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## Expressive Genericity: Trademarks as Language In the Pepsi Generation

Rochelle Cooper Dreyfuss\*

*The Mets are one of four major league baseball teams that boast their own clothing store.* — Gerald Eskenazi, noting that the Angels, Red Sox and Pirates are about to join the Mets, Padres, Brewers and A's in running such enterprises.<sup>1</sup>

*When I campaign alone I'm approachable. Women talk to me, complain, but when I'm with Ted I'm a Barbie doll.* — Marcia Chellis, quoting Joan Kennedy's account of her life with Edward Kennedy.<sup>2</sup>

*What does all this consolidating mean for publishing? The birth of McBooks.* — Sheldon Himelfarb, reporting the effect of "McEfficiency" and "McMarket research" on the publishing business after Random House purchased the Crown Publishing Group.<sup>3</sup>

*'Star War' Funds Cut in the Senate* — Headline, New York Times, September 27, 1989.<sup>4</sup>

*Their concern was how to pretend they had never left home. What hotels in Madrid boasted king-sized Beautyrest mattresses? What restaurants in Tokyo offered Sweet 'n' Low? Did Amsterdam have a McDonalds? Did Mexico City have a Taco Bell? Did any place in Rome serve Chef Boyardee ravioli?"* — Anne Tyler, describing the guide books prepared by her protagonist, Macon Leary.<sup>5</sup>

Trademarks have come a long way. Originating in the stratified economy of the middle ages as a marketing tool of the merchant class,<sup>6</sup> these symbols have passed into popular culture. During the journey, ideograms that once functioned solely as signals denoting the source, origin, and quality of goods, have become products in their own right, valued as indicators of the status, preferences, and aspirations of those who use them.<sup>7</sup> Some trademarks have worked their way into the English language; others provide bases for vibrant, evocative metaphors.<sup>8</sup> In a sense, trademarks are the emerging lingua franca: with a sufficient com-

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1 Eskenazi, *Sports Logos Now Symbols of Big Profits*, N.Y. Times, June 19, 1989, at A1, col. 2.

2 M. CHELLIS, *THE JOAN KENNEDY STORY: LIVING WITH THE KENNEDYS* 191 (Jove ed. 1986).

3 N.Y. Times, Sept. 25, 1988, § 4, at 25, col. 1.

4 Rosenthal, *'Star War' Funds Cut in the Senate*, N.Y. Times, Sept. 27, 1989, at A1, col. 1.

5 A. TYLER, *THE ACCIDENTAL TOURIST* 11 (Berkley ed. 1986).

6 F. SCHECHTER, *THE HISTORICAL FOUNDATIONS OF THE LAW RELATING TO TRADEMARKS* (1925).

7 See Eskenazi, *supra* note 1 (noting that combined sales of items bearing the logos of the teams of the National Football League, the National Basketball Association and Major League Baseball amount to billions of dollars); Bates, *Big Bucks in Boosterism; Marketing College Souvenirs Has Become a Billion-dollar Business*, L.A. Times, Sept. 25, 1989, Pt. 4, at 5, col. 1.

8 See G. CANNON, *HISTORICAL CHANGE AND ENGLISH WORD-FORMATION, RECENT VOCABULARY* 250 (1987).

mand of these terms, one can make oneself understood the world over, and in the process, enjoy the comforts of home.

Trademark law has not kept pace with trademark practice. Concerned initially with maintaining the lines of communication between the mercantile class and its customers, the law encouraged entrepreneurs to invest in quality-producing activities by protecting the goodwill that inhered in their source-identifying marks. Thus, in both state unfair competition cases and federal trademark actions, claims focused on the impact of the mark on purchasing decisions. By the same token, defenses centered on the commercial requirements of the competitive marketplace. The terms that delimited the reach of trademark law—consumer confusion, gap bridging, fair use, genericity, abandonment—were understood strictly by reference to these commercial interests.

But as trademark owners have begun to capitalize on the salience of these symbols in the culture, the justifications that formerly delineated the scope of the law have lost significance. The Mets' right to prevent others from selling banners, caps, and tee shirts marked with its logo could not initially be explained on quality-promotion grounds so long as it was clear that fans are not confused, and that they did not regard the franchise as insuring the quality of anything but a baseball team.<sup>9</sup> Nor does traditional trademark law offer an account for, or limits to, McDonald's claim to control non-food uses of the prefix "Mc,"<sup>10</sup> or George Lucas's attempt to exclude public interest groups from utilizing the title of his movie, "Star Wars."<sup>11</sup>

Lacking the traditional analytical tools provided by trademark law, courts have lately attempted to apply first amendment jurisprudence to such claims. But as *San Francisco Arts & Athletics Inc. v. United States Olympic Committee*<sup>12</sup> ("Gay Olympics") demonstrates, although the Constitution supplies a normative principle favoring public access to the tools of expression, the body of law that has developed under the first amendment provides a surprisingly uncongenial framework for analysis. Perhaps this provision is simply too blunt an instrument to parse rights to individual words; perhaps its focus on the communication of ideas makes it an inappropriate way to think about the linguistic material by which ideas are conveyed. In any event, the Court's decision to give the United States Olympic Committee (USOC) plenary authority over the word "Olympic" puts in jeopardy the public's ability to avail itself of the powerful rhetorical capacity of trademarks. Indeed, the controversy surrounding the burning of an American flag—the trademark of the United States—demonstrates how little the law understands the evocative significance of

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9 See, e.g., *Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg.*, 510 F.2d 1004 (5th Cir.), cert. denied, 423 U.S. 868 (1975).

10 See, e.g., *Quality Inns Int'l, Inc. v. McDonald's Corp.*, 695 F. Supp. 198 (D. Md. 1988).

11 See, e.g., *Lucasfilm Ltd. v. High Frontier*, 622 F. Supp. 931 (D.D.C. 1985).

12 483 U.S. 522 (1987).

trademarks and how poorly current jurisprudential techniques deal with conflicting claims to these ideograms.<sup>13</sup>

This Article attempts to develop a framework for allocating rights in words. After quickly recounting how the changing legal climate has tended to grant trademark owners ever greater control over their marks, Part I explains why these recently developed rules imperfectly measure, and therefore provide inadequate access to, the expressive dimension of trademarks. Part II takes a hard look at the connection between words and communication. It scrutinizes one example of the Court's handiwork in this area, and then draws upon the linguistic literature to show that discourse is indeed inhibited as control over words is lost. This Part suggests that since intellectual property law represents the single most coherent attempt to analyze rights in words, its commerce-oriented doctrines can be used as models upon which to base more expressively-directed safeguards. These new principles would owe their justification to first amendment jurisprudence, and would supplement the analytical framework that has been its progeny. To demonstrate how this suggestion would work, the Article ends with the construction of a doctrine of "expressive genericity," which protects access to the marketplace of ideas in a manner similar to the way that trademark's genericity defense has protected the marketplace of commerce.

This effort should not be understood as normative in the sense that I consider the guidelines it recommends the correct method for allocating rights in words. In fact, I do not believe that there is a tenable theory for plenary control over trademarks. As Part I makes clear, the justifications supporting other intellectual property rights, such as patents and copyrights, do not apply to expressive uses of trademarks because free ridership on the commercial aspect of marks is not a problem and besides, there is little need to create economic incentives to encourage businesses to develop a vocabulary with which to conduct commerce. Furthermore, the rationale underlying trademark law is fully effectuated by protecting the significance of marks in the principal markets of their proprietors. Nonetheless, if courts continue to permit trademark owners to extend their control, a framework for identifying and protecting core expressive interests will need to be developed.<sup>14</sup>

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13 See *Texas v. Johnson*, 109 S. Ct. 2533 (1989). Cf. *Cohen v. California*, 403 U.S. 15, 19-21 (1971) (noting the many jurisprudential classifications that fail to categorize an attempt to criminalize the use of particular words).

14 Thus, it should be emphasized that expressive concerns could be equally well protected by simply cutting back on the scope of trademark law. Signaling capacity could, for example, be fully protected by insuring exclusivity in words and symbols only as they appear on labels. So long as the public understood that the label (as statutorily defined) was the only place to look for a designation of source or origin, trademarks could be made freely available for all other purposes. This Article, however, accepts the expansion of trademark rights beyond the signaling core and attempts to create safeguards for expressive interests within that framework.

## I. Tracing the Expansion: A Trademark Approach

Linguists comment that without a metalanguage with which to write, it is difficult to avoid tautology when discussing what words do.<sup>15</sup> Accordingly, I begin with a brief statement on nomenclature. I call any device or symbol in which exclusive rights are sought a "trademark," a "mark," or an "ideogram" and consider its central role to be that of identifying goods and services and distinguishing them from those manufactured or sold by others.<sup>16</sup> I call this the "signaling" function of the mark. For instance, the word "Barbie" on a particular full-figured doll with a highly cosmetized face and an extensive wardrobe functions as a signal when it identifies Mattel as the manufacturer of a certain toy and signifies that the qualities associated with other Mattel products are also true of the doll.

The Joan Kennedy quotation at the beginning of this Article illustrates a second way in which trademarks are utilized. In referring to "Barbie" in order to indicate that she was treated like a beautiful but empty-headed accessory, Kennedy exploited a set of meanings that are quite different from the ones invoked by Mattel, and I label this use of the trademark "expressive." Although Marcia Chellis quoted Kennedy in a commercial product (her book), the absence of a connection between the presence of the word "Barbie" and a decision to purchase the book means that the word was not being used in what I have defined as its signaling sense.

If these two contexts exhausted the possible uses of marks, trademark law would be quite simple. Signaling usages of trademarks by parties other than the trademark owner would be actionable; other usages would be entirely permissible. The first use would be protected—and, indeed, is protected by both federal and state law<sup>17</sup>—because exclusivity is essential to an efficient marketplace. Without an unambiguous signal for goods, consumers would have no way to apply their past experience to future purchasing decisions. This absence would reduce suppliers' incentives to invest in quality-producing and brand-differentiating activities as the benefits of the investment could not be captured through

15 See, e.g., O. AKHMANOVA, *LEXICOLOGY: THEORY AND METHOD* 5-7 (1972); Jakobson, *Two Aspects of Language and Two Types of Aphasic Disturbances*, in R. JAKOBSON & M. HALLE, *FUNDAMENTALS OF LANGUAGE* 81 (2d rev. ed. 1971).

16 This definition is based on § 45 of the Lanham Act, 15 U.S.C. § 1127 (1988). I intend, however, to use the word "trademark" more comprehensively than it is used in the Act. That is, although for clarity's sake, I speak of trademarks and goods, the observations in the Article apply to service, certification, and collective marks, as well as marks, logos and advertising motifs protected under state law. In addition, many of my conclusions are also applicable to the emerging right of publicity. See, e.g., *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) (challenging Federico Fellini's use of the name and image of Ginger Rodgers in his movie, *Fred and Ginger*).

17 The Lanham Act, 15 U.S.C. §§ 1051-1127 (1988), is the principal source of federal protection for trademarks. It is supplemented by various other provisions, including the laws and regulations of the Federal Trade Commission, see, e.g., 15 U.S.C. §§ 41-58, the criminal law, 18 U.S.C. § 2320, and international trade laws and treaties, e.g., the Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, 25 Stat. 1372, T.S. No. 37, as revised, [1970] 21 U.S.T. 1583, T.I.A.S. 6923.

