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Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works

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POLICING THE BORDER BETWEEN TRADEMARKS AND FREE SPEECH: PROTECTING UNAUTHORIZED TRADEMARK USE IN EXPRESSIVE WORKS

Pratheepan Gulasekaram*

Abstract: Artists and other creators of expressive works often include trademarks and trademarked products as part of their works. They do so for a number of reasons, including lighthearted humor, critical cultural commentary, parody, or even simply to shock. In instances where such use is both unauthorized by and perceived as disparaging to the mark owner or the trademarked product, owners have attempted to sue under trademark law to enjoin the expressive use. This Article argues that, under a proper analysis of trademark law, precedent, and the free expression ideal enshrined in the First Amendment, mark owners should rarely, if ever, prevail in such actions. This Article evaluates the current state of the law, criticizing its inconsistencies and equivocations, and suggests that the correct analytical framework for these disputes must protect the public, creative nature of trademarks and their cultural meaning. The proposed framework mandates balancing of the competing public interest factors of marketplace confusion and free expression to resolve infringement cases, with the assumption that this approach will rarely lead to liability for defendants. As for claims of reputational harm, the free expression concerns compel defendant-friendly results in all cases. After defending this framework, this Article then scrutinizes the background legal doctrine framing this debate—the Supreme Court’s commercial speech doctrine—to discern its relevance to controversies occasioned by unauthorized trademark use. The Article concludes that as commercialism in artistic works such as feature films increases, the line between commercial and noncommercial speech will blur and will again force reconsideration of the border between trademark law and free speech.

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INTRODUCTION

I know what you're thinking. Did he fire six shots or only five? Well, to tell you the truth, in all this excitement, I've kinda lost track myself. But being as this is a .44 Magnum, the most powerful handgun in the world, and would blow your head clean off, you've got to ask yourself one question: "Do I feel lucky?" Well, do ya punk? — *Clint Eastwood, as Detective "Dirty" Harry Callahan.*¹

Whether people have seen the movie or not, most have heard variations of these famous lines and know that Clint Eastwood, as Dirty Harry, carries a Smith & Wesson .44 Magnum.² This endorsement is etched in our cultural landscape, like Andy Warhol's works depicting Campbell's soup cans, E.T.'s taste for Reese's Pieces, and Paul Simon's hit, "Kodachrome." In *Dirty Harry*, Eastwood is packing product placement and testifying to the expressive powers of trademarked products.³ In many cases where a trademarked product appears in an expressive work such as a motion picture, artists actively solicit cooperation from trademark owners in the hope that they will agree to such use, pay for the placement, or offer free use of the products in

1. DIRTY HARRY (Warner Bros. 1971).

2. See, e.g., Ralph Frammolino & Steve Berry, *A Powerful New Revolver Is Already Drawing Fire*, L.A. TIMES, Feb. 14, 2003, at A1 (discussing Smith & Wesson's newest revolver model, which uses a .50 caliber bullet).

3. See DIRTY HARRY, *supra* note 1.

conjunctive advertising.⁴ Though much has been written about the growing use of paid and authorized trademark placement,⁵ comparatively little has been written about the use of a trademark or trademarked product in an expressive work *without* the trademark owner's permission.⁶

The crux of this Article is that even without permission, those engaged in noncommercial expression, such as filmmakers, are at liberty to reference, disparage, ridicule, or otherwise use a trademark or trademarked product in their expressive work without undue fear of trademark liability. I arrive at this conclusion by defining the outer boundary of trademark ownership rights. I identify this boundary by comparing and contrasting trademark rights to private and public property, ultimately deciding that the private property rights of trademark owners must yield to efficient communication about and creative public uses of such property.

In determining how the First Amendment to the U.S. Constitution protects the use of a trademark in the absence of the trademark owner's consent, I attempt to answer two questions. Does the First Amendment protect the right to use trademarks and trademarked products in expressive and artistic endeavors without the authorization of trademark owners? If so, what is the foundation and scope of that right? While some federal courts have addressed these questions,⁷ no court has articulated a comprehensive analytical framework for examining the

4. See, e.g., Michelle Fowler, *To Protect and . . . To Profit: The Trademarking of the LAPD as an Example of Expanding Intellectual Property Rights*, 74 S. CAL. L. REV. 1623, 1642 (2001) (noting that the Los Angeles Police Department (LAPD) gave producers of the movie *Dragnet* permission to feature an official LAPD badge, and producers subsequently donated several buildings to Los Angeles); Avi Friedman, *Protection of Sports Trademarks*, 15 LOY. L.A. ENT. L. REV. 689, 689 (1995) (noting that major professional sports teams have created licensing departments to control use of their trademarks); see also *Ride and Prejudice*, ECONOMIST, Oct. 29, 2005, at 16; *Lights, Camera, Brands*, ECONOMIST, Oct. 29, 2005, at 61.

5. See, e.g., Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960 (1993); Steven L. Snyder, Note: *Movies and Product Placement: Is Hollywood Turning Films Into Commercial Speech?*, 1992 U. ILL. L. REV. 301; see also *Lights, Camera, Brands*, *supra* note 4, at 61 (noting the growing prevalence of product placement and noting that the product placement market was worth \$3.5 billion in 2004).

6. See J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 10.22.1 (4th ed. 2002) ("There is a surprising paucity of case law on the legality of the unpermitted use of commercial trademarks in works of art.").

7. See, e.g., *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900–07 (9th Cir. 2002) (protecting a music group's use of the plaintiff's trademark "Barbie" in a song title); *Rogers v. Grimaldi*, 875 F.2d 994, 998–99 (2d Cir. 1989) (protecting a filmmaker's use of the plaintiff's name in a movie title).

issues.

The current uncertainty in the law stems from the muddled judicial approach employed in some of the first cases that attempt to police the boundary between trademark law and the First Amendment.⁸ Cases like *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*⁹ severely skewed the analysis by likening trademarks to private real property and then applying the analysis set forth in *Lloyd Corp. v. Tanner*,¹⁰ a U.S. Supreme Court decision that restricted expressive activities on privately owned shopping centers so long as there were “alternative avenues” available to the speaker.¹¹ Not surprisingly, this approach has led to instances of near-blanket protection for trademark owners by granting them control over their marks to the same extent that owners of brick-and-mortar commercial centers control their physical spaces.¹² As Professor Robert Denicola has pointed out, some courts have simply ignored the salient differences between trademarks and private real property.¹³ In his forward-looking article written in the aftermath of the

8. See, e.g., *Parks v. LaFace Records*, 329 F.3d 437, 447 (6th Cir. 2003) (noting three approaches to balancing First Amendment interests with trademark law: “(a) the ‘likelihood of confusion’ test; (b) the ‘alternative avenues’ test; and (c) the *Rogers v. Grimaldi* test.”); *Dallas Cowboy Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979); *Dr. Seuss Enters. L.P. v. Penguin Books USA, Inc. (Dr. Seuss J)*, 924 F. Supp. 1559, 1571–72 (S.D. Cal. 1996), *aff’d*, 109 F.3d 1394, 1404 (9th Cir. 1997) (noting three approaches to regulation of noncommercial speech under the Lanham Act: (1) alternative avenues; (2) the balancing test articulated in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989); and (3) blanket refusal to apply the Lanham Act to noncommercial speech).

9. 604 F.2d 200 (2d Cir. 1979).

10. 407 U.S. 551 (1972).

11. See *Dallas Cowboys Cheerleaders*, 604 F.2d at 206 (citing *Lloyd*, 407 U.S. at 567 (holding that a private shopping center could prohibit the distribution of handbills “where adequate alternative avenues of communication exist” for the leafletters’ speech)). But see *Parks*, 329 F.3d at 448–49 (noting the “alternative avenues” test as one possible approach, but instead choosing to apply the *Rogers* balancing approach); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 671–72 (5th Cir. 2000) (rejecting the lower court’s reliance on the alternative avenues approach and remanding the case for reconsideration of scope of injunction); *Rogers*, 875 F.2d at 1000 (2d Cir. 1989) (refusing to enjoin the filmmakers’ use of a celebrity’s name in movie title); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 34 (1st Cir. 1987) (protecting pornographic magazine publishers’ use of the plaintiff’s trademarked logo and product line in connection with pornographic pictures in the magazine).

12. See, e.g., *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) (applying the alternative-avenues test to uphold an injunction against an unauthorized mark user); *Brach Van Houten Holding, Inc. v. Save Brach’s Coal. for Chi.*, 856 F. Supp. 472, 476 (N.D. Ill. 1994) (applying the alternative-avenues test and noting that where the unauthorized use of a trademark functions to identify the source of the product or message, rather than communicating the message, trademark law generally prevails over the First Amendment).

13. See Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging*

Dallas Cowboys Cheerleaders decision, Professor Denicola argued that when the ideas expressed by an unauthorized use cause the injury to plaintiff's mark, the spatial rationale of the "shopping center" cases is wholly inapplicable.¹⁴

Judicial approaches to trademark law that rely on a real property analogy are flawed because trademarks do more than simply identify the source of goods and services. Unlike the shopping centers at issue in *Lloyd*, trademarks are also part of the lexicon by which we express significant cultural ideas. As Judge Alex Kozinski elaborated, "[s]ome trademarks enter our public discourse and become an integral part of our vocabulary. . . . Trademarks often fill in gaps in our vocabulary and add a contemporary flavor to our expressions."¹⁵ To borrow Professor Lawrence Lessig's description of certain copyrights, many trademarks have become part of our "creative commons."¹⁶ The public utility of trademarks thus cautions against disregarding a defendant's First Amendment right to use trademarks as a means of efficient communication or creative cultural commentary. Furthermore, as with most cultural commentary, there will often be "alternative avenues" that could have been used for expression, rendering such a restrictive test wholly antithetical to First Amendment concerns.

As some courts expressly employed a private real property analysis, others began wrestling with the inadequacies of this analogy, sometimes coming to the conclusion that constitutional concerns required untethering trademark law from the confines of private real property rights.¹⁷ Accordingly, in cases like *L.L. Bean, Inc. v. Drake Publishers, Inc.*,¹⁸ *Rogers v. Grimaldi*,¹⁹ and *Mattel, Inc. v. MCA Records, Inc.*,²⁰

Rationales for Protection of the Trade Symbols, 1982 WIS. L. REV. 158, 206.

14. See *id.* ("If the injury to the plaintiff's trademark arises from the ideas that have been expressed through the defendant's use, it is no answer to cite the 'shopping center' cases to justify suppression on the ground that 'adequate alternative avenues of communication exist.' The issue is not where the defendant may speak, but rather what he must say.") (citations omitted).

15. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

16. See Lawrence Lessig, *The Creative Commons*, 65 MONT. L. REV. 1, 11 (2004).

17. Compare *Dallas Cowboy Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979), (relying on First Amendment interpretation in real property cases to protect the plaintiff's trademark), with *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 32 (1st Cir. 1987) (protecting pornographic magazine publishers' use of plaintiff's trademarked logo and product in connection with pornographic pictures in magazine).

18. 811 F.2d 26 (1st Cir. 1987).

19. 875 F.2d 994 (2d Cir. 1989).

20. 296 F.3d 894 (9th Cir. 2002).

courts shied away from the reasoning used in *Dallas Cowboys Cheerleaders*, choosing instead to emphasize the expressive, public, and cultural elements of trademarks.²¹ Unfortunately, despite the availability of this alternate perspective, some courts have employed, and still mistakenly employ, rigid private property analyses that fail to account for broader public interests in free expression.²² Even courts that have chosen to infuse constitutional concerns into their decision-making have done so clumsily, leaving much of the boundary between trademark and free expression undefined.²³

The drafters of the Federal Trademark Dilution Act of 1995 (FTDA),²⁴ an amendment to the Lanham Act of 1946,²⁵ understood these competing private and public ideals. While providing for reputational harm liability—a clear private interest—the FTDA specifically exempted “noncommercial use” of trademarks from liability,²⁶ essentially providing a statutory basis for free speech protection. The drafters acknowledged that the statutory exemption was consistent with existing case law that “recognize[s] that the use of marks in certain forms of artistic and expressive speech is protected by the First Amendment.”²⁷ Despite this codification of First Amendment norms, some courts still evince discomfort with the full import of incorporating constitutional free expression values into trademark analysis.²⁸ Moreover, even where the statutory exemption protects unauthorized uses, courts often fail to recognize the constitutionally-mandated nature of the outcome, instead relying solely on statutory language.²⁹

21. *See id.* at 906–07 (protecting a music group’s use of plaintiff’s trademark in song and song title that made fun of the cultural values represented by the plaintiff’s trademarked product); *Rogers*, 875 F.2d at 1000–02 (refusing to enjoin the filmmakers’ use of a celebrity’s name in a movie title); *L.L. Bean*, 811 F.2d at 32 (protecting a pornographic magazine publisher’s use of the plaintiff’s trademarked logo and product in connection with pornographic pictures in the magazine).

22. *See infra* Part I.B.

23. *See infra* Part II.C.

24. Federal Trade Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (codified at 15 U.S.C. § 1125(c) (2000)).

25. *Id.* §§ 1051–1141.

26. *See id.* § 1125(c)(4)(B).

27. *See Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 906 (9th Cir. 2002) (quoting 141 CONG. REC. S19311 (daily ed. Dec. 29, 1995)).

28. *See, e.g., Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 507–08 (2d Cir. 1996) (noting uncertainty as to whether all unauthorized expressive uses are exempt from dilution liability under New York’s anti-dilution statute). *But see MCA Records*, 296 F.3d at 907 (applying FTDA noncommercial exemption for unauthorized expressive uses).

29. *See, e.g., Hormel*, 73 F.3d at 508 (holding that there is no likelihood of dilution based on: (1)

I argue that when assessing trademark owners' claims of unauthorized mark use in an artistic or expressive context, courts should find the sensible middle ground between purely private and purely public concerns. The combination of the *Rogers* test in infringement claims and the full consideration of First Amendment norms in dilution claims ensures creativity and efficiency for the public while maintaining property rights and incentives for trademark owners.³⁰ In infringement claims, the parameters of trademark law and free expression are best assessed by the *Rogers* framework, which balances the public interest in protecting the use of trademarks as a source-identifier with the public interest in free speech.³¹ Although the *Rogers* court limited its analysis to trademark infringement under narrowly confined factual circumstances,³² the analysis can and should be used to define the boundaries of trademark law whenever consumer confusion is at issue. In the dilution context, where reputational harm is mostly at issue and consumer confusion is not, unauthorized expressive use falls clearly into the realm of public control.³³ The "noncommercial use" exception to the FTDA is a legislative recognition of this boundary.³⁴

The use of trademarks to convey expressive ideas is entitled to robust First Amendment protection that may only be trumped in clear instances when the use significantly impairs the source-identifying function of the mark—i.e., only when the likelihood of consumer confusion is high and market fraud is a genuine danger.³⁵ As those instances are rare in expressive activity, artists and others are entitled to broad leeway in using, ridiculing, commenting on, or displaying any trademarked

the lack of evidence that unauthorized use will cause negative associations, (2) the defendant's status as a non-competitor, and (3) the parody element of the unauthorized use of the plaintiff's mark). *But see MCA Records*, 296 F.3d at 906 (noting that the FTDA statutory exemption was created in part to allay First Amendment concerns).

30. This Article addresses infringement claims and dilution claims under both federal and state law. State and federal infringement claims both focus on whether the unauthorized use of a mark creates a likelihood of consumer confusion as to the origin or endorsement of the thing that bears the unauthorized mark. *See* 15 U.S.C. § 1125(a)(1)(A); *see, e.g., CAL. BUS. & PROF. CODE* § 14320(a) (West 2005). A critical difference between state and federal dilution claims is that the latter has a statutory exemption for noncommercial use. *See* 15 U.S.C. § 1125(c)(4)(B).

31. *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

32. *Id.* ("In the context of titles, this 'no alternative' standard provides insufficient leeway for literary expression.")

33. *See infra* Part II.

34. *See* 15 U.S.C. § 1125(c)(4)(b).

35. *See infra* Part III (focusing on examples of potential liability under this proposed standard).

products. A mark owner's argument that a defendant's idea or unauthorized use in an expressive context confuses consumers or sullies a plaintiff's reputation should not survive motions for dismissal or summary judgment. Under my proposed use of the *Rogers* test in infringement claims and a recognition of First Amendment concerns in dilution claims, artists and other expressive users will access the entirety of their expressive freedom.

Finally, I show that instead of attempting to impose trademark-dilution liability on artists who use or denigrate others' marks without permission, trademark owners would be better served by challenging the U.S. Supreme Court's current distinction between commercial and noncommercial speech.³⁶ The analysis presented here should lead mark owners to the realization that, properly defined, trademark law cannot and should not in most cases redress harm from expressive uses, despite any unwholesomeness of that use. For mark owners and for courts, the more critical question is whether a particular use is in fact an expressive or artistic use or whether it is a commercial use that could be subject to greater trademark law liability. It is this distinction—and not the difference between a wholesome and damaging portrayal—that ultimately matters for imposition of dilution liability. While the designation of speech as commercial or noncommercial does not directly impact the analysis of infringement claims,³⁷ it indirectly impacts those claims in a number of ways explored in further detail below. Primarily, it alters the weight and import of the factors courts consider in the infringement analysis.³⁸ In contrast to the commercial context where public confusion concerns are measured against private economic interests, in the noncommercial context, the public confusion concern is measured against an equally weighty public free expression concern.³⁹ In addition, the designation between the two types of speech inherently impacts the relevance of the individual factors considered in infringement analyses, making certain factors practically dispositive in those cases.⁴⁰

36. See, e.g., *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 68–72 (1983) (evaluating whether an advertisement that commented on public health was commercial or noncommercial speech and holding that it was commercial speech).

