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TRADEMARKING “JEET KUNE DO”

Christopher Bucklin*

I. INTRODUCTION

On July 20, 1973, martial arts legend Bruce Lee died at the age of thirty-two.1 Through his brief but exceptional life, Bruce Lee left a unique legacy that will likely never be duplicated. Among his many accomplishments,2 probably his most enduring contribution to society was his own personal expression of the martial arts: Jeet Kune Do.3 Due to Bruce Lee’s enormous global popularity,4 the term “Jeet Kune Do” has

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2. Many of Bruce Lee’s achievements are summarized by the following passage:

Bruce Lee (1940–1973) is generally considered the greatest martial artist of the twentieth century. A true Renaissance man, Lee was a talented artist, poet, philosopher, writer, and actor, apart from being a formidable fighter. His insights into philosophy, physical fitness, self-defense, and moviemaking, have been enjoyed and lauded by millions of people around the world for well over two decades. He is the founder of Jeet kune do, the first martial art to ever be predicated on total freedom for the individual practitioner. A learned man, Lee attended the University of Washington where he majored in philosophy. His personal library contains over 2,500 books on topics ranging from Eastern yoga to Western psychoanalysis. His achievements and example continue to inspire athletes and artists from around the world.


3. Jeet Kune Do literally means “way of the intercepting fist.” 1 LITTLE, WORDS OF THE DRAGON, supra note 1, at 164 n.5.

4. See 2 LITTLE, THE TAO OF GUNG FU, supra note 2, at 199. See also JOHN
been used, directly or indirectly, to sell clothing, books, posters, magazines, assorted memorabilia, instructional videos, seminars, and self-defense classes. But who may actually use the term “Jeet Kune Do”? Is it a protected trademark? If it is a trademark, who has the authority to authorize its use? What are the limitations, if any, of such use? These are some of the issues addressed in this comment.

This comment first traces the origin and subsequent chronology of the term “Jeet Kune Do.” Relevant principles of trademark law and case law precedent then follow. Considered with respect to the law of trademarks, the issue is: can Jeet Kune Do be trademarked? The analysis section discusses such issues as ownership of the mark, the mark's distinctiveness, possible abandonment of the mark, dilution of the mark's distinctiveness, third-party defenses, Bruce Lee's intent regarding the mark, and Jeet Kune Do as a “class” of martial arts. The comment then proposes that the Jeet Kune Do mark may be a protectible trademark and suggests how the estate of Bruce Lee could act to protect the mark.

II. BACKGROUND

A. Origin of “Jeet Kune Do”

Bruce Lee was born in San Francisco's Chinatown on November 27, 1940 to Mr. and Mrs. Lee Hoi Chuen. In 1953, while growing up in Hong Kong, Bruce Lee began to study Wing Chun, a style of Gung Fu, under grandmaster Yip Man. When he was eighteen, Bruce Lee returned to the United States at his parents' request.

In 1964, after living in the United States for five years and having taught martial arts professionally, another Chinese martial artist, who disliked Lee teaching Chinese mar-

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5. See infra Part II.A.
6. See infra Part II.B–C.
7. See infra Parts III, IV.
8. See infra Part IV.
9. See infra Part V.
10. See infra Part II.B–C.
11. See id. at 188.
12. See id.
tial arts to non-Chinese, challenged Lee to a fight.13 Lee accepted the challenge and ultimately defeated his antagonist in three minutes.14 Although victorious, Lee was distraught that the conflict took so long and left him so physically drained.15 As a result, Lee completely reexamined his traditional approach to the martial arts.16

Not wanting to confine himself to just one martial art, Lee fervently researched other forms of combat in an effort to acquire the very best techniques from a variety of arts.17 In addition to Wing Chun, Lee researched other combative forms such as Western boxing, Thai boxing, fencing, Savate, wrestling, Judo, Aikido, Karate, and other styles of Gung Fu.18 Lee eventually concluded that no one martial art or “style” completely encompassed the totality of combat.19 Rather, each martial art added something unique to a greater scheme of fighting.20 As a result, Lee considered the greatest martial artist to be without a single style, and instead one who possesses all styles, so that ultimately, he or she has no style at all.21 As Lee stated: “I think the highest state of martial art, in application, must have no absolute form.”22 To achieve this end, Lee wanted to establish, not a “style,”23 but an expression of martial arts that liberated, rather than bound, an individual’s abilities.24 This notion of abandoning the traditional, fixed forms of martial arts in favor of liberated, free expression is the cornerstone of the art Bruce Lee created: “Jeet Kune Do.”25 As Lee asserted:

13. See id. at 189.
14. See id.
15. See id.
18. See id.; see also CHRIS KENT & TIM TACKETT, JEET KUNE DO KICKBOXING 9 (1986).
19. See L. LEE, supra note 17, at 64. See also LITTLE, THE WARRIOR WITHIN, supra note 4, at 107; infra note 292 and accompanying text.
21. See 3 JOHN LITTLE, BRUCE LEE—JEET KUNE DO 27 (1997) [hereinafter LITTLE, JEET KUNE DO]; see also infra note 292 and accompanying text.
22. 3 LITTLE, JEET KUNE DO, at 27.
23. See BRUCE LEE, TAO OF JEET KUNE DO 24 (1975); L. LEE, supra note 17, at 44; LITTLE, THE WARRIOR WITHIN, supra note 4, at 106–07; see also infra note 292 and accompanying text.
25. See B. LEE, supra note 23, at 12.
Jeet Kune Do favors formlessness so that it can assume all forms and since Jeet Kune Do has no style, it can fit with all styles. As a result, Jeet Kune Do utilizes all ways and is bound by none and, likewise, uses any technique or means which serve its end.\(^{26}\)

Lee also claimed, "The art of Jeet Kune Do is simply to simplify. It is being oneself,\(^{27}\) and, "Jeet Kune Do is the art not founded on techniques or doctrine. It is just as you are."\(^{28}\) Believing in these principles, Lee even placed Chinese characters around his class Jeet Kune Do emblem that translated to: "Using no way as way; having no limitation as limitation.\(^{29}\)

To guide his practitioners to attain this "formlessness," Lee established four major tenets defining Jeet Kune Do's core philosophy: (1) research your own experience; (2) absorb what is useful; (3) reject what is useless; and (4) add what is specifically your own.\(^{30}\)

Lee was revolutionary because his self-developed art of Jeet Kune Do was the first martial art based on an individual's total liberation of means, rather than a traditional set of rigid techniques.\(^{31}\) Moreover, Lee acknowledged that "the success of Jeet Kune Do lies in its freedom, both to use technique and to dispense with it.\(^{32}\)

Since Lee disliked the notion of martial art "styles,\(^{33}\) he created the term "Jeet Kune Do" more for convenience than for commercial value, i.e., to give his personal expression of the martial arts some kind of designation.\(^{34}\) "Jeet Kune Do" literally means "way of the intercepting fist."\(^{35}\) Lee coined the term sometime in 1965 or 1966,\(^{36}\) after he reexamined his approach to the martial arts, researched other combative forms,

\(^{26}\) Id.
\(^{27}\) Id.
\(^{28}\) Id. at 204.
\(^{29}\) See LITTLE, THE WARRIOR WITHIN, supra note 4, at 112.
\(^{30}\) See id. at 114.
\(^{31}\) See 2 LITTLE, THE TAO OF GUNG FU, supra note 2, at 199.
\(^{32}\) B. LEE, supra note 23, at 22.
\(^{33}\) See id. at 24; L. LEE, supra note 17, at 44; LITTLE, THE WARRIOR WITHIN, supra note 4, at 106–07; see also infra note 292 and accompanying text.
\(^{34}\) See 1 LITTLE, WORDS OF THE DRAGON, supra note 1, at 127.
\(^{35}\) See 1 id. at 164 n.5.
\(^{36}\) See 3 LITTLE, JEET KUNE DO, supra note 21, at 47; Rick Tucci, Dan Inosanto Returns to Black Belt, BLACK BELT, Aug. 1995, at 48.
and formulated his own expression of martial arts. When an opponent attacks in fencing, a stop-hit involves parrying and counter-attacking at the same time, rather than in two individual steps. This technique appealed to Lee because it symbolized a highly effective and efficient way to hit an opponent quickly during an attack, which is ideal in Jeet Kune Do. Combining "stop-hit" with the Cantonese word for "fist," Lee coined the term "Jeet Kune Do." Lee's fame and eclectic personal expression of martial arts resulted in worldwide recognition for himself and his art of Jeet Kune Do. As an inevitable result of popularity, other individuals infringed upon Lee's proprietary rights. To determine whether actual infringement occurred requires some background information on relevant U.S. trademark law.

B. Trademark Law

1. Defining "Trademark"

A "trademark" is defined by the Lanham Act, the federal trademark statute, as:

[A]ny word, name, symbol, or device, or any combination thereof (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, 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.