States protect trademarks through their common law of unfair competition and a variety of statutory provisions, see, e.g., *UNIFORM DECEPTIVE TRADE PRACTICES ACT*, 7A U.L.A. 265 (1966); Alexander & Coil, *The Impact of New State Unfair Trade Practices Acts on the Field of Unfair Competition*, 67 TRADEMARK REP. 625 (1977).

repeat sales to loyal customers. In addition, resource misallocations would occur whenever ambiguities in the marking of goods led consumers to purchase products unsuited to their needs.<sup>18</sup> Expressive uses of marks do not usually involve purchasing decisions. Accordingly, no prohibitions on such usages are generally necessary.

Somewhat unfortunately, however, hybrid usages of trademarks are also possible. It is these uses, which exist along the spectrum between what might be called their signaling and expressive functions, that have caused most of the difficulties. The easiest cases are, of course, those closest to the poles. On the expressive side, these are cases like *Prestonettes, Inc. v. Coty*,<sup>19</sup> and *Champion Spark Plug Co. v. Sanders*,<sup>20</sup> in which marks are utilized commercially, but not in the signaling sense. In *Prestonettes*, a reference to the trademark owner's business was made in connection with the sale of scented face powder in order to fully describe the product's ingredients; in *Sanders*, the original labels on rebuilt spark plugs were left in place to denote their history. Finding it clear that the trademarks "Coty" and "Champion" were being used in a manner similar to the way that Joan Kennedy used "Barbie," to convey information about attributes other than source, and that the uses were necessary to fully describe the merchandise, the Court found both permissible. The Lanham Act now protects the nonsignaling aspect of such references under the rubric of fair use.<sup>21</sup> To the extent that a particular symbol becomes indispensable in describing goods, the usage is likewise safeguarded, but under the concept of genericity.<sup>22</sup>

The easy cases on the opposite pole are ones that involve signaling uses of the mark, but not in the commerce of the trademark owner. In these cases, core trademark interests are endangered when the trademark owner's message becomes garbled in the manner in which it is confused by dual usage in the same market. That is, if it is likely that the consumer will translate dissatisfaction with the second user's product into disappointment with the trademark owner, then the interest in preserving goodwill and encouraging investment in quality is undermined.

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18 . Initially, this problem was not thought to be a concern of trademark law. For an example, consider the facts of *American Washboard Co. v. Saginaw Mfg.*, 103 F. 281 (6th Cir. 1900), where the court refused to enjoin the manufacturer of zinc washboards from using the trademark "Aluminum" on the ground that the defendant's use of a generic word could not be prohibited, and thus could not give rise to an inference of passing off. Furthermore, the court reasoned that any confusion suffered by consumers was actionable by them, not by the washboard manufacturer. As a result of permitting continued sale of mismarked washboards, the demand curves for aluminum and zinc may have been skewed. Some customers, although convinced that aluminum rendered clothing cleaner than zinc, would nonetheless, purchase zinc washboards. This demand for zinc would then presumably raise the price of the metal and divert supply to a use which no one, in fact, valued. Perhaps for this reason, the result in the case was reversed legislatively, see § 43(a) of the Lanham Act, 15 U.S.C. § 1125, which provides a right of action against misleading descriptions of products.

19 264 U.S. 359 (1924).

20 331 U.S. 125 (1947).

21 See § 33(b)(4) of the Lanham Act, 15 U.S.C. § 1115(b)(4), which provides a defense for a "use . . . which is descriptive of and used fairly and in good faith only to describe the goods to users. . . ."

22 See § 14(3) of the Lanham Act, 15 U.S.C. § 1064(3) (1988) (which permits cancellation of registered marks that become generic); § 15(4), 15 U.S.C. § 1065(4) (which excepts generic marks from the incontestability provisions of the Act); *King-Seeley Thermos Co. v. Aladdin Indus.*, 321 F.2d 577 (2d Cir. 1963) (finding that "thermos" (with a small "t") had entered the public domain).

In *Polaroid Corp. v. Polarad Electronics Corp.*,<sup>23</sup> for example, the Second Circuit announced a series of factors that quantify the likelihood that consumers will be confused into thinking that Polaroid was the source of electronic devices manufactured by Polarad.<sup>24</sup>

This leaves the cases in the middle which would not be winners under a rigid application of traditional trademark law, but which have enjoyed a measure of success on a variety of theories. The paradigm here is the "surplus value" case which can be illustrated by the hypothetical sale of a tee shirt adorned with the word "Barbie" and manufactured by an apparel maker, let us say BVD. This is not a pure signaling case because the decision whether the shirt is of good enough quality to purchase will not be made easier by the presence of the word "Barbie," which has meaning (as a signal for Mattel) only in the toy market. At the same time, however, the reference to "Barbie" on the tee shirt is not identical to the use said to be made of that term by Joan Kennedy. Sale of the Chellis book did not depend in any way on the presence of the word in the manuscript. Indeed, it is unlikely that the purchaser would have known it was there. In contrast, the only reason to choose a "Barbie" shirt over a red one, or a "Betty Boop" one, is because the word makes a difference to the buyer. I call this usage a "surplus value" case because the existence of such a tee shirt means that someone attaches value to the word "Barbie" on the shirt, and that value is in excess to, or a surplus over, its function as a signal about toys.

In a sense, the existence of surplus value cases is itself a sign that the role of trademarks in the culture is different from what it once was. It is doubtful that the demand for articles marked in this way derives from a desire to accord advertising space to the trademark owner. Rather, these terms apparently have meanings of their own. They may, for example, serve to announce that characteristics associated with the product on which they appear as signals, are true of, or endorsed by, the purchaser; they may create an identification between the buyer and the trademark owner, or act as a vehicle for commenting on the product or its manufacturer.<sup>25</sup> The expressive dimension of trademarks may even enhance the prestige and value of the items on which they appear as signals.<sup>26</sup> But whatever the reason behind the desire to utilize the mark, so long as the

23 287 F.2d 492 (2d Cir.), cert. denied, 368 U.S. 820 (1961).

24 In so doing, the court looked at: "the strength of [the] mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of defendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers." *Id.* at 495. It added that "[e]ven this extensive catalogue does not exhaust the possibilities—the court may have to take still other variables into account." *Id.*

25 See, e.g., Grimes & Battersby, *The Protection of Merchandising Properties*, 69 TRADEMARK REP. 431 (1979)(describing status properties, such as the Gucci symbol, which are attractive for their "snob appeal," personification properties, which identify the user with characteristics of the goods upon which the mark normally appears, and popularity properties, which transfer "hype" in one market to other markets).

26 See, e.g., *Vuitton Et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769 (9th Cir. 1981)(use of Louis Vuitton's "L.V." trademark in a pattern which affected the aesthetics of the items on which it appeared).

mark is not being used as a signal, traditional trademark law offers no answer to the question of who should garner this value.

Not unsurprisingly, however, trademark owners have expressed a preference in favor of themselves. One of their strategies for reaping surplus benefits from their marks centers on stretching traditional principles by demonstrating that competitive harm in the market for the trademarked goods can result even from ostensibly nonsignaling usages. The likelihood-of-confusion rationale of *Polaroid* has, accordingly, been adapted to protect trademark owners against confusion in both their original market in which consumers are likely to perceive a possibility of entry. Thus, the doctrine now includes protection against usages that may tend to injure the trademark owner's reputation,<sup>27</sup> imply sponsorship,<sup>28</sup> limit expansion opportunities,<sup>29</sup> and erode<sup>30</sup> or tarnish<sup>31</sup> advertising values.<sup>32</sup> In addition, some trademark owners have mounted successful attacks based on a misdescription rationale;<sup>33</sup> others have claimed that to be effective, signals require protection from "dilution," erosion of distinctiveness which, they argue, can be caused even by non-confusing uses.<sup>34</sup>

Of course, a more direct approach to the problem is also possible. This is the argument that surplus value must go somewhere. Since trademark owners created the value through their investments, it is they who should garner whatever rewards are available. Or in our example, if a barbie tee-shirt costs more than a regular tee-shirt, then as between Mattel and BVD, the former should capture the extra profit because it is Mattel that made the "Barbie" word famous, and therefore worth purchasing

27 See Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 163 (citing *L.E. Waterman Co. v. Gordon*, 72 F.2d 272 (2d Cir. 1934), as seminal in accepting this rationale), which is based on the theory that even when goods are dissimilar, the consumer will attribute defects in the junior user's product to the trademark owner.

28 *Id.* at 167-68 (citing *Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg.*, 510 F.2d 1004 (5th Cir.), *cert. denied*, 423 U.S. 868 (1975)). The theory behind extending this protection is that consumers may retaliate against a perceived endorsement with which they disagree.

29 *Id.* at 167 (citing *Scarves by Vera, Inc. v. Todo Imports Ltd.*, 544 F.2d 1167 (2d Cir. 1976)). Here, the notion is that trademark law should protect not only the original market, but also auxiliary fields to which the trademark owner is likely to move.

30 *Id.* at 182-83 (citing *Tiffany & Co. v. Boston Club, Inc.*, 231 F. Supp. 836 (D. Mass. 1964)). Trademark owners expand to new markets by capitalizing on the goodwill earned by the original product line; by broadening trademark doctrine to protect against erosion, the law enhances the incentive to safeguard the quality of merchandise and services.

31 *Id.* at 186 (citing *Coca-Cola Co. v. Gemini Rising Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972) (relying also on a confusion rationale)). Here, the principle seems to be that trademark owners will be injured by bad mental associations with their products.

32 See also Grimes and Battersby, *supra* note 25.

33 See § 43 of the Lanham Act, 15 U.S.C. § 1125(a); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979).

34 See, e.g., *Tiffany & Co. v. Boston Club, Inc.*, 231 F. Supp. 836, 844 (D. Mass. 1964). The dilution theory has enjoyed some success in the states, where it has been accepted legislatively by approximately 17 states, see J. MCCARTHY, *TRADEMARKS AND UNFAIR COMPETITION* § 24:13 (2d ed. 1984) (1983 statistic), see, e.g., Act of May 2, 1947, ch. 307 § 7(a), 1949 Mass. Acts 300 (Current version at MASS GEN. LAWS ANN. ch. 110B, § 12 (West)). However, Congress refused to incorporate a dilution provision into § 43(a), 15 U.S.C. 1115(a), when the Lanham Act was revised in 1988, see H.R. REP. 1028, 100th Cong., 2d Sess. 5 (1988).



at a premium.<sup>35</sup> Conversely, to assign the reward to BVD would unjustly enrich the apparel manufacturer, which would then "reap [a benefit] where it has not sown."<sup>36</sup>

Recently, this argument has received acceptance. For example, in deciding that the USOC could use a trademark-like provision of the Amateur Sports Act of 1978<sup>37</sup> to prevent San Francisco Arts & Athletics (SFAA), a gay-rights group, from calling their international athletic competition the "Gay Olympic Games," the Supreme Court endorsed the reaping and sowing idea,<sup>38</sup> and then went on to say that:

Because Congress could reasonably conclude that the USOC had distinguished the word "Olympic" through its own efforts, Congress' decision to grant the USOC a limited property right in the word "Olympic" falls within the scope of trademark law protections. . .<sup>39</sup>

The Court also stated that:

One reason for Congress to grant the USOC exclusive control of the word "Olympic," as with other trademarks, is to ensure that the USOC receives the benefit of its own efforts so that the USOC will have an incentive to continue to produce a "quality product," that, in turn, benefits the public.<sup>40</sup>

Preliminarily, it should be noted that although the *Gay Olympics* decision nominally applies only to a *sui generis* statute which was clearly intended to provide the USOC with benefits greater than those accorded ordinary trademark owners,<sup>41</sup> the notion of conceiving the investment in signaling as creating an entitlement to control surplus value will surely be transferred to trademark claims.<sup>42</sup> Given that the Court explicitly cited trademark law as the source of its decision<sup>43</sup> and, moreover, ex-

<sup>35</sup> Cf., e.g., Brown, *Designers Worry About Self-Image*, N.Y. Times, Oct. 12, 1989, at D23, col. 1 (noting the importance of "image" to the principal business of the trademark owner).