37. See 15 U.S.C. § 1114 (omitting express exemption for noncommercial uses).

38. See *infra* Part III for discussion regarding saliency of infringement factors in the context of expressive works.

39. See *infra* Part I.C.

40. See *infra* Parts III & IV.B–C.

Part I examines the competing judicial approaches to trademark claims in expressive works. Part II explores the deficiencies in the current, prevailing judicial treatment of such claims. Part III offers a defense of the proposed analytical methodology. Finally, Part IV argues that the boundary between trademark and free speech established by the proposed methodology will shift only if the U.S. Supreme Court reconsiders its commercial/noncommercial speech dichotomy. Using product placement in movies as an example, this Article considers how expanding the definition of commercial speech will shift the trademark/free speech analysis towards greater consideration of private property concerns.

I. DEVELOPMENT OF THE LAW

Trademark law addressing infringement and dilution is based on both a vibrant statutory framework and a muddled array of precedents from various federal courts. This Article first explains the present statutory framework. It then outlines early judicial attempts to address the issue of unauthorized expressive uses and the evolution of that analysis.

A. *Current Statutory Framework*

As a subset of unfair competition laws in general,⁴¹ the Lanham Act provides causes of action against persons who (1) use trademarks in a manner that is likely to cause confusion as to the origin, sponsorship, or approval of their goods by another person⁴² or (2) misrepresent the source of the trademarked product or service in commercial advertising.⁴³ The underlying tenet of the Lanham Act is consumer protection, stemming from a desire to prevent companies from misleading consumers into using products or services by infringing upon other companies' more popular or more highly regarded trademarks.⁴⁴ The motivation to protect consumers is a strong theme throughout the trademark-infringement provisions of the Lanham Act,⁴⁵ which evinces a design to protect public interests to the same extent as, if not more than,

41. See *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003) (noting unfair competition's origins in English common law, later codified in the Lanham Act).

42. See 15 U.S.C. § 1125(a)(1)(A) (providing a cause of action for a confusion claim).

43. See *id.* § 1125(a)(1)(B) (providing a cause of action for a misrepresentation claim).

44. See *Moseley*, 537 U.S. at 428.

45. See *id.*; *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905 (9th Cir. 2002).

competing commercial interests.⁴⁶

To state a trademark infringement claim based on confusion, the plaintiff must show that the defendant's use of its trademark is likely to cause consumers to believe that the plaintiff endorsed, manufactured, sponsored, or was otherwise affiliated with the defendant's confusingly similar product.⁴⁷ The U.S. Courts of Appeals have employed various multi-factored tests to determine likelihood of confusion, generally focusing on the following concerns: (1) the strength of plaintiff's trademark; (2) the similarity of plaintiff's and defendant's trademarks; (3) the proximity of plaintiff's and defendant's products; (4) the likelihood that plaintiff will bridge the gap between its products and defendant's products; (5) the actual or potential likelihood for confusion; (6) the defendant's intent to confuse the public;⁴⁸ (7) the quality of defendant's product; and (8) the sophistication of consumers.⁴⁹ In the specific context of expressive uses, not all of these factors are always relevant to the court, and some may take on greater significance in those uses compared to their significance in commercial uses.⁵⁰

In 1995, Congress added a federal cause of action for dilution claims when it passed the FTDA as an amendment to the Lanham Act.⁵¹ Before enactment of the FTDA, trademark owners possessed only federal causes of action for *infringement*, and were relegated to relying on state laws for *dilution* claims.⁵² Claims based on dilution, unlike claims based

46. See 15 U.S.C. §§ 1111–1129 (requiring willful infringement for damages and providing exemptions for noncommercial, newsworthy, and fair use expressions); *Moseley*, 537 U.S. at 428–29 (noting that “[i]nfringement law protects consumers from being misled by the use of infringing marks” and “[u]nlike traditional infringement law, the prohibitions against trademark dilution . . . are not motivated by an interest in protecting consumers”).

47. See 15 U.S.C. § 1125(a)(1)(A).

48. This factor focuses on intent to confuse, not intent to disparage. Many unauthorized users intend to disparage products, but do not intend to confuse consumers. See, e.g., *Mattel*, 296 F.3d at 900 (protecting the defendant's song that poked fun at the plaintiff's trademarked “Barbie” doll, where the defendant was not attempting to sell competitive dolls or confuse consumers as to the plaintiff's endorsement of the song).

49. See, e.g., *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979) (citing RESTATEMENT (FIRST) OF TORTS §§ 729, 731 (1938)) (identifying factors used when products are related but not competitive); *Polaroid, Inc. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (citing RESTATEMENT (FIRST) OF TORTS §§ 729, 730, 731 (1938)) (identifying factors used when products are different).

50. See *infra* Part III for discussion regarding the saliency of infringement factors in the context of expressive works.

51. See Federal Trade Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (codified at 15 U.S.C. § 1125(c) (2000)).

52. See *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 430 (2003) (noting that at least

on infringement that allege confusion or misrepresentation, assert either blurring or tarnishment of the trademark.⁵³ Blurring occurs when a distinct mark loses its ability to identify the product that made the mark famous (e.g., “Buick Aspirin” or “Du Pont Shoes”).⁵⁴ Tarnishment occurs when use of the mark in certain contexts causes negative associations with the mark.⁵⁵ The FTDA for the most part reflects the wisdom of the various state anti-dilution statutes that were in existence for decades before the FTDA was created.⁵⁶

To state a federal dilution claim a plaintiff must show that: (1) its trademark is famous; (2) the defendant put the mark to use after the plaintiff’s mark became famous; (3) the defendant put the mark to commercial use in commerce; and (4) actual dilution occurred.⁵⁷ Following a court’s determination that the plaintiff satisfies these four prongs, the court must then consider whether the dilutive use nevertheless falls into an enumerated exemption in the FTDA.⁵⁸ The most significant of those exemptions, for purposes of artistic and expressive works, is the “noncommercial use” exemption codified at 15 U.S.C. § 1125(c)(4)(B).⁵⁹ If the defendant’s use is noncommercial—as most, if not all, expressive uses are—it is wholly exempt from dilution liability under the FTDA.⁶⁰

twenty-five states had anti-dilution statutes before the FTDA was enacted).

53. *Id.*

54. See MCCARTHY, *supra* note 6, § 24:68.

55. See *id.* § 24:69.

56. Courts have noted that the elements of state dilution claims are similar to the elements of a federal dilution claim. See, e.g., *Panavision Int’l, L.P. v. Toeppen*, 141 F.3d 1316, 1324 (9th Cir. 1998) (noting that California’s anti-dilution statute is similar to the FTDA and subject to the same analysis). But see *Moseley*, 537 U.S. at 432–33 (noting that “[t]he contrast between the state [anti-dilution] statutes and the federal [dilution] statute” is that the federal dilution statute “unambiguously requires a showing of actual dilution rather than a likelihood of dilution”).

57. See 15 U.S.C. § 1125(c)(1) (2000); *Moseley*, 537 U.S. at 433 (requiring a showing of *actual* dilution, and not simply a *likelihood* of dilution, before a plaintiff can prevail on either a blurring or tarnishment theory under the FTDA).

58. See *Moseley*, 537 U.S. at 434; *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 903 (9th Cir. 2002) (determining first that the song title would satisfy dilution factors and then holding that it nevertheless satisfied the noncommercial use exemption).

59. 15 U.S.C. § 1125(c) (“(1) The owner of a famous mark shall be entitled . . . to an injunction against another person’s commercial use in commerce of a mark or trade name . . . (4) The following shall not be actionable under this section: (A) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark. (B) Noncommercial use of a mark. (C) All forms of news reporting and news commentary.”).

60. See *id.* The “noncommercial use” exemption, *id.* § 1125(c)(4)(B), and the “commercial use in

Although state anti-dilution statutes generally differ from the FTDA in two major ways, these differences are inconsequential for this analysis. First, state anti-dilution statutes do not require “actual dilution” but rather a likelihood of dilution.⁶¹ The actual dilution standard, however, only presents a difference in standards of proof for federal claims as opposed to state claims; it does not represent a different theoretical orientation to the proper scope of the First Amendment’s protection of unauthorized expressive use.⁶² Second, state anti-dilution statutes do not contain an exemption for noncommercial use.⁶³ Similarly, this absence should not affect my analysis. If my contention is correct, then whether the cases deal with the FTDA’s express exemption or with state anti-dilution laws, the First Amendment would control, creating a fundamental norm that cannot be abridged by federal or state statute or lack thereof.⁶⁴ In this sense, the FTDA’s statutory exemption, while helpful and clear, is superfluous: it protects what is already protected.⁶⁵

With federal or state claims based on either confusion or dilution, the rights of trademark owners often clash with the First Amendment rights of artists, publishers, and commentators. Such clashes often occur in the context of books, magazines, news reporting, consumer reviews, critical

commerce” element, *id.* § 1125(c)(1), are not in conflict with each other. The commercial use-in-commerce language refers to Congress’s intent to legislate to the extent of its authority, not a substantive limit on Lanham Act causes of action. *See Charles Atlas, Ltd. v. DC Comics, Inc.*, 112 F. Supp. 2d 330, 336 (S.D.N.Y. 2000) (citing *United We Stand Am., Inc. v. United We Stand Am. N.Y., Inc.*, 128 F.3d 86, 92 (2d Cir. 1997)); *see also Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 903 (9th Cir. 2002) (concluding that the defendant’s use of the plaintiff’s mark in a song was a “commercial use in commerce” because the defendants sold the song containing the mark to consumers in the marketplace); *Lucasfilm Ltd. v. Media Mkt. Group, Ltd.*, 182 F. Supp. 2d 897, 900 (N.D. Cal. 2002) (“An expressive use is not rendered commercial by the impact of the use on sales.”). A mark’s use is “commercial” in the FTDA exemption or First Amendment sense only if it is within the definitional bounds of the U.S. Supreme Court’s commercial speech doctrine. *See Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 66 (1983) (defining commercial speech as that which “does no more than propose a commercial transaction”) (citations omitted).

61. *See, e.g., Pillsbury Co. v. Milky Way Prods., Inc.*, No. C78-679A, 1981 U.S. Dist. LEXIS 17722, at *40-41 (N.D. Ga. Dec. 24, 1981) (noting that Georgia’s anti-dilution statute requires only a likelihood of dilution).

62. *See MCCARTHY, supra* note 6, § 24:95 (confirming that actual dilution represents a quantum-of-proof difference from likelihood-of-dilution standard).

63. *See, e.g., CAL. BUS. & PROF. CODE* § 14320(a) (West 2005).

64. *See Charles Atlas*, 112 F. Supp. 2d at 341 (citing *Yankee Publ’g Inc. v. News Am. Publ’g Inc.*, 809 F. Supp. 267, 282 (S.D.N.Y. 1992) (“[T]he same First Amendment considerations that limit a cause of action under the Lanham Act apply also to a cause of action under New York law.”)).

65. *See MCA Records*, 296 F.3d at 906 (quoting 141 CONG. REC. S19311 (daily ed. Dec. 29, 1995)).

commentaries, paintings, motion pictures, parodies, and other forms of protected expression.⁶⁶ In the dilution context, this expressive activity is at least partially shielded from liability under the FTDA.⁶⁷ In contrast, in state dilution claims and all confusion claims, this expressive activity is protected only so far as the courts choose to recognize First Amendment concerns.⁶⁸

B. Misguided Beginnings to the Analysis of Trademark Claims in the Context of Expressive Works

In a number of prominent cases, including *Coca-Cola Co. v. Gemini Rising, Inc.*,⁶⁹ *Dallas Cowboys Cheerleaders*, and *Pillsbury Co. v. Milky Way Productions, Inc.*,⁷⁰ courts have ruled in favor of mark owners, agreeing that their property rights in their marks included the ability to enjoin disparaging uses of their marks in expressive contexts under federal trademark and state competition law.⁷¹ These misguided beginnings still occasionally haunt jurisprudence in this area, causing courts to unnecessarily harmonize their existence rather than simply discarding them as outdated and incorrect law.⁷² More importantly, these

66. See e.g., *Rogers v. Grimaldi*, 875 F.2d 994, 997–98 (2d Cir. 1989) (involving a conflict between a filmmaker’s free-expression rights and the plaintiff’s trademark rights in her famous name).

67. See 15 U.S.C. § 1125(c) (2000).

68. See, e.g., CAL. BUS. & PROF. CODE § 14320(a) (providing no express statutory exemption or accommodation of First Amendment concerns); *Charles Atlas*, 112 F. Supp. 2d at 341.

69. 346 F. Supp. 1183 (E.D.N.Y. 1972).

70. No. C78-679A, 1981 U.S. Dist. LEXIS 17722 (N.D. Ga. Dec. 24, 1981). Reaching a similar result as the *Coca-Cola* and *Dallas Cowboys Cheerleaders* courts, the *Pillsbury* court enjoined depiction of Pillsbury’s “Poppin’ Fresh” character by defendant in a pornographic magazine. See *id.* at *40–41. Although the court concluded that the trademark owner could not show sufficient likelihood of confusion to merit an injunction on its *infringement* claim, see *id.* at *37–38, the court expressly concluded that relief was appropriate based on plaintiff’s *tarnishment* claim under Georgia anti-dilution statutes, see *id.* at *40–41. The court held that First Amendment concerns were not sufficient to prevail over the likelihood of damage to plaintiff’s business reputation from the defendant’s placement of plaintiff’s mark in a “depraved context.” See *id.* at *39.

71. See *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (affirming order of preliminary injunction on confusion claim); *Pillsbury*, 1981 U.S. Dist. LEXIS 17722, at *40–41 (granting injunctive relief on dilution claim); *Coca-Cola*, 346 F. Supp. at 1193 (granting motion for preliminary injunction on infringement and dilution claims).

72. For example, after *Dallas Cowboys Cheerleaders*, courts in the Second Circuit stretched to distinguish their cases from this case. See, e.g., *Rogers v. Grimaldi*, 875 F.2d 994, 999–1000 (2d Cir. 1989) (distinguishing *Dallas Cowboys Cheerleaders* as a case involving “blatantly false advertising”); *Tetley, Inc. v. Topps Chewing Gum, Inc.*, 556 F. Supp. 785, 791–92 (E.D.N.Y. 1983) (distinguishing *Dallas Cowboys Cheerleaders* as a case that involved a defendant pornographer

initial cases anchored trademark law in a private real property analysis from which it is just recently attempting to break free.

Coca-Cola, an early decision by the U.S. District Court for the Eastern District of New York, rooted its analysis in a desire to provide absolute protection to the plaintiff mark-owner from reputational harm.⁷³ This case involved a poster company's use of the familiar and trademarked Coca-Cola bottle outline with the words "Enjoy Cocaine" written in Coca-Cola's distinctive script.⁷⁴ The district court issued a preliminary injunction against the defendant from manufacturing defendant's posters, noting that the defendant (1) associated "a noxious substance" with plaintiff's "wholesome beverage," and (2) caused actual confusion in the marketplace.⁷⁵ The court granted the injunction based on its assessment that Coca-Cola was likely to prevail on both its likelihood-of-confusion claim under the Lanham Act and its dilution claim under state law.⁷⁶ The court refused to recognize defendant's First Amendment defense, opining that damage to a mark and to the mark owner's goodwill and business reputation was a special circumstance in which the court may enjoin or restrain expressive material.⁷⁷ To the extent that a court bases its decision to reject a First Amendment defense on reputational damage instead of consumer confusion, the *Coca-Cola* decision is emblematic of judicial decision-making that strikes the wrong balance between private and public interests.

In *Dallas Cowboys Cheerleaders*, the Second Circuit similarly relied on a real property analogy and enjoined the distribution and exhibition of the pornographic film *Debbie Does Dallas*.⁷⁸ In film and print advertisements, defendants featured the lead actress wearing a costume

competing with a sports franchise in the same "national entertainment market").

73. See *Coca-Cola*, 346 F. Supp. at 1188–89 (reasoning that "[p]laintiff's property right in its mark clearly extends to its reproduction and publication in advertising and for other promotional uses regarding its products" and that "[t]o associate such a noxious substance as cocaine with plaintiff's wholesome beverage . . . would clearly have a tendency to impugn that product and injure plaintiff's business reputation . . .").

74. *Id.* at 1186.

75. *Id.* at 1188–89 & n.5 (noting that customers had actually written to Coca-Cola, demanding an explanation as to why the soft-drink company was promoting illegal drug use).

76. See *id.* at 1191–93.

77. See *id.* at 1192–93 (rejecting the defendant's argument that "in the absence of special circumstances a court of equity will not enjoin or restrain literary or spoken material") (internal quotations omitted).

78. *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 207 (2d Cir. 1979).

strikingly similar to the trademarked outfits worn by the actual Dallas Cowboys Cheerleaders.⁷⁹ The court, analyzing the plaintiff's confusion claim under the Lanham Act and New York state anti-dilution law, reasoned that because the advertisements could lead the public to believe that the film involved an ex-Dallas Cowboys Cheerleader, the possibility existed that the public would think the film was a publicity move by the actual Dallas Cowboys cheerleaders.⁸⁰ However, as many commentators have noted,⁸¹ underlying the court's decision appears to be a belief that the film's content was "gross and revolting."⁸² The defendant filmmaker argued that his movie explored the concept of sexuality in sports and was therefore protected speech not amenable to trademark liability.⁸³ In rejecting the filmmaker's First Amendment defense, the court invoked a real property analogy—relying on *Lloyd*, where handbill leafletters were denied a First Amendment right to distribute handbills on private commercial real estate⁸⁴—to conclude that because the filmmaker could have made his statement about sexuality in sports using "alternative avenues" that did not violate property rights, the unauthorized use was not protected speech.⁸⁵

C. *Untethering Trademark and Real Property: The Uneasy Emergence of Constitutional Consideration*

In subsequent cases, courts began to reject the concept of trademarks as private property and embrace the idea of trademarks as vehicles of public expression that are concurrently public and private.⁸⁶ Professor Denicola's critique took specific aim at the uncomplicated and deficient analysis in *Coca-Cola*, arguing that "the court's statement in *Coca-Cola* [rejecting consideration of First Amendment rights] bespeaks a kind of

79. *See id.* at 205.

80. *See id.* at 205 & n.8.