37. See LITTLE, THE WARRIOR WITHIN, supra note 4, at 190.
39. See id.
40. See id. Simplicity, directness, efficiency, and adaptability are all highly important principles of Jeet Kune Do. See B. LEE, supra note 23, at 12.
41. See INOSANTO, supra note 38, at 66–67.
42. See 2 LITTLE, THE TAO OF GUNG FU, supra note 2, at 199. See also LITTLE, THE WARRIOR WITHIN, supra note 4, at 183–85; Graham, supra note 4.
2. Distinctiveness

All trademarks must be distinctive to receive protection. The U.S. Supreme Court has asserted two ways to achieve distinctiveness in a mark: (1) by being inherently distinctive, or (2) by acquiring distinctiveness through "secondary meaning" that results when a mark is merely descriptive on its face—which would ordinarily preclude it from trademark status—but which consumers have come to nevertheless recognize as an identifier of the product or its source. If a mark cannot gain (or retain) distinctiveness, it is deemed generic and cannot be a trademark.

A mark is inherently distinctive if it is so distinguishable that no showing of secondary meaning is necessary, e.g., a mark that is a completely imaginary word. In contrast, a mark that is not inherently distinctive is not distinguishable on its own, and cannot be deemed a trademark without a showing of secondary meaning, e.g., a mark that is composed of a commonly used word that, by itself, does not indicate a source or product yet in context of public perception is recognized as a source or product identifier.

Within these two major classifications, there are four sub-categories of distinctiveness: (1) arbitrary and fanciful, (2) suggestive, (3) descriptive, and (4) generic. Marks that fall within the first two categories are inherently distinctive, while a "descriptive" mark is not inherently distinctive, and hence requires a showing of secondary meaning for protection.

addition, if "Jeet Kune Do" were used as a name of a business, it would be more appropriately a "trade name." See Lanham Act § 45. This comment uses the term "trademark" instead of "service mark" or "trade name" since "trademark" is commonly used to refer to these types of marks and these terms ordinarily have the same legal requirements. See 1 MCCARTHY, supra, § 3:1.

44. See 2 MCCARTHY, supra note 43, § 11:2.


46. See 2 MCCARTHY, supra note 43, § 11:2. A term is generic either by inherently lacking distinctiveness (e.g., "soap," "car," "cereal," etc.), or by being a once valid trademark that subsequently lost its distinctiveness over time (e.g., "aspirin," "cellophane," "escalator," "yo-yo," "nylon," and "kerosene"). See JANE C. GINSBURG ET AL., TRADEMARK AND UNFAIR COMPETITION LAW 339-49 (2d ed. 1996).

47. See 2 MCCARTHY, supra note 43, § 11:2; see also infra notes 52-54 and accompanying text (citing examples of inherently distinctive marks).

48. See 2 MCCARTHY, supra note 43, § 11:2; see also infra note 60 and accompanying text (citing examples of descriptive marks that acquired secondary meaning).

49. See 2 MCCARTHY, supra note 43, § 11:2.
as a trademark. As mentioned earlier, a mark that is "generic" has no distinctiveness by definition, and cannot become a trademark.

An "arbitrary" mark uses a fairly common word or set of words, yet when utilized in context of a particular good or service, does not suggest or describe any of its qualities or characteristics. In contrast, a "fanciful" mark consists of words that are completely made-up, obsolete, or otherwise wholly unfamiliar to the typical purchaser. "Suggestive" marks hint at what the product or service is, yet do not describe it enough to lose distinctiveness. These three types of marks are deemed "strong" trademarks because of their inherent distinctiveness, with "fanciful" marks being the strongest. Owning a "strong" mark is important since these marks receive the greatest protection in a variety of markets and circumstances.

As opposed to these inherently distinctive categories, a "descriptive" mark cannot stand as a trademark on its own, and requires a showing of secondary meaning. Typically, a mark falls within this category because it merely describes some aspect or characteristic of a good or service. However, since even general or descriptive terms may acquire distinct public recognition, these marks may still become trademarks with proof of secondary meaning. Absent such a showing, however, a "descriptive" mark cannot become a trademark.

50. See 2 id.
51. See supra text accompanying note 46. Since a "generic" mark inherently has no distinctiveness, it is somewhat of a misnomer to call it a sub-category of distinctiveness.
52. See 2 MCCARTHY, supra note 43, § 11:11. Examples of arbitrary marks include "V-8" (i.e., the vegetable juice beverage) and "Ivory" soap. See 2 id.
54. See 2 id. § 11:12. An example of a suggestive mark is the mark for the bus transportation company, "Greyhound," which suggests speed and sleekness. See 2 id.
55. See 2 id. § 11:4.
56. See 2 id. § 11:6.
57. See 2 id.
58. See 2 MCCARTHY, supra note 43, § 11:15.
59. See 2 id. §§ 11:15-16.
60. See 2 id. § 11:15. Examples of descriptive marks that acquired secondary meaning include, "International Business Machines" ("IBM") and "General Electric" ("GE").
61. See 2 id.
Testing distinctiveness of marks that employ foreign words is a two-step process. These words are first translated into English and then evaluated using the same tests as described above. The ultimate issue is whether the mark would be inherently distinctive or merely descriptive to consumers who speak the particular language of the mark in question. Foreign marks found descriptive must, as with English marks, show secondary meaning among its particular language-speaking consumers to qualify as protected. Also, if the foreign term uses a generic designation, it cannot be a valid trademark.

Under U.S. trademark law, one need not register a trademark to obtain enforceable rights in the mark. While registering a mark with the federal Patent and Trademark Office ("PTO") may provide nationwide trademark protection, the use of the mark to identify a single source is what ultimately creates a trademark. If the use of a mark causes recognition of a source for a particular product or service, a protected trademark results.

A trademark does not need to specifically identify its owner’s name. Rather, a trademark should indicate to the public a single source, though the public is not required to

62. See 2 id. § 11:34.
63. See 2 id. For example, the Chinese characters “Tung Fong Jih Pao,” which were used as the name of a Chinese newspaper, were found merely descriptive. The term literally means “Oriental Daily News." See In re Oriental Daily News, Inc., 230 U.S.P.Q. 637 (T.T.A.B. 1986).
64. See 2 MCCARTHY, supra note 43, § 11:34.
65. See 2 id. § 12:41. For example, the Hungarian term “Ha-Lush-Ka” was held a generic mark in the United States since it literally translates to mean “egg noodles.” See Weiss Noodle Co. v. Golden Cracknel & Specialty Co., 290 F.2d 845 (C.C.P.A. 1961).
66. See 3 MCCARTHY, supra note 43, § 19:3.
67. See 3 id. § 26:31. In addition to receiving nationwide protection, federal trademark registration has further benefits: attaining “incontestable” status after five consecutive years of use; serving as a notice and warning of use to others; barring imported goods bearing infringing marks; providing protection against counterfeiting; leaving open the possibility of court-ordered treble (i.e., enhanced) damages upon infringement; providing certain evidentiary advantages to a mark’s owner; permitting use of the “®” symbol, the phrase “Registered in U.S. Patent Office,” or “U.S. Pat. Off.” to denote federal registration; and confirming the ownership and validity of a mark, product, or business. See GINSBURG ET AL., supra note 46, at 227–28.
68. See 3 MCCARTHY, supra note 43, § 19:3.
69. See 3 id. § 3:3.
70. See 3 id. § 3:7. For example, the marks “Cheer,” “Tide,” and “Crest” are all product name trademarks belonging to Procter & Gamble. See 3 id.
know that source's name.\textsuperscript{71} As long as the public recognizes the mark as deriving from a single source, the mark may serve as a trademark even though the public may not know the name of the source.\textsuperscript{72}

Like a word, a single letter or group of letters not constituting a word, including an abbreviation,\textsuperscript{73} may also be a trademark.\textsuperscript{74} An arrangement of letters that is arbitrary or well-known publicly is more likely to be recognized since this adds to the mark's distinctiveness.\textsuperscript{75} However, a series of unique letters that merely abbreviates a generic term is also deemed generic.\textsuperscript{76}

3. Abandonment

"Abandonment" of a mark causes its original owner to lose exclusive trademark rights in the mark,\textsuperscript{77} even if registered.\textsuperscript{78} Once abandoned, the mark becomes part of the public domain and may be used by anyone.\textsuperscript{79} Subsequently, an original user cannot regain rights in an abandoned mark simply by reviving use of the mark.\textsuperscript{80}

Abandonment may occur in several ways. First, actions of the original trademark owner may bring about "non-intentional" abandonment.\textsuperscript{81} Non-intentional abandonment occurs via uncontrolled licensing of a mark,\textsuperscript{82} assigning a
mark apart from its goodwill, or the mark becoming generic. In each of these instances, the mark, either through an act or non-act of the original owner, loses its meaning as an indicator of source, and hence fails to act as a trademark.