<sup>36</sup> *International News Serv. v. Associated Press*, 248 U.S. 215, 239 (1918). This case announced a theory of misappropriation, but in connection with news stories, not trademarks. Nonetheless, the case is often cited in support of surplus value claims, see, e.g., *Flextized, Inc. v. National Flextized Corp.*, 335 F.2d 774 (2d Cir. 1964), *cert. denied*, 380 U.S. 913 (1965).

<sup>37</sup> 36 U.S.C. § 380(a) provide that without the consent of the USOC, the symbol of the International Olympic Committee (5 interlocking rings), the emblem of the USOC, the words "Olympic," "Olympiad," and "Citius Altius Fortius," and designations of sponsorship by the USOC and the International Olympic Committee cannot be used "for the purpose of trade, to induce the sale of any goods or services, or to promote any theatrical exhibition, athletic performance, or competition."

<sup>38</sup> *Gay Olympics*, 483 U.S. 522, 532 (1987).

<sup>39</sup> *Id.* at 534-35.

<sup>40</sup> *Id.* at 537. The Court also justified its decision by noting that "[Congress] could also determine that unauthorized uses, even if not confusing, nevertheless may harm the USOC by lessening the distinctiveness and thus the commercial value of the marks." *Id.* at 539. In another section of the opinion, it reasoned that public access to a word must be "balanced against the principle that when a word acquires value 'as the result of organization and the expenditure of labor, skill and money' by an entity, that entity constitutionally may obtain a limited property right in the word." *Id.* at 532 (quoting *International News Serv. v. Associated Press*, 248 U.S. 215, 239 (1918)).

<sup>41</sup> The Amateur Sports Act differs from the Lanham Act (and state law) in that it does not require proof of consumer confusion. In addition, it does not incorporate Lanham Act defenses.

<sup>42</sup> See, e.g., *Board of Gov. of Univ. of N.C. v. Helpingstine*, 714 F. Supp. 167, 177 n.5 (M.D.N.C. 1989) (acknowledging plaintiff's argument that *Gay Olympics* supports its right to the surplus value of its marks, but deciding for the plaintiff without reaching the issue).

<sup>43</sup> Thus, at 483 U.S. at 539, the Court cited Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 825 (1927).

pressly considered the needs of trademark owners in deciding the scope of the USOC's rights,<sup>44</sup> it can be assumed that the Court saw the differences between the two statutes as a question of degree, not kind. Other courts are therefore likely to interpret its reasoning about the requirements of trademark owners as indicative of the appropriate direction in which to take surplus value cases. A trademark owner may be required to prove a greater likelihood of confusion than is required of the USOC, but in the future its investment in popularizing the mark will be taken into account so that it receives "the benefits of its own efforts."<sup>45</sup> Thus, the point at which relief is offered trademark owners can be expected to shift from quite near the *Polaroid* side of the signaling spectrum to somewhere much closer to the expressive pole.<sup>46</sup>

Because so many trademark usages are hybrid, free speech interests are deeply implicated by this migration. If investment is dispositive of the trademark owner's right to control, then the public's ability to evoke the expressive dimension of marks is in danger of significant restriction. Furthermore, fallacies in the fundamental assumptions made by courts that have approved this "if value, then right" theory mean that the right lacks a coherent limit. Without a principled way to bound the power of control, it is not possible to fashion defenses analogous to the sort commonly found in real property, trademark, copyright, patent, or state-based intellectual property law.

The point concerning the effect of the new theory on expressive concerns can be demonstrated by considering the use of trademarks in parodies, which have been considered important vehicles for social commentary at least since the time of Chaucer.<sup>47</sup> Others have noted that

44 See 483 U.S. at 531-32, 537.

45 *Id.* at 537. The consideration of a trademark owner's investment in the mark represents a change from existing law. See, e.g., *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961), discussed *supra* notes 23-24 and accompanying text, where none of the factors suggested by the court involved the effort expended by the senior user; *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 119 (1938) (money spent on making "shredded wheat" a household word is "without legal significance" in determining the right of the owner to use the mark); *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 80 (2d Cir. 1936) (discounting the relevance of the "billions reached" by DuPont's advertising "cellophane" for cellulose wrap), *cert. denied*, 299 U.S. 601 (1936) and 304 U.S. 575 (1938).

46 To put this another way, the confusion question is often very close. Additional weight given to the trademark owner by requiring the court to consider the extent of investment in the mark will likely be dispositive in a number of cases.

The Court also may have changed trademark law by arguing that marks do not become generic if they have acquired secondary meaning, 483 U.S. at 534-35. Secondary meaning has long been used to demonstrate the distinctiveness of marks that would otherwise be considered too descriptive to serve as signals. Prior to *Gay Olympics*, however, it was never thought that a generic word could become a protectable trademark by virtue of its secondary meaning, or by its proprietor's investment in creating secondary meaning, see, e.g., *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 581 (2d Cir. 1963) ("No doubt the . . . doctrine [of genericity] can be a harsh one for it places a penalty on the manufacturer who has made skillful use of advertising."). See generally, Kravitz, *Trademarks, Speech and the Gay Olympics Case*, 69 B.U. L. REV. 131, 167-72 (1989). On this reasoning, the court in *American Washboard Co. v. Saginaw Mfg.*, 103 F. 281 (6th Cir. 1900), discussed *supra* note 18, could have held the word "Aluminum" the property of the American Washboard Company and required competitors to talk of their own products as made of a shiny metal, mass number 13, with atomic weight equal to 26.981.

47 See *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 28 (1st Cir.), *appeal dismissed*, 483 U.S. 1013 (1987).

even modest expansion of the domain of trademark law has threatened such usages,<sup>48</sup> but the problem is now much more severe. *Girl Scouts v. Personality Posters Manufacturing*,<sup>49</sup> for instance, involved the sale of posters depicting a pregnant girl dressed in a Girl Scout uniform over the motto, "Be Prepared." Before courts began to adopt the new reasoning, this was analyzed as a *Polaroid* type of case in which the unlikelihood of consumer confusion led the court to conclude that the trademark owner did not require relief. However, once the right to capture all the value in a signal is accepted, it is difficult to see why the Girl Scouts should be unable to control the humorous benefit that comes from contrasting pregnancy with the public perception of Girl Scouts. Since it is the scouting organization that created the perception, it should, under this reasoning, be the one to decide when, where, and if the slogan invoked.<sup>50</sup>

Even usages much closer to the Joan Kennedy archetype may get caught up in the shift. Thus, a pre-*Gay Olympics* court had no trouble finding that a public interest group could use the connotations developed by George Lucas's movie, "Star Wars," to express the belief that Ronald Reagan's defense initiative was expensive science fiction.<sup>51</sup> Post-*Gay Olympics*, this sort of case may turn out to be much more difficult. "If value, then right" is an appealing axiom, for it is suggestive of real property and the relative ease with which claims in such cases are usually decided in favor of the property owner.<sup>52</sup>

Indeed, the effectiveness of the dissents in *Johnson v. Texas*,<sup>53</sup> the flag burning case, owe much to this equation. After some rousing poetry,<sup>54</sup> Chief Justice Rehnquist quoted property analogies in a variety of cases, including *Gay Olympics*,<sup>55</sup> and attempted, for constitutional purposes, to use this analogy to distinguish the Nation's interest in its flag from the words at issue in *Chaplinsky v. New Hampshire*.<sup>56</sup> Justice Stevens went so far as to equate the burning of a single copy of the flag with desecration

48 See, e.g., Dorsen, *Satiric Appropriation and the Law of Libel, Trademark, and Copyright: Remedies Without Wrongs*, 65 B.U. L. Rev. 923 (1985); Note, *Trademark Parody: A First Use and First Amendment Analysis*, 72 VA. L. Rev. 1079 (1986); Denicola, *supra* note 27.

49 304 F. Supp. 1228 (S.D.N.Y. 1969).

50 Compare *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir.) (pre-*Gay Olympics* case refusing to enjoin magazine's parody of the L.L. Bean catalogue), *appeal dismissed*, 483 U.S. 1013 (1987), with *American Express Co. v. Vibra Approved Labs.*, 10 U.S.P.Q. 2d 2006 (S.D.N.Y. 1989) (post-*Gay Olympics* enjoining distribution of a "condom card" using the slogan "Never Leave Home Without It").

51 *Lucasfilm Ltd. v. High Frontier*, 622 F. Supp. 931, 934 (D.D.C. 1985) (holding that the "[d]efendants have not used the phrase . . . in a way that might create confusion. . .").

52 Cf. *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987), *cert. denied*, 109 S. Ct. 326 (1988).

53 109 S. Ct. 2533 (1989).

54 *Id.* at 2549-50.

55 *Id.* at 2552 (citing the passage, "when a word . . . acquires value 'as the result of organization and the expenditure of labor, skill, and money' by an entity, that entity constitutionally may obtain a limited property right in the word. . . ." *Gay Olympics*, 483 U.S. 522, 532 (1987) (citing *International News Serv. v. Associated Press*, 248 U.S. 215, 239 (1918))); *Id.* at 2554 (quoting Justice Fortas' dissent in *Street v. New York*, 394 U.S. 576, 615-17 (1969) ("A flag may be property. . .")); *Id.* at 2555 (quoting Justice White's concurrence in *Smith v. Goguen*, 415 U.S. 566, 587 (1974) ("The flag is itself a monument.")).

56 315 U.S. 568 (1942); see *Johnson*, 109 S. Ct. at 2552-53.

of real property—the Washington Monument<sup>57</sup>—and this image has been picked up by those who support congressional action to reverse the Court's disposition.<sup>58</sup>

The fallacies in the right/value theory can be revealed in a number of ways, not the least of which is that the choice for assigning surplus value is not between a trademark owner and a trademark user—Mattel and BVD—but between trademark owners and the public—Mattel and tee-shirt consumers. If Mattel is given (through trademark law or another legal regime) the right to exclude others from selling “Barbie” tee shirts, then it can indeed charge a premium over the cost of manufacturing the shirt, which will be paid by those purchasers who value the product at or above the set price. If, on the other hand, no one has an exclusive right to use the word on a shirt, a supracompetitive price will presumably attract rivals, who will compete it down to cost. In that event, the surplus value will go not to BVD or to Mattel, but to purchasers. Since it is they who found uses for “Barbie” in excess of signaling, this does not seem like a case in which parties reap that which they have not sown.

To put this in a larger context, public goods can usually be made into exclusive property by operation of law; the issue in such cases is whether there is a justification for giving private parties wealth that would otherwise accrue to those who use the goods. Outside the signaling context (where trademark rights are protected), increasing the pool of word utilizers does not impose costs on prior users in the way that, say, adding cattle to a pasture detracts from its ability to maintain the first farmer's herd.<sup>59</sup> Accordingly, and contrary to the dissents' implication in *Johnson*, the rationale that supports exclusive rights in real property has no application here.

It is also an overstatement to equate rights in trademarks with rights in other intellectual property, which was part of the strategy in *Gay Olympics*. As noted, that opinion sought to justify protection for the USOC by arguing that the public benefits from the diversion of surplus value to quality enhancing activity. This language sounds similar to the claims that patent profits support innovation<sup>60</sup> and that copyright royalties subsidize authorship.<sup>61</sup> It is also analogous to the rationales used in two common law intellectual property cases that were cited in *Gay Olympics*, *International News Service v. Associated Press* (“INS”),<sup>62</sup> which endorsed a right against misappropriation of news stories, and *Zacchini v. Scripps-*

57 *Johnson*, 109 S. Ct. at 2556.

