created merely because 'prudence' dictates." 134 S. Ct. 1377, 1388 (2014) (citation omitted).

253. 410 F. Supp. 171, 174 (D. Idaho 1975) (requiring only that legal representative be "one who stands in the place of and represents the interests of another").

254. See supra note 149 and accompanying text (detailing district courts' expression of concern regarding duplicate suits arising from same act of infringement).

255. 554 U.S. 269, 291–92 (2008) (allowing assignees standing despite such concerns and explaining simply "courts are not helpless in the face of such problems").

suits, the nominal weight the Supreme Court afforded such concerns in *Sprint* may nonetheless be worthy of greater consideration as these courts shape a "legal representative" definition.

These practical concerns may also be outweighed by the Court's interest in promoting international comity. As the Supreme Court has indicated, "Comity is not just a vague political concern favoring international cooperation when it is in our interest to do so"; instead, "it is a principle under which judicial decisions reflect the systemic value of reciprocal tolerance and goodwill."[256] Accordingly, the "Court ordinarily construes ambiguous statutes to avoid unreasonable interference with the sovereign authority of other nations" in order to promote "harmony [of laws] particularly needed in today's highly interdependent commercial world."[257]

While Congress in 1946 may not have predicted the structure of the Russian Federation's trademark-enforcement entities—or even the existence of the Russian Federation, as it is presently constituted—Congress did expressly state that, with the passage of the Lanham Act, it sought to realize its obligations under international treaties.[258] In order to ensure reciprocal protection for American citizens, Congress sought "fully to secure to nationals of countries signatory to the conventions their trade-mark rights in this country."[259] Assuming Russian law indeed prohibits the government from appearing in litigation, denying FTE—or similar entities seeking to enforce trademark rights in the United States on behalf of foreign governments—standing could hamper the ability of foreign states to maintain control over their marks beyond their borders.

Given the principles supporting statutory construction in favor of international comity, Congress's express intention to ensure protections of foreign marks in the United States, and the ambiguity inherent in

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256. Société Nationale Industrielle Aérospatiale v. U.S. Dist. Court, 482 U.S. 522, 555 (1987).

257. F. Hoffmann-La Roche Ltd. v. Empagran S.A., 542 U.S. 155, 164–65 (2004) ("This rule of statutory construction cautions courts to assume that legislators take account of the legitimate sovereign interests of other nations when they write American laws.").

258. H.R. Rep. No. 79-219, at 3–4 (1945) (enumerating one goal as "carry[ing] out by statute our international commitments to the end that American traders in foreign countries may secure the protection to their marks to which they are entitled"). In 1868, the United States entered into a treaty with Russia which provided that

> counterfeiting in one of the two countries of the trade marks affixed in the other on merchandise to show its origin and quality, shall be strictly prohibited . . . and shall give ground for an action of damages . . . to be prosecuted in the courts of the country in which the counterfeit shall be proven.

Treaty with Russia, U.S.-Russ., Jan. 27, 1868, 16 Stat. 725. Although this treaty preceded the Lanham Act by many years, similar commitments may have informed the restructuring of trademark law in 1946.

259. H.R. Rep. No. 79-219, at 3.

"legal representative," courts adopting a broad interpretation of "legal representative" may be most in accord with the original intention of the Lanham Act's framers. This conclusion is reinforced by the consumer protection function of trademark law, which is seemingly served equally well by a legal representative expressly granted authorization to sue on the registrant's behalf as by a trademark registrant herself.

CONCLUSION

The phrase "legal representative" may have once seemed an innocuous and fairly unimportant piece of section 32. The Second Circuit decision in *Sojuzplodoimport*, however, makes evident that the interpretation of the phrase can have a significant impact on foreign governments and other trademark owners relying upon third-party representation in American courts. Because the history and text of the Lanham Act weigh in favor of a broad interpretation, and constitutional standing concerns do not mandate a trademark owner's incapacity to sue, mere authorization of the trademark owner may be sufficient grounds for "legal representative" standing. Accordingly, the best definition of "legal representative" may simply be one in which the plaintiff is granted the right—whether exclusive or nonexclusive—to bring suit on the trademark owner's behalf. Congress or the Supreme Court should adopt this definition to ensure uniformity in interpretation and to best serve the interests of consumers and trademark owners both at home and abroad.