81. *See, e.g.,* Robert N. Kravitz, *Trademarks, Speech, and the Gay Olympics Case*, 69 B.U. L. REV. 131, 148–53 (1989); Arlen W. Langvardt, *Protected Marks and Protected Speech: Establishing the First Amendment Boundaries in Trademark Parody Cases*, 36 VILL. L. REV. 1, 23 (1991).

82. *See Dallas Cowboys Cheerleaders*, 604 F.2d at 202.

83. *Id.* at 206.

84. *Lloyd Corp. v. Tanner*, 407 U.S. 551, 566–67 (1972).

85. *See Dallas Cowboys Cheerleaders*, 604 F.2d at 206 (citing *Lloyd*, 407 U.S. at 567).

86. *See, e.g.,* L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 32 (1st Cir. 1987) (recognizing the importance of First Amendment principles in protecting a defendant magazine-publisher's use of plaintiff's trademark in a pornographic magazine).

absolutism hardly in keeping with modern [F]irst [A]mendment theory.”⁸⁷ So, too, with *Dallas Cowboys Cheerleaders*: “[T]he sweeping rejection of the defendant’s [F]irst [A]mendment claim in *Dallas Cowboys Cheerleaders* is dangerously simplistic.”⁸⁸

The *L.L. Bean* court embraced this rationale and eschewed the easy resolution of the free speech issue employed by the *Dallas Cowboys Cheerleaders* court.⁸⁹ The *L.L. Bean* court, in its assessment of a pornographic magazine’s sex-oriented parody of plaintiff’s trademarked school-supply products, acknowledged this competing perspective and refused to equate the rights of a trademark owner with the rights of a real-property owner.⁹⁰ In dismissing the plaintiff’s state law dilution claims, the court reasoned that the pornographic magazine was not using the plaintiff’s mark for a “commercial” purpose, but rather for parody and artistic purposes.⁹¹ As such, the court refused to allow the trademark owner to control all public discourse on its trademarked products.⁹²

The marquee moment for the emerging constitutional consideration in trademark law arrived with *Rogers*, where the Second Circuit determined that director Federico Fellini’s movie title, *Ginger & Fred*, did not violate actress Ginger Rogers’s trademark rights in her name under the federal infringement statute.⁹³ The *Rogers* court reasoned that the proper analysis for confusion claims under the Lanham Act should account for the interests protected by both trademark infringement laws and the Constitution.⁹⁴ To do so, the court employed a balancing test for the movie title at issue, assessing trademark liability by considering whether the public interest in avoiding confusion outweighed the public interest in free expression.⁹⁵ Employing the Second Circuit’s multi-factored likelihood-of-confusion test, the court determined that use of Rogers’s name in the title might create some confusion as to source or

87. Denicola, *supra* note 13, at 205.

88. *Id.* at 206.

89. See *L.L. Bean*, 811 F.2d at 29 (rejecting plaintiff’s tarnishment claim under Maine dilution law).

90. *Id.*

91. *Id.* at 32.

92. See *id.* at 31 (“Neither the strictures of the First Amendment nor the history and theory of anti-dilution law permit a finding of tarnishment based solely on the presence of an unwholesome or negative context in which a trademark is used without authorization. Such a reading of the anti-dilution statute unhinges it from its origins in the marketplace.”).

93. See *Rogers v. Grimaldi*, 875 F.2d 994, 1005 (2d Cir. 1989).

94. *Id.* at 999.

95. *Id.*

affiliation.⁹⁶ The court ruled, however, that when the title of the expressive work bears artistic relevance to the underlying artistic work, “some” confusion is legally acceptable and therefore insufficient to state an infringement claim.⁹⁷ The court’s focus on the “noncommercial” nature of the use foreshadowed the distinction that, I argue, is critical in assessing both infringement and dilution claims.

The balancing test articulated by the *Rogers* court is compelling because it is the only approach attuned to the primary purpose of trademark laws: protecting the public against confusion and fraud.⁹⁸ The innovation of the *Rogers* court is not its employment of flexible balancing per se, but rather its choice of the two interests considered in the balance. Both interests on the scale are public: (1) the *public* interest in avoiding confusion; and (2) the *public* interest in free speech.⁹⁹ The underlying message is unmistakable: in the context of expressive works, private property interests in trademark are protected only to the extent they coincide with the public’s interest in avoiding confusion and fraud. By de-emphasizing consideration of private interests in its balancing test, the *Rogers* court recognized a famous trademark’s tremendous cultural and communicative value, which in expressive use transcends a trademark’s value solely as a source-identifier.

Since *Rogers*, decisions in this area of law have vacillated between the competing values of private property and public concern.¹⁰⁰ Courts’ attempts to navigate between these two poles have led to confused and

96. *Id.* at 1000–01.

97. *See id.* at 1001 (“To the extent that there is a risk that the title will mislead some consumers as to what the work is about, that risk is outweighed by the danger that suppressing an artistically relevant though ambiguous title will unduly restrict expression.”).

98. With respect to FTDA claims, the result of the *Rogers* balancing test is preordained because the noncommercial exception will always tilt the scale to the public’s interest in free speech. Even though the primary purpose of the FTDA is to protect mark owners’ property interests, and not to protect consumers against confusion like the Lanham Act, *see* 15 U.S.C. § 1125(a) (2000) (providing civil remedy to a plaintiff trademark-owner); *id.* § 1125(c)(4) (exempting public uses in expression and media from liability), I argue that trademark law applied to expression is correctly understood only when it considers public concerns.

99. *See Rogers*, 875 F.2d at 999 (noting that the Lanham Act should be applied to artistic works where the public interest in avoiding consumer confusion outweighs the public interest in free expression); *see also* *Parks v. LaFace Records*, 329 F.3d 437, 449 (6th Cir. 2003) (“The public has at least as much interest in the free exchange of ideas as it does in avoiding misleading advertising.”).

100. *See, e.g., Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 507–08 (2d Cir. 1996) (protecting a filmmaker’s use of the plaintiff’s trademark as a humorous character in a movie); *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 403 (8th Cir. 1987) (enjoining a shirt designer’s use of the plaintiff’s trademark on a t-shirt design).

inconsistent analyses.¹⁰¹ For example, even as the Second and Ninth Circuits forged ahead with more nuanced, artist-friendly decisions in cases like *Hormel Foods Corp. v. Jim Henson Productions, Inc.*,¹⁰² *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*,¹⁰³ and *MCA Records*,¹⁰⁴ the Eighth Circuit's tandem of *Mutual of Omaha Insurance Co. v. Novak*¹⁰⁵ and *Anheuser-Busch, Inc. v. Balducci Publications*¹⁰⁶

101. See, e.g., *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 507–08 (2d Cir. 1996); *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 403 (8th Cir. 1987). see also *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559, 1571 (S.D. Cal. 1996), *aff'd*, 109 F.3d 1394 (9th Cir. 1997).

102. 73 F.3d 497 (2d Cir. 1996). The court rejected the plaintiff's confusion and dilution claims that its trademark for Spam, a pork product, was infringed by the defendant's depiction of a wild-boar Muppet named Spa'am. *Id.* at 505–06. Although the court did not expressly employ the *Rogers* test, it noted that the confusion claim failed at district court because children, understanding the Muppets' unique brand of humor, would not be confused into thinking that Hormel had sponsored the film or was otherwise affiliated with the Muppets. *Id.* at 502. With regard to the state dilution claim, the court did not expressly address First Amendment concerns. See *id.* at 505–08. In rejecting Hormel's dilution claim, the court reasoned that under a tarnishment theory, Henson, the Muppets, and the movies in which they appeared were not competitors with Hormel for sale of meat products. *Id.* at 507–08. Tarnishment claims, the court noted, were successful in cases involving sexuality, obscenity, and illegal activity. *Id.* at 507.

103. 924 F. Supp. 1559 (S.D. Cal. 1996), *aff'd*, 109 F.3d 1394 (9th Cir. 1997). The court found that the plaintiff's trademark claim did not establish a reasonable likelihood of success on the merits. *Id.* at 1571. The plaintiff sued the defendant for using the familiar Dr. Seuss style of storytelling to recount the O.J. Simpson double-homicide trial. *Id.* Concluding that the plaintiff had shown a likelihood of success on the merits of the *copyright* claim, the court enjoined the defendant's publication and sale of its book. See *id.* at 1562. In evaluating the plaintiff's *trademark* claims, however, the court found that the plaintiff did not have a reasonable likelihood of success on the merits of its infringement claim, *id.* at 1571, and that the FTDA did not provide a basis for liability for a parody that is merely amusing, not confusing, *id.* at 1574.

104. 296 F.3d 894, 902 (9th Cir. 2002). The court rejected the plaintiff's confusion and dilution claims. *Id.* at 907. Mattel, owner of the world-renowned Barbie trademark identifying its distinctive line of dolls, sued a music band for its use of the name "Barbie" in their song "Barbie Girl," which, in its lyrics, mocks Barbie and the mores the doll represents. *Id.* at 899. With regard to Mattel's confusion-infringement claim, the court endorsed the *Rogers* balancing test, persuaded that the title "Barbie Girl" was relevant to defendants' commentary on the trademarked product. *Id.* at 902. Applying the *Rogers* test, the court balanced the competing public interests, finding that the free-speech concerns far outweighed the possibility of public confusion, if any, engendered by the song title. See *id.* Noting that the Barbie trademark had been imbued with a "meaning beyond its source-identifying function," the court refused to allow any private property interests of the trademark owner to outweigh the public interest in free expression. *Id.* at 900. On the FTDA claim, the court held that although the use of the mark was dilutive, the use was exempted from dilution liability because it fell within the noncommercial use exemption to the FTDA. *Id.* at 906–07.

105. 836 F.2d 397 (8th Cir. 1987). The court enjoined the defendant's satirical "Mutant of Omaha" merchandise, featuring a shrunken "Indian Head" and the caption "Nuclear Holocaust Insurance" as a confusion infringement of Mutual of Omaha's "Indian Head" trademark. *Id.* at 403. The court first concluded that under the Eighth Circuit's infringement analysis, the defendant's reference to the plaintiff's trademark was likely to confuse consumers as to source and affiliation.

harkened back to the restrictive real property constrictions of prior case law.¹⁰⁷ Artist-friendly decisions like *MCA Records* properly invoked the *Rogers* test, but improperly limited the situations in which the *Rogers* test should apply.¹⁰⁸ Such indefensible limitations on the reach of free expression concerns have caused further analytical quandaries for courts assessing trademark claims.¹⁰⁹

The passage of the FTDA in 1995, despite foreshadowing a judicial commitment to greater free expression consideration, has not curtailed the stunted incorporation of First Amendment concerns.¹¹⁰ The FTDA created a federal cause of action for dilution while simultaneously codifying a First Amendment defense for expressive uses of trademarks

Id. Second, the court employed a private real property analysis, citing *Dallas Cowboys Cheerleaders* for the proposition that trademark law does not have to yield to the First Amendment where alternate avenues of expression exist for the defendant. *Id.* at 402. Because the defendant could have presented his editorial parody in a book, magazine, or film, the injunction did not infringe upon constitutional rights. *See id.* at 402. The court did not address the state disparagement claim because it would not have affected the remedy. *See id.* at 398 n.2.

106. 28 F.3d 769 (8th Cir. 1994). The court reversed the dismissal of the plaintiff's infringement and dilution claims based on the defendant's mockery of the plaintiff's advertising slogans. *Id.* at 779. The court ruled for the plaintiff even though the defendant's chosen avenue for expression—a humor magazine—was one of the “avenues” deemed acceptable for expression by the *Mutual of Omaha* court. *See id.* at 775–76. In *Balducci*, the court first found that the defendant's parody ad created a likelihood of confusion under the Eighth Circuit's multi-factored infringement test. *Id.* at 775. In the second part of its analysis, the court nominally applied the *Rogers* balancing test to determine if the First Amendment nevertheless protected the defendant's confusing use. *Id.* at 776. Yet in applying the test, the court noted that the confusion created by defendant's ad “might have to be tolerated if even plausibly necessary to achieve the desired commentary In this case, the confusion is wholly unnecessary to Balducci's stated purpose. . . . Balducci could have conveyed its message with substantially less risk of consumer confusion.” *Id.* The court noted that Balducci could have substantially reduced the risk of consumer confusion created by the parody ad by adding an obvious disclaimer or altering the protected marks in a meaningful way so that consumers would not be confused. *Id.* By evaluating the necessity *vel non* of the ad, the court essentially used a private real property analogy to dispose of the defendant's First Amendment protections. In effect, the court employed the alternative-avenues test under the guise of the balancing test.

107. At least in part, these disparate analytical paradigms can be attributed to chronology. *Hormel, Dr. Seuss*, and *MCA Records* were all decided contemporaneously with, or subsequent to, the passage of the FTDA, whereas both *Mutual of Omaha* and *Balducci* pre-dated the Act. Notably, in both *Dr. Seuss* and *MCA Records*, the courts considered claims under the FTDA, but expressly rejected those claims. *MCA Records*, 296 F.3d at 902–06; *Dr. Seuss*, 924 F. Supp. at 1573–74.

108. *See, e.g., MCA Records*, 296 F.3d at 902 (applying the *Rogers* standard for literary titles to song titles).

109. *See, e.g., Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 808 (9th Cir. 2003) (rejecting plaintiff's trademark claims, but failing to extend the *MCA Records* standard beyond titles).

110. *See, e.g., id.* (rejecting plaintiff's trademark claims, but reluctant to apply the FTDA exemption to a body of artistic work, and instead only applying FTDA exemption to title of work).

against those newly-minted federal dilution claims.¹¹¹ The legislative record of the FTDA reflects a general desire to protect artistic and expressive works and specifically account for constitutional concerns.¹¹² Still, such legislative considerations did not correct the irreconcilable paradigms advanced in differently decided cases. First, the FTDA's codification only related to dilution claims (blurring and tarnishment), and not infringement claims.¹¹³ The disparate rulings on infringement continued after the FTDA's enactment.¹¹⁴ Second, passage of the FTDA did not specifically overrule any cases relying on private, real property constrictions. Ostensibly, *Dallas Cowboys Cheerleaders*, *Coca-Cola*, *Pillsbury*, *Balducci*, and *Mutual of Omaha* remain good law and are still cited in support of federal court decisions.¹¹⁵

The next section details the flaws produced by courts' vacillation between the perceived polarities and their improper incorporation of free expression concerns. I will then discuss a potential solution to these problems. Finally, I apply that solution to the ripening conflicts between trademark and free expression.

II. DEFICIENCIES IN THE CURRENT ANALYSIS

As it currently stands, the existing case law suffers from three distinct flaws. First, trademark cases misconceive the limits of real property rights. Thus, advocates of the trademark protection apparent in cases like

111. See 15 U.S.C. § 1125(a), (c)(4)(B) (2000); *MCA Records*, 296 F.3d at 906 ("The FTDA's section-by-section analysis presented in the House and Senate suggests that the bill's sponsors relied on the 'noncommercial use' exemption to allay First Amendment concerns.") (citing H.R. REP. NO. 104-374, at 8 (1995), reprinted in 1995 U.S.C.C.A.N. 1029, 1035; 141 CONG. REC. S19311 (daily ed. Dec. 29, 1995)).

112. See *MCA Records*, 296 F.3d at 906 ("The FTDA's section-by-section analysis presented in the House and Senate suggests that the bill's sponsors relied on the 'noncommercial use' exemption to allay First Amendment concerns.") (citing H.R. REP. NO. 104-374, at 8 (1995), reprinted in 1995 U.S.C.C.A.N. 1029, 1035; 141 CONG. REC. S19311 (daily ed. Dec. 29, 1995)).

113. See 15 U.S.C. § 1125.

114. See *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc. (Dr. Seuss II)*, 109 F.3d 1394, 1403-06 (9th Cir. 1997) (citing, with approval, *Mut. of Omaha Ins. Co. v. Novak*, 648 F. Supp. 905, 910 (D. Neb. 1986), *aff'd*, 836 F.2d 397 (8th Cir. 1987)) (enjoining the defendant book publisher's use of the plaintiff's trademarked style in a humor book); see also *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 734 (D. Minn. 1998) (citing *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, and noting that the Eighth Circuit has allowed injunctive relief "even when the enjoined material included some expressive content") (enjoining the filmmaker's use of the plaintiff's trademark in movie regarding obesity in the Midwest).

115. See, e.g., *Am. Dairy Queen*, 35 F. Supp. 2d at 731-34; *Dr. Seuss I*, 924 F. Supp at 1570-75; see also *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 43-44 (2d Cir. 1994).

Dallas Cowboys Cheerleaders perversely argue for property protection that exceeds actual private real property rights. Second, unprincipled equivocation between real property and free speech poles has forced courts to create untenable subject-matter- and genre-based classifications. These category-based rationales, which are fundamentally no more than judicially-imposed values, have led to inconsistent results that render the jurisprudence unworkable, unusable, and inefficient. Third, the deadweight of irreconcilable precedent has forced courts to employ unnecessary legal doctrines, appropriate only for commercial uses, to expressive work. The doctrinal and factual limitations placed on the few cases that have successfully incorporated constitutional concerns have served to complicate and re-endanger the ability to create cultural commentary through unauthorized trademark use.

These weaknesses highlight the need for a simplified standard that sensibly defines the boundary between trademark rights and free expression. Further, they obscure the more pressing and consequential questions regarding application of the U.S. Supreme Court's commercial speech doctrine. I address these two issues in Parts III and IV below, and provide in this Part a full explanation of the identified deficits in the current analysis.

A. *The Proper Private Real Property Analogy*

Even if it were proper for courts to address unauthorized expressive uses by comparison to private real property, trademark owners should still be denied monopoly-control over their marks. Private property, especially private real property, coexists with, and sometimes yields to, public use and concern.¹¹⁶ The framers of the U.S. Constitution embedded this concept in the Fifth Amendment's Takings Clause.¹¹⁷ Judge Kozinski has explained this symbiotic relationship in more detail: "[p]rivate land . . . is far more useful if separated from other private land by public streets, roads and highways. Public parks, utility rights-of-way and sewers reduce the amount of land in private hands, but vastly enhance the value of the property that remains."¹¹⁸

116. See *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1513 (9th Cir. 1993) (Kozinski, J., dissenting), *denying reh'g* to 971 F.2d 1395 (9th Cir. 1992).