58 See, e.g., 135 Cong. Rec. S12598 (daily ed. Oct. 4, 1989)(statement of Sen. Mitchell); *id.* at S12600 (statement of Sen. Gramm); *id.* at S12616 (statement of Sen. Wilson); Buckley, *The Court and The Flag Decision*, 41 NAT'L REV. 54 (Aug. 4, 1989).

59 Cf. Landes & Posner, *Trademark Law: An Economic Perspective*, 30 J. L. & ECON. 265, 267 (1987); R. POSNER, *ECONOMIC ANALYSIS OF LAW* 27-31 (2d ed. 1977).

60 See, e.g., Dreyfuss, *Dethroning Lear: Licensee Estoppel and the Incentive to Innovate*, 72 VA. L. REV. 677, 679-80 (1986).

61 See, e.g., Dreyfuss, *The Creative Employee and the Copyright Act of 1976*, 54 U. CHI. L. REV. 590, 628-30 (1987).

62 248 U.S. 215 (1918) [hereinafter *INS*]. This citation was especially interesting because the continued vitality of its misappropriation theory had been subject to considerable debate, see, e.g., Baird, *Common Law Intellectual Property and the Legacy of International News Service v. Associated Press*,

*Howard Broadcasting Co.*,<sup>63</sup> the "human cannonball" case, which upheld the right of publicity against a first amendment challenge.<sup>64</sup>

One problem with analogizing rights in trademarks to rights in other intellectual property can be seen when comparing the product for which exclusivity is sought with the business of its creator. In patent, copyright, misappropriation, and publicity, the law protects the one and only product that the creator has for sale: the invention, the book, the news story, or the spectacle. If the creator cannot reap a profit from that product, then there is nothing upon which to base a source of pecuniary return. Exclusivity is therefore necessary to assure the creator freedom from those who did not make the creative effort and thus would undercut the price at which the creator could profitably sell the work.<sup>65</sup> In contrast, the owner of a trademark is really in the business of selling a *different* product—dolls in the case of Mattel. The profit and the incentive to enhance quality comes from the marketing success of this other product, not the trademark. Exclusivity in the trademark is only needed to point consumers in the right direction, and that function is preserved by protecting the mark's signaling function.

Indeed, it is somewhat perverse to encourage the trademark owner's primary activity by facilitating the capture of profits from some other good. In the case of other intellectual property rights, the choice of exclusivity as an incentive mechanism is at least partially justified by the notion that the values captured provide the optimal amount of incentive to produce works of a similar nature in the future.<sup>66</sup> But the public may enjoy the expressive dimensions of a trademark more than it values the underlying product. If so, diverting surplus value to activity in the product field would lead to over-stimulation of investment in the product.

Even if the public does value trademarks enough to care whether the economy provides enough motivation to produce them, it is not clear

50 U. CHI. L. REV. 411 (1983); *Product Simulation: A Right or Wrong*, 64 COLUM. L. REV. 1178 (1964)(Leeds, Handler, Derenberg, Brown, and Bender, contributors).

63 433 U.S. 562 (1977).

64 *Gay Olympics*, 483 U.S. at 532-33. *INS* involved the right of the International News Service to enjoin the Associated Press from taking uncopyrighted news stories that *INS* transmitted to the east coast and retransmitting them to AP subscribers on the west coast. In holding for *INS*, the Court reasoned that a right against misappropriation was necessary to make profitable an investment in newsgathering, an activity from which the public benefits. 248 U.S. at 241. The Court also invoked the reaping and sowing metaphor alluded to earlier. *Id.* at 239. Similarly in *Zacchini*, the Court reasoned that the human cannonball could protect his act from unauthorized rebroadcast on the theory that a right of publicity would encourage a creator "to make the investment required to produce a [work] of interest to the public." 433 U.S. at 576.

65 Because the right of publicity as endorsed in *Zacchini* has this special property of protecting work product, the case must be distinguished from publicity cases that protect other aspects of a celebrity's personhood. See, e.g., *Hirsch v. S.C. Johnson & Son, Inc.*, 90 Wis. 2d 379, 280 N.W.2d 129 (1979) (protecting football player's nickname).

66 In theory, the price of creative works depends on demand. Accordingly, high demand would create high profits, which would mean public satisfaction would translate into greater remuneration to those who produce like works. In practice, it is often the case that demand for the work measures its value imperfectly, see, e.g., Dreyfuss, *supra* note 61 (citing as obstacles the limited duration of copyright, the inability of copyright holders to price discriminate, and the inability of users to correctly evaluate works before they have consumed them). Furthermore, creativity may not be as predictable as other endeavors. Nonetheless, copyright and patent law are premised on the notion that the market is the best mechanism yet devised to spur creativity. See also Wright, *The Economics of Invention Incentives: Patents, Prizes and Research Contracts*, 73 AM. ECON. REV. 691 (1983).

that surplus value protection is necessary. The exigencies of the marketplace require its participants to develop signals in order to differentiate their goods from those of their rivals. Nice symbols are more likely to be produced than displeasing ones because the more agreeable the signal, the more easily it will be remembered, and the better the product will sell.<sup>67</sup>

The fallacies in the real property and intellectual property analogies are unsatisfying from more than a theoretical point of view; they have direct impact on the manner in which benefits are distributed as between right-holders and the public. For the traditional rights, this allocation is achieved by asking the question, how much exclusivity is necessary to accomplish the desired goals? Once these goals are realized, surplus can be diverted to consumers. This is not to say it is always easy to find the best balance between access and reward: for the statutory rights, allocation is accomplished somewhat arbitrarily<sup>68</sup> by legislative fiat;<sup>69</sup> for common law rights, case-by-case analysis often leads to unsatisfactory results in individual cases. But although disagreements will be inevitable, the justifications for these rights do provide a framework that makes a discussion of the balance possible.

These quasi-trademark claims stand in sharp contrast. By equating "value" with "right," the decisions fail to create an internal reference point against which to measure the need for exclusivity.<sup>70</sup> Instead of asking a question about *how much* value the creator needs in order to be optimally motivated, this right simply asks *whether* value, for every diversion of value is, by definition, too much. Thus, the problems engendered by expanding proprietary rights exist not only for the paradigm cases involving surplus value, but for all other hybrid usages. Furthermore, the rights created apparently endure forever; enforcement decisions are devoid of reference to the illicit motives of other users, to the potential harm to the complainant's activities, or to the inability of the complainant to receive an adequate return on investment.<sup>71</sup> Nor is there room, as

67 I do not, however, fully agree with Landes and Posner, *supra* note 59, at 273, who claim that trademarks should not be fully protected because words are easily and cheaply created. If anything, this argument cuts in the opposite direction: if words are cheap, little is lost in giving trademark owners plenary control.

68 Thus, for example, there has never been an adequate explanation of the 17-year duration of utility patents, *see* Kaplow, *The Patent-Antitrust Intersection: A Reappraisal*, 97 HARV. L. REV. 1813, 1823-29 (1984). Nor is there a clear reason why Congress chose not to accord public performance rights to the copyright holder of sound recordings, 17 U.S.C. § 114(a) (1988), or excepted only sound recordings of musical works from the first-sale doctrine, 17 U.S.C. § 109(a) (1988) (first-sale doctrine). *Id.* at § 109(b) (exception).

69 Through, for example, duration limitations and compulsory license provisions.

70 To a significant extent, much the same can be said for the right of publicity recognized in *Zacchini*. Although the Court was faced in that case with a first amendment—i.e. public access—challenge to the right of publicity, Scripps-Howard's claim was so diffuse that it failed to alert the Court to the dangers of simply equating rights of publicity with copyright. Thus, the Court failed to grapple with the fact that copyright law contains inherent limitations (such as duration, fair use, and compulsory licensing provisions) that protect the public, while rights of publicity do not. This has left the states to deal with the problems presented by a theoretically perpetual right that could severely limit the ability of the public to effectively discuss the lives and works of others. *Cf.* Ropski & Marschang, *The Stars' Wars: Names, Pictures and Lookalikes*, 17 AIPLA Q.J. 81, 99 (1989).

71 *Cf.* *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987), *cert. denied*, 109 S.Ct. 326 (1988), in which the court enjoined, over first amendment challenge, the distribution of items

there is in copyright and traditional trademark law, to compare the public's need to put the protected work to a particular use with the right holder's claim for control.<sup>72</sup>

As a result of abandoning the theoretical structure of trademark law, and instead building on faulty analogies to real property and other intellectual property regimes, courts have been left with the task of balancing public and private interests under the framework of the first amendment. But this has proved to be a troublesome proposition. Because traditional trademark law averted collision with free speech interests by reserving rights to contexts in which consumers might be confused and by shaping doctrines that aggressively protect the free use of marks outside the signaling context,<sup>73</sup> there is meager precedent on which to rely.<sup>74</sup>

*Gay Olympics* is a case in point. Like most courts entertaining free speech claims, the Supreme Court attempted to invoke the concepts of deception and commercialism as touchstones for deciding when speech can be regulated.<sup>75</sup> Both references proved unavailing. Once the Court found that the USOC had authority to control its marks even in the absence of confusion, speech that was by definition nondeceptive came under the control of the trademark owner.<sup>76</sup> The Court then attempted to justify the expressive restriction that this represented on the ground that SFAA's use was commercial, and therefore entitled to only "a limited form of First Amendment protection,"<sup>77</sup> but this reasoning protects

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marked with a feather-bonneted, emaciated head and the terms, "Mutant of Omaha" and "Nuclear Holocaust Insurance"; the dissent noted the thinness of the evidence on the likelihood of confusion. *Id.* at 403.

<sup>72</sup> See, e.g., 17 U.S.C. § 107 (1988) (fair use provision in copyright law) and 15 U.S.C. § 1115(b)(4) (1988) (fair use provision of federal trademark law). For example, the *Gay Olympics* Court had actually been asked to address the contention that the fair use defense of the Lanham Act should apply to enforcement decisions under the Amateur Sports Act, but it failed to do so. Instead, it merely noted that the Lanham Act was meant to provide the USOC with greater exclusivity than that given trademark owners. But since other provisions of the two acts differed—e.g., in imposing a requirement of demonstrating consumer confusion—this was hardly an adequate treatment of the question.

Ironically, some balancing is made even with respect to real property, in which the claim for exclusivity is perhaps at its zenith, see, e.g., D. DOBBS, R. KEETON, & D. OWEN, PROSSER AND KEETON ON TORTS, 145-48 (5th ed. 1984) (defense of necessity); *Pruneyard Shopping Center v. Robins*, 447 U.S. 74 (1980) (first amendment interest).

<sup>73</sup> See, e.g., *Stop the Olympic Prison v. United States Olympic Comm.*, 489 F. Supp. 1112 (S.D.N.Y. 1980); *Reddy Communications, Inc. v. Environmental Action Found.*, 477 F. Supp. 936 (D.D.C. 1979).

<sup>74</sup> *Cliff's Notes, Inc. v. Bantam Doubleday Dell Publishing Group*, 718 F. Supp. 1159 (S.D.N.Y. 1989), *vacated*, 886 F.2d 490 (2d Cir. 1989), is an example of the problem. In that case, the district court preliminarily enjoined the defendant from publishing "Spy Notes," a parody on plaintiff's study guides. Reasoning that trademark laws "contribute to a favorable climate for expression by complementing the economic incentive that copyright law provides to create and disseminate artistic works," 718 F. Supp. at 1162 (citing *Silverman v. CBS, Inc.*, 870 F.2d 40, 48 (2d Cir.), *cert. denied*, 109 S.Ct. 3219 (1989)), the district court had searched for a way to balance the newly-created right of the plaintiff against first amendment concerns. 718 F. Supp. at 1162-64. It settled on a likelihood of confusion test, *id.* at 1519-22, which accords rather poorly with the rationale for creating the right in the first place. On appeal, the Second Circuit approved a similar approach, but looked also at "the primary intent" of the second user—and reversed. See also *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

<sup>75</sup> See *Gay Olympics*, 483 U.S. at 535 n.12 (1987) (deception). *Id.* at 535-39 (commercialism).