Second, abandonment may occur through subsequent non-use of the mark. Since use of a mark to identify a single source creates a trademark right, a mark's ensuing non-use following some initial usage may cause abandonment. Modern trademark law requires a showing of "intent not to resume" use of a mark to find abandonment by non-use. To overcome this non-use claim, an alleged mark owner must prove not merely an intent to continue some token use of the mark, but rather intent to resume commercial use. An alleged mark owner may also refute abandonment by non-use with a showing of valid reasons, e.g., temporary suspension of use caused by external factors.

Third, non-use for a prolonged period creates a presumption of abandonment. The Lanham Act asserts that three consecutive years of non-use constitutes "prima facie abandonment," i.e., a rebuttable presumption of abandonment an alleged trademark holder has the burden of overcoming. Abandonment requires "clear and convincing" proof since it involves the forfeiture of acquired rights. To meet this burden, mere self-serving testimony from an alleged trademark owner may be rebutted by objective evidence, such as actions of the alleged trademark holder that suggest aban-

83. See 2 MCCARTHY, supra note 43, § 17:7. Since assigning a mark apart from its goodwill may cause the mark to no longer designate a certain nature and/or quality of goods, such action may constitute abandonment. See 2 id.
84. See 2 id. § 17:8; see also supra text accompanying note 46.
85. See 2 MCCARTHY, supra note 43, § 17:5.
87. See 3 MCCARTHY, supra note 43, § 19:3.
88. See 2 id. § 17:9.
89. See Lanham Act § 45.
90. See 2 MCCARTHY, supra note 43, § 17:11.
91. See 2 id.
92. See 2 id.
93. See 2 id. § 17:16. Examples of such valid external factors include war, a labor strike, bankruptcy, and unprofitable sales. See 2 id.
94. See 2 id. § 17:18.
95. 2 Id.
96. See 2 MCCARTHY, supra note 43, § 17:12.
In particular, failure to sue third-party infringers may evidence abandonment. The failure to prosecute infringers often weakens a mark through unchecked, widespread use. That is to say, abandonment is really not at issue here since this requires showing that a mark has lost all significance as an indicator of origin. Instead, the rationale is that by not regulating third-party use of a mark, it has lost its strength. As a result, failure to sue known infringers is really only relevant to abandonment when showing that a mark has lost all of its significance.

Further, abandonment might not be found where a trademark owner does not object to some third-party uses of a mark, while objecting to others (e.g., only those that specifically conflict with the holder's use of the mark), since an owner is not obligated to sue every infringing use.

4. Dilution

Even the subtlest unauthorized use of a mark may weaken or reduce its distinctiveness through a process known as "dilution." Dilution, unlike blatant trademark infringement, involves the gradual weakening of a mark's strength through two forms: blurring and tarnishment. First, dilution by "blurring" entails actual or potential customer confusion, not necessarily as to source, sponsorship, or affiliation, but as to unauthorized use of the mark on goods or services other than those of the original owner's. Such actual or po-
potential use of the same mark on different products weakens the mark's strength. Second, dilution by “tarnishment” is the degrading of a mark’s public reputation and goodwill, typically through unauthorized use of the mark in obscene, illegal, or unwholesome products. As with blurring, dilution of this sort reduces a mark’s identification capacity, thereby diminishing its effect as a trademark.

The Lanham Act specifically grants the owner of a “famous mark” the special right to claim dilution protection. To determine whether a mark is “distinctive and famous,” the Lanham Act designates eight factors to consider:

(A) the degree of inherent or acquired distinctiveness of the mark;
(B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
(C) the duration and extent of advertising and publicity of the mark;
(D) the geographical extent of the trading area in which the mark is used;
(E) the channels of trade for the goods or services with which the mark is used;
(F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks’ owner and the person against whom the injunction is sought;

include third parties selling products like “Disney” aspirin, “Nike” light bulbs, and “Pepsi” tires.

108. See 3 MCCARTHY, supra note 43, § 24:68.
109. See 3 id. § 24:95. Actual examples of dilution by tarnishment include the children’s board game “Candyland” being diluted by the Internet web site “candyland.com,” which contained sexually explicit material; “Budweiser” beer being diluted by “Buttweiser” printed on T-shirts; and “Toys ‘R’ Us” being diluted by the Internet web site “adultarus.com,” which sold adult sexual products. See 3 id.
110. See 3 id.
111. See Lanham Act § 43(c). This notion should not be interpreted to mean that only famous marks can be protected as a trademark. Fundamentally, a mark must be distinctive in order to be a trademark. See 2 MCCARTHY, supra note 43, § 11.2. While all trademarks must be “distinctive,” only a small number are actually “famous.” See 3 id. § 24:92. Though deeming a mark “famous” is not required for trademark protection, famous and/or strong marks receive greater protection than weaker marks where likelihood of confusion between a mark’s owner and an alleged infringer is in dispute. See 4 id. § 29:61. Thus, it is beneficial for a mark to be considered “famous.”
(G) the nature and extent of use of the same or similar marks by third parties; and

(H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.\footnote{112}

In deciding whether a mark is "famous," a court weighs each factor independently, and then examines the cumulative result.\footnote{113} Moreover, a court is not limited to these eight considerations,\footnote{114} and may review additional factors it deems relevant to a particular case.

Dilution case law asserts that only strong marks have the requisite distinctiveness to be diluted.\footnote{115} Conversely, dilution is not possible with weak marks which have lost their distinctiveness.\footnote{116} But how strong must a mark be to merit dilution protection? At the very least, the mark must have more "distinctiveness" and "strength" than that minimally required of a trademark.\footnote{117} Some marks, such as nationally famous marks, certainly meet this standard.\footnote{118} However, other marks are well-known only to a specifically defined region, industry, or market.\footnote{119} In these instances, the lack of substantial nationwide fame will likely invalidate a dilution claim in the case of dissimilar products, since the impact of alleged dilution will probably be inconsequential.\footnote{120} In contrast, if a mark famous to a small population or market segment is used by another in the same or similar segment, the original owner may assert the Lanham Act's dilution provisions to protect the owner's rights in the mark.\footnote{121}

5. Extent of Trademark Protection

The Lanham Act's authority is not necessarily limited to the United States. U.S. trademark protection reaches activities in foreign nations if such activities affect a holder's

\footnote{112. Lanham Act § 43(c).}
\footnote{113. See 3 MCCARTHY, supra note 43, § 24:92.}
\footnote{114. See Lanham Act § 43(c).}
\footnote{115. See 3 MCCARTHY, supra note 43, § 24:108.}
\footnote{116. See 3 id.}
\footnote{117. See 3 id. § 24:109.}
\footnote{118. See 3 id. "Coca-Cola," "Ford," and "McDonald's" are all clear examples of nationally famous marks.}
\footnote{119. See 3 id. § 24:112.}
\footnote{120. See 3 id.}
\footnote{121. See 3 MCCARTHY, supra note 43, § 24:112.}
trademark rights in the United States and involve U.S. interstate commerce. For example, where a foreign party uses an American holder's mark on products imported into the United States, the Lanham Act may impose liability. This protection may also apply when a foreign party performs allegedly infringing acts that only indirectly affect U.S. commerce. Finally, protection occurs when a domestic infringing party uses a mark solely for export to foreign nations.

Further, many nations recognize the "famous marks doctrine" as a means of protecting well known, yet unregistered, foreign marks. Though many countries do not protect unregistered marks, the famous marks doctrine is an exception to the general rule. Although the level of protection varies with each country, the famous marks doctrine appears in some international trade agreements and recognizes the fame of a mark, even when such fame results from its popularity in other countries.

6. Defenses

Despite the potentially broad rights associated with trademarks, trademark owners cannot delay for too long in asserting their rights against infringers. In addition to aban-

122. See 3 id. § 25:58. Bringing suit in this situation assumes a showing of personal and/or subject-matter jurisdiction over a defendant in a U.S. court. See 4 id. §§ 29:56, 58. Assuming jurisdiction requirements are met, an American court has the authority to bar a party from certain acts domestically and/or internationally. See 4 id. § 29:60. However, turbulent international relations as well as foreign legal systems in conflict with American law, may prevent such international decrees. See 4 id.

123. See 4 id. § 29:56.

124. See 4 id. § 29:57. An example of indirect foreign infringement occurs when a foreign party manufactures and sells goods with a domestic party's mark on it (without authorization) solely within foreign markets (i.e., no importation of the goods to the United States), and American visitors to the foreign markets buy the goods and bring them back to the United States. See Steele v. Bulova Watch Co., 344 U.S. 280 (1952).

125. See 4 MCCARTHY, supra note 43, § 29:59.

126. See 4 id. § 29:61.

127. See 4 id.

128. See 4 id.

129. See 4 id. § 29:63. Both the North American Free Trade Agreement (NAFTA) and the General Agreement on Tariffs and Trade (GATT) recognize the famous marks doctrine. See 4 id.