117. See U.S. CONST. amend. V.

118. *White*, 989 F.2d at 1513 (Kozinski, J., dissenting). The Ninth Circuit denied rehearing en banc, thereby upholding a game show host's common-law right-of-publicity action against an

Because incursions into private property for public purposes are necessary and productive, limiting the reach of trademark law vis-à-vis expressive works does not degrade or curtail trademark rights, but clarifies these rights. The extent of trademark law, even when conceived as private real property, should not reach so far as to preclude free use of trademarks to promote cultural creativity and efficiently communicate ideas. In addition to diffuse cultural and public benefits from unauthorized public use, the public use of marks, in many cases, enhances the trademark owner's value by reinforcing associations and strengthening the popularity of the trademarked product.¹¹⁹

In the arena of commercial competition, rigorous trademark protection furthers incentives to create.¹²⁰ Confirming this point, Professors William Landes and Richard Posner have suggested that without such protection the plaintiff trademark-owner would have "less incentive either to develop a strong trademark or to produce a high-quality good."¹²¹ When applied to *non-competitors*, however, that protection stifles criticism and commentary and over-deters artistic choices. Overprotection of trademark rights against non-competitive expressive uses can be just as harmful as underprotection because it represses the purpose of trademark law: to foster incentives to create.¹²² This remains true even where the mark owner perceives no immediate direct benefit from the unauthorized public use or believes that the concentrated commercial losses of the unauthorized use outweigh diffuse societal gains.

While a *competitor's* free-ride on plaintiff's mark could dull incentives to produce strong marks and high-quality goods, it is not clear that an *expressive, non-competitive* use would do so. For instance, the song "Barbie Girl" will not directly diminish Mattel's share of the plastic doll market because the song does not compete with Mattel for sales of its Barbie plastic dolls.¹²³ Similarly, the sale of a "Mutant of

advertisement referencing her image without her consent.

119. See, e.g., *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 506 (2d Cir. 1996) (reasoning that Henson's use of a Muppet named Spa'am was likely to increase identification of Hormel's Spam pork product with Hormel).

120. William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J. L. & ECON. 265, 303 (1987).

121. *Id.*

122. See *White*, 989 F.2d at 1513 (Kozinski, J., dissenting) ("Overprotection [of intellectual property] stifles the very creative forces it's supposed to nurture.") (citations omitted).

123. See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002) (noting that the song title "does not explicitly mislead as to the source of the work" nor "explicitly or otherwise,

Omaha” t-shirt will not reduce incentives for Mutual of Omaha to provide quality insurance services and develop a trademark to identify its insurance sales business.¹²⁴ Mattel’s and Mutual of Omaha’s loss of incentives to aggressively market their trademarks and produce high-quality products is minimal at most.

Moreover, even if expressive noncommercial uses would reduce a plaintiff’s incentives in the same way competitive uses would, the potential societal costs of deterring free speech would more than outweigh the cost of dulled incentives to private trademark owners.¹²⁵ Because of the fundamental importance of free expression and its contribution to a “vibrant cultural commons,”¹²⁶ trademark owners must tolerate and subsidize minimal levels of confusion and reputational harm to their private property. The ostensibly mindless Garbage Pail Kids trading cards may have to be tolerated so that biting commentaries on the cultural mores represented by the Barbie doll are not stifled.¹²⁷ As the Fourth Circuit explained, it is important that trademarks not be transformed from rights against unfair competition to rights to control language. . . . Such a transformation would diminish our ability to discuss the products or criticize the conduct of companies that may be of widespread public concern and importance. . . . Much useful social and commercial discourse would be all but impossible if speakers were under threat of an infringement lawsuit every time they made reference to a person, company or product by using its trademark.¹²⁸

A conception of private property that ignores these ever-present necessities of public use and accommodation is inaccurate. Thus,

suggest that it was produced by Mattel”).

124. See *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 404 (8th Cir. 1987) (Heaney, J., dissenting) (“There is not a whit of evidence that either Mutual’s sales or its image suffered to any degree . . .”).

125. Cf. *White*, 989 F.2d at 1516 (Kozinski, J., dissenting) (“Intellectual property rights aren’t free: They’re imposed at the expense of future creators and of the public at large.”).

126. See Lawrence Lessig, *The Creative Commons*, 55 FLA. L. REV. 763, 768 (2003).

127. See *MCA Records*, 296 F.3d at 902 (upholding judgment in favor of defendant’s use of plaintiff’s mark “Barbie” to comment on the values that defendant claimed Barbie represents). *But see Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*, 642 F. Supp. 1031, 1032, 1039 (N.D. Ga. 1986) (issuing preliminary injunction against the defendant-humorist’s Garbage Pail Kids trading cards/stickers that pictured, in reference to the plaintiff’s Cabbage Patch Kids children dolls, the Garbage Pail Kids vomiting, making obscene gestures, and acting rudely).

128. *CPC Int’l, Inc. v. Skippy Inc.*, 214 F.3d 456, 462 (4th Cir. 2000) (citations and internal quotations omitted).

trademark case law that employs this comparison without understanding its limits fails to identify the proper boundary between trademark and free expression.

B. Untenable Subject-Matter- and Genre-Based Distinctions

Despite the First Amendment and the codification of its norms into the FTDA exemption for noncommercial uses, courts are still reluctant to recognize the full import of constitutional norms.¹²⁹ Motivated by apparent visceral disapproval of certain expressive uses, such courts have sought to justify their trademark-owner-friendly results through subject-matter- and genre-based categories¹³⁰ of dilution liability (specifically tarnishment).¹³¹ Even courts that have ruled in favor of the artist-defendant have nevertheless expressed the belief that certain categories of expression might lead to liability.¹³² The Second Circuit suggested as much when it considered the infringement and dilution claims of Hormel, owner of the “Spam” trademark for its pork-based snack-meat product, against Jim Henson’s use of a hog-like Muppet named “Spa’am” in a movie.¹³³ Although the court protected Henson’s unauthorized use, it noted that some successful tarnishment claims have involved unauthorized uses of a mark in the context of sexuality, obscenity, and illegal activity such as illicit drug use.¹³⁴

129. See, e.g., *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 507 (2d Cir. 1996); *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 43–44 (2d Cir. 1994); *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402–03 (8th Cir. 1987).

130. As used in this Article, “subject-matter-based distinctions” refers to classifications based on the substantive associations apparent in the expressive work (e.g., Coca-Cola with drug use, or Mickey Mouse with sexuality). I am not referring to the specific manner in which it is used by First Amendment jurisprudence regarding governmental regulation of content or subject matter. See, e.g., *United States v. Playboy Entm’t Group, Inc.*, 529 U.S. 803 (2000) (applying strict scrutiny because law regulating only sexual speech was a subject matter restriction). Similarly, “genre-based distinctions” refers to classifications based on the type of expression (e.g., parody, satire, editorial).

131. See, e.g., *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 44 (2d Cir. 1994) (“[T]arnishment . . . is usually found [in NY state dilution case law] where a distinctive mark is depicted in the context of sexual activity, obscenity, or illegal activity.”); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 733 (D. Minn. 1998) (“While tarnishment most frequently occurs when a mark is used in connection with sexually explicit materials, . . . other negative associations can also constitute tarnishment.”) (citations omitted).

132. See, e.g., *Hormel Foods*, 73 F.3d at 507 (citing *Deere & Co.* with approval, but distinguishing the case on the grounds that “a simple humorous reference” would not dilute Hormel’s mark).

133. *Id.*

134. *Id.*

Subject-matter-based findings of trademark liability rest upon the notion that certain types of expressive associations are so far beyond the bounds of reasonableness and good taste as to invite liability. On this view, Henson's use of a cute, singing Muppet named Spa'am in a children's movie was acceptable, whereas use of that same Muppet in an underground comic book wherein Spa'am is engaged in sexual activity with other Muppets may not be. This type of reasoning undergirds several notable cases in which plaintiffs prevailed against defendants' unauthorized uses.¹³⁵

This subject-matter-based reasoning, however, is untenable for two related reasons: (1) courts are not competent to make value judgments regarding the worth of different types of speech;¹³⁶ and (2) courts will encounter a line-drawing problem, already evident in the case law.¹³⁷ The inherent problem with singling out cases for tarnishment liability based on the unwholesomeness of their respective associations—for example, illegal drugs¹³⁸ or pornography¹³⁹—is that courts are essentially being permitted to make value judgments regarding the worthiness of specific types of speech. An artist's or commentator's legal rights should not depend on whether an individual judge “gets” the humorist's joke or the critic's jab.¹⁴⁰

135. See, e.g., *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402–03 (8th Cir. 1987) (enjoining the defendant's use in a parody of nuclear holocaust); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (enjoining the defendant's use in a pornographic movie); *Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*, 642 F. Supp. 1031, 1040–41 (N.D. Ga. 1986) (enjoining the defendant's use where noxious and vulgar behavior was involved); *Pillsbury Co. v. Milky Way Prods., Inc.*, No. C78-679A, 1981 U.S. Dist. LEXIS 17722, at *46–47 (N.D. Ga. Dec. 24, 1981) (ruling that plaintiff met its burden of proof on dilution claim against defendant's use of plaintiff's mark in a pornographic magazine); *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1189–91 (E.D.N.Y. 1972) (enjoining the defendant's use in the context of illicit drug use).

136. See, e.g., *Yankee Publ'g, Inc. v. News Am. Publ'g, Inc.*, 809 F. Supp. 267, 281 (S.D.N.Y. 1992) (“Here, Yankee asks this court to engage in literary criticism—judging how successful New York's expressive message was. It is one thing to reject a First Amendment claim because the court disbelieves the claim that a communicative message was intended. It is quite another to reject a First Amendment claim because the court gives low marks to the success of the literary device. Courts are ill equipped to pass literary judgment.”) (emphasis omitted).

137. *Compare Coca-Cola*, 346 F. Supp. at 1189–91 (enjoining the distribution of a poster that portrayed the Coca-Cola bottle design with the words “Enjoy Cocaine”), with *Girl Scouts of the U.S. v. Personality Posters Mfg Co.*, 304 F. Supp. 1228, 1232 (S.D.N.Y. 1969) (refusing to enjoin the distribution of a poster depicting a pregnant Girl Scout with the ironic slogan, “Be Prepared”).

138. *Coca-Cola*, 346 F. Supp. at 1189.

139. *Dallas Cowboys Cheerleaders*, 604 F.2d at 203.

140. See *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 773 (8th Cir. 1994) (“The determination of whether ‘likelihood of confusion’ exists is a factual determination.”); *Mut. of*

The point is showcased by comparing two cases, both of which posed similar factual issues but were decided differently. In *Coca-Cola*, the District Court for the Eastern District of New York enjoined further sales of a poster of a Coca-Cola bottle with the altered slogan “Enjoy Cocaine.”¹⁴¹ In *Girl Scouts of the United States of America v. Personality Posters Manufacturing Co.*,¹⁴² the District Court for the Southern District of New York refused to enjoin distribution of a poster of a pregnant Girl Scout and the ironic use of the Girl Scout slogan, “Be Prepared.”¹⁴³ The results in these cases are difficult to reconcile unless one resorts to a values-based assessment: the Girl Scout poster is more effective and subversive, and hence more socially valuable commentary than the “Enjoy Cocaine” poster, which appears only to promote drug use. The problem with this conclusion is that it leaves too much to the skill of the advocate or the creativity of specific judges.¹⁴⁴ One could plausibly read the “Enjoy Cocaine” poster in *Coca-Cola* as either a reference to the Coca-Cola Company’s historic usage of cocaine in its product, or perhaps as a commentary on Coca-Cola’s beverages becoming the new pervasive drug, as addictive as cocaine, even if less physically harmful. Under either possible explanation, the “Enjoy Cocaine” poster arguably presents commentary and critique on par with that of the Girl Scout poster.

This thought exercise is easily replicated. The “unwholesome” or “disparaging” associations in cases like *Mutual of Omaha*, *Balducci*, and *Dallas Cowboys Cheerleaders*, or any other case in which the defendant’s use was enjoined, can also be reformulated into ostensibly more “valuable” commentary or critique.¹⁴⁵ The dissent in *Mutual of*

Omaha, 836 F.2d at 398 (“Likelihood of confusion is a question of fact.”).

141. *Coca-Cola*, 346 F. Supp. at 1193.

142. 304 F. Supp. 1228 (S.D.N.Y. 1969).

143. *Id.* at 1231 (denying preliminary injunction because plaintiff “failed utterly to establish the requisite element of customer confusion”).

144. Note that in *Coca-Cola*, the court mentioned that consumers were actually confused, with some writing to Coca-Cola to protest the company’s apparent endorsement of drug use. See 346 F. Supp. at 1188–89. The *Girl Scouts* court did not mention any such evidence of actual confusion, but did mention that the “[p]laintiff has failed utterly to establish the requisite element of customer confusion.” See 304 F. Supp. at 1231. The significance *vel non* of this evidence in *Coca-Cola* is discussed in further detail, *infra* Part III.

145. See *Mut. of Omaha*, 836 F.2d at 402–03 (enjoining the defendant’s association of plaintiff’s trademark with nuclear holocaust); *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 772 (8th Cir. 1994) (enjoining the defendant’s association of plaintiff’s trademark with environmental disasters); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 202 (2d Cir. 1979) (enjoining the defendant’s association of plaintiff’s trademark with explicit sexuality).

Omaha made this exact point when it roundly criticized the majority's refusal to recognize the defendant's use of the plaintiff's mark as a satirical comment on the folly of nuclear war instead of an attempt to harm Mutual of Omaha's reputation.¹⁴⁶ In *Balducci*, the defendant was the publisher of a magazine that used the plaintiff's "Michelob" mark in a mock advertisement critical of the plaintiff and an oil spill that resulted in water pollution.¹⁴⁷ The Eighth Circuit ruled for the trademark owner in part because it made the judgment that the defendant's parody unnecessarily attacked the plaintiff in communicating the defendant's intended message.¹⁴⁸

These cases lead to the conclusion that by allowing judges to determine the social value to be accorded to expressive works, courts conduct a standardless exercise in imagination and creativity. When a court determines liability in cases involving sexuality, obscenity, drug use, or other "unwholesome" associations, it runs the risk of transforming itself from a guardian of constitutional mandates into a literary and social critic—a demotion the judiciary is ill-equipped to handle.¹⁴⁹ Decisions such as *Coca-Cola*, *Dallas Cowboys Cheerleaders*, and *Mutual of Omaha* are incorrect to the extent they rely on private reputational tarnishment rather than fraud and confusion in the public marketplace. The judicial system cannot become the arbiter of good taste;¹⁵⁰ as Justice Oliver Wendell Holmes remarked over a century ago, "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth [of an artistic work],

146. See *Mut. of Omaha*, 836 F.2d at 404–05 (Heaney, J., dissenting).

147. *Balducci*, 28 F.3d at 772.

148. *Id.* (noting that the defendant's "unsupported attack," which suggested that the plaintiff's products were contaminated with oil, was "not even remotely necessary" to the goal of commenting on oil spill and pollution issues).

149. See *Yankee Publ'g, Inc. v. News Am. Publ'g, Inc.*, 809 F. Supp. 267, 281 (S.D.N.Y. 1992) ("Here, Yankee asks this court to engage in literary criticism—judging how successful New York's expressive message was. It is one thing to reject a First Amendment claim because the court disbelieves the claim that a communicative message was intended. It is quite another to reject a First Amendment claim because the court gives low marks to the success of the literary device. Courts are ill equipped to pass literary judgment.") (emphasis omitted).

150. See *Univ. of Notre Dame Du Lac v. Twentieth Century-Fox Film Corp.*, 22 A.D.2d 452, 458 (N.Y. App. Div. 1965) (declining to enjoin film which allegedly placed the University of Notre Dame in a negative light and injured its reputation, and stating "we may not import the role of literary or dramatic critic into our functioning as judges in this case Whether [the artistic works] are creations of merit, whether they have value only as entertainment and no value whatever as opinion, information or education, pose questions which would require us to stake out those elusive lines that we have been warned not to attempt").

outside of the narrowest and most obvious limits.”¹⁵¹

The examples detailed above demonstrate that despite the First Amendment and the statutory exemptions of the FTDA, courts have found liability for associations related to drug use, sexuality, obscenity, and noxious behavior. The unfortunate but inevitable byproduct of such exceptions is that courts create line-drawing problems for themselves and sister courts. In addition to creating a judiciary of book reviewers and film critics with varied tastes, as a practical matter judicial attempts to distinguish varying degrees of “social value” in speech produces an unnavigable, and hence unusable, clutter of precedents.

Even an abridged sampling of cases demonstrates this chaos. For example, contrast *L.L. Bean*, in which the court reversed an injunction granted on motion for summary judgment against the placement of a sexually explicit parody in a pornographic magazine,¹⁵² with *Pillsbury*, in which the court enjoined the defendant’s display of the plaintiff’s mark performing a sexual act in a pornographic magazine on a dilution claim.¹⁵³ In *Tetley, Inc. v. Topps Chewing Gum, Inc.*,¹⁵⁴ the court refused to enjoin the defendant’s manufacture of stickers and cards with the mark “Petley Flea Bags” in an obvious, and purportedly humorous, reference to the plaintiff’s trademarked Tetley tea beverages.¹⁵⁵ In *Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*,¹⁵⁶ although similar conduct was at issue, the court granted a preliminary injunction against the defendant’s use of “Garbage Pail Kids” in reference to plaintiff’s trademark “Cabbage Patch Kids.”¹⁵⁷ While the *Dallas Cowboys Cheerleaders* court decried the revolting juxtaposition of a cheerleader wearing a uniform “strikingly similar” to the Dallas Cowboys trademarked uniform with a pornographic movie,¹⁵⁸ the court in *Lucasfilm, Ltd. v. Media Market Group, Ltd.*,¹⁵⁹ recently refused to

151. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

152. *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 27 (1st Cir. 1987).