<sup>76</sup> *Id.* at 530.

<sup>77</sup> *Id.* at 535 (citing *Posadas de Puerto Rico Ass'n v. Tourism Co. of Puerto Rico*, 478 U.S. 328, 340 (1986)).

access in only a narrow category of cases and is, in any event, unpersuasive. After all, the essence of a hybrid case is that a trademark is being used as both a signal—that is, in commerce—and as expression. Accordingly, except in the rare instance in which there is no attempt to capture the surplus, the first amendment will not release trademarks for rhetorical purposes. A public-interest group's use of "Star Wars" may pass muster,<sup>78</sup> but even public-interest groups sometimes support their activities through sales of items bearing their slogans.<sup>79</sup> Furthermore, some passages in the Court's opinion judge commercialism by the effect of SFAA's activities on the USOC rather than by analyzing what SFAA was itself doing.<sup>80</sup> With an impact standard such as this, the first amendment might not even shield the use of marks in editorials, if the material can be interpreted as critical of the trademark owner.<sup>81</sup>

Even if the Court's label of commercialism is accepted, its reasoning is unpersuasive. Commercial speech does receive a limited form of first amendment protection, and the Court might have explicitly considered the form that such protection should take in the context of word usage. Instead, however, the Court invoked the same fallacious real property analogy that it used to define the scope of the USOC's right in the first place: it found the intrusion acceptable as a time, place or manner restriction.<sup>82</sup>

<sup>78</sup> *Lucasfilm, Ltd. v. High Frontier*, 622 F. Supp. 931 (D.D.C. 1985).

<sup>79</sup> *See, e.g., Stop the Olympic Prison v. United States Olympic Comm.*, 489 F. Supp. 1112 (S.D.N.Y. 1980), in which a court allowed a group called STOP to sell posters using the words "Stop the Olympic Committee" and the five rings in order to raise money to protest the conversion of the Olympic Village in Lake Placid into a prison. Although the Court cited this case, *see Gay Olympics*, 483 U.S. at 536 n.14, as an example of an expressive use of the term Olympic that has been upheld, it is difficult to see how the case could come out the same now. The district court refused to find the use barred by the Amateur Sports Act, holding that "only a relative few [posters] were sold by the [group], and the money paid for each appears to have been more in the nature of a contribution . . . than a purchase price." 489 F. Supp. at 1121. Under *Gay Olympics*, however, sale of the posters may have been enough to classify the activity as commercial, and therefore actionable. *See also Reddy Communications, Inc. v. Environmental Action Found.*, 477 F. Supp. 936, 941 (D.D.C. 1979)(public interest group sold to the public "books and magazines wherein caricatures of Reddy appear") (decided on a no-confusion rationale).

<sup>80</sup> *Gay Olympics*, 483 U.S. at 539 (describing SFAA as seeking to "exploit the 'commercial magnetism' of the word given value by the USOC"). *See also Kravitz, supra* note 46, at 173-77 (noting other differences between the way that the Court analyzed the commercialism issue in this case and in other first amendment cases).

<sup>81</sup> *See, e.g., L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir.)(refusing to enjoin publication of a sexually explicit parody of the L.L. Bean catalogue on the ground that the first amendment protected editorialization), *cert. denied*, 483 U.S. 1013 (1987).

<sup>82</sup> *Gay Olympics*, 483 U.S. at 536 (Act merely regulates "the manner in which the SFAA may convey its message"). The Court also justified the restriction on speech as supported by a "substantial governmental interest." *Id.* at 537. In the context of the *Gay Olympics* case, and perhaps other trademark usage cases, this justification is also unpersuasive. First, according to the Court's own analysis, the party whose interests are furthered is in no sense a governmental entity. *Id.* at 542-47 (rejecting the claim that the USOC is subject to the Equal Protection Clause on the ground that the state action requirement had not been met). Second, the kinds of interests that the Court accepts as justifications are generally more compelling than a national desire to promote amateur athletics. Thus, the Court cited *United States v. O'Brien*, 391 U.S. 367 (1968), a case so unlike *Gay Olympics* that it is difficult to think of a more farfetched analogy. 483 U.S. at 537. It concerned a draft card burning; the government interest at stake there—military readiness—is so strong that the Court generally declines to weigh it against any liberty interest. *See, e.g., Goldman v. Weinberger*, 475 U.S. 503, 508 (1986) (citing Warren, *The Bill of Rights and the Military*, 37 N.Y.U. L. Rev. 181, 187 (1962)). Finally, the substantial-interest test usually requires a finding that there is a good fit be-



The time-place-or-manner idea is not, however, a congenial way in which to think about words. This designation is sometimes useful to differentiate between regulations that are constitutional because they are aimed at "some danger beyond the speech,"<sup>83</sup> and those that are problematic because they are intended to minimize dangers posed by the content of speech. It is, however, difficult to see how that categorization is relevant to the question of controlling linguistic usage. The restraint at issue is, in some sense, viewpoint neutral, but it is aimed precisely at the content of speech, and not at some problem, such as noise or litter—problems afflicting property, not words—that occur as a byproduct of speech.<sup>84</sup>

More important, the acceptability of time, place or manner restrictions posit the existence of other times, places, and manners in which the message can be conveyed. Yet the essence of the first amendment claim is that there are instances in which the loss of vocabulary is, effectively, the loss of the ability to communicate. The Court never fully analyzed the acceptability of the alternative it offered SFAA, and thus never considered the efficacy question. The next section takes up this issue. After comparing SFAA's original message with the one sent by the Court, this Part surveys the linguistic literature to demonstrate that SFAA's predicament was not unique. It then attempts to develop limits to the reach of these new proprietary interests by creating an expressive analogue to those doctrines of trademark law that protect public access.

## II. Cabining the Trend: A Linguistic Approach

The *Gay Olympics* case is a good context in which to consider the connection between the vehicles of speech and the efficacy of communication because in claiming that the word "Olympic" was generic and available to all, SFAA essentially made the argument that the loss of the ability to use "Olympic" was effectively suppression of its speech. Although somewhat opaque on this point,<sup>85</sup> the Court managed to duck the constitutional issue. Instead, it held that since "Gay Games" informed potential customers that tickets would entitle them to view ath-

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tween the interest protected and the restraint. See, e.g., *Posadas de Puerto Rico Assoc. v. Tourism Co.*, 478 U.S. 328, 340 (1986) ("the speech may be restricted only if the government's interests in doing so is substantial, the restrictions directly advance the government's asserted interest, and the restrictions are no more extensive than necessary to serve that interest."). Cf. *Perry Educ. Ass'n v. Perry Local Educators' Ass'n*, 460 U.S. 37, 45 (1983) (requiring a tight fit between the restriction and "a compelling state interest"). Here there is no fit at all, for the concern for promoting amateur athletics is not a goal that inherently requires any restrictions on speech. For example, since the profit that the USOC makes on its marks is unrelated to the benefit the organization is thought to bestow, the government could have equally well subsidized the USOC's activities or granted an extraordinary tax deduction to contributions to them. And even if it were thought indispensable for the USOC to raise money through the marketing of its ideograms, it may have been possible to award it words that have less expressive content than the 2000-year old phrases of ancient Greece.

83 L. TRIBE, *AMERICAN CONSTITUTIONAL LAW* 794 (2d ed. 1988).

84 See, e.g., *Cox v. New Hampshire*, 312 U.S. 569 (1941) (parades). See also *Texas v. Johnson*, 109 S. Ct. 2533, 2540-42 (1989).

85 See *supra* note 40.

letic competitions, that term was an adequate substitute for the challenged mark, "Gay Olympic Games."<sup>86</sup>

In fact, this substitution is highly inadequate. SFAA was not an impresario of sporting events, similar in function and purpose to the NBA, NFL, or PGA. Rather, a nonprofit corporation organized under California law, its mission was to educate the public about homosexuality, to portray it positively, to provide recreation for homosexuals, and to create a climate of friendship and cooperation among people of all sexual preferences.<sup>87</sup> To further that goal by demonstrating that gay people are as athletic as anyone else, SFAA created a series of competitive sporting events. To recall the tenets of the ancient Greeks and to evoke their spirit of cooperation, mutual acceptance, and international friendship, it called the tournament the "Gay Olympic Games."<sup>88</sup> While the events could easily be called "Gay Games," that title conveys none of this history and elicits none of these associations. Thus, no matter how successful "Gay Games" were in the marketplace of athletic events, it is doubtful that a society accustomed to receiving information in easily swallowed "sound bites" fully appreciated the message that SFAA was trying to interject into the marketplace of ideas.

It is not only ironic that in a case about communication, the Court managed to misinterpret the message that SFAA was attempting to convey. In translating "Olympic" as "game" and missing the rich set of connotations that surround the former expression, the Court illustrated just how much words and their paraphrases differ. There is an open texture to certain words that makes them much more than "a short cut from mind to mind."<sup>89</sup> This openness comes, in part, from the fact that some words have core denotations (definitions that can be found in a dictionary), and a set of connotations that depend upon their history, derivation, and identification with users.<sup>90</sup> These peripheral meanings are often highly individualized to the speaker, the listener, and possibly to the method by which they interact or perceive one another.<sup>91</sup> When such words are used, they become infused with the listener's own associations, and their message is incorporated into the listener's own frame of reference. The result is that the expression as perceived can have much

<sup>86</sup> *Gay Olympics*, 483 U.S. at 532-35.

<sup>87</sup> *Id.* at 535 n.13.

<sup>88</sup> As planned by the SFAA, the events were similar in format to the Olympic games that were held in Greece 2000 years ago, as revived in the current era. *Gay Olympics*, 483 U.S. at 533 nn.9 & 10. They were to feature a series of athletic competitions taking place over a several-day period, and were to be held every four years in different locations around the world. Athletes from many nations would be invited to compete for gold, silver, and bronze medals. Each event would begin with a torch relay and a parade of uniformed athletes divided by city. For a comparison between the ancient games and those run by the USOC and SFAA, see *id.* at 540 n.18.

<sup>89</sup> *Texas v. Johnson*, 109 S. Ct. 2533, 2539 (1989) (quoting *West Virginia Bd. of Educ. v. Barnette*, 319 U.S. 624, 632 (1943)).

<sup>90</sup> R. HALL, JR., *INTRODUCTORY LINGUISTICS* 232-35 (1964). For example, consider whether a sentence using "thou" would have the same effect as one substituting "you;" if "pudding" is a perfect substitute for "dessert." Cf. Ross, *U and Non-U: An Essay in Sociological Linguistics*, in *THE IMPORTANCE OF LANGUAGE* 91, 102-03 (M. Black ed. 1962) (giving, among many other examples, use of the words "serviette" instead of "napkin" and "raincoat" instead of "burberry" as a method for distinguishing between lower- and upper-class britons).

