

# U.S. Supreme Court

**Park N' Fly Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189 (1985)**

**Park N' Fly Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189 (1985)**

**No. 83-1132**

**Argued October 9, 1984**

**Decided January 8, 1985**

**469 U.S. 189**

## *Syllabus*

Petitioner operates long-term parking lots near airports in St. Louis Cleveland, Houston, Boston, Memphis, and San Francisco. In 1969, petitioner applied to the United States Patent and Trademark Office to register a service mark consisting of the logo of an airplane and the words "Park 'N Fly." The registration issued in 1971, and nearly six years later petitioner filed an affidavit with the Patent and Trademark Office to establish the incontestable status of the mark under § 33(b) of the Trademark Act of 1946 (Lanham Act), which provides that "registration shall be conclusive evidence of the registrant's exclusive right to use the registered mark," subject to the provisions of § 15 and § 33(b) itself. Respondent provides long-term airport parking services called "Dollar Park and Fly," but only operates in Portland, Ore. Petitioner filed an infringement action in Federal District Court seeking to enjoin respondent from using the words "Park and Fly" in connection with its business. The District Court granted the injunction, rejecting, *inter alia*, respondent's defense that petitioner's mark is unenforceable because it is merely descriptive. The Court of Appeals reversed, holding that incontestability provides a defense against the cancellation of a mark but may not be used offensively to enjoin another's use, that, under this analysis, petitioner could obtain an injunction only if its mark would be entitled to continued registration without regard to its incontestable status, and that therefore respondent could defend by showing that the mark was merely descriptive. The court then determined that petitioner's mark is merely descriptive and respondent should not be enjoined from using the words "Park and Fly."

*Held:* The holder of a registered mark may rely on incontestability to enjoin infringement, and an infringement action may not be defended on the grounds that the mark is merely descriptive. Pp. [469 U. S. 193-205](#).

(a) The Lanham Act nowhere distinguishes between a registrant's offensive and defensive use of an incontestable mark, but, on the contrary, § 33(b)'s declaration that the registrant has an "exclusive right" to use the mark indicates that incontestable status may be used to enjoin infringement. The Act's language also refutes any conclusion that an incontestable mark may be challenged as merely descriptive. Pp. [469 U. S. 193-197](#).

(b) Nothing in the Lanham Act's legislative history supports a departure from the plain language of the provisions concerning incontestability. Indeed, a conclusion that incontestable status may provide the basis for enforcement of the registrant's exclusive right to use a mark promotes the Act's goals in providing national protection of trademarks in order to secure to the mark's owner the goodwill of his business and to protect the ability of consumers to distinguish among competing producers. Pp. 469 U. S. 197-202.

(c) There is no merit to respondent's argument that the Court of Appeals' decision should be upheld because trademark registrations are issued after an *ex parte* proceeding and generally without inquiry into the merits of an application. The facts of this case belie the suggestion that registration is virtually automatic, and respondent is simply wrong to suggest that third parties do not have an opportunity to challenge applications for trademark registration. The power of courts under § 34 of the Lanham Act to grant injunctions "according to principles of equity" does not encompass a substantive challenge to the validity of an incontestable mark on the grounds that it lacks secondary meaning. Otherwise, the meaning of "equity" would be expanded to the point of vitiating the Act's more specific provisions. Similarly, the power of courts to cancel registrations and "otherwise rectify the register" under § 37 of the Act must be subject to the specific provisions concerning incontestability. Pp. 469 U. S. 202-203.

(d) The Court of Appeals was not justified in relying on its decision in *Tillamook County Creamery v. Tillamook Cheese & Dairy Assn.*, 345 F.2d 158, *cert. denied*, 382 U.S. 903, for the proposition that a registrant may not rely on incontestability to enjoin the use of a mark. Pp. 469 U. S. 203-205.

718 F.2d 327, reversed and remanded.

O'CONNOR, J., delivered the opinion of the Court, in which BURGER, C.J., and BRENNAN, WHITE, MARSHALL, BLACKMUN, POWELL, and REHNQUIST, JJ., joined. STEVENS, J., filed a dissenting opinion, *post*, p. 469 U. S. 206.