130. See 4 id. § 29:64. This spillover effect of a mark's fame can occur even when the products that the mark represents are not available in that country. See 4 id.
donment, an owner’s continued procrastination may allow an alleged infringer to claim a defense of either statute of limitations or estoppel by laches. First, statute of limitations provisions establish maximum time periods for bringing or enforcing certain actions. The Lanham Act provides no specific statute of limitations for trademark infringement actions. Nevertheless, most courts adopt the forum state’s statute of limitations for similar sorts of actions, which varies from state to state. However, in cases where delay in bringing suit is an issue, it is the laches defense that most often prohibits both monetary and injunctive relief.

Estoppel by laches occurs when a trademark owner’s delay in bringing suit results in prejudice to the alleged infringer, and serves as some bar to relief. Though this defense is more popular than asserting a statute of limitations violation, some courts nonetheless use the closest state statute of limitations as a guide to rule on the validity of a laches defense. Although a laches defense may limit certain monetary and injunctive remedies, courts seldom issue permanent injunctions when a likelihood of confusion between a trademark holder and an infringer’s products is shown. Indeed, a strong showing of likelihood of confusion may completely invalidate a laches defense. In contrast, a laches defense is more persuasive where other factors favor the alleged infringer’s position, e.g., the mark becoming generic, implied consent to use the mark, an excessive delay in claiming in-

132. See 5 id. § 31:2; see also infra text accompanying notes 138–49.
134. See 5 MCCARTHY, supra note 43, § 31:33.
135. See 5 id. For example, an analogous state suit to federal trademark infringement is a tort against property; a corresponding action to Lanham Act § 43(a) false advertisement claims include those under state tort statutes, statutory liability, fraud, and injury to property; and state fraud statutes provide a similar action to both Lanham Act § 43(a) false attribution of authorship claims and to Lanham Act § 38 fraud claims. See 5 id. § 31:33 n.6.
136. State statute of limitations applied in Lanham Act suits typically range from two to six years. See 5 id.
137. See 5 id. § 31:1.
138. See 5 id. § 31:2. McCarthy also defines estoppel by laches with the following equation: Estoppel by laches = delay x prejudice, where varying amounts of either “delay” and/or “prejudice” may result in estoppel by laches. See 5 id.
139. See 5 id. § 31:1; supra notes 135–36 and accompanying text.
141. See 5 id. § 31:10.
fringement, an infringer's use of the mark in good faith, and/or no likelihood of confusion between the marks of the alleged owner and alleged infringer.\textsuperscript{142} However, with the possible exception of abandonment through excessive delay, the laches defense will likely fail where there has been knowing and deliberate infringement.\textsuperscript{143}

The amount of delay necessary to establish a laches defense varies.\textsuperscript{144} Laches defenses have been rejected for delays ranging from four months to thirteen years.\textsuperscript{145} Conversely, other cases found laches defenses valid for delays ranging from three to sixty-nine years.\textsuperscript{146} Therefore, there is no fixed rule regarding the amount of delay that merits a laches defense.\textsuperscript{147} Without established guidelines, this defense's applicability varies with each case.\textsuperscript{148} In applying this doctrine, courts must weigh the specific facts and circumstances of the case, the interests and equities of both parties, and the public interest.\textsuperscript{149}

Another possible defense that an alleged infringer may raise is "acquiescence."\textsuperscript{150} Acquiescence involves a delay in bringing suit and an implication of active consent by the trademark owner, whether by word or action, to use the mark.\textsuperscript{161} A showing of reliance on this consent may not only provide a defense against infringement, but may also prevent a trademark owner's attempted revocation of consent.\textsuperscript{152} As with laches, however, the acquiescence defense may be wholly negated by a clear showing of likelihood of confusion between the marks of the alleged owner and alleged infringer.\textsuperscript{153}

C. Case Law

Little case law exists in the area of trademark rights relating to martial arts. However, a few cases demonstrate how

\begin{itemize}
\item \textsuperscript{142} See 5 id. § 31:7.
\item \textsuperscript{143} See 5 id. § 31:9.
\item \textsuperscript{144} See 5 id. §§ 31:29–:30.
\item \textsuperscript{145} See 5 id. § 31:29.
\item \textsuperscript{146} See 5 McCarthy, supra note 43, § 31:30.
\item \textsuperscript{147} See 5 id. § 31:22.
\item \textsuperscript{148} See 5 id.
\item \textsuperscript{149} See 5 id.
\item \textsuperscript{150} See 5 id. § 31:41.
\item \textsuperscript{151} See 5 id.
\item \textsuperscript{152} See 5 McCarthy, supra note 43, § 31:42.
\item \textsuperscript{153} See 5 id. § 31:41.
\end{itemize}
far trademark rights in this area can reach.

In the case of *Gracie v. Gracie*, the federally registered trademark "Gracie Jiu-Jitsu" provided the basis for injunctive relief against a family member's use of the mark in association with his martial arts school. Though a five-year delay in filing suit resulted in a laches defense claim, the court still found for the mark owner. The court ruled that the owner's delay was neither unreasonable nor inexcusable given other suits involving the owner, as well as the owner's lack of notice. The facts that the alleged infringer shared the "Gracie" family name and was an active practitioner and teacher of the Gracie style of Jiu-Jitsu for many years were immaterial in the court's ruling. *Gracie* demonstrates that a federally registered mark receives significant protection, even where there are seemingly favorable facts on the side of the alleged infringer. It also demonstrates how mitigating circumstances, such as continuous litigation and lack of notice, can overcome a laches defense.

In contrast, the court in *Chang School of Judo & Karate, Inc. v. Dragon Gym, Inc.* granted summary judgment in favor of the defendant because the plaintiff could not prove he was the mark's senior user. In *Chang*, the mark "T.K.A." was allegedly conceived by the plaintiff to abbreviate the concept of concurrently teaching techniques from Tae Kwon Do, Karate, and Aikido. The plaintiff asserted that he divulged this mark and its teaching premise to the defendant as a prospective business partner. After the breakdown of partnership negotiations, the defendant subsequently registered the

155. See id.
156. See id. at *1-*2.
157. See id. at *2.
159. See supra note 149 and accompanying text.
161. See id. at *1. A "senior user" is the party that first uses or intends to use a mark. In contrast, a "junior user" is a party that seeks to exploit a mark, not necessarily in bad faith or with malicious intent, after another has already used it.
162. See id.
mark in the state of Pennsylvania and used it for his own business purposes. The court held that, even if the plaintiff in fact originated the mark, the plaintiff's lack of evidence showing actual use of the mark voided his claim of trademark infringement. Chong illustrates that it is not enough to merely invent a mark; instead, to qualify as a trademark, actual use of the mark in some capacity must occur.

Finally, in Suh v. Yang, the district court ruled that the term “Kuk Sool” was a generic term for a form of Korean martial arts. Applying the established trademark principle of translating foreign terms into their English equivalent to evaluate distinctiveness, the court found “Kuk Sool” to mean “national martial arts” or “traditional martial arts” in Korean. The plaintiff wholly created the mark, extensively used the mark for several decades, and registered the mark in Canada, England, and over half of the United States. Nevertheless, the court ruled that the term itself merely designated a type or “class” of martial arts. As such, the term was too broad to give exclusive trademark rights to the plaintiff. Suh suggests that even where a mark is invented by a single source, used at length over time in a variety of jurisdictions, and significantly registered, a finding that the mark is “generic” completely invalidates any claim of trademark infringement.

III. IDENTIFICATION OF THE LEGAL PROBLEM

The term “Jeet Kune Do” has great monetary value, whether used to sell merchandise, self-defense classes, or in other forms of commercial endeavors. Indeed, if considered a “trademark,” the party owning the mark’s exclusive rights would have the option of preventing others from using the

163. See id. at *2.
164. See id. at *1–*2.
165. See id. at *2.
166. See 3 MCCARTHY, supra note 43, § 19:3.
168. See id. at 792.
169. See id. at 790; 2 MCCARTHY, supra note 43, § 11:34.
171. See id. at 786.
172. See id. at 792. The court equated the class of martial arts “Kuk Sool” represents to that of other non-registerable classes like Karate, Gung Fu, and Tae Kwon Do. See id.
173. See supra note 46 and accompanying text.
mark and/or licensing its use for profit. But can "Jeet Kune Do" qualify as a trademark?\textsuperscript{174} Even if found distinct, has the mark been abandoned?\textsuperscript{175} Are there any implications to the mark being "famous" to a particular population segment?\textsuperscript{176} Over the past twenty-seven years, has the mark become "diluted"?\textsuperscript{177} If found a trademark, how would this affect those who have used the mark for commercial purposes in the past twenty-seven years?\textsuperscript{178} These are some of the issues addressed in the following analysis.

**IV. ANALYSIS OF THE LEGAL PROBLEM**

**A. Ownership of "Jeet Kune Do"**

Who would appropriately own the trademark rights to the "Jeet Kune Do" ("JKD") mark if such rights are merited? Since Bruce Lee never sold or assigned his rights to the mark, and since all property rights were eventually transferred to his estate upon his death,\textsuperscript{179} the estate of the late Bruce Lee ("Estate") would presumably own the trademark rights to the JKD mark. As a result, this analysis centers on the Estate's perspective.