153. *Pillsbury Co. v. Milky Way Prods., Inc.*, No. C78-679A, 1981 U.S. Dist. LEXIS 17722, at *40–41 (N.D. Ga. Dec. 24, 1981).

154. 556 F. Supp. 785 (E.D.N.Y. 1983).

155. *Id.* at 789.

156. 642 F. Supp. 1031 (N.D. Ga. 1986).

157. *Id.* at 1040.

158. *See Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 207 (2d Cir. 1979) (affirming preliminary injunction against a pornographic film featuring the plaintiff’s trademark).

159. 182 F. Supp. 2d 897 (N.D. Cal. 2002).

enjoin the defendant's parody of the plaintiff's film, *Star Wars*, in a pornographic movie, *Starballz*.¹⁶⁰ These comparisons support the notion that the subject-matter-based categorical exceptions prevalent in the current case law are unworkable in theory and in fact.

Just as untenable as these subject-matter distinctions are distinctions based on the genre of expression. For example, in protecting a pornographic magazine's First Amendment right to mock L.L. Bean's product line and mark, the First Circuit emphasized that its ruling rested in part upon the particular genre—parody—that the defendant employed.¹⁶¹ This notion of limiting constitutional protection of unauthorized trademark use to successful parodies also finds no support in logic or law.¹⁶²

One commentator has suggested that parody be explicitly protected by trademark law; specifically, that the Lanham Act be amended to exempt “parod[ies that] cause[] no likelihood of confusion,” and that the FTDA be amended to add an exemption of use of trademark in parody.¹⁶³ The proposed amendment, however, would only reify categorical assumptions regarding the relative social worth of different types of commentary and critique. It is true that parodies, by their nature, invite suits by trademark owners.¹⁶⁴ The parodist-defendant purposely

160. See *id.* at 901 (finding that “no reasonable consumer is likely to be confused between *Star Wars* and *Starballz*, which is labeled as an adult film, [and] animated,” and denying preliminary injunction based on a trademark infringement claim).

161. See *L.L. Bean v. Drake Publishers, Inc.*, 811 F.2d 26, 33 (1st Cir. 1987) (“Our reluctance to apply the anti-dilution statute to the instant case also stems from a recognition of the vital importance of parody. Although, as we have noted, parody is often offensive, it is nevertheless deserving of substantial freedom—both as entertainment and as a form of social and literary criticism.”) (citations and internal quotations omitted); see also *Lucasfilm, Ltd.*, 182 F. Supp. 2d at 901 (noting, in the context of an infringement claim, that “because a parody is meant to comment on or criticize an original work, it is unlikely to be confused with the original work”).

162. See *Yankee Publ'g, Inc. v. News Am. Publ'g, Inc.*, 809 F. Supp. 267, 279 (S.D.N.Y. 1992) (“But the dispute as to whether New York's cover was parody misses the point. Yankee's argument implies that the special considerations emanating from the First Amendment depend on whether the allegedly infringing work is one of parody. That is not correct. Because unauthorized uses that provoke litigation, both in the copyright and in the trademark field, often involve parody, the decisions often discuss the special latitudes that are afforded to parody. But parody is merely an example of the types of expressive content that are favored in fair use analysis under the copyright law and First Amendment deference under the trademark law. . . . New York's commentary . . . is an expressive message that is fully entitled to First Amendment deference, as much so as in the case of typical parody.”) (emphasis omitted).

163. See Kelly L. Baxter, Comment, *Trademark Parody: How to Balance the Lanham Act With the First Amendment*, 44 SANTA CLARA L. REV. 1179, 1209 (2004).

164. See Sarah Mayhew Schlosser, Note, *The High Price of (Criticizing) Coffee: The Chilling Effect of the Federal Trademark Dilution Act on Corporate Parody*, 43 ARIZ. L. REV. 931, 945

concedes many of the elements necessary to prove infringement and dilution, including the strength of trademark, similarity of the marks, and intentional reproduction of the mark.¹⁶⁵ In addition, parodies are often profane, and their goal is to degrade the reputation of the product.¹⁶⁶ But the fact that a particular genre is more prevalent in an area of law provides no argument as to why it deserves explicit mention or special protection. Constitutional concerns must be incorporated wholesale, not piecemeal, into trademark law.

The weakness of subject-matter- and genre-based classifications is that they are overbroad and underinclusive, sweeping in too much valuable speech and arbitrarily protecting other types of speech. More fundamentally, these classifications increase unpredictability in the law, making the boundary between trademark and free expression even more elusive. Having elucidated the problems with the private real property analogies and the untenability of subject-matter- and genre-based distinctions, I turn now to the third major defect in the case law.

C. *Limited Holdings and Inappropriate Legal Doctrines*

The third major flaw with cases regarding unauthorized trademark use is that courts have unnecessarily stunted the growth of a simple, unified analysis for cases involving expressive works.¹⁶⁷ This is especially true with infringement claims, where factual determinations of confusion can be dispositive.¹⁶⁸ In general, courts have facilitated this impotence by cabining each case to its facts,¹⁶⁹ and refusing to allow First Amendment

(2001). Given the unique characteristics of parody, it stands to reason that corporations and other trademark owners, or even public figures, will most often sue for unauthorized use when the use is in the form of a parody.

165. See Steven M. Perez, Comment, *Confronting Biased Treatment of Trademark Parody Under the Lanham Act*, 44 EMORY L.J. 1451, 1454 (1995).

166. See, e.g., *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902–03 (9th Cir. 2002) (discussing the song “Barbie Girl,” which deliberately derided mores and social values ostensibly represented by the plaintiff’s “Barbie” doll); *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 753 (9th Cir. 1978) (discussing the defendant’s underground magazine, which deliberately placed wholesome Disney characters in lurid settings).

167. See, e.g., *MCA Records*, 296 F.3d at 902 (failing to extend the *Rogers* standard beyond the titles of works); *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 807–08 (9th Cir. 2003) (citing *MCA Records* for the proposition that *Rogers* applies to titles of works, then using a different analysis for the body of expressive works).

168. See, e.g., *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1188–89 (noting evidence of consumer confusion in the form of letters written to the plaintiff regarding the defendant’s work).

169. See, e.g., *Walking Mountain Prods.*, 353 F.3d at 808–12; *Cliffs Notes, Inc. v. Bantam*

protection to expand to its natural boundary with trademark law. The result: courts have forced themselves into the unfortunate position of having to create and/or apply inappropriate and ill-fitting legal doctrines to justify their results.¹⁷⁰ Even the cases that reach the appropriate result do so by limiting their holdings to their facts.¹⁷¹

This Article argues that in infringement claims, the *Rogers* balancing test—and the public interest factors it contemplates—is the only correct approach to the conflict between trademark rights and free expression. Although its approach was radically different from the private property paradigm in cases like *Coca-Cola*, *Dallas Cowboys Cheerleaders*, and *Pillsbury*, the *Rogers* court did not appear to appreciate the full import of its decision and new theoretical methodology.¹⁷² Instead of wholly abandoning the reasoning of such cases, the *Rogers* court instead chose to distinguish *Dallas Cowboys Cheerleaders*, reading it as a case of blatantly false advertising by the filmmaker rather than a conflict between trademark law and free expression.¹⁷³

Compounding the unwillingness to expressly reject this line of precedent, subsequent cases have chosen not to expand application of the *Rogers* test far beyond the titular or cover-design context.¹⁷⁴ This limitation is unnecessary because the public interest balancing factors could diagnose the entire panoply of unauthorized uses—whether in titles, cover designs, literary content, or photographs.¹⁷⁵ Surprisingly, no

Doubleday Dell Publ'g Group, Inc., 886 F.2d 490, 494 (2d Cir. 1989) (applying the *Rogers* balancing analysis in refusing to enjoin the defendant's cover design parody of the plaintiff's famous "Cliffs Notes" cover design, but stating, "[i]t is true that *Rogers* . . . was concerned with a very different problem from the one we have here. . . . This case is not about whether a title is false advertising but whether the appearance of a work's cover is confusingly similar . . .").

170. See, e.g., *Walking Mountain Prods.*, 353 F.3d at 808–09 (using the nominative-fair-use test to deny the plaintiff's request for an injunction).

171. *Id.*

172. *Rogers v. Grimaldi*, 875 F.2d 994, 999–1000 (2d Cir. 1989).

173. *Id.* at 999 n.4.

174. See, e.g., *Cliffs Notes*, 886 F.2d at 494 (extending the application of the *Rogers* balancing test from the titles of movies to the cover designs of literary works). In *Cliffs Notes*, the cover of the defendant's book parodied the plaintiff's famous Cliffs Notes book cover. *Id.* at 492. Like the *Rogers* court, the *Cliffs Notes* court explained that the expressive element inherent in a title or cover required more protection than a mere commercial label. *Id.* at 495. The court reaffirmed that a balancing approach was the best analytical tool for parodies where expression, not commercial exploitation, was the primary intent of the artist. *Id.* at 495.

175. See, e.g., *Walking Mountain Prods.*, 353 F.3d at 808 (photographic series); *Cliffs Notes*, 886 F.2d at 494 (cover designs); *Charles Atlas, Ltd. v. DC Comics, Inc.*, 112 F. Supp. 2d 330, 338–39 (S.D.N.Y. 2000) (contents of comic book); *Yankee Publ'g, Inc. v. News Am. Publ'g, Inc.*, 809 F. Supp. 267, 278–79 (S.D.N.Y. 1992) (cover design); see also *Ride and Prejudice*, *supra* note 4, at 16

court considering the question has ever articulated a persuasive reason for this limitation other than the self-fulfilling rationale of adherence to precedent.¹⁷⁶

In *MCA Records*, the court held that a music group's use of the trademark name "Barbie" in the *title* of its song "Barbie Girl," which poked fun at the values represented by the doll, was protected under the *Rogers* test.¹⁷⁷ Under this test, the court properly held that the public's interest in free expression greatly outweighed potential consumer confusion created by the defendant's use of the Barbie name in the *title* "Barbie Girl."¹⁷⁸ However, by reaffirming the limited unauthorized uses to which the test would apply—namely, the *titles* of artistic works¹⁷⁹—the court was able to reach the correct result only at the expense of prolonging the unpredictability in this area of law. Because the court failed to clarify the proper treatment of non-titular unauthorized uses by artificially limiting the reach of constitutional standards in infringement actions,¹⁸⁰ it placed expressive works that choose to reference trademarks without permission at risk. This danger quickly became more than academic.¹⁸¹

Soon after *MCA Records*, the Ninth Circuit confronted the issue of unauthorized trademark use in the *title and body* of an artistic work, once more dealing with Mattel's attempts to protect its Barbie trademark.¹⁸² In *Mattel, Inc. v. Walking Mountain Productions*,¹⁸³ the court concluded that the defendant's photographic series, "Food Chain Barbie," which depicted nude and dismantled Barbie dolls in various absurd and sexual situations involving food preparation, did not violate trademark, copyright, or trade libel law.¹⁸⁴ Uneasy about extending the

(discussing a novelist who wrote a book for Bulgari, a jewelry manufacturer).

176. See, e.g., *Walking Mountain Prods.*, 353 F.3d at 808 n.14.

177. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002).

178. *Id.* The court, concluding that defendant's use was noncommercial, also affirmed summary judgment dismissal of Mattel's dilution claims based on defendant's First Amendment rights. See *id.* at 906–07.

179. *Id.* at 902.

180. *Id.*; see also *Walking Mountain Prods.*, 353 F.3d at 808–09.

181. See *Walking Mountain Prods.*, 353 F.3d at 807–12 (evaluating the district court's grant of summary judgment to the defendant for its use of the "Barbie" trademark in the title of a photographic work and for using Barbie dolls in the photographic series comprising the body of the expressive work).

182. *Id.*

183. 353 F.3d 792 (9th Cir. 2003).

184. *Id.* at 816 (affirming the district court's grant of summary judgment to defendant on all

MCA Records holding, however, the court eschewed application of the balancing test to both title and content, instead analyzing each separately.¹⁸⁵

As a result of overly cautious and limited applications of the *Rogers* balancing test, courts have resorted to the fair use doctrine to protect First Amendment interests.¹⁸⁶ For example, in *Walking Mountain Productions*, the court noted that it was unclear whether the *Rogers* test applied beyond the titular context; in regard to Mattel's trade dress claim, based on the use of the Barbie dolls, the court chose not to apply the balancing test.¹⁸⁷ Instead, the court affirmed dismissal of the infringement claim leveled against the content of the work, holding that Mattel's trade dress infringement claim could be disposed of under the Ninth Circuit's nominative fair use defense for trademark.¹⁸⁸ Undoubtedly, the nominative fair use doctrine allows a federal court to avoid tackling constitutional issues to resolve a relatively mundane

substantive claims).

185. *Id.* at 807–09.

186. *See, e.g., id.* at 808–12 (using nominative fair use in expressive context); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 304 (9th Cir. 1992) (using nominative fair use to evaluate a newspaper's use of the plaintiff's trademark and name).

187. *Walking Mountain Prods.*, 353 F.3d at 808 n.14.

188. Best illustrated by cases like *Cairns v. Franklin Mint Co.*, 292 F.3d 1139 (9th Cir. 2002), and *New Kids on the Block*, nominative-fair-use cases typically involve *commercial* use of a plaintiff's trademark for the purpose of identifying or describing defendant's product. In *Cairns*, for example, the trustees and executors of Princess Diana's memorial fund and estate brought suit against the manufacturer of commercially sold jewelry, plates, and dolls that bore the unauthorized name and likeness of Princess Diana. *Cairns*, 292 F.3d at 1149–50. To evaluate infringement when defendant asserts nominative-fair-use protection, the multi-factored likelihood-of-confusion test is replaced by the tripartite nominative-fair-use test: (1) the plaintiff's product must be one not readily identifiable without use of the mark; (2) only so much of the mark may be used as is reasonably necessary to identify plaintiff's product; and (3) the defendant must do nothing that would suggest sponsorship or endorsement by plaintiff. *Id.* at 1151 (citing *New Kids on the Block*, 971 F.2d at 308). Applying this test, the *Cairns* court found that the defendant's use of Princess Diana's name and likeness on their wares was reasonable to identify and describe defendant's product, and was therefore protected as a nominative fair use. *Id.* at 1155. Other recent cases have also resulted in decisions favorable to the defendants. *See, e.g., Walking Mountain Prods.*, 353 F.3d at 816 (refusing to enjoin the defendant's photographic series); *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 806 (9th Cir. 2002) (protecting a former model's use of the plaintiff's trademark on her website as nominative fair use); *New Kids on the Block*, 971 F.2d at 309 (protecting the defendants-newspapers' use of the plaintiff-band's name as nominative fair use).

When a defendant uses a plaintiff's mark to describe the defendant's product and not at all to describe or identify the plaintiff's product, the defendant may assert trademark law's classic fair use defense, codified in 15 U.S.C. § 1115(b) (2000), by proving three elements: (1) that the defendant's use of the mark is not as a trademark; (2) that the defendant used the mark fairly and in good faith; and (3) that the defendant uses the mark only to describe its product. *Cairns*, 292 F.3d at 1150–51.

trademark dispute. Courts are wont to avoid potentially far-reaching constitutional questions where such questions are unnecessary to reach a result.¹⁸⁹ This reasoning is circular: inartful application of a doctrine like nominative fair use becomes necessary only because courts have been unwilling to simplify the constitutional analysis in this area through a consistent, uniform application of a free speech standard. More fundamentally, courts err when they employ doctrines such as nominative fair use because doing so essentially reduces an artist's or expressionist's privilege to that of a competitor. Axiomatic to the Lanham Act, First Amendment jurisprudence, and common sense is the principle that commercial competitors are subject to limitations inapplicable to non-competitor artists.¹⁹⁰

Moreover, nominative fair use is inapplicable beyond the commercially competitive arena. First, the "fair use" exemption within the FTDA applies only to "fair use . . . in *comparative commercial advertising or promotion to identify the competing goods or services . . .*"¹⁹¹ Second, virtually every nominative and classic fair use case in trademark law involves plaintiffs and defendants who are in commercial and competitive situations.¹⁹² Third, employment of a doctrine like fair use represents a regression into consideration of private concerns.

Both classic and nominative fair use doctrines are "defenses," intended to carve out limited exceptions from the backdrop of protection for privately-owned intellectual property.¹⁹³ By their terms, both doctrines restrict the quality and quantity of a defendant's use, limiting the motivation, quantity, and quality of that use.¹⁹⁴ These proscriptions

189. See *Walking Mountain Prods.*, 353 F.3d at 808 n.14 ("By instead employing the nominative fair use test . . . we are following the time-honored tradition of avoiding constitutional questions where narrower grounds are available.") (citations omitted).

190. See 15 U.S.C. § 1125(c)(4) (providing an exemption for noncommercial use that is unavailable for commercial use); cf. Landes & Posner, *supra* note 120, and accompanying text (discussing economic incentives that inform the application of trademark laws in commercial settings).

191. 15 U.S.C. § 1125(c)(4)(A) (emphasis added).

192. See, e.g., *Cairns*, 292 F.3d at 1149–51 (noting that defendant sold memorabilia with Princess Diana's likeness, conduct in which plaintiff also engaged); *Playboy Enters.*, 279 F.3d at 806 (describing the defendant's use of the plaintiff's trademark to help market and publicize her website).

193. See *Cairns*, 292 F.3d at 1150–51 (describing the classic fair use defense and placing the burden of proof on the defendant).