<sup>91</sup> R. JAKOBSON & M. HALLE, *supra* note 15, at 76.

greater impact on the recipient's thinking than the words that were actually transmitted.<sup>92</sup>

Studies of cognition reveal that words can be open-textured in a stronger sense as well. Because words sometimes have several core meanings, particular usages can require listeners to consider several denotations, their respective connotations, and the connections between them.<sup>93</sup> This effort can lead to a new level of understanding, which might not have been achieved by words lacking the same associational set. Nor would these insights be produced by an expanded statement of meaning because a paraphrase of a word, like a paraphrase of any other metaphor,<sup>94</sup> closes the set of associations and constrains the field of connections that are necessary to the expansion of perception.<sup>95</sup>

Paradoxically, words can advance understanding not only by splintering and juxtaposing associations, but also by crystallizing the relationship between diverse experiences.<sup>96</sup> For example, the early stage of scientific inquiry can be understood as a process of proposing nominal definitions, which are expressions naming concepts and defining the criteria for deciding when the concepts apply. The defined terms are then utilized in higher level manipulation, such as ordering, empirical testing, and, ultimately, the formulation of theoretical constructs.<sup>97</sup> Although it is the empirical import of these constructs—their explanatory and predictive capacity—that is the essence of scientific advance,<sup>98</sup> it is the definitional and classification procedure that enables scientists to find the correlations between observables that makes theorizing possible.<sup>99</sup>

Linguists understand the role that specific words play in structuring thought and organizing experience. They observe the phenomenon described above as reflected in the correlation between language patterns and theoretical constructs,<sup>100</sup> and also the rapidity with which cultures devise words to fit new conceptualizations.<sup>101</sup> Were the relationship be-

92 See, e.g., Lakoff & Johnson, *The Metaphorical Structure of the Human Conceptual System*, 4 COGNITIVE SCIENCE 195 (1980). See also M. EDELMAN, *POLITICAL LANGUAGE* (1977).

93 See, e.g., O. AKHMANOVA, *supra* note 15, at 36-49; R. HALL, *supra* note 90, at 231.

94 R. HALL, *supra* note 90, at 350 (giving the example of use of the Latin word for breath (spiritus) to convey the then-emerging notion of the spirit).

95 Davidson, *What Metaphors Mean*, 5 CRITICAL INQUIRY 31 (1978). See also M. EDELMAN, *supra* note 92, at 23-26 ("classification evokes beliefs and perceptions that we normally accept uncritically, precisely because they are generated subtly by the terms used to designate them.").

96 R. HALL, *supra* note 90, at 400-02.

97 C. HEMPEL, *FUNDAMENTALS OF CONCEPT FORMATION IN EMPIRICAL SCIENCE* (1952).

98 *Id.* at 47.

99 *Id.* at 1-2 ("concept formation and theory formation in science are so closely interrelated as to constitute virtually two different aspects of the same procedure"). See also M. EDELMAN, *supra* note 92, at 58.

An example may be helpful. The doctor that sees patients losing weight, acting tired, and contracting pneumonia and esoteric cancers will treat these conditions as effectively as possible. But the doctor who recognizes that these conditions often appear together, would create a classification and name it. Once the classification has been identified—"AIDS"—causes can be postulated and cures developed.

100 R. HALL, *supra* note 90, at 400-02 (citing the connection between Aristotle's categories of perception and Greek grammar).

101 G. CANNON, *supra* note 8, at 1-28; R. HALL, *supra* note 90, at 284, 348. Such words come from a variety of sources: other languages, dead languages, or other contexts. Sometimes such words are coined.

tween a word and its paraphrase merely a short cut, language groups could afford to take time developing words to suit new needs. Instead, even the French, who zealously guard linguistic integrity, are quick to fill empty vocabulary slots, even if that requires borrowing phrases from other languages.<sup>102</sup>

Similarly, physicians who treat aphasia, the loss of language, find that it is a more profound disorder than muteness, the loss of speech. The inability of aphasics to comprehend particular words interferes with the operations that they need to think.<sup>103</sup> A grasp of literal meaning is not helpful, as cognition is often mediated by the metaphorical character of words, which provoke comparisons between phenomena, or by their metonymic significance, which induce understanding of the whole of a phenomenon from consideration of a part of it.<sup>104</sup> Thus, it is not only that technology has shortened attention span to the point where only messages packaged into "sound bites" are heard, though that phenomenon is certainly important to consider when contemplating claims to individual words.<sup>105</sup> It may well be the case that the human intellect is constructed such that it is the density with which information is packed that is critical. If densely packed units—words infused with sets of denotations and associated connotations—are processed more readily than longer, less concentrated linguistic segments, loss of words can, in a very real sense, be equated with loss of the ability to communicate.<sup>106</sup>

Of course, even if the connection between words and thought is conceded, it could be argued that no particular word is essential to communication, as the process of nominal definition could be utilized to induce a shift in concept identifiers. So, for example, if SFAA felt that not

102 R. BIDOIS, *LES MOTS TROMPEURS* (1970) (discussing incorporation of English into French vocabulary).

103 R. JAKOBSON & M. HALLE, *supra* note 15, at 81-82 (citing Hemphil & Stengel, *Pure Word Deafness*, in 3 J. NEUROLOGY AND PSYCHIATRY 251 (1940), for an aphasic patient's statement: "I can hear you dead plain, but I cannot get what you say. . . . I hear your voice but not your words. . . . It does not pronounce itself.>").

104 R. JAKOBSON & M. HALLE, *supra* note 15, at 83. Several of the quotations that began this Article use trademarks metaphorically, but the qualities of trademarked goods are so well understood in the culture that metonymic use can be even more powerful. Consider, for example, Joyce Maynard's description of one of her characters: "Nona was very tiny and doll-like. She wore Villager skirts and Lady Manhattan blouses with only the top button undone and wrote to her parents twice a week." J. MAYNARD, *BABY LOVE* 25 (1981).

105 *Cf. Election '88: The Media Aftermath*, 115 BROADCASTING, No. 20, at 35 (Nov. 14, 1988) ("As for the campaign, it had been one of sound bites and visuals and events staged for impact on the evening news—Vice President George Bush in a flag factory and Governor Michael Dukakis careening around a proving ground in a tank were among the more notable."); Nyhan, *The Dukakis Demonizing That Has Taken Hold*, Boston Globe, Nov. 1, 1988, at 13 ("You gotta have 'sound bites.' You're judged on the impact of your TV spots, no matter how slimy, untruthful or mean-spirited or racist they might be."). See also Tackett, *Losers Weep Briefly, Then Start Fight Over*, Chicago Tribune, July 4, 1989, at 5; Clark, *Frenzy in the Tawana Brawley Case, Two Reporters Became the Story by Scooping the Pack*, Chicago Tribune, June 4, 1989, at 1.

106 *Cf. Cohen v. California*, 403 U.S. 15, 25-26 (1971) ("[W]e cannot overlook the fact, because it is well illustrated by the episode involved here, that much linguistic expression serves a dual communicative function: it conveys not only ideas capable of relatively precise, detached explication, but otherwise inexpressible emotions as well. In fact, words are often chosen as much for their emotive as their cognitive force. We cannot sanction the view that the Constitution, while solicitous of the cognitive content of individual speech, has little or no regard for that emotive function which, practically speaking, may often be the more important element of the overall message sought to be communicated.").

enough meaning were packed into "Gay Games," it could redefine the idea of cooperation, acceptance, international friendship, and competition by announcing, "let 'Grekko' stand for 'Olympic.'" Calling the sporting events "Gay Grekko Games" would then have as much impact as the title that utilized "Olympic." Since this process demands some use of the trademark, accepting it would require recognition of a limited form of fair use (a sort of definitional use), but trademark owners like the USOC would be fully protected without sacrificing expressive concerns.<sup>107</sup>

The difficulty with such a procedure is that words do not become part of the effective language as easily as this process would require. At any given time, speakers experiment with a wide variety of sound groups (phonemes), but only a small number of these potential words actually enter the vocabulary.<sup>108</sup> Although linguists have not developed a complete theory for predicting which sounds become words, the innovations that are successful tend to share certain traits. They are made up of sound clusters that are euphonious, readily pronounced, easily inflected, and accommodate well to grammatical rules. Either because there are a large number of initial users or because the phonemes contain internal cues, the meaning of successful words are quickly grasped. They are introduced by prestigious speakers whom others wish to emulate, or by speakers who are mobile enough to spread the new word efficiently.<sup>109</sup> Not every group of phonemes meets the first set of requirements; finding ones that do can be expensive, especially if the word is to enter more than one language.<sup>110</sup> Added to this is the cost of educating the right seed group so that the new word and its meaning spread to others.

Since the process of producing a word is expensive, the real question in requiring substitution through nominal definition is, who should pay the cost. As between members of the public (such as SFAA) who wish to use trademarks expressively and trademark owners (such as the USOC), the latter appears to be the superior choice. First, the cost of developing perfect synonyms for marks could be considered part of the quid pro quo for acquiring control over them. It is, in contrast, difficult to see how a single expressive user could capture enough of the benefits of a new word to compensate for the cost of developing it. Although this user could ask for contributions from the public, which would also benefit from the naming of new conceptualizations, the transaction costs involved in such an enterprise are likely to be prohibitive. Second, trademark owners are already in the business of developing words and advertising their meaning. The marginal cost of developing two words for the same concept is surely lower than the cost that a member of the

107 The constitutional necessity of a fair use defense remains an open question after *Gay Olympics*. Although the Court found that the Amateur Sports Act did not incorporate the defenses of the Lanham Act, *Gay Olympics*, 483 U.S. 522, 531 (1987), it failed to consider whether fair use was constitutionally required.

108 Thus, for example, people's ages can be estimated according to the slang that they use, since some words, such as "23-skidoo" and "gung-ho" having been unsuccessful at spreading into the general vocabulary of English speakers. See R. HALL, *supra* note 90, at 235.

109 See G. CANNON, *supra* note 8, at 3-4, 235 n.2, 273-74; R. HALL, *supra* note 90, at 256, 283-86.

110 R. BIDOIS, *supra* note 102, at 67.

public would incur in creating only one word. Moreover, words are most readily adopted into language when they fill conceptual voids;<sup>111</sup> indeed, most trademarks that have passed into the language have done so precisely because there was no other word to describe the product they signified.<sup>112</sup> Since trademark owners control timing, they are in the best position to exploit the window of opportunity provided by the existence of empty language slots.

In fact, the notion of imposing this duty on trademark owners is not new, for the doctrine of genericity works exactly this way. It protects the efficacy of communication by recognizing the public's need for a trademark that becomes the common signifier for the set to which the product on which it appears belongs. Such marks are considered generic, and a successful demonstration of genericity is a defense to infringement actions.<sup>113</sup> Not only does the doctrine protect public access to important words, it has a significant side effect. An owner that does not wish to lose its mark will often introduce a second word, which it educates the public to use for the category. The trademark itself can then retain its role as a signal. Thus, General Foods has successfully promoted the term "decaffeinated coffee" to protect "Sanka" from genericization and Xerox is currently working on public acceptance for "photocopy." As a result of these efforts, the public obtains more than just a few new words: it acquires the vehicles necessary to formulate questions about whether Sanka is the best decaffeinated coffee, or Xerox the best photocopier. Indeed, SFAA had suggested precisely this approach in *Gay Olympics*.<sup>114</sup> Had it been successful, the Court's declaration that the 2000-year old Greek word was generic would have forced Congress to release "Olympic" to the public and to emulate General Foods and Xerox by developing a second series of terms for the USOC to sell.