**B. Distinctiveness**

One of the most fundamental issues is whether the term "Jeet Kune Do" is distinctive enough to merit trademark status.\textsuperscript{180} Trademark precedent requires translation of a term composed of foreign words into English to evaluate its distinctiveness.\textsuperscript{181} "Jeet Kune Do" translates to "way of the intercepting fist."\textsuperscript{182} Given how the term was derived and subsequently used, the JKD mark arguably falls within one of the three sub-categories of distinctiveness, "fanciful," "sugges-

\textsuperscript{174} See infra Part IV.B.
\textsuperscript{175} See infra Part IV.C.
\textsuperscript{176} See infra Part IV.D.
\textsuperscript{177} See infra Part IV.E.
\textsuperscript{178} See infra Part IV.E.
\textsuperscript{179} See Telephone Interview with Adrian Marshall, Bruce Lee's former attorney and attorney of the Bruce Lee Estate (Nov. 11, 1998). After a complicated five-year probate proceeding, all of Bruce Lee's estate passed to his widow, Linda Lee Cadwell. See id.
\textsuperscript{180} See 2 MCCARTHY, supra note 43, § 11:2.
\textsuperscript{181} See 2 id. § 11:34.
\textsuperscript{182} See supra text accompanying note 3.
First, because Bruce Lee coined “Jeet Kune Do” out of his imagination and the term could not be reasonably confused with any other martial art then existing, the facts indicate that the mark is the most distinctive type of all: “fanciful.” This is a strong argument since a fanciful mark is one that is made-up, obsolete, or otherwise wholly unfamiliar to the typical purchaser. It is certain that Bruce Lee made up the

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183. For various reasons, the Jeet Kune Do mark would probably not be considered either “arbitrary” or “generic.” First, “Jeet Kune Do” is not likely “arbitrary” since the term, when translated, does suggest some characteristics of Bruce Lee’s art. See 2 McCarthy, supra note 43, § 11:11. Second, “Jeet Kune Do” (or its English translation) is probably not “generic” because the term is distinctive. It would be a different matter if the mark translated into “way of fighting” or “way of Chinese fighting” or some other vague interpretation that merely stated the nature of the thing it was representing. See supra note 170 and accompanying text. However, the words “intercepting” (“jeet”) and “fist” (“kune”) give the term distinction. See 1 Little, Words of the Dragon, supra note 1, at 95. Also, the term itself only denotes a concept or principle of the art. See supra note 40. The literal term does not sufficiently describe the art itself—Bruce Lee’s expression of combat included quite a variety of fighting techniques as well as philosophical aspects. See Little, The Warrior Within, supra note 4, at 104–05. Hence, “way of the intercepting fist” does not adequately define the nature of the art. See Chris Kent & Tim Tackett, Jun Fan/Jeet Kune Do 9 (1988). In addition, the mark has not become generic by developing such popularity since its origination that the public uses the term as a generic name for the product itself. See 2 McCarthy, supra note 43, § 11:9. That is, the public does not refer to “Jeet Kune Do” as a synonym for “martial arts.” Finally, unlike many other martial arts, Jeet Kune Do has not lost all distinctiveness because it is not hundreds or thousands of years old, with its exact origins obscured over time. See supra note 172 and accompanying text. Rather, Jeet Kune Do and the JKD mark are only about thirty years old, and the identification of their originator is absolutely certain. See Inosanto, supra note 38, at 66–67; 3 Little, Jeet Kune Do, supra note 21, at 47; Tucci, supra note 36; infra text accompanying note 188.

184. See 3 Little, Jeet Kune Do, supra note 21, at 47; Little, The Warrior Within, supra note 4, at 190; Tucci, supra note 36.

185. It is arguable that some individuals unfamiliar with the martial arts could potentially confuse “Jeet Kune Do” with the Korean martial art, “Tae Kwon Do.” Similarly, the abbreviations for each, “JKD” and “TKD,” may also be considered confusing. However, “Tae Kwon Do” is a Korean term, while “Jeet Kune Do” is Cantonese, a Chinese dialect. Hence, it is not likely that these terms would be confusing to the most important consumers here—at least from a trademark standpoint—those who speak the respective languages of the terms involved. See supra notes 63–65. Also, no party could claim infringement upon the term “Tae Kwon Do” because it is considered generic. See supra text accompanying note 172.


187. See supra note 53 and accompanying text.
term “Jeet Kune Do.” While the words used in the term are not obsolete, its literal translation would be quite unfamiliar to Cantonese-speaking consumers, at least when originated.

It is arguable that because the mark is rooted in the fencing term “stop-hit,” it is merely descriptive. However, the term itself does not accurately describe the art. In addition, Bruce Lee replaced the word “hit” with “fist.” Further, when Lee devised the translation for “stop” in the context of what he wanted the term to mean, the best Cantonese interpretation more accurately meant “intercepting.” Finally, the addition of “Do” also joined “way of” to the term. While some Cantonese speakers may possibly deduce that “way of,” “intercepting,” and “fist” denotes a martial art of some kind, it is unlikely, especially since the term itself does not accurately define what the art represents. Taken together then, Cantonese-speaking consumers with no prior knowledge of Jeet Kune Do would likely find the term “fanciful,” and thus an inherently descriptive mark.

Second, because “way of the intercepting fist” suggests some qualities of the “product” the mark represents (i.e., a fighting art), and since the term was based on the concepts of simplicity, directness, efficiency, and adaptability, the JKD mark is arguably “suggestive.” However, this classification is doubtful since many Cantonese speakers would probably not think “Jeet Kune Do,” on its face, is a martial art. The general public could not infer the concepts Jeet Kune Do is based upon from the mark itself. Still, it is plausible that since the JKD mark may suggest a martial art, it is “suggestive.”

Third, if the JKD mark merely designates a martial art, the term could be deemed “descriptive” because it simply describes an aspect of the product. In this case, the term would not be inherently distinctive, and would hence require a

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188. See 3 Little, Jeet Kune Do, supra note 21, at 47; Little, The Warrior Within, supra note 4, at 190; Tucci, supra note 36. Bruce Lee’s tombstone in Seattle, Washington is even inscribed: “Founder of Jeet Kune Do.” L. Lee, supra note 17, at 164.

189. See supra note 63.

190. See supra text accompanying note 183.


192. See 1 Little, Words of the Dragon, supra note 1, at 164 n.5.

193. See 1 id.

194. See supra text accompanying note 183.

195. See supra note 40 and accompanying text.
showing of acquired public recognition, or "secondary meaning," to be a trademark. However, if JKD as a "suggestive" mark is questionable, JKD as a "descriptive" mark is even less likely since "way of the intercepting fist" does not correctly define the art it represents. At most, the term characterizes a concept that the art favors; however, even this is not obvious, and thus, not thoroughly "descriptive."

In sum, "Jeet Kune Do" is likely the most distinctive type of mark, "fanciful," although it is somewhat likely to be deemed "suggestive." In either event, the mark is inherently distinctive, and therefore "strong." While finding the mark "descriptive" is possible, this is improbable given the lack of inherent descriptiveness of the mark itself in relation to what it represents.

C. Abandonment

Even if the JKD mark is distinct, the issue remains as to whether the Estate abandoned it in the years since Bruce Lee's death. If abandonment has occurred, the mark becomes part of the public domain and may be used by anyone. There has likely been a three-year period within the past twenty-seven years when the Estate did not use the term "Jeet Kune Do," or the initials "JKD," in some capacity. As a result, prima facie abandonment (i.e., the rebuttable presumption of abandonment) is presumed. The Estate now has the burden of showing that it did not abandon its proprietary rights in the mark.

"Non-intentional" abandonment, which may result from uncontrolled licensing of a mark, assigning a mark apart from its goodwill, or the mark becoming generic, has not occurred in the present case. The Estate has licensed Bruce Lee's proprietary rights to a very select group, and has therefore not

197. See supra text accompanying note 183.
198. See 2 McCarthy, supra note 43, § 11:14. Having a "strong" mark is beneficial since it gives its owner broader trademark rights, and, in marginal "likelihood of confusion" cases, the mark's owner is generally favored. See 2 id. § 11:6; see also 3 id. § 24:64.
199. See 2 id. § 17:1.
200. See Telephone Interview with Adrian Marshall, supra note 179.
201. See 2 McCarthy, supra note 43, § 17:18.
202. See supra notes 82–84.
203. See Telephone Interview with Adrian Marshall, supra note 179. Typi-
engaged in uncontrolled licensing of the JKD mark. The Estate has likewise not assigned or contracted any mark it claims a right to apart from its goodwill. Finally, the JKD mark is not generic.