194. See *id.* at 1150 (enumerating factors for both classic and nominative fair use).

are anathema to the public's weighty interest in free expression. The legal requirements for the fair use defenses are not tied to public interest rationales; rather, they represent the balancing of the trademark owner's purely private property interest versus the defendant's right to use plaintiff's trademark only as a source-identifier or a tool for comparative advertising.¹⁹⁵ By shifting the focus to these interests, the application of doctrines such as fair use resurrects the discredited reliance on unlimited private real property rights.¹⁹⁶

Ironically, given the justifications proffered for application of the balancing test to *titles* of artistic works, it makes even less sense to use a separate analysis for the *content and body* of those same works. Consistent with economic and incentive-based theories of trademark protection,¹⁹⁷ unauthorized use of trademark within the body of an expressive work—but not in the title, cover, or advertisement for the work—reduces the risk that defendant is trying to “free-ride” on the plaintiff's commercial reputation or capitalize on an unbargained-for commercial advantage from the plaintiff.¹⁹⁸ Unlike a work's title, which clearly has severable market significance for advertising and source-identification, the contents of the work are generally presented in context and with explanation. Therefore, it is even less likely that any countervailing private concerns exist to override the free expression

195. *Id.* (omitting public interest factors in enumerated classic and nominative fair use tests).

196. At least one trial court has extended use of the balancing test beyond artistic titles, to alleged infringement occurring within the body and substance of a defendant's expression. See *Charles Atlas, Ltd. v. DC Comics, Inc.*, 112 F. Supp. 2d 330, 335–41 (S.D.N.Y. 2000) (analyzing the plaintiff's claim that the defendants used its trademarked advertisement promoting its body building courses to develop the character and story line for the defendant's comic character, Flex Mentallo). Rejecting the plaintiff's infringement claims, the court in *Charles Atlas* extensively detailed the First Amendment value of the defendant's comic book, heavily weighting the free speech half of the scale. *Id.* at 337–39. The opinion calls for robust application of the First Amendment where the unauthorized use occurs in the “interior” of a work (here, a comic book) because such use provides further evidence that the defendant's use was part of a storyline rather than to advance a competing, confusing product. *Id.* at 338–39. On the confusion side of the scale, the court noted that the non-competitive nature of the plaintiff's and defendant's respective products and expressions, the sophistication of consumers, and the lack of empirical evidence of confusion ensured that the likelihood of confusion was “slim.” *Id.* at 341.

197. See Landes & Posner, *supra* note 120 and accompanying text.

198. *Cf. Felix the Cat Prods., Inc. v. New Line Cinema Corp.*, CV 99-9339 FMC (RXc), 2000 U.S. Dist. LEXIS 21763, at *9 (C.D. Cal. 2000) (discussing the defendant's unauthorized use of the plaintiff's character in a movie and stating that by the time the audience sees the plaintiff's trademarked character, “defendants have already reaped their harvest of ticket revenue. Defendants' financial success neither depends on, nor is affected by, the goodwill associated with [plaintiff's mark]. The use of [plaintiff's mark] is thus not an advertisement”).

interests. Again, this limitation of the case law serves only to hide the parameters of trademark law vis-à-vis public free expression concerns.

These three major flaws in the case law—incomplete private property analogies, untenable subject-matter- and genre-based distinctions, and unnecessarily limited reasoning—collectively contribute to the blurred boundary between trademarks and free expression. More fundamentally, they render the case law relatively useless as a predictive tool for future cases. Part III proposes a solution to these difficulties and presents a defense of that solution.

III. UNAUTHORIZED TRADEMARK USE IN EXPRESSIVE WORKS: THE PROPER ANALYTICAL FRAMEWORK

By its successes and failures, the case law reveals that the long-running conflict between a private real property model of trademark law and the First Amendment is on the verge of being definitively settled in favor of First Amendment concerns. Applying the proper analytical framework to federal or state claims based on either confusion or dilution, the rights of trademark owners do not trump the First Amendment rights of artists, publishers, and commentators in their unauthorized expressive use of marks. If a defendant engages in noncommercial speech—i.e., speech that does more than propose a commercial transaction—the defendant's unauthorized use of a plaintiff's trademark is always protected from dilution liability. In dilution claims, defendant artists will prevail against claims of reputational harm suffered by mark owners because such harm is not sufficient to trump free speech concerns. Likewise, a defendant's use of a mark is protected from confusion-based infringement liability so long as the public interest in free expression clearly outweighs the potential confusion in the marketplace. As minimal levels of confusion will be insufficient to overcome the free speech ideal, the balance will presumptively favor defendant artists and allow them to prevail in confusion-based infringement claims. This framework and its implied presumption would apply regardless of whether the trademark is used in the title or content of a work, or of the medium in which the trademark is presented, be it a sticker, t-shirt, magazine, poster, or movie. The approach this Article presents delineates the boundary between trademark law and free expression. In addition, it simplifies judicial decision-making and creates greater predictability for artists, parodists, satirists, authors, and filmmakers who choose to reference, disparage, or otherwise present trademarks in their works.

As courts begin to use this proposed framework, trademark owners will, as some already have, develop strategies to liken their marks to other protected private property, such as copyright.¹⁹⁹ Fortunately, courts have foreclosed these avenues.²⁰⁰ Having traveled a great distance from the shopping mall at issue in *Lloyd*, trademark law in the context of expressive works must find the right balance between private and public concerns.

Mark owners err when they view this debate as a forced choice between the two extremes of complete private property protection and free-for-all public use. Abandonment of a private real property anchor does not sink trademark owners into a protection-less “anarchy.”²⁰¹

199. See, e.g., *id.* (noting that the plaintiff had argued for trademark-like protection for copyright claim); cf. *Comedy III Prods., Inc. v. New Line Cinema Corp.*, 200 F.3d 593, 595 (9th Cir. 2000) (rejecting plaintiff’s attempt to circumvent copyright law by invoking trademark law).

200. Plaintiffs have attempted to argue for copyright-like protection for their marks, which would give them greater ability to control the use and reference of their marks against all potential users, regardless of the First Amendment. See *Comedy III Prods.*, 200 F.3d at 595; *Felix the Cat Prods.*, 2000 U.S. Dist. LEXIS 21763, at *10–11. Trademark law was never intended to provide, and has never provided, this type of protection; rather, such blanket control over intellectual property is reserved only for copyrights. See MCCARTHY, *supra* note 6, § 6. First, the U.S. Constitution does not expressly grant property rights in trademarks, as it does for patents and copyrights. See U.S. CONST. art. I, § 8, cl. 8. Second, whereas copyright law gives the author the right to prevent unauthorized copying of his particular expression *ab initio*, trademark law originally only prevented use of marks that would cause confusion with the public; mere reproduction of a trademark, with nothing more, will not state an infringement or dilution claim, because simple copying will not necessarily degrade the goodwill of the trademark. See MCCARTHY, *supra* note 6, § 6:14.

Undoubtedly, both trademark and copyright law can protect multiple aspects of the same product. This does not mean, however, that copyright protections can be substituted for trademark laws, or vice versa. *Id.* § 6:17.1. Asserting copyright claims with trademark claims presupposes that the material referenced or used is copyrightable or maintains current copyright protection. Even when a product contains copyrightable aspects, however, the analyses for each type of intellectual property must be kept distinct. See, e.g., *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 799–808 (9th Cir. 2003) (applying copyright law’s fair use test to copyright claims, but applying trademark law’s distinctive fair use analysis to trademark claims). As the Ninth Circuit stated in response to a plaintiff’s argument that its *Three Stooges* film footage used in a movie was a protectable trademark, “the footage at issue here was clearly covered by the Copyright Act . . . and the Lanham Act cannot be used to circumvent copyright law.” *Comedy III Prods.*, 200 F.3d at 595. Expanding on this pronouncement, a California district court, rejecting very similar trademark and copyright claims by the owner of a copyrighted cartoon clip used in a movie without permission, noted:

Reading the allegations of plaintiff’s complaint broadly, it appears that plaintiff presents a straight-forward copyright case. The complaint alleges a copyright interest and unauthorized copying by defendants. In contrast, the complaint’s multiple attempts at invoking trademark law would require the Court to extend trademark law beyond commercial use and make actionable the expression of an idea in a motion picture.

Felix the Cat Prods., 2000 U.S. Dist. LEXIS 21763, at *10.

201. See Lessig, *supra* note 16, at 13 (stating that efforts to create a legal regime with less restrictive copyright laws “have failed because the debate has become so polarized and so binary

Discussing copyright protection, Professor Lessig has noted this false dichotomy between, as he puts it, “the alls and the nones”: “[T]he world is not divided into two, but into three. There are those who believe in all rights reserved, those who believe in no rights at all, but there are also many who believe that some rights should be controlled but not all.”²⁰² I argue for trademark, as Lessig has for copyright, that the proper judicial framework takes the sensible middle-ground between these two poles.

The *Rogers* balancing test achieves this middle ground in infringement cases. First, the test retains the likelihood-of-confusion analysis on one side of the scale.²⁰³ Therefore, trademark owners may still prevail upon presenting evidence of actual confusion and market fraud. Second, the test requires that the unauthorized use bear some minimal relevance to the expressive work.²⁰⁴ This factor ensures that the expressive work is a genuine contribution to the culture, and not a commercial free-ride. Neither of these concerns would be present in either a purely private- or a purely public-concern-oriented regime.

The balanced framework proposed here—applying the *Rogers* test to infringement cases and fully recognizing First Amendment concerns in dilution cases—is subject to critiques that it (1) is based on an incorrect understanding of legislative purpose and statutory construction, and (2) renders trademark law’s protection of mark owners’ rights toothless. Undoubtedly, this framework will yield more defendant-friendly decisions that safeguard unauthorized trademark use in expressive works. This should be no cause for alarm. It represents an appropriate course correction, saving us from the cultural monopoly that results from a “permission society” and a “licensed culture.”²⁰⁵ Nevertheless, because this proposed methodology carries a strong presumption in favor of artists, parodists, humorists, filmmakers, and writers, it is certainly unsettling to corporate and private interests.

The nub of the first objection is that the FTDA exemption of noncommercial uses reflects Congress’s desire to protect free expression concerns in federal dilution claims only. By not providing a parallel

that the choice seems a choice just between property and anarchy. And in that world, there is no choice for us except property”).

202. *Id.* at 10.

203. *Rogers v. Grimaldi*, 875 F.2d 994, 998–1000 (2d Cir. 1989).

204. *Id.* (noting that the film’s title bore relevance to the film’s content); see *Parks v. LaFace Records*, 329 F.3d 437, 452 (6th Cir. 2003) (“The first prong of *Rogers* requires a determination of whether there is any artistic relationship between the title and the underlying work.”).

205. Lessig, *supra* note 16, at 9–10; Lessig, *supra* note 126, at 771.

exemption for infringement claims,²⁰⁶ the argument goes, Congress did not intend to so broadly protect all trademark claims. Therefore, a unified approach cannot be employed; the analysis must be bifurcated according to type of trademark claim, with infringement claims and state dilution claims receiving little First Amendment protection. The ready and facile response is that to the extent the core of the First Amendment's protection is implicated, it is not Congress's choice to deny or limit protection to infringement or state dilution claims. The more sophisticated response engages the nature and essence of the two types of claims, leading to the conclusion that a statutory exemption is relevant for dilution claims but would be superfluous for infringement actions.²⁰⁷

Embodiment of the constitutional ideal of free speech within the FTDA makes sense because, in the absence of consistent judicial protection of First Amendment concerns,²⁰⁸ artistic works alleged to be dilutive need explicit statutory protection against blurring and tarnishment suits. The statutory protection for expressive works from dilution claims recognizes that a plaintiff's private interest in pursuing a dilution claim (especially a tarnishment claim that focuses on reputational harm) is not closely allied with a parallel public interest.²⁰⁹ The public and private interests do not symbiotically coexist as they do in consumer-confusion-based infringement claims.²¹⁰ In contrast to infringement claims, the dilution claimant does not simultaneously implicate significant public interests, such as preventing consumer

206. Compare 15 U.S.C. § 1114 (2000) (no exemption for expressive uses), with *id.* § 1125. (express exemption for expressive uses).

207. See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905 (9th Cir. 2002) (noting that because of inherent limitations, "dilution injunctions . . . lack the built-in First Amendment compass of trademark injunctions").

208. See *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 431 (2003) (noting legislative history demonstrating that First Amendment concerns led sponsors of the FTDA to create "fair use" and "noncommercial" exceptions to federal dilution liability); *MCA Records*, 296 F.3d at 906 (noting legislative history demonstrating that the sponsors of the FTDA responded to First Amendment concerns by relying on the noncommercial exception).

209. See *Moseley*, 537 U.S. at 429 ("Unlike traditional infringement law, the prohibitions against trademark dilution . . . are not motivated by an interest in protecting consumers.").

210. Compare *Rogers v. Grimaldi*, 875 F.2d 994, 997–98 (2d Cir. 1989) (evaluating infringement case where plaintiff's private interest in protecting the value of her name is allied with the potential public interest in not being misled as to plaintiff's endorsement of the film), with *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 30–33 (1st Cir. 1987) (evaluating dilution case where plaintiff's private interest in keeping wholesome associations for its trademark unallied with potential public interest in humor and pornography).

fraud.²¹¹

The claim here is not that works alleged to be infringing are any less worthy of receiving constitutional consideration. Rather, the reality is that infringement law inherently accounts for free expression concerns in a way dilution law, prior to the FTDA, did not.²¹² The key factor limiting an infringement action's reach and ensuring its peaceful coexistence with free expression principles is its foundation in the idea of avoiding confusion. For example, injunctions in infringement actions are confined only to those trademark uses that are likely to confuse consumers or cause fraud, basically limiting the reach of the injunction to competitors attempting to gain commercial advantage over the trademark owner.²¹³ With dilution, the allegedly violative use is not always by a competitor; therefore, the injunctions have a potentially broader reach, possibly enjoining an entire marketing campaign, movie, song, or line of non-competing products.²¹⁴ With infringement, injunctions are issued to protect consumers from "what is essentially a fraud," and this rationale is "wholly consistent with the theory of the First Amendment, which does not protect commercial fraud."²¹⁵ Thus, when trademark law sticks to its traditional role of avoiding confusion in the marketplace, it has little likelihood of hindering free expression.²¹⁶ Trademark law threatens to exceed its proper boundary only when it leaves the realm of confusion and meanders into the quagmire of reputational harms alleged in dilution claims.

Without careful proscription, dilution laws—by allowing trademark owners to sue for reputational harms—have the potential to extend

211. See Schlosser, *supra* note 164, at 946–56 (arguing that dilution claims, as opposed to infringement claims, function more as earned property rights, inuring solely to the benefit of the trademark owner, without concomitant public interest value to offset free speech concerns).

212. Compare Pillsbury Co. v. Milky Way Prods., Inc. No. C78-679A, 1981 U.S. Dist. LEXIS 17722, at *37–38 (N.D. Ga. Dec. 24, 1981) (granting preliminary injunction, based in part, on the court's analysis of the infringement claim against the magazine's use of plaintiff's trade characters engaged in sexual acts), with Lucasfilm Ltd. v. Media Mkt. Group, Ltd., 182 F. Supp. 2d 897, 900–01 (N.D. Cal. 2002) (denying preliminary injunction that would have prohibited a film's reference to the plaintiff's trademark in an animated pornographic film under the FTDA noncommercial use exemption).

213. See 15 U.S.C. § 1114(1)(a), (2) (2000); *id.* § 1116(d)(4)(B), (d)(11).

214. See Hormel Foods Corp. v. Jim Henson Prods., Inc., 73 F.3d 497, 507 (2d Cir. 1996) (stating that "direct competition" with the plaintiff's product is an "important, even if not determinative, factor" in assessing the viability of a tarnishment claim).

215. See Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 905 (9th Cir. 2002).

216. See Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 973 (1993).

trademark law into areas it was never intended to reach.²¹⁷ It may be reasonable to prohibit a commercial competitor from altering, destroying, or presenting a competing trademark of another trademark owner.²¹⁸ But what is reasonable for competitors is arbitrary and stifling when applied to artists.

The second critique—that broad, expression-friendly protection for defendants renders trademark law toothless—is misplaced because the proposed framework does not close all remedies for mark owners seeking to enjoin unauthorized expressive use of their mark. With the proper evidentiary production, the *Rogers* balancing test leaves ample opportunity for mark owners to prevail even when the unauthorized use occurs in an expressive context.²¹⁹ Also, under the proposed framework, mark owners are not hindered from prevailing on claims against competitors or those attempting solely to gain a commercial advantage.²²⁰ Admittedly, a mark owner will find it difficult to enjoin unauthorized expressive use on a dilution claim, but so long as there is a sufficient evidentiary showing of possible confusion, mark owners will be able to enjoin the unauthorized use on an infringement claim.

217. See Kravitz, *supra* note 81, at 143, 184 (arguing that the “tarnishment rationale potentially extends the sweep of trademark protection virtually without limit” and that dilution law “may jeopardize the richness of free discourse we so highly treasure”).

218. See, e.g., *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 44–45 (2d Cir. 1994). The *Deere* court considered dilution claims by Deere against a competitor who had presented Deere’s famous deer logo in an altered and unflattering manner in a television commercial. *Id.* at 43–45. First, the court noted that the defendant’s use risked tarnishing the plaintiff’s mark. *Id.* at 45. Specifically, the court noted that defendant’s alteration and degradation of Deere’s trademark carried a risk of injury to Deere’s business and trademark reputation that could not be tolerated when the interest was solely commercial—here, promoting defendant’s competing products. *Id.* at 44–45. Second, the court noted that dilution was most likely to be found where, as in *Deere*, the alleged violator was a competitor of the plaintiff. *Id.* at 45.

Note, however, that commercial competitors may use another’s trademark if the competitor is using the mark only to identify the mark owner or is using the mark in comparative advertising. *Id.* at 44; cf. *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 806 (9th Cir. 2002) (protecting the defendant’s reference to plaintiff’s mark to identify the plaintiff and plaintiff’s relationship to defendant).