But SFAA's failure to convince the Court of the genericity of "Olympic" may hold the key to resolving the problem of public access to marks in a legal regime intent on expanding proprietary rights. Thus, the explanation for the Court's willingness to accept "games" as a substitute for "Olympic" may lie in the fact that it compartmentalized the vocabulary into expressive and competitive components. Since it took the genericity defense solely in its traditional form, as a claim about the competitive vocabulary, it evaluated the word in only the competitive context, as a word denoting athletic tournaments, and came to the conclusion that ample synonyms were readily available. Had it instead focused on the expressive significance of "Olympic," and looked for replacements that would evoke the tenets of the ancient Greeks, it might have reached a different result on the genericity issue.

If the Court's ability to compartmentalize vocabulary and understand language contextually is a universal facility—and linguistic research

111 R. HALL, *supra* note 90, at 284 (citing the definitional tradition in science); R. BIDOIS, *supra* note 102, at 69 (citing development of terms for imported goods).

112 Examples include aspirin, cellophane, shredded wheat, and linoleum.

113 See, e.g., *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 80 (2d Cir. 1936); cf. *Lanham Act* § 14(3), 15 U.S.C. § 1064(3) (1988).

114 *Gay Olympics*, 483 U.S. 522, 532-35 (1987).

indicates that it is<sup>115</sup>—then trademark law could be altered with this capacity in mind. Thus, it should be possible to build upon the defenses that trademark law has constructed for the competitive vocabulary a parallel set of principles to protect expressive speech. In a regime that recognized the facility to compartmentalize, signaling functions would be analysed according to the conventional *Polaroid* principles, and the newly developed doctrines would operate to allocate rights when trademarks are used expressively. Proprietary rights to marks would then be protected across the entire signaling spectrum, except in instances in which expressive communication was suppressed by the loss of vocabulary.

Reliance on traditional trademark principles as a framework for expressive speech may appear incongruous in view of the remarks made earlier about the dissonance between the justifications for trademark protection and the motivation that has led to the recognition of rights in hybrid cases. However, trademark law has several properties that make it a useful place to begin developing a jurisprudence that can analyze claims to the expressive vocabulary. This branch of the law is one of the only areas in which the problem of words, as distinguished from ideas, has received systematic analysis. The lack of cases at the antitrust/trademark and first amendment/trademark interface is some indication that the structure it has developed ably protects communicative efficiency within the marketplace of commerce. Accordingly, it holds some promise for the marketplace of ideas. Furthermore, its method of analysis has managed to avoid the need to decide which of its elements are constitutionally compelled.<sup>116</sup> In light of the difficulty in deciding when “symbols [are] sufficiently special to warrant . . . unique status” under the first amendment,<sup>117</sup> a prudentially-based scheme, whose doctrines act as a buffer between proprietary and public claims, may be the wisest, and only available avenue for fully safeguarding speech.<sup>118</sup>

To provide protection to the expressive vocabulary that is equivalent in range to that provided for competitive speech, the full array of trademark defenses would have to be reconstructed, a task beyond the scope of this Article. However, to demonstrate how this analysis would work, the genericity defense discussed above can be used as an illustration. Its expressive analogue would presumably look as follows: courts entertaining hybrid use cases would first decide whether there is an expressive component to the challenged use and then consider how central the trademark is to the usage. If the mark is found to be rhetorically unique within its context, it would be considered expressively—but not necessarily competitively—generic, and the trademark owner would not be permitted to suppress its utilization in that context.<sup>119</sup>

115 See, e.g., G. GILBERT & M. MULKAY, *OPENING PANDORA'S BOX: A SOCIOLOGICAL ANALYSIS OF SCIENTISTS' DISCOURSE* 6-7 (1984) (citing M. HALLIDAY, *LANGUAGE AS SOCIAL SEMIOTIC* 28-29, 32 (1978)).

116 In *Gay Olympics*, for example, the Court managed to avoid deciding whether either the doctrine of genericity or the defense of fair use was constitutionally required. See *supra* notes 85-86.

117 *Texas v. Johnson*, 109 S. Ct. 2533, 2546 (1989).

118 See Kravitz, *supra* note 46, at 170.

119 The notion that a word can be generic in some contexts but not others is also not new, see, e.g., *Bayer v. United Drug Co.*, 272 F. Supp. 505 (S.D.N.Y. 1921), in which Judge Learned Hand found

This analysis would have several benefits. Courts are currently expanding trademark owners' rights by finding more second uses confusing, yet are forced to balance access interests against proprietary rights under the same confusion rubric.<sup>120</sup> In contrast, the suggested analysis would permit courts to drop the fiction of consumer confusion, and instead focus on the primary concern, which is the expressive significance of the mark. At the same time, this procedure would create an incentive structure similar to the one operating within the competitive vocabulary. Owners would think twice before they filled language slots with phrases in which they have a proprietary interest. Alternatively, they would be encouraged to contribute to the public domain a synonym for any new conceptualizations that they identify.

As with competitive marks, the doctrine of genericity is easier to suggest than to implement. The *Gay Olympic* Court's willingness to accept the commercial success of "Gay Games" as indicative of the role played by the word "Olympic"<sup>121</sup> demonstrates that it can be difficult to locate a challenged use on the signaling spectrum. Identification of the user will, however, often be a clue: public interest groups, such as SFAA, editorial writers, such as newspapers and magazines, are more likely to be using a mark expressively than those who are only in the business of marketing posters or tee shirts.<sup>122</sup> Accordingly, while use by the latter might also have expressive significance, their claim for access would require a greater showing of unique need than that required by more purely expressive users. Thus, an entity that sells inexpensive items with clever slogans might be prevented from parodying a trademark, even though the same phrase might be accessible to a political action group.<sup>123</sup> Intent may also play an important role in deciding the expressiveness of the use. For instance, a parody aimed at exposing a new idea would be considered more expressive than one designed solely to exploit the mark.<sup>124</sup>

More often, the difficult problem will be in gauging expressive significance. The easier cases here will be the reference cases, those closest

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"aspirin" generic as used by the public, but not as used by health professionals. Cf. *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577 (2d Cir. 1963) (finding thermos with a small "t" generic, but not if capitalized).

120 See, e.g., *Cliff's Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490 (2d Cir. 1989) ("in deciding the reach of the Lanham Act in any case where an expressive work is alleged to infringe a trademark, it is appropriate to weigh the public interest in free expression against the public interest in avoiding consumer confusion").

121 483 U.S. 522, 536 (1987).

122 Compare, e.g., *American Express Co. v. Vibra Approved Laboratories Corp.*, 10 U.S.P.Q.2d (BNA) 2006 (S.D.N.Y. 1989)(enjoining distribution of a "condom card" using the slogan "Never Leave Home Without It") and *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972)(enjoining "Enjoy Cocaine" poster) with *Cliff's Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490 (2d Cir. 1989) (permitting *Spy* magazine parody of *Cliff's Notes*) and *Reddy Communications v. Environmental Action Found.*, 477 F. Supp. 936 (D.D.C. 1979)(permitting environmental group to caricature "Reddy Kilowatt").

123 See, e.g., *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987), cert. denied, 109 S. Ct. 326 (1988) (enjoining a novelty-item manufacturer from parodying logo; leaving open question whether the parody would be permissible in a "book, magazine, or film").

124 See, e.g., *Cliff's Notes, Inc.*, 886 F.2d 490 (allowing greater latitude when "expression, and not commercial exploitation of another's trademark, is the primary intent"; *id.* at 495 (quoting *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206-07 (2d Cir. 1979), as a contrast).



on the spectrum to *Prestonettes* and *Sanders*, in which the trademark is used to refer to the trademark owner.<sup>125</sup> *Stop the Olympic Prison v. United States Olympic Committee*<sup>126</sup> is an example. There, the word "Olympic" and the interlocking-ring logo were used on posters that were sold for profit,<sup>127</sup> but the context of the use was a protest against the conversion of Lake Placid's Olympic Village into a prison. Without the capacity to direct the public's attention to this activity, it would not have been possible to mount an effective campaign against the USOC. Accordingly, "Olympic" should be considered expressively generic when used in this way.<sup>128</sup> This analysis would also be applicable to political demonstrations that utilize American flags.<sup>129</sup>

Expressive requirements will not always be as clear as in these reference cases, but the method used for determining competitive genericity can be tailored to identify expressive needs in more ambiguous contexts. Instead of studying consumers through shopping mall intercepts and other surveying techniques, which is the procedure in competitive cases, the new inquiry would focus on speakers of the language through an examination of their written and oral communications—the technique, in

<sup>125</sup> These uses could also be assimilated into a fair use doctrine, as was suggested in Note, *supra* note 48, at 1099.

<sup>126</sup> 489 F. Supp. 1112 (S.D.N.Y. 1980), *aff'd*, 636 F.2d 1204 (2d Cir. 1980). For facts of the case see *supra* note 79.

<sup>127</sup> *Id.* at 1121.

<sup>128</sup> At one time, it would have been possible to use this analysis for the sports cases, which involve unauthorized use of team logos on items like baseball caps, because proprietary control deprives the public — fans — of the ability to express their identification with their teams. See, e.g., *Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg.*, 510 F.2d 1004 (5th Cir.), *cert. denied*, 423 U.S. 868 (1975); *Board of Gov. of Univ. of N.C. v. Helpingstone*, 714 F. Supp. 167 (M.D.N.C. 1989); *Boston Professional Hockey Ass'n v. Reliable Knitting Works, Inc.*, 178 U.S.P.Q. 274 (E.D. Wis. 1973); *National Football League Properties, Inc. v. Dallas Cap & Emblem Mfg., Inc.*, 26 Ill. App. 3d 820, 327 N.E.2d 247 (1975); *Denicola*, *supra* note 27, at 168 n.43. *But cf.* *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 918 (9th Cir. 1980) (rejecting the rationale of *Boston Professional Hockey v. Dallas Cap & Emblem* in the context of a club logo), *cert. denied*, 452 U.S. 941 (1981).

However, at this point, these cases should probably be considered lost causes: sports teams have fully entered the merchandising market, see Eskanazi, *supra* note 1 (noting that like major league teams, many colleges and universities have embarked on licensing schemes that earn considerable profits). Accordingly, these entities can now use traditional trademark doctrine to prevent others from using their works. But the road taken to create this business opportunity is instructive, for expansion of trademark rights has, in these cases, demonstrably deprived the public of expressive vehicles.

To reiterate a point made earlier: I remain unsympathetic to the claim that the surplus value in these logos (as in any other trademarks) should be allocated to owners even if the profits from increasing sales were demonstrably related to financial support that increased quality — and standings. If the sale of tickets and media rights were insufficient, owners eager for more could have always tried to earn the competitive profits in logoed items, and have arranged for monopoly profits in "genuine" team equipment and in items signed by the players.