A more persuasive claim exists for abandonment through "non-use" of the mark. Non-use abandonment requires "clear and convincing" proof that the Estate had an "intent not to resume" use of the mark. This is the Estate's most difficult obstacle. While the Estate adamantly prohibits known infringement of Bruce Lee's likeness and name, the Estate has taken no action against any party solely for an unauthorized use of the JKD mark. While the Estate may argue it never had reason to take such action, its failure to sue third-party infringers greatly suggests abandonment, especially since the Estate consistently brought suit for other types of infringement.

As Chang School of Judo & Karate, Inc. v. Dragon Gym, Inc. illustrates, being the originator of a mark is insufficient to establish a trademark—there must be actual use of the mark. Bruce Lee used the JKD mark for at least seven years before his death in 1973. To maintain its rights in the mark, the Estate must show actual use or intent to continue commercial use of the mark since that time, not merely token

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204. See Telephone Interview with Adrian Marshall, supra note 179.
205. See supra text accompanying note 183.
206. See 2 MCCARTHY, supra note 43, § 17:12.
208. See Telephone Interview with Adrian Marshall, supra note 179; see also supra note 203 and accompanying text.
209. See Telephone Interview with Adrian Marshall, supra note 179.
211. See supra text accompanying note 203.
213. See id. at *2.
214. "Jeet Kune Do" was coined sometime in 1965 or 1966; Bruce Lee passed away in 1973. See 3 LITTLE, JEET KUNE DO, supra note 21, at 47; 1 LITTLE, WORDS OF THE DRAGON, supra note 1; Tucci, supra note 36.
use.\textsuperscript{215} While temporary gaps within the past twenty-seven years may be excused in certain circumstances, long periods of delay require an explanation of good reason.\textsuperscript{216} Without this showing of good reason, and in light of the lack of lawsuits brought by the Estate against potential infringers of the JKD mark, a court may find abandonment.

As a defense, the Estate may emphasize the fact that it has attentively maintained its “publicity” rights in Bruce Lee’s image and name against potential infringers.\textsuperscript{217} This arguably indicates the Estate’s intent to continue use of Lee’s proprietary rights, including rights in the marks he originated. Further, the Estate’s failure to bring suit against any party for infringing its rights in the JKD mark does not necessarily evidence abandonment since an owner is not obligated to sue for every infringing use.\textsuperscript{218} Therefore, if the Estate demonstrates that it did not bring an infringement claim against any infringer because it sincerely had no reason to bring suit,\textsuperscript{219} abandonment is not proven. With these arguments, therefore, the Estate could assert that the “clear and convincing” abandonment standard is not met.\textsuperscript{220}

D. Dilution & Fame

Assuming the above argument is persuasive and the Estate rebuts prima facie and non-use abandonment, there are still dilution issues involving the JKD mark. Dilution through “blurring” of the term “Jeet Kune Do,” either directly\textsuperscript{221} or indirectly,\textsuperscript{222} has likely occurred to some degree

\textsuperscript{215} See 2 McCarthy, supra note 43, § 17:11.
\textsuperscript{216} See supra notes 92–93 and accompanying text.
\textsuperscript{217} See supra text accompanying note 203. The “right of publicity” is “the inherent right of every human to control the commercial use of his or her identity.” 4 McCarthy, supra note 43, § 28:1. Except for use of one’s identity that constitutes free speech or free press, this legal right is infringed through unauthorized use that will likely damage the commercial value of one’s identity. See 4 id. Further, the present state of the law generally asserts that the right of publicity is descendible property with an unconditional post-mortem duration. See 4 id. § 28:45.
\textsuperscript{218} See 2 McCarthy, supra note 43, § 17:17.
\textsuperscript{219} This would occur, for example, if the Estate never encountered a use of the JKD mark that it found offensive. See supra text accompanying note 104.
\textsuperscript{220} See 2 McCarthy, supra note 43, § 17:12.
\textsuperscript{221} Blurring of the JKD mark could occur directly through so-called Jeet Kune Do instructors who do not have permission, either from Bruce Lee or the Estate, to sell personal instruction, videotapes, or seminars under the name recognition of “Jeet Kune Do.”
since 1973, despite the Estate's efforts. Blurring occurs when consumer confusion results from third parties' unauthorized use of the JKD mark on goods or services that are not the original owner's goods or services. To a lesser extent, the JKD mark may also have been diluted by "tarnishment," i.e., degradation of the mark's public reputation and goodwill.

The Lanham Act specifically grants a "famous mark" special protection from dilution. To determine whether "Jeet Kune Do" is "famous" requires an evaluation of the eight specified criteria in the Lanham Act.

Factor (A), the degree of inherent or acquired distinctiveness of a mark, traditionally requires an allegedly famous mark to evidence a significant showing of fame. As a result, a sufficient level of fame among allegedly famous marks is highly selective and discriminating. While the JKD mark is quite famous among a specific segment of the population, it is highly doubtful the mark meets this requirement in regard

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223. See supra text accompanying note 203.
224. See supra note 107 and accompanying text.
225. See supra note 109 and accompanying text. This is less plausible than "blurring" since "tarnishment" is typically associated with obscene, illegal, or unwholesome products. See supra note 109 and accompanying text. Therefore, while unauthorized, the likely infringement claimed in terms of the JKD mark (if in fact "Jeet Kune Do" is deemed a trademark) would probably not constitute dilution by tarnishment. See supra text accompanying notes 221–22. However, an argument can be made that the Bruce Lee-exploitation movies of Asia, insofar as they affect U.S. interstate commerce, qualify as a form of tarnishment since such films likely degrade the reputation of both Bruce Lee and his art. See supra note 122 and accompanying text.
226. See supra note 111 and accompanying text. For a brief discussion of whether Bruce Lee's name can be trademarked and found a "famous mark" under the Lanham Act, see infra note 303 and accompanying text.
228. See Lanham Act § 43(c).
230. See 3 id.
231. Undoubtedly, this segment includes athletes, martial artists, and fans of Bruce Lee around the world. See 2 LITTLE, THE TAO OF GUNG FU, supra note 2, at 199.
to the general public, especially under the Lanham Act's rigid scrutiny.

Factor (B), the duration and extent of a mark's use in connection with the goods or services with which the mark is used,\(^{232}\) essentially assesses the fame of the mark acquired through secondary meaning.\(^{233}\) The "secondary meaning" required here must be greater than that necessary to convert a "descriptive" mark into a trademark, since this factor evaluates a mark's fame.\(^{234}\) Again, while "Jeet Kune Do" has acquired secondary meaning among a specific segment of the population,\(^{235}\) perhaps even to the degree of "fame," Jeet Kune Do would not be nearly as popular among the general public. Hence, the JKD mark would not likely meet this factor in a broader regard.

Factor (C), the duration and extent of advertising and publicity of the mark,\(^{236}\) evaluates the quality and quantity of advertising and publicity of the mark.\(^{237}\) Over the past twenty-seven years, the Estate has engaged in several licensing agreements,\(^{238}\) endorsements,\(^{239}\) and various commercial endeavors,\(^{240}\) all of which affect the advertising and publicity of the JKD mark. However, these efforts focus on a specific target market,\(^{241}\) and have not led to broad national exposure. Consequently, while the various promotional and publicity endeavors involving the JKD mark boost recognition among a certain population segment,\(^{242}\) they have not led to general recognition that JKD is a "famous" mark.

Factor (D), the geographical trading area of a mark,\(^{243}\) examines how far-reaching a mark's use is on a national scale.\(^{244}\)

\(^{232}\) See Lanham Act § 43(c).
\(^{233}\) See 3 McCarthy, supra note 43, § 24:92.
\(^{234}\) See id.
\(^{235}\) See supra text accompanying note 231.
\(^{236}\) See 3 id.
\(^{237}\) See supra note 179.
\(^{238}\) The Estate has licensed various memorabilia, such as clothing, pictures, video documentaries, and statues. See Telephone Interview with Adrian Marshall, supra note 179.
\(^{239}\) The Estate has endorsed various books, individuals, and organizations, e.g., the Bruce Lee Educational Foundation. See id.
\(^{240}\) The Estate has also produced books and publications of its own. See id.
\(^{241}\) See supra text accompanying note 231.
\(^{242}\) See supra text accompanying note 231.
\(^{244}\) See 3 McCarthy, supra note 43, § 24:92.
This factor does not evaluate the fame of the JKD mark, but rather its geographical extent of use. The Estate could easily meet this criterion since many of its JKD-related endeavors have national as well as international reach.

Factor (E), the "channels of trade" element, merely requires definition of the specific market in which a mark is famous. This factor also favors the Estate since the specific segment of the population to which the JKD mark is used is readily ascertainable: athletes, martial artists, and fans of Bruce Lee.

Factor (F), a mark’s recognition in diverse product lines, underscores the fact that a mark famous only to a specific population segment or market cannot be diluted through use of the mark in an unrelated segment or market. This aptly applies to the JKD mark since its popularity is decidedly segmented. As a result, even if found “famous” among this particular market, the protection afforded to the JKD mark could not be extended to products or services completely unattached to Bruce Lee, the Estate, Jeet Kune Do, or the martial arts.