219. See *Rogers v. Grimaldi*, 875 F.2d 994, 998–99 (2d Cir. 1989) (noting that First Amendment concerns “do not insulate” titles of artistic works and requiring “some artistic relevance” to the underlying work). Presumably, more than *de minimus* amounts of confusion would have led to infringement liability. See also discussion *infra* notes 221–23 and accompanying text regarding *Dallas Cowboy Cheerleaders* and *Coca-Cola*.

220. Cf. *Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*, 642 F. Supp. 1031, 1038 (N.D. Ga. 1986). As argued *infra*, even under the *Rogers* standard a plaintiff could prevail in a case like *Original Appalachian Artworks* if it could show a purely commercial free-ride without countervailing expressive context.

Under this framework, plaintiff trademark-owners are not wholly without recourse in scenarios presented in cases such as *Dallas Cowboys Cheerleaders*, *Coca-Cola*, or *Original Appalachian Artworks*. Plaintiffs in such cases may seek a determination that the confusion engendered by a defendant's use outweighs any free expression concerns. For example, under the *Rogers* balancing test, the plaintiff in *Dallas Cowboys Cheerleaders* may very well prevail on the theory that the posters used in advertising the film were excessively confusing. The posters at issue depicted the lead actress of the pornographic movie wearing a uniform strikingly similar to the real Dallas Cowboys cheerleader uniform, accompanied with captions like "Starring Ex Dallas Cowgirl Cheerleader Bambi Woods" and "You'll do more than cheer for this X Dallas Cheerleader."²²¹ Because the poster could confuse and mislead consumers into believing that an actual ex-Dallas Cowboys cheerleader was participating in the pornographic movie, the court's opinion could be recast as one of the rare instances in which the public confusion concern outweighs free speech concerns. The court's real dilemma on this view is the extent and nature of the remedy.²²² Likewise, in both *Coca-Cola* and *Original Appalachian Artworks*, the courts noted the strong likelihood of confusion, based on actual market confusion.²²³

Taken together, *Dallas Cowboys Cheerleaders*, *Coca-Cola*, and

221. See *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 202-03 & n.1 (2d Cir. 1979) (noting that the plaintiff's trademarks included "Dallas Cowboys Cheerleaders," "Dallas Cowgirls," and "Texas Cowgirls").

222. See Kravitz, *supra* note 81, at 150 (suggesting that if the court were perturbed by the misleading advertisements in *Dallas Cowboys Cheerleaders*, the proper remedy, consistent with the First Amendment, would have been to enjoin only the advertising, but not the movie). Under this view, the problem is that the injunction was too broad and swept in protected speech, in the form of the movie, along with unprotected speech, in the form of the advertisements.

Another related problem is courts' predilection toward injunctions instead of monetary damages. See Alison P. Howard, Comment, *A Fistful of Lawsuits: The Press, the First Amendment, and Section 43(a) of the Lanham Act*, 88 CAL L. REV. 127, 173 (2000) (criticizing, based on First Amendment principles, courts' preference for injunctions instead of damages). Arguably, for commercial uses that tarnish a trademark, particularly if a non-competing product is tarnished, the value of the mark may be diminished, but the public is not necessarily harmed. In such cases, where the damage is mainly private, it makes little sense to restrict public speech. Monetary damages equivalent to the loss in value of the mark serve as an appropriate and commensurate remedy.

223. See *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1188 (E.D.N.Y. 1972) (noting that the plaintiff presented evidence of actual customer confusion in the form of letters from many customers around the country who believed Coca-Cola was promoting drug use); *Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*, 642 F. Supp. 1031, 1038 (N.D. Ga. 1986) (noting that the purchasers of Cabbage Patch Kids and Garbage Pail Kids were basically the same— young children—and that the evidence demonstrated that those consumers associated the defendant's products with the plaintiff's mark).

Original Appalachian Artworks also suggest that the modes of expression may enhance the likelihood of public confusion. As neither a poster, nor a sticker, nor a t-shirt is part of a larger expressive work, each one acts as an attention-getting, built-in marketing tool for the products. In other words, the unauthorized expressive use is selling nothing but itself.²²⁴ That fact alone does not limit constitutional protection for these types of expression, but the medium of expression could impact the likelihood of confusion analysis. Because larger, more substantial expressive works provide contexts and explanations that would dispel confusion to a greater extent than a poster or sticker, it may be appropriate to consider the medium of expression as one factor in the confusion side of the balancing test. At least one recently filed case will probe the intersection between mode of expression, context, and likelihood of confusion.²²⁵

Despite the possibility of finding trademark infringement liability based on evidence of actual confusion, the balancing test will still weigh

224. See, e.g., *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) (limiting the injunction to the defendant's use of an altered trademark on t-shirts, coffee mugs, and buttons, but not precluding the defendant from using the altered trademark in books, magazines, or films).

225. Car-Freshner Corp., owner of the famous pine-tree air freshener trademark, recently sued Comdog Cards & Novelties for trademark infringement and state-law unfair competition based on the defendant's use of the pine-tree mark and likeness on a glowing, "scratch-and-sniff" novelty greeting card. See Jordan Smith, *The Odd Case of Pinetree v. Corndog*, AUSTIN CHRON., May 13, 2005, available at http://www.austinchronicle.com/issues/dispatch/2005-05-13/pols_feature7.html; Casey Dickinson, *Car-Freshner Sues Texas Company*, CENT. N.Y. BUS. J., Apr. 29, 2005, available at http://www.findarticles.com/p/articles/mi_qa3718/is_200504/ai_n13639795/print. Although Car-Freshner has aggressively litigated to protect its mark in the past with some success, defendant Comdog Cards has, at this early stage of the suit, shown no signs of capitulating to the plaintiff's cease-and-desist demands, instead arguing that its unauthorized use of the mark is protected parody. See Smith, *supra* (noting that Car-Freshner has filed at least four federal trademark suits since 2002); Defendant's Answer at 3, *Car-Freshner Corp. v. Detwiler*, No. 05-CV-0436-TJM-GHL (N.D.N.Y. filed May 30, 2005) (on file with author); see, e.g., *Car-Freshner Corp. v. Big Lots Stores, Inc.*, 314 F. Supp. 2d 145, 154 (N.D.N.Y. 2004) (granting summary judgment for plaintiff). Defendants argue that the pine-tree logo on a Christmas card is an obviously humorous take on the use of an air-freshener pine tree as a Christmas tree. Defendant's Answer at 2, *Car-Freshner Corp. v. Detwiler*, No. 05-CV-0436-TJM-GHL. The facts of the case present issues nearly identical to cases like *Original Appalachian Artworks*, *Tetley Tea Bags*, or *Mutual of Omaha* because the context surrounding the claimed "parody" is limited and the overall environment of the use arguably does not provide enough substance to mitigate the likelihood of public confusion. Given the analysis I proffer, however, on balance it would appear that here, where there is a difference in (1) consumer markets and (2) consumer expectations created by "novelty" greeting cards, trademark liability should not attach. Judge Thomas J. McAvoy of the District Court for the Northern District of New York, despite having ruled in favor of Car-Freshner on previous claims of infringement against commercial competitors, would be justified in ruling for defendant here based on its First Amendment defense. *Big Lots*, 314 F. Supp. 2d at 154.

heavily in favor of defendants. The nature of the factors considered in the multi-factored likelihood-of-confusion tests render it unlikely that courts will find confusion stemming from expressive works.²²⁶ Specifically, the probable outcomes of two factors forcefully skew the likelihood of confusion analysis outcome: (1) consumer sophistication; and (2) the context of the unauthorized use. For example, in *Hormel*, the court reasoned that children who watched the Muppets were familiar with the Muppets' brand of humor and would not be deceived into thinking that Hormel had endorsed the movie character Spa'am.²²⁷ In *Caterpillar Inc. v. Walt Disney Co.*,²²⁸ the defendant, producer of the children's movie *George of the Jungle*, used the plaintiff's bulldozers in a scene where movie villains were about to destroy a forest.²²⁹ The court denied Caterpillar's request for an injunction against the filmmaker, noting that both children and parents were aware of the cartoonish and fantastical nature of the film and would not be fooled into associating appearance in the film with sponsorship of the film.²³⁰ Courts are willing to engage in a detailed examination of the actual consumer, giving credence to the consumers' ability to discern and differentiate, even when those consumers are children.²³¹ Given the virtually universal application of these two factors to any trademark use in an artistic or expressive setting, plaintiffs claiming infringement should only occasionally be able to prevail on a claim against use of their products in expressive works.

Courts have also made the practical determination that the more disparaging, misused, comical, and/or negative the portrayal of the trademarked product, the less likely it is that a reasonable consumer would be fooled into thinking that the trademark owner endorsed the

226. See *supra* Part I.A for a discussion of the likelihood-of-confusion test.

227. See *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 502 (2d Cir. 1996).

228. 287 F. Supp. 2d 913 (C.D. Ill. 2003).

229. *Id.* at 921–22.

230. See *id.* at 917, 923 (denying plaintiff machinery-manufacturer's motion for a temporary restraining order against makers of the *George of the Jungle* animated movie, where the plaintiff claimed that the use of its trademark on bulldozers as the instruments of deforestation infringed and tarnished plaintiff's trademark).

231. See *Hormel*, 73 F.3d at 502; *Caterpillar*, 287 F. Supp. 2d at 921–23. *But see* *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205 (2d Cir. 1979) (failing to examine the intended consumer to discern whether that consumer would associate the plaintiff with the defendant's pornographic movie and stating “[i]ndeed, it is hard to believe that anyone who had seen defendants' sexually depraved film could ever thereafter disassociate it from plaintiff's cheerleaders.”).

portrayal.²³² In denying the plaintiff's infringement claim in *MCA Records*, the court noted that the "only indication" of Mattel's association with the song was the use of "Barbie" in the title,²³³ the lyrics of the song, which target and mock the values arguably represented by the doll, however, would not cause consumer confusion as to Mattel's sponsorship because they derided Barbie's image instead of celebrating it.²³⁴

Although I suggest that my model strikes the correct balance between trademarks and free expression, mark owners may still protect against egregious unauthorized uses in expressive works where there is no confusion by challenging the U.S. Supreme Court's definition of commercial speech. If the scope of noncommercial speech is narrowed, the balance between trademark and free expression would shift in favor of private concerns. Thus, the critical question is whether sufficient reasons exist to foment a sea change in the U.S. Supreme Court's commercial/noncommercial speech dichotomy. In Part IV, I explore the Court's current jurisprudence and consider scenarios that may force reconsideration of the commercial speech doctrine, focusing specifically on the issue of product placements in movies. The predicted weakness of trademark law in the new paradigm may only be temporary.

IV. THE REAL QUESTION: SHOULD EXPRESSIVE USE ALWAYS COUNT AS NONCOMMERCIAL SPEECH?

What should be clear by now is that once an unauthorized trademark use is determined to be "expressive" or "noncommercial," mark owners should have difficulty prevailing in a trademark action.²³⁵ Without showing a likelihood of confusion, the conduct falls outside the bounds of trademark law.²³⁶ Thus, trademark owners are misguided, or at the very least inefficiently spending their resources, if they attempt to enjoin

232. See, e.g., *Films of Distinction, Inc. v. Allegro Film Prods., Inc.*, 12 F. Supp. 2d 1068, 1077 (C.D. Cal. 1998) ("Although plaintiff's allegations of customer confusion as to the source of the fictional [TV] channel are sufficient to survive a motion to dismiss, the [c]ourt notes that '[w]here the use of the mark is in an unflattering context or setting which would be disadvantageous to the mark's holder, it would seem customer confusion as to endorsement or affiliation is particularly unlikely.'") (quoting *Nat'l Fed'n of the Blind, Inc. v. Loompanics Enters., Inc.*, 936 F. Supp. 1232, 1242 (D. Md. 1996)).

233. See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002).

234. *Id.* at 901.

235. See *supra* Parts II & III; 15 U.S.C. § 1125(c) (2000).

236. See *supra* Parts II & III; 15 U.S.C. § 1125(c).

noncommercial uses based on a paradigm of private-property-like control or categorical liability for unwholesome associations.

Instead of attempting to reinvigorate bankrupt judicial modes, a trademark owner would be better advised to concentrate on the question that silently frames the conflict: what types of expression constitute commercial or noncommercial speech? The relevance of this question is especially poignant in filmmaking because of the ever-evolving symbiosis of artistic and commercial elements in modern-day motion pictures.²³⁷ The use and placement of trademarked products in movies has expanded exponentially since the movie *E.T.*, with trademarked products prominently finding their way into dozens of movies.²³⁸ A new industry of specialized product placement firms, separate and distinct from general-advertising firms, has popped up in Hollywood and other major entertainment centers.²³⁹ In many instances, a product's appearance in a movie causes the product's sales to skyrocket.²⁴⁰ Even so, most companies, realizing that not every use of their trademarked

237. See A.O. Scott, *Post-Popism*, N.Y. TIMES MAGAZINE, Aug. 7, 2005, at 11 ("Of course, nobody bothers to complain much anymore that the movies themselves have become advertisements. Product placement has turned the movie screen into a moving billboard . . .").

A famous use of a trademarked product is *E.T.*'s predilection for Reese's Pieces candy. When candy maker M & M's refused to consent to the appearance of their trademarked product in the Steven Spielberg-directed blockbuster, the filmmakers approached Hershey's, who gave its permission for the use of its trademarked Reese's Pieces in the film. The sale of Reese's Pieces skyrocketed as its popularity with children soared after its appearance in the movie. Amazingly, Hershey's never paid for the showcasing of their product, instead agreeing to a tie-in marketing campaign after the movie's release placements. Frank Zazza, Product Placement Valuation & Product Placement News: Special Report, iTVX, <http://www.itvx.com/SpecialReport.asp> (last visited Oct. 20, 2005). One estimate placed Hershey's windfall at a 65% increase in sales of Reese's Pieces following its use in *E.T.* Claudine R. Cleopha, A Content Analysis of African-American-Oriented Programming on United Paramount Network (Aug. 9, 2005) (unpublished Honors Thesis, Florida State University) (on file with Florida State University D-Scholarship Repository), available at <http://dscholarship.lib.fsu.edu/undergrad/123/>; cf. Zazza, *supra* (stating that Hershey's received an 80% increase in sales). When Spielberg's lovable alien chose Hershey's candy, pervasive product placement in the movies was born.

238. See *Lights, Camera, Brands*, *supra* note 4, at 61 (noting that the product placement market in 2004 was worth \$3.5 billion); Steven L. Snyder, Note, *Movies and Product Placement: Is Hollywood Turning Films into Commercial Speech?*, 1992 U. ILL. L. REV. 301, 305-07 (listing famous product placements in movies).

239. See generally Product Placement News, <http://www.productplacement.biz/> (last visited Sept. 1, 2005); Hollywood Product Placement, <http://www.hollywoodproductplacement.com/> (last visited Sept. 1, 2005). The product placement industry has become large and noticeable enough to have inspired mocking parodies on the internet. See Product Placement Awards, <http://www.productplacementawards.com> (purporting to present awards for the best product placements) (last visited Sept. 1, 2005).

240. See *supra* notes 237-39.

products will have the “E.T. effect,” have assiduously sought to control their image by carefully monitoring the use of their trademarks in advertisements, magazines, posters, paintings, and motion pictures.²⁴¹ Consequently, filmmakers and movie studios have sought and acquired permission from the trademark owners before displaying those marks in their movies.²⁴²

With the increased attention to the financial windfalls and advertising potential in major motion pictures, films may soon present thorny categorization questions under the U.S. Supreme Court’s commercial speech doctrine. Concomitantly, with increased product placements, the risk of trademark-infringement liability is also heightened. Using the movie industry as an example, this Part will discuss the importance of the noncommercial speech designation, demonstrating how ripening conflicts in the product placement arena will require courts to more precisely define commercial and noncommercial speech which will lead to the appropriate balance between trademarks and free speech.

A. The Advent of Product Placement and Current Analysis of Motion Pictures Under the Commercial Speech Doctrine

The U.S. Supreme Court has recognized for decades that “expression by means of motion pictures is included within the free speech and free press guaranty of the First and Fourteenth Amendments.”²⁴³ Even while firmly placing motion pictures on the same First Amendment pedestal as newspapers and literary works, the Supreme Court has cautioned:

It does not follow that the Constitution requires absolute freedom to exhibit every motion picture of every kind at all times and all places. . . . Nor does it follow that motion pictures

241. See Snyder, *supra* note 238, at 303–08; see, e.g., Hormel Foods Corp. v. Jim Henson Prods., Inc., 73 F.3d 497, 502 (2d Cir. 1996) (refusing to enjoin the defendant’s use of a Muppet character named Spa’am in apparent reference to the plaintiff’s meat-product, Spam); Car-Freshner Corp. v. Detwiler, No. 05-CV-0436-TJM-GHL (N.D.N.Y. filed May 30, 2005) (on file with author) (discussing the plaintiff’s attempts to enjoin a greeting card company from using the plaintiff’s “pine-tree” trademark on humorous card); Dale Buss, *A Product-Placement Hall of Fame*, BUS. WEEK, June 11, 1998, available at <http://www.businessweek.com/1998/25/b3583062.htm> (recounting the most effective product placements from 1982 to 1998).

242. See, e.g., Fowler, *supra* note 4, at 1626–28 (noting that filmmakers ask for LAPD acquiescence in using LAPD trademarks in part to maintain good relationships with the LAPD); Friedman, *supra* note 4, at 690; see also *Lights, Camera, Brands*, *supra* note 4, at 61 (“In the film industry, a lot of product-placement deals are made in return for a brand spending large sums marketing the association with the film, as well as for hard cash.”).

243. Joseph Burstyn, Inc. v. Wilson, 343 U.S. 495, 502 (1952).

are necessarily subject to the precise rules governing any other particular method of expression. Each method tends to present its own peculiar problems.²⁴⁴

Speaking in 1952, the Court could not have anticipated that one of those “particular problems” would be the advent of product placement in motion pictures and its troublesome implications for the Court’s then-unwritten commercial speech doctrine.