<sup>129</sup> It is useful to contrast the cases cited *supra* note 128 (sports cases), with cases like *Vuitton Et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769 (9th Cir. 1981), in which a claim was made that a pattern created with Louis Vuitton's trademark could not be protected by trademark law because it was "aesthetically functional." This concept, with which courts have struggled over the last decade, was sometimes also applied in the sports cases. See J.M. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 7:26(D)(E) (2d ed. 1984). Under the analysis suggested here, the two sets of cases should have come out differently. In the sports cases, the logo was used to refer to the trademark owner and was thus necessary to the message in a way that is not implicated in the aesthetic functionality cases.

fact, of linguists.<sup>130</sup> And instead of determining whether “the principal significance of the word . . . [is] its indication of the nature or class of an article, . . . [or] an indication of its origin,”<sup>131</sup> the new inquiry would establish the set of denotations and connotations associated with a mark and determine whether there exists another effective mechanism for invoking that set. Because acceptance into the fabric of ordinary language would indicate both that a mark possessed an expressive dimension and that the public found this dimension a useful (and, possibly, needed) addition to the vocabulary, it would also be helpful to look at the information that linguists use to decide whether a borrowing has been fully received into the language: inclusion of the word in dictionaries, use unrelated to the original source of the word, respelling to conform to accepted patterns, inflection to conform to grammar, productivity in the formation of new words, and failure of writers to italicize the word or use its diacritics.<sup>132</sup>

The facts reported in *Quality Inns International, Inc. v. McDonald's Corporation*,<sup>133</sup> are somewhat illustrative of how this procedure might work. The defendant, owner of a motel chain called “McSleep,” was sued for its unauthorized use of the prefix “Mc.” Seeking to prove that “Mc” is generic, it introduced through the testimony of an expert linguist a data base consisting of writings that utilized the “Mc” construction. The linguist successfully demonstrated that the data, which included such usages as “McLaw” for franchise law firms, “McMiz” for roadshows of *Les Miserables*, and “McPaper” for *USA Today*, tended to show that “Mc” is the name for the class of services that are standardized, basic, consistent, and convenient.<sup>134</sup> The defense, however, ultimately lost. First, the defendant failed to fully articulate the question its expert was to answer. Since only questions as to the meaning of the word were asked, the testimony was vulnerable to the claim that linguists have no special expertise in decoding.<sup>135</sup> Second, the court took the many descriptive terms needed to define the “Mc” concept as an indication that “[t]here was no single independent meaning of “Mc” understood in the language,” and that therefore “Mc” could not be considered rhetorically unique.<sup>136</sup>

Had the analysis suggested here been used, a fuller set of data would have been compiled to determine not only the meaning of the prefix “Mc” but also the availability of alternatives to the construction. An absence of synonyms may have persuaded the court that “Mc” was the crystallization of an otherwise nameless conceptualization, defined by terms like standardized, basic, consistent, and convenient. Although the

130 See, e.g., G. CANNON, *supra* note 8, 21-28 (describing the corpus forming the data base for his language studies); R. HALL, *supra* note 90, 239-59 (describing studies of linguistic geography).

131 *Feathercombs, Inc. v. Solo Prods. Corp.*, 306 F.2d 251, 256 (2d Cir.), *cert. denied*, 371 U.S. 910 (1962). Cf., e.g., *G. Heileman Brewing Co. v. Anheuser-Busch, Inc.*, 873 F.2d 985 (7th Cir. 1989).

132 G. CANNON, *supra* note 8, at 48, 69-70 (giving “hoover,” a verb in England, as an example of a somewhat productive trademark).

133 695 F. Supp. 198 (D. Md. 1988).

134 *Id.* at 215-16. The transcript contains a more comprehensive list of the words that describe the category. See Tr. at 856.

135 Tr. at 1028.

136 695 F. Supp. at 216.

defendant's use of this new word was very close to the signaling side of the spectrum (it implied sponsorship), where the claim for access would require establishing a high degree of necessity, the court might have been persuaded to side with Quality Inns had it fully appreciated what McDonald's had done. Rather than provide the public with a name for this new concept and then advertise its own services as belonging to it, McDonalds had promulgated a "McLanguage"<sup>137</sup> in order to use the availability of the vocabulary slot to make its trademark the sole vehicle for discussing the conceptualization it had identified.<sup>138</sup>

In the case of trademarks that are not merely metaphorical in the manner in which all richly-associated words have that quality, but instead are deliberately used as metaphors, further inquiry may be necessary. Since the purpose of intentional metaphors is to surprise listeners into considering a full associational set,<sup>139</sup> novelty can be important. Accordingly, such usages would not receive sufficient protection from a test that looked only to indicia of common acceptance. For these cases, it is appropriate to determine the relationship between the communication and the mark. If the mark produces special insights and there are reasons why other linguistic devices would not serve as well, the mark should be considered situationally expressively generic.<sup>140</sup>

For an example, contrast *Interbank Card Association v. Simms*,<sup>141</sup> involving cards bearing the trademark "Master Charge" and the words "Give Christ charge of your life," with *L.L. Bean, Inc. v. Drake Publishers, Inc.*,<sup>142</sup> which concerned a sexual version of the plaintiff's ubiquitous catalogue. Use in the first case was probably closer to the expressive pole than use in the second because the first defendant was a religious organization while the second in the business of selling was magazines. Yet it is more important to protect access in the second instance. In the first, there is no discernable nexus between the trademark and the message. Since the play on words provides no new insight into the attainment of spiritual well being, the defendant's communicative capacity is not suppressed if deprived of the use of the Master Charge mark.<sup>143</sup> In the second, however, the message may be that intimate human interaction has been sacrificed to efficiency considerations. Success of mail order in displacing

137 *Id.* at 203 (constructions included terms such as "McService," "McPrice," and "McBest").

138 It should be noted that the Patent and Trademark Office had some hostility to claims to a family of marks, see Breitenfeld, *When Is a "Family of Trademarks" Effective*, 52 TRADEMARK REP. 351 (1962). Failure to recognize these advertising strategies may have had the beneficial side effect of preventing companies from creating privately controlled language.

139 *Cf.* Davidson, *supra* note 95 (comparing effective metaphors, which require the listener to determine the way in which the compared items are similar with dead metaphors (such as the mouth of a river) in which the literal meaning of the phrase has been lost).

140 See *Bayer v. United Drug Co.*, 272 F. Supp. (S.D.N.Y. 1921) (notes that even in traditional trademark law, genericity can depend on the situation in which the mark is used).

141 431 F. Supp. 131 (So. N.D. Cal. 1977).

142 811 F.2d 26 (1st Cir.), *appeal dismissed*, 483 U.S. 1013 (1987).

143 A market-failure approach to trademark defenses would look at whether there is reason to believe that rights could not be purchased in the normal course. *Cf.* Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and Its Predecessors*, 82 COLUM. L. REV. 1600 (1982). Under this view, the analysis might run as follows: Since many trademarks and slogans are susceptible to equally effective spiritual messages, there is little fear that a religious group bent on using trademarks would not be able to negotiate a license with some trademark owner.

face-to-face shopping symbolizes this loss. Accordingly, there is a solid fit between the impact of the communication and the use of the trademark; L.L. Bean's role as a premier player in the catalogue market<sup>144</sup> provides a reason to believe that use of other marks would not provide the identical impact.<sup>145</sup>

Admittedly, this rule has the property of penalizing precisely those trademark owners who are so successful that their marks become the symbols of their businesses. But the same is true of trademark owners whose marks become competitively generic. The point of the genericity doctrine is to encourage owners to avoid especially important terms and to contribute new words to the public domain; since those that dominate markets are best positioned to perform the latter function, it is they who should receive the most encouragement. Besides, as the McDonalds example illustrates, it is sometimes the case that dominance is used to suppress rival words by inviting the public to adopt the mark as the name for the concept associated with the goods on which it acts as a signal.<sup>146</sup> A law that regulates the extent to which dominance can be used to competitive advantage is not particularly exceptional.<sup>147</sup>

As with genericity, so with other items in the arsenal of trademark defenses. Because trademark law differs from ordinary first amendment jurisprudence precisely in the greater attention that it has paid to the significance of words, as opposed to the content of communication, its other facets may also be useful templates upon which to build safeguards for speech. Thus, attention should be paid to defenses such as fair use, functionality, abandonment, laches, and continuous prior use. Further elaboration of these doctrines would flesh out the buffer between public and private rights in words.<sup>148</sup> In addition, this analysis may provide a

144 See, e.g., the cover of the October 1987 issue of Consumer Reports, which put the L.L. Bean catalogue first in a picture of eight mail-order publications. See also *id.* at 614 (listing L.L. Bean as one of the four largest mail-order companies).

It is interesting to note that marks likely to be considered expressively generic include the very strong marks that are most likely to receive protection beyond traditional trademark law. Cf. *Allied Maintenance Corp. v. Allied Mechanical Trades, Inc.*, 42 N.Y.2d 538, 369 N.E.2d 1162, 399 N.Y.S.2d 628 (1977) (interpreting New York's dilution law as protecting only very strong marks). At first blush, this result may seem incongruous, but it might actually work quite well. Commercial contexts could be vigorously protected without worrying about access concerns as the new definition of genericity would provide a defense to overintrusion into expressive requirements.

145 Admittedly, the fit between this mark and message is somewhat thin. If a market-failure analysis of genericity is used, it is arguable that there are enough mail-order operations to make it likely that Drake could have obtained a license to parody one of them. The fact that the use was editorial does, however, move it toward the expressive end of the spectrum, which, under this analysis, requires less of a showing of need than is required of uses with a higher signaling component.

146 Cf. *Vuitton Et Fils S.A. v. J. Young Enters.*, 644 F.2d 769 (9th Cir. 1981) (creating aesthetically pleasing design with repetitions of a successful trademark).

147 See, e.g., 15 U.S.C. §§ 1-11 (the Sherman Act); 15 U.S.C. §§ 12-27 (the Clayton Act).

148 Attempts have already been made to use abandonment, which is defined in § 45 of the Lanham Act, 15 U.S.C. § 1127 (1988), in this way. In an interesting dissent to *United States Jaycees v. Philadelphia Jaycees*, 639 F.2d 134 (3d Cir. 1981) (upholding the national organization's trademark right to prevent a splinter group from calling itself "Jaycees"), Judge Gibbons argued that the "Jaycees" mark for mens' clubs had lost significance because the owner's course of conduct had allowed third parties to equate the mark with nondiscriminatory associations. *Id.* at 147 (Gibbons, J., dissenting). The dissent might have been more persuasive had Judge Gibbons separated the signaling function of the mark (signifying a club) from its expressive connotation (signifying discriminatory policies). Cf. *Quality Inns Int'l, Inc. v. McDonald's Corp.*, 695 F. Supp. 198, 212-14 (D. Md.

deeper understanding of the significance of word usages. With that knowledge, first amendment jurisprudence could be altered to produce a body of law more closely attuned to the communicative significance of words, ideograms, and other symbols and signifiers.

### III. Conclusion

It would be interesting to know whether expressive use of trademarks is expanding or whether the rate of trademark litigation has increased as the right to control usage in hybrid cases has received greater recognition. I suspect that in fact, both are true. Apparently, the graduates of the American educational system are no longer acquainted with the classic literature that in the past formed the basis for rhetorical and literary allusion. Betty Crocker has replaced Hestia in the public consciousness. Accordingly, it is not surprising that speakers and writers are drawn to those devices that are, by dint of heavy advertising, doubtlessly universally familiar. At the same time, the popularity of marks as expressive vehicles has spawned a new industry, and it is equally unsurprising that those who made these devices so useful have asserted claims on the profits that this industry generates.

I have made the assumption that proprietary claims to trademarks and ideograms will not abate, and that marks will receive increasingly vigorous protection across the signaling spectrum. Focusing on the linguistic literature, which demonstrates the capacity of the mind to comprehend and exploit the multiple meaning of words, I have proposed a method for developing a framework to protect the expressive dimension of marks in the new legal climate. My hope is that the direction that I have taken, which recognizes trademark law as the principal jurisprudential tradition for analyzing the significance of words, will be pursued by others. Trademark law possesses many features that allocate rights in words, and these may be better than, or useful complements to, the genericity approach that I have chosen as an illustration.

It would also be interesting to know whether the safeguards suggested here are constitutionally compelled. I, however, have left that question to another day. Outside the special context of the Amateur Sports Act, the expansion of trademark rights is judicially driven, based on interpretations of statutes and elaboration of the common law. The same power that oversees the recognition of proprietary rights can be used to erect limitations that safeguard public concerns.

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1988). Because the USOC sponsored "olympic" events for groups such as the handicapped, this analysis may even have applied in the *Gay Olympics* case. See 483 U.S. 522, 542 n. 22 (1987).