Factor (G), third-party use of the same or similar mark, asserts that a designation among a group of like marks is not “famous.” As stated earlier, various unauthorized uses of the Estate’s proprietary rights resulted in legal action by the Estate whenever such infringement became known. However, the Estate never filed an action solely on the basis of unauthorized use of the JKD mark. The relevancy of this legal inaction depends upon the number of times third parties...

245. Projects of the Estate that have had extremely broad geographic range include films/documentaries, certain affiliations (e.g., the Bruce Lee Educational Foundation), and books (e.g., Bruce Lee’s Fighting Method, volumes 1 to 4, and Tao of Jeet Kune Do have been sold in 9 languages). See 1–4 BRUCE LEE & M. UYEHARA, BRUCE LEE’S FIGHTING METHOD (1976); B. LEE, supra note 23; Telephone Interview with Adrian Marshall, supra note 179.

246. See Lanham Act § 43(c).


248. See Lanham Act § 43(c).

249. See 3 MCCARTHY, supra note 43, § 24:92.

250. See supra text accompanying note 231.

251. See supra text accompanying note 203.


253. See supra text accompanying note 222.

254. See supra text accompanying note 203.

255. See Telephone Interview with Adrian Marshall, supra note 179.
have used the JKD mark in connection with a variety of goods or services. The more third parties used the JKD mark for the purpose of signifying a product, the less likely the mark is identified with a single source.

Factor (H), determining how a mark was registered, asserts that failure to federally register a mark evidences the owner’s admission that the mark is not “famous.” Moreover, it is inconsistent for the holder of a mark to assert that it is “famous” under the Lanham Act, thereby empowering the holder with special anti-dilution protection, when the mark is unregistered. Neither Bruce Lee nor the Estate has ever attempted to trademark “Jeet Kune Do” or “JKD.” Given the strict historical interpretation of this factor, the Estate must explain why the unregistered JKD mark is still entitled to “famous” status.

Taken together, these eight factors indicate a strong likelihood that the JKD mark is not nationally “famous” under the Lanham Act’s definition. However, this does not mean that the mark is totally devoid of dilution protection. Since JKD may be considered “famous” among a particular segment of the population, the Estate may assert the Lanham Act’s dilution protections when another uses the JKD mark for a product in the same or similar segment. Thus, this anti-dilution protection is limited because it will not apply to instances of dissimilar products or services.

Even this limited anti-dilution protection under the Lanham Act is significant. Not only would it give the Estate national dilution protection (even if only to a particular market)

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257. See 3 id.
260. See 3 id.
261. See Telephone Interview with Adrian Marshall, supra note 179; Telephone Interview with James O’Neill, attorney of the Bruce Lee Estate and the Bruce Lee Educational Foundation (Nov. 13, 1998).
262. See 3 MCCARTHY, supra note 43, § 24:92.
263. See supra text accompanying note 231.
264. See 3 MCCARTHY, supra note 43, § 24:112.
265. See 3 id. Practically speaking, however, this limitation is probably insignificant since the term “Jeet Kune Do” would rarely be used in a context other than in relation to Bruce Lee, the Estate, or the martial arts.
TRADEMARKING “JEET KUNE DO” against any further domestic “blurring” or “tarnishment,” it also reaches foreign activities affecting the Estate’s trademark rights in America and affecting U.S. interstate commerce. Such authority could also extend to foreign activities that only indirectly affect American commerce, as well as to cases where a domestic infringing party uses the Estate’s mark solely for export to foreign nations. Moreover, being deemed “famous” to a particular population segment under the Lanham Act may protect the JKD mark in nations that recognize the “famous marks doctrine” as a means of protecting well known, yet unregistered, foreign marks. While the JKD mark may be independently “famous” in some of these foreign nations, deeming the mark famous under the Lanham Act only supports the Estate’s foreign claims.

E. Defenses

An alleged infringer may have several defenses for use of the mark. First, an infringer may assert that the statute of limitations has run on the infringement claim. While the Lanham Act provides no defined statute of limitations, courts usually adopt the state statute of limitations for similar sorts of actions. Under this defense, the alleged infringer, without arguing any merits of the case, simply asserts that the Estate’s delay in bringing suit for the statutory period bars its opportunity to file an infringement claim. While this defense is available in some instances, an alleged infringer will more likely assert the estoppel by laches defense against the delay in bringing suit.

Laches involves a delay that results in prejudice to the alleged infringer, which in turn serves as some bar to relief. While there is no established consensus on what amount of

266. See supra text accompanying notes 221–22.
267. See supra text accompanying note 225.
268. See supra text accompanying note 122.
269. See supra note 124 and accompanying text.
271. See 4 id. § 29:61.
272. See supra notes 4 and 245 and accompanying text.
273. See supra text accompanying note 111.
275. See 5 MCCARTHY, supra note 43, § 31:33; supra notes 135 and 136.
277. See supra note 138 and accompanying text.
delay justifies a laches defense, the case law seems to allow no delay longer than fifteen years. Assuming an infringer began use of the JKD mark immediately following Bruce Lee's death (i.e., when the mark ceased active use by its originator), the Estate would have to account for a delay as long as twenty-seven years. Assuming this worst-case scenario, such an extended delay in bringing suit would undoubtedly merit a laches defense. This long delay could estop the Estate's infringement claim even in cases where there is a high likelihood of confusion or where a third party knowingly and deliberately infringed the JKD mark.

Such delays could be absolved, however, if the Estate gave a valid reason for the delay. For example, in Gracie v. Gracie, the court overlooked a five-year delay in bringing suit because of other litigation involving the trademark holder and the lack of notice of the infringing use. The Estate may similarly argue that "other litigation" prevented a more immediate suit. While the Estate has engaged in a number of lawsuits, the Estate could probably not cite twenty-seven years' worth of continuous litigation that prevented it from filing suit. The Estate might prevail if it cited a lack of notice of the infringing use in question. Of course, the credibility of this argument varies on a case-by-case basis. However, case law suggests that even a lack of notice may not excuse such a long delay.

For some alleged infringers, "acquiescence" may provide a valid defense. "Acquiescence" requires a delay in bringing suit and an implication of active consent by the trademark owner, whether by word or deed, to use the mark. Under the unique circumstances surrounding the JKD mark, Bruce Lee or the Estate may have granted consent to use the

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278. See 5 MCCARTHY, supra note 43, § 31:29.
279. See 1 LITTLE, WORDS OF THE DRAGON, supra note 1, at 160.
281. See 5 id. § 31:14.
283. See supra text accompanying note 203; see also 5 MCCARTHY, supra note 43, § 31:16.
285. See 5 id. § 31:30 n.3.
286. See 5 id. § 31:41.
287. See 5 id. § 31:42.
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mark. In either instance, reliance on such consent for a long period of time likely precludes any attempted revocation of consent by the Estate.

In sum, there are potentially strong defenses available to third parties if the Estate were to file suit for infringement. Generally, the longer an alleged infringer used the JKD mark the more likely a defense will be successful because of the exceptionally long period of potential delay in this case.

F. Originator’s Intent and Jeet Kune Do as a “Class”

Finally, there are some novel arguments against trademarking the JKD mark at all. First, Bruce Lee maintained the following views on the importance of the term “Jeet Kune Do”:

I stress again, I have not created or invented any kind of martial art. Jeet Kune Do is derived from what I have learned, plus my evaluation of it. Thus, my JKD is not confined by any kind of martial arts. On the contrary, I welcome those who like JKD to study it and improve it.

“Very often when people talk about JKD, they are very much concerned about its title. Actually, the title is not important. It’s only a symbol for the kind of martial art we study.”

If people say Jeet Kune Do is different from ‘this’ or from ‘that,’ then let the name of Jeet Kune Do be wiped out, for that is what it is, just a name. Please don’t fuss over it.

From these remarks, it can be reasonably inferred that Lee did not particularly care about the mark itself. Further, Lee may have never intended for Jeet Kune Do to become the “Gospel Truth” in the minds of its practitioners or for third

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289. 3 LITTLE, JEET KUNE DO, supra note 21, at 55.
290. 3 id. at 49.
292. Bruce Lee summarized his dislike of martial art “styles” in the following:

I do not teach because I do not believe in styles anymore. I mean I do not believe that there is such a thing as, like, “the Chinese way” of fighting or the “Japanese way” of fighting . . . or whatever “way” of fighting, because unless a human being has three arms and four legs, there can be no different form of fighting. But, basically, we only have two hands and two feet. So styles tend to separate man—because they have their own doctrines and the doctrine became the Gospel Truth
parties to fight over rights to the mark in court. Thus, since
the originator of the mark never placed much emphasis on
the importance of the actual JKD term, no third party should
have a right to claim its ownership.