When applied to a movie that contains no paid-for product placements and where any trademark use in the film is minimal and incidental, this First Amendment protection for motion pictures remains unchallenged. The question presented here is whether product placement has sufficiently transformed movies into commercial speech, therefore stripping motion pictures of constitutional and statutory protection, and forcing filmmakers to solicit permission from mark owners before using those marks. Under current U.S. Supreme Court precedent, any speech that does more than propose a commercial transaction is “noncommercial.”²⁴⁵ A movie, because it does not propose a commercial transaction, falls squarely into the definition of noncommercial speech and will be deemed fully protected, artistic expression under the Supreme Court’s current framework.²⁴⁶ As of now, filmmakers need not seek and receive permission from trademark owners before displaying trademarks.²⁴⁷

Despite this current result regarding commercial speech doctrine and movies, films that feature extensive product placement and advertising tie-ins cause intuitive discomfort with this standard. Once a filmmaker accepts payment or other compensation to place a specific product in a film, those choices arguably are no longer purely artistic. Extended focus on a can of Pepsi or the showcasing of an Apple laptop computer, for example, are directorial decisions occasioned by the movie studios’ direct financial stake in the presentation of those products. Thus, in a ninety- to 120-minute movie, the viewer may be subjected to upwards of twenty paid “advertisements.”²⁴⁸ As such, certain motion pictures could

244. *Id.* at 502–03.

245. See *Pittsburgh Press Co. v. Pittsburgh Comm’n on Human Relations*, 413 U.S. 376, 384–85 (1973).

246. See *id.*; see also *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 65 (1983).

247. See discussion *infra* Part IV.A., and notes 250–257 and accompanying text, explaining, in greater detail, the Supreme Court’s commercial speech doctrine as it applies to expressive works. See also Snyder, *supra* note 238, at 325.

248. See Alex J. Kozinski & Stuart Banner, *Who’s Afraid of Commercial Speech?*, 76 VA. L.

be seen as lengthy, multi-product commercials, just as many television commercials are actually short “films” which showcase a product.²⁴⁹

Despite this continuing trend towards greater product placement, U.S. Supreme Court precedent allows films to retain their status as noncommercial speech.²⁵⁰ Two Supreme Court decisions, *Bolger v. Youngs Drug Products Corp.*²⁵¹ and *Board of Trustees of the State University of New York v. Fox*,²⁵² indicate that the commercial/noncommercial nature of speech is determined by evaluating the “primary purpose” of speech, which in turn is derived from considering the totality of the circumstances surrounding the speech itself, the speaker, and the audience.²⁵³ Unlike the case with product placement in movies, the retailers in *Fox* and *Bolger* were adding nonessential, noncommercial speech in hopes of converting their speech to noncommercial speech. Such a façade, the Court noted, was just as ineffective as attempting to convert a sales presentation into religious or political speech by convening it with a prayer or the Pledge of Allegiance.²⁵⁴ The Court seemed bothered in both cases by the

REV. 627, 640 n.54 (1990).

249. *Id.* (pointing out that a popular Pepsi commercial featuring Michael J. Fox never expressly sold the product, instead focusing on the actor’s comically strenuous efforts to please his new neighbor). Other examples of such marketing include the Nike “I’m Tiger Woods” commercials that arguably make political statements about race and sports, rather than expressly promoting products.

250. See *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983); *Bd. of Trs. of the State Univ. of N.Y. v. Fox*, 492 U.S. 469 (1989).

251. 463 U.S. 60 (1983).

252. 492 U.S. 469 (1989).

253. See *Fox*, 492 U.S. at 474–77; *Bolger*, 463 U.S. at 66–68. In *Bolger*, the Supreme Court clarified that neither the fact that speech is in the form of an advertisement, nor that the speech references a specific product, nor that the speaker has economic motivation for the speech, is an independently sufficient ground to classify speech as commercial. 463 U.S. at 66–67. In *Bolger*, the totality of facts, combined with the Court’s view that the advertisements’ comments on public health and family planning were only tenuously linked to the economic aspects of the defendants’ flyers, led to the conclusion that the speech was commercial. *Id.* at 66–68. Despite concluding that the speech was commercial, the Court nevertheless declared the law prohibiting the mailing of the defendants’ flyers unconstitutional. *Id.* at 74–75. Building upon this line of reasoning, the Court in *Fox* considered whether Tupperware parties that presented retail goods with concurrent discussion of home economics amounted to commercial speech. 492 U.S. at 472. Again, the Court concluded that inclusion of noncommercial, educational elements could not transform the Tupperware parties, which essentially proposed a commercial transaction for the goods exhibited by defendant, into noncommercial speech. *Id.* at 471–75. The Court ruled, however, that the First Amendment issue was not ripe for adjudication. *Id.* at 484.

254. See *Fox*, 492 U.S. at 474 (“No law of man or of nature makes it impossible to sell housewares without teaching home economics Nothing in the resolution prevents the speaker

defendants' attempts to "immunize" their commercial speech from judicial scrutiny by supplementing it with related noncommercial speech.²⁵⁵

Under the U.S. Supreme Court's primary-purpose analysis, motion pictures with product placements are noncommercial speech.²⁵⁶ Unlike *Bolger* and *Fox*, movies are primarily and overwhelmingly noncommercial expressions with commercial elements sprinkled throughout their artistic message.²⁵⁷ Subjecting a James Bond film to the rubric of *Bolger* and *Fox* yields the result that the movie is noncommercial: the primary purpose of the movie is to communicate an expressive message, which could have been relayed without placing a specific brand of sports car in the movie. Further, considering the totality of factors, the filmmaker's primary motivation in creating the movie is to sell the movie as an artistic product, not to create sales of the featured products. If the filmmaker's artistic vision calls for a character to drink a soda or use a computer, the choice of which soda or which computer manufacturer is completely incidental to the vision. The fact that the movie studio receives money from a particular soda or computer manufacturer is also arguably incidental to the primarily noncommercial speech. Thus, despite the increasing prevalence of product placements, currently, it would appear that movies still retain "noncommercial" categorization under the U.S. Supreme Court's current commercial speech rubric.

B. Pushing the Definitional Bounds of Noncommercial Speech

How far this categorization will be extended in the future, however, is a matter of some uncertainty. Two judges, criticizing the results reached by courts considering commercial speech questions, have noted that the line between commercial and noncommercial speech is not easy to discern.²⁵⁸ Nowhere are the limitations of this strict dichotomy more

from conveying, or the audience from hearing, these noncommercial messages, and nothing in the nature of things requires them to be combined with commercial messages.").

255. See *id.*; *Bolger*, 463 U.S. at 68 (discussing the inclusion of healthcare facts in a drug store flyer, which was also used as an advertisement and stating "[a]dvertisers should not be permitted to immunize false or misleading product information from government regulation simply by including references to public issues.").

256. See Snyder, *supra* note 238, at 325 (arguing that under *Bolger*, a film containing product placements is not commercial speech).

257. *Id.* at 326–27.

258. See *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1520 (9th Cir. 1993) (Kozinski, J.,

evident than in the context of motion picture product placements. I present below six product-placement scenarios that, when considered under the commercial/noncommercial speech polarity, suggest that the “commerciality” of speech might better be understood as a spectrum or sliding scale. As I illustrate, if commerciality were a sliding scale, the latter scenarios would fall on the commercial side. The hypothetical scenarios are as follows:

(1) a filmmaker needs a particular type of product in his movie (car, computer, etc.) and makes a wholly value-neutral decision as to which particular brand of product to use;

(2) a filmmaker chooses certain trademarks to appear in the movie based on consumer survey data indicating greater appeal of certain trademarks over others in order to increase movie revenues;

(3) a filmmaker simply dislikes a particular brand or trademarked product and chooses to portray that product in a negative light as an attempt to harm the product or corporation represented by the trademark;

(4) a filmmaker routinely pays a product placement agency to review all scripts so that the agency can suggest alterations and additions resulting in product placement revenue;

(5) a filmmaker charges a “non-placement fee” on non-discriminatory terms to all manufacturers of a product, so that manufacturers can pay to opt out of negative portrayals; and

(6) a filmmaker accepts payment from a manufacturer to portray a competitor-manufacturer’s product in a negative or disparaging light.

Of these possibilities, scenarios (1) and (2) present the fewest problems for the commercial speech doctrine. Although a trademark owner may be upset that its trademarked car was chosen for a bank robbery or its computer used to inject a virus into government computers, it has very little recourse against the filmmaker. The film is an expressive work and would be deemed noncommercial. The

dissenting from denial of rehearing en banc) (“In our pop culture, where salesmanship must be entertaining and entertainment must sell, the line between the commercial and noncommercial has not merely blurred; it has disappeared.”); see also *Kasky v. Nike, Inc.*, 45 P.3d 243, 279 (Cal. 2002) (Brown, J., dissenting) (“In today’s world, the difference between commercial and noncommercial speech is not black and white. Due to the growing politicization of commercial matters and increased sophistication of advertising campaigns, the intersection between commercial and noncommercial speech has become larger and larger. As this gray area expands, continued adherence to the dichotomous, all-or-nothing approach developed by the United States Supreme Court will eventually lead us down one of two unappealing paths: either the voices of businesses in the public debate will be effectively silenced, or businesses will be able to dupe consumers with impunity.”), cert. dismissed, *Nike, Inc. v. Kasky*, 539 U.S. 654 (2003).

filmmaker does not directly profit from the use or degradation of the plaintiff's trademark, and use of the mark is incidental to the artistic vision. In the second scenario, although the choice of which trademark product to display is based on consumer survey data, the choice is not directly motivated by profit. The filmmaker may receive a better or worse commercial response to his film based on the subtle incorporation of consumer attitudes, but such effect is tangential to the artistic vision. Virtually all artists seek some degree of traction with consumers,²⁵⁹ so perhaps the filmmaker's scientific approach to that end should be no cause for alarm.

The third scenario presents a troubling issue because the filmmaker's choice of trademarked product is not value-neutral. It is not simply necessity and happenstance that drives this product choice—a Ford sedan is chosen specifically because the filmmaker bears rational or irrational dislike towards the company. Because the filmmaker again derives no direct revenue from the use of the product, arguably scenario (3) attains the same result as scenarios (1) and (2). Nevertheless, this scenario raises the question whether, for purposes of commercial speech classification and trademark liability, the defendant's motive matters. If so, what types of motives matter? Perhaps irrational hatred should matter for a defamation claim,²⁶⁰ but not for the purposes of classifying commercial speech and attaining trademark liability.

In the fourth scenario, a marketing or advertising agency conducts a preliminary review of movie scripts to discover product placement opportunities. Because the scripts are already written before the alterations for product placements are introduced, arguably the artistic message is primary and the commercial aspects only tangential. Assuming a product placement agency's edits are cosmetic and not substantive, the argument is even stronger that the commercially-oriented aspects of the speech are merely minor additives, incapable of transforming noncommercial speech into commercial speech. On the other hand, the artistic product in scenario (4) is clearly altered by a direct profit motive which differentiates it from scenarios (1), (2), and

259. See *White*, 989 F.2d at 1517 (Kozinski, J., dissenting) (“[T]he majority talks of the ‘difference between fun and profit,’ but in the entertainment industry fun is profit.”) (emphasis and internal citations omitted).

260. See Mary F. Prechtel, Comment, *Classical Malice: A New Fault Standard for Defamation in Fiction*, 55 OHIO ST. L.J. 187, 202–14 (1994) (arguing that current defamation laws are inappropriate when applied to works of fiction, but that a classical malice standard might be appropriate).

(3).

The fifth and sixth scenarios present the thorniest issues for categorizing movies as noncommercial or commercial speech. In both scenarios, the economic motivation to disparage or negatively portray a particular trademarked product is evident. Accepting payment for non-placement or for placement of a competing trademark may tip the scale more in favor of a finding of commercial speech. Under the *Bolger* test,²⁶¹ the identity of the speaker and the economic motivation for the speech are factors in the totality of circumstances analysis.

Ultimately, the bulk of speech in both scenarios (5) and (6) remains noncommercial, but the commercial aspects of speech in both situations are more prominent and discernible than in scenarios (1) through (4). Scenario (5), as with scenario (4), offers filmmakers the direct opportunity to profit from exclusion of certain trademarked products, even when they do not profit from the product that actually appears on screen. To the extent the commercial speech doctrine will reflect a continuum in the future, the speech in scenario (5) appears to be significantly more “commercial” than the previous examples.

Finally, in scenario (6) a manufacturer pays the filmmaker to have a competitor’s product negatively portrayed. Here, it appears that the speech and unauthorized trademark use has crossed the threshold into commercial speech, like that of the defendants in *Bolger* and *Fox*. The mark owner’s strongest claim is based on the identity of speaker: the speaker in scenario (6) is actually a market competitor and not the filmmaker. The claim would be based on the notion that a competitor cannot use the filmmaker and the artistic medium to gain a commercial advantage that it could not accomplish without the middleperson and the medium. Given courts’ hostility to trademark defilement by a competitor,²⁶² they are unlikely to immunize the speech by declaring it noncommercial under these facts.

If it is true, as this Article argues, that trademark laws do not protect a trademark owner’s product from being disparaged or ridiculed in a movie, then the background regime is one of near-complete artistic autonomy for the filmmaker with concomitant uncertainty for the trademark owner. Against this backdrop, a trademark owner may choose

261. *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 66–68 (1983).

262. *See, e.g., Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 42 (2d Cir. 1994) (holding defendant liable for alteration of plaintiff’s trademark in a commercial advertisement); *cf. Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 507 (2d Cir. 1996) (stating that competitive status is an important factor in trademark analysis).

to opt out of the uncertainty by paying a fee to ensure that its product will not be negatively portrayed as part of the film's expressive message. Thus, any conflict arising out of the portrayal at that point would sound in contract law, not in trademark or competition law.

The purpose of this Article is not to provide definitive answers to, or a complete analysis of, the question of whether these scenarios would be classified as commercial or noncommercial speech. Rather, these examples highlight some of the issues that courts and litigants may encounter as unauthorized trademark use increases in expressive works and the commercial aspects of those uses become more apparent. In addition, they showcase the difficulty caused by conceiving of commerciality as an easily cleaved duality.

In sum, a motion picture is still primarily an artistic endeavor, albeit one with huge commercial promise and impact for the featured trademarked products. Along the spectrum from scenarios (1) to (6), filmmakers, and by extension other artists, will force reconsideration of the Court's commercial speech doctrine. Any redefinition of commercial speech that expands its parameters will push the boundary between trademark and free expression towards private concerns.

C. *Increasing the Likelihood of Confusion*

While the significance of the noncommercial/commercial distinction is apparent in determining the boundary between trademark law and the First Amendment in the dilution context, it is more attenuated in the confusion context. Even if product placements do not transform films into commercial speech subject to dilution liability, the increasing presence of product placements may facilitate the ability to establish the likelihood of confusion necessary to claim infringement. The movie-going consumer is now well aware that James Bond may drive an Aston Martin or a BMW, or that Neo, Morpheus, and Trinity of *The Matrix* use a particular cellular phone.²⁶³ When viewers are aware that *many* of the products they see on screen appear pursuant to a marketing contract, they may be more likely to assume that *all* trademarked products appearing on screen are similarly placed pursuant to lucrative deals. Based on this "audience expectation" rationale, litigants have

263. See, e.g., *A Chronological History of the James Bond Film Vehicles*, CAR ENTHUSIAST, http://www.carenthusiast.com/news0910/bond_3.htm (last visited Oct. 20, 2005) (chronicling James Bonds' history of vehicles); *Samsung Pays \$100mm for Product Placement in Matrix Sequels*, http://www.mediathinking.com/more/A37_0_1_0_M/ (May 12, 2003, 10:58 EST).

(unsuccessfully) argued that unauthorized use in a movie caused confusion as to the mark owner's affiliation with, endorsement, or sponsorship of the movie.²⁶⁴

Despite unfavorable treatment of such claims in recent litigation, the "audience expectation" does correlate with the "consumer sophistication" factor assessed in the balancing test's confusion metric.²⁶⁵ Although such expectations would not alone overcome free expression concerns, the calcification of viewer expectation will likely make it more difficult for filmmakers to counter infringement suits.

CONCLUSION

Unauthorized use of trademarks in expressive works has fomented significant controversy between mark owners asserting rights under federal trademark law and defendants claiming protection under the First Amendment. Filmmakers, singers, painters, parodists, and authors increasingly reference trademarks as a method of effectively communicating with audiences and succinctly expressing their thoughts about popular, commercial culture. As trademarks in our popular culture have evolved into shorthand symbols for values, ideas, and experiences, they no longer fall within the exclusive domain of the trademark holder. Rather, when used as part of an artistic work, trademarks become the legitimate subject of a parodist's humor or a filmmaker's cinematic vision. As Judge Kozinski stated, "the trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function."²⁶⁶

The proper boundary between trademark law and free expression prevents trademark owners from dictating the appearance or usage of their trademarks in the noncommercial sphere. Perhaps in the future the definition of that sphere will change, causing a concomitant redefinition

264. *See, e.g., Caterpillar Inc. v. Walt Disney Co.*, 287 F. Supp. 2d 913, 922–23 (C.D. Ill. 2003) (denying plaintiff manufacturer's motion for a temporary restraining order against defendant filmmaker for an allegedly dilutive use of plaintiff's trademarked bulldozers in defendant's movie). This argument was advanced by the plaintiff to no avail; the court's order denying the temporary restraining order disregarded it completely. *Id.* at 918; *see also* Plaintiff's Motion for Temporary Restraining Order, *Caterpillar, Inc. v. Walt Disney Co.*, No. 03-CV1334 at 7 (C.D. Ill. 2003) (on file with author).

265. *See supra* Part III (discussing specific factors within the multi-factored likelihood-of-confusion test that feature more prominently when the alleged infringement occurs in an expressive work).

266. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

of the boundary of trademark law. For now, however, artists may continue to create, secure in the knowledge that in the sequel, Speech-Zilla defeats Trademark Kong.²⁶⁷

267. *See id.* at 898 (“If this were a sci-fi melodrama, it might be called Speech-Zilla meets Trademark Kong.”).