On a somewhat related rationale, it may be argued that
the philosophy behind Jeet Kune Do makes the art amorphous, and therefore impossible to define. The tenets of (1)
researching your own experience, (2) absorbing what is use-
ful, (3) rejecting what is useless, and (4) adding what is spe-
cifically your own makes “Jeet Kune Do” different for every
practitioner. Hence, it is arguable that vesting the use of the
JKD mark in one party is improper since the art of Jeet Kune
Do is not a rigid curriculum, but more accurately a “class” of
martial arts. Therefore, as a class of martial arts, Jeet
Kune Do cannot be trademarked.

The first argument regarding the originator’s intent, al-
though possessing intuitive validity, does not necessarily
have legal standing. A trademark is fundamentally a unique
designator of a product or source. If used to designate a
product, a trademark is likely to result regardless of the in-
tent of the originator. This is precisely how Bruce Lee used
the term “Jeet Kune Do”—as a unique mark describing his
expression of the martial arts, and therefore a designation of
what he taught to others. Once a mark is used in this way
in commerce, the Lanham Act does not require the origina-

3 LITTLE, JEET KUNE DO, supra note 21, at 59–60.
293. See 3 LITTLE, JEET KUNE DO, supra note 21, at 47; LITTLE, THE
WARRIOR WITHIN, supra note 4, at 190; Tucci, supra note 36.
294. See LITTLE, THE WARRIOR WITHIN, supra note 4, at 114.
295. See supra note 172 and accompanying text. Note that the use of “class”
in the text is not to be confused with the various classes assigned to goods and
services associated with a mark upon trademark registration. For example,
such trademark classes of goods include “chemicals,” “machinery,” and “cloth-
ing,” while service classes include “advertising and business,” “telecommunica-
authority to establish such a classification system is given to the PTO's Com-
missioner of Patents and Trademarks. See Trademark Act of 1946 (Lanham
296. See supra note 43.
297. See supra note 43.
298. See 3 LITTLE, JEET KUNE DO, supra note 21, at 59.
tor's intent to create a trademark. Therefore, while Bruce Lee may not have planned to create a trademark, he in fact originated a unique mark used in commerce to distinguish his product, and thereby created a trademark.299 Bruce Lee's intent not to place importance on the term "Jeet Kune Do" does not invalidate the establishment of a trademark.

The second argument, that Jeet Kune Do is a "class" of martial arts and is thus unable to be trademarked, has more merit. If in fact Jeet Kune Do is deemed a "class" of martial arts, it cannot be trademarked.300 Given the lack of case law in this area, the ultimate determination of this issue is uncertain. In evaluating this issue, the presiding court must focus on the issue of distinctiveness, both in terms of the art and the "Jeet Kune Do" mark itself.301

V. PROPOSAL

There are several actions the Estate may take to protect its property rights. First, the Estate should attempt to federally register the marks "Jeet Kune Do" and "JKD."302 In addition, the Estate should consider seeking a trademark in the name "Bruce Lee," since federal trademark protection is very broad, both domestically and internationally.303

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299. Although he stated numerous times his intent not to have Jeet Kune Do be thought of as a "style," Bruce Lee did acknowledge that he needed to designate his art somehow, even if only for convenience's sake. See supra notes 23, 34, and 292 and accompanying text. Thus, the basic requirement that the mark be used to distinguish Lee's "product" was satisfied.

300. See supra note 172 and accompanying text.

301. See supra note 172 and accompanying text.

302. A search of federal trademarks revealed that neither "Jeet Kune Do" nor "JKD" have been federally registered. The PTO maintains a web site from which members of the public can determine whether a mark has been registered. See U.S. Trademark Boolean Search Page (visited Jan. 22, 1999) <http://trademarks.uspto.gov>.

303. A search of federal trademarks revealed that "Bruce Lee" has not been federally registered. See id.

The Lanham Act does allow the trademark of a surname if secondary meaning can be shown, which is a burden the Estate could likely meet. See Trademark Act of 1946 (Lanham Act) § 2(e)(4), (f), 15 U.S.C. § 1052(e)(4), (f) (1998). In fact, the Estate is more likely able to register Bruce Lee's name than "Jeet Kune Do," given Bruce Lee's widespread popularity compared to Jeet Kune Do's more segmented notoriety. See supra notes 4 and 231 and accompanying text. Moreover, the fact that the Estate has actively pursued protection of its proprietary rights in Bruce Lee's name and likeness, while also engaging in commercial endeavors in these rights, evidences the Estate's "substantial exclusive and continuous use" of the mark. Lanham Act § 2(f); see supra notes 203
If the PTO rejects these trademark applications, the Estate should contemplate registering with state trademark offices. While not as far-reaching or influential as federal protection, state trademark registration may still be beneficial, particularly in states where infringement is most frequent. Though not ideal, state protection is preferable to no preservation of rights at all.

VI. CONCLUSION

The Bruce Lee Estate must overcome many obstacles to preserve its trademark rights in the "Jeet Kune Do" mark. First, the Estate must establish that the mark has sufficient distinctiveness. "Jeet Kune Do" would most likely be found the most distinctive type of mark, "fanciful," or possibly "suggestive." In either case, the mark would be deemed inherently distinctive, and therefore "strong." Even if distinct, the issue of abandonment of the mark in the twenty-seven years since Bruce Lee's death remains. Although the mark was probably not "non-intentionally" abandoned, the Estate must rebut the presumption of prima facie abandonment. Even more problematic, the Estate must show that abandonment through "non-use" of the mark has not occurred. Under this claim, an alleged infringer must

and 238-40 and accompanying text.

Here, national registration is preferable since the Estate's use of California Civil Code § 990 is much more limited in terms of jurisdictional reach than the federal Lanham Act, which has great domestic and international authority. See supra notes 122-25 and 203 and accompanying text.

If the Estate is granted registration in Bruce Lee's name, it may then bolster its protection further by asserting in subsequent lawsuits that the mark is "famous" under the Lanham Act. See Lanham Act § 43(c). If the Estate can meet the requisite standards, of which there is a good possibility, the Estate would have expanded rights against dilution, and not just protection in instances of overt infringement. See supra notes 106, 107, and 111 and accompanying text.

304. See Ginsburg et al., supra note 46, at 45. Of course, federal registration rights would take precedent over state registration rights. See id. For example, where another party already has federal rights to a mark, one's subsequent state registration would be invalidated; or where the federal PTO declares a mark "generic," this would also invalidate one's subsequent state trademark registration.

305. See supra Part IV.B.
306. See supra Part IV.B.
307. See supra Part IV.B.
308. See supra Part IV.C.
309. See supra Part IV.C.
show by "clear and convincing" evidence that the Estate intended not to resume use of the JKD mark. 310

The Estate's best defense against non-use abandonment is to emphasize the fact that it has attentively maintained its "publicity" rights in Bruce Lee's image and name against potential infringers. This arguably indicates the Estate's intent to continue use of Bruce Lee's proprietary rights. 311 The Estate must also explain that not bringing suit against any party for infringing its right in the JKD mark does not necessarily evidence abandonment since the owner of a mark is not obligated to sue every infringing use. 312 With these arguments, the Estate may assert that the "clear and convincing" standard is not met. 313

Assuming the above arguments are persuasive and the Estate rebuts prima facie and non-use abandonment, dilution issues of the JKD mark remain. Dilution through "blurring" and "tarnishment" of the term "Jeet Kune Do" has likely occurred since Bruce Lee's death in 1973, despite the Estate's efforts to oppose infringement. 314

The Estate may seek special protection from dilution by attempting to gain the Lanham Act's "famous mark" status. 315 However, an evaluation of the Lanham Act's eight statutory factors indicates that the JKD mark is not nationally "famous" under the Lanham Act's strict specifications. 316 Although not nationally "famous," the JKD mark is probably famous among a specific population segment. 317 Even this limited "famous" status not only gives the Estate significant national anti-dilution protection, but also meaningful foreign protection. 318 Hence, the potential reach of the Estate's authority to stop "Jeet Kune Do" infringement could be quite broad.

However, in addition to the preceding abandonment arguments, there are several valid defenses available to third

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310. See supra Part IV.C.
311. See supra Part IV.C.
312. See supra Part IV.C.
313. See supra Part IV.C.
314. See supra Part IV.D.
315. See supra Part IV.D.
316. See supra Part IV.D.
317. See supra Part IV.D.
318. See supra Part IV.D.
Such defenses include statute of limitations, estoppel by laches, and acquiescence. While the merit of such defenses would vary from case to case, they remain viable arguments for alleged infringers to justify their otherwise infringing use. Further, the Estate may have to reconcile issues involving Bruce Lee’s intent regarding the mark's use and whether Jeet Kune Do is a distinct martial art or merely a martial arts “class.”

Despite these obstacles, however, the Estate still has a significant chance of obtaining at least some rights in Bruce Lee’s Jeet Kune Do trademark. The Estate should seize this opportunity to better protect itself and the proprietary rights of Bruce Lee.

319. See supra Part IV.E.
320. See supra Part IV.E.
321. See supra Part IV.E.
322. See supra Part IV.F.
323. See supra Part V.
324. See supra Part V.