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INCREASING FIRST AMENDMENT SCRUTINY OF TRADEMARK LAW

Lisa P. Ramsey*

ABSTRACT

Trademarks consist of language. Trademark law regulates certain uses of trademarked language to communicate information or ideas, yet few courts subject trademark law to First Amendment scrutiny. This Article argues that more courts should. Not every infringing use of a trademark is misleading commercial speech. The Supreme Court has struck down other nonmisleading commercial speech regulations using intermediate constitutional scrutiny. Moreover, the Court's First Amendment jurisprudence dictates that content-based trademark laws regulating noncommercial speech should be subject to strict scrutiny analysis. This Article provides a detailed framework for understanding how trademark law can raise serious First Amendment concerns and sets forth the options for courts who acknowledge this conflict. Most courts protect speech by narrowly construing trademark claims and broadly interpreting defenses. This doctrinal approach protects expression in individual cases, but protected speech is still harmed by trademark law in the real world. It is often difficult to predict the outcome of trademark law's multi-factor balancing tests. Those who cannot afford to litigate will self-censor rather than fight for their right of free expression. Trademark law will better serve First Amendment interests if it contains more speech-protective trademark rules or categorical safe harbors for certain uses of trademarks. Among other benefits, categorical rules create more predictability and make it easier for courts to dispose of frivolous trademark disputes early. Finally, when trademark laws suppress or chill protected expression, courts should not hesitate to apply First Amendment scrutiny and find that law unconstitutional.

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INTRODUCTION	383
I. INCREASING FIRST AMENDMENT PROTECTION FOR COMMERCIAL SPEECH.....	390
A. THE EVOLUTION OF THE U.S. SUPREME COURT'S COMMERCIAL SPEECH DOCTRINE	390
B. TRADEMARKS AND COMMERCIAL SPEECH.....	395
II. A FRAMEWORK FOR EVALUATING THE CONSTITUTIONALITY OF TRADEMARK LAWS UNDER THE FIRST AMENDMENT	404
A. STATE ACTION	407
B. FIRST AMENDMENT "SPEECH"	409
C. CATEGORICAL EXCEPTIONS TO FIRST AMENDMENT PROTECTION	412
1. <i>No Categorical Exception for Trademarks</i>	412
2. <i>Misleading Uses of Trademarks in Commercial Speech</i>	414
D. FIRST AMENDMENT SCRUTINY.....	421
1. <i>Intermediate Scrutiny for Commercial Speech Regulations</i>	425
2. <i>Strict Scrutiny for Content-Based Trademark Laws</i> . ..	427
a. The Level of Constitutional Scrutiny	427
b. The Distinction Between Content-Based and Content-Neutral Regulations of Speech	429
c. Trademark Laws Are Content-Based Regulations of Speech.....	431
i. <i>Word Choice Discrimination</i>	433
ii. <i>Subject Matter Discrimination</i>	437
a. Misleading Uses of Trademarks	437
b. Diluting Uses of Trademarks	438
c. Commercial Uses of Trademarks	439
d. Other Content-Based Exceptions to Trademark Liability	440
iii. <i>Viewpoint Discrimination</i>	441
d. Constitutional Analysis of Trademark Laws Regulating Noncommercial Speech.....	442
3. <i>Other First Amendment Doctrines</i>	446
III. OPTIONS FOR INCREASING FIRST AMENDMENT SCRUTINY OF TRADEMARK LAW	447
A. CONTEXTUAL SPEECH-PROTECTIVE INTERPRETATIONS OF TRADEMARK LAW	447
B. CONSTITUTIONAL ANALYSIS	450
C. SPEECH-PROTECTIVE TRADEMARK RULES.....	454
CONCLUSION	457

INTRODUCTION

FIRMS use language to sell goods and services. If the words used are claimed as trademarks by others, use of that language may result in trademark litigation. Firms have sued competitors based on their use of the phrase “We’ll Pick You Up” as a slogan for car rental services, “Travel Planner” for travel guides, and “Bottled at Source” used in packaging and advertising for bottled water. American Airlines sued the Internet search engine firm Google for using its trademarks to trigger sponsored advertising links displayed near organic search results. Louis Vuitton Malletier S.A. sued Haute Diggity Dog claiming its “Chewy Vuitton” line of dog toys infringed and diluted the “Louis Vuitton” mark. A firm claiming rights in the registered trademark “Life is Good” has accused others of trademark violations for using similar words in advertising for electronics (“Life’s Good”) and on the front of T-shirts (“Life is Gay” and “Life Sucks”). The owner of a trademark registration for the term “Change Rocks” for jewelry claims Barack Obama’s political campaign must get permission before it can sell T-shirts or other campaign memorabilia that displays the term “Change Rocks.” These trademark disputes raise an important question: Is there a First Amendment right to use words to advertise or sell goods and services, or display words on T-shirts and other merchandise, when those words are claimed as trademarks by others?¹

Early trademark law focused on protecting firms from illegitimate diversions of their trade by competitors.² The government banned the deceptive and misleading use of distinctive trademarks that caused a likelihood of confusion regarding the source of commercial goods or services. For example, a competitor of Coca-Cola Company could not use the “Coca-Cola” mark or a similar term as a brand name for its own drink product.³ Such restrictions on use of a trademark did not raise First Amendment concerns. Commercial advertising was not deemed to be worthy of protection by the First Amendment until the 1970s.⁴ Moreo-

1. U.S. CONST. amend. I. For information about the trademark disputes mentioned in this paragraph see *Advantage Rent-A-Car, Inc. v. Enter. Rent-A-Car, Co.*, 238 F.3d 378 (5th Cir. 2001); *Official Airline Guides v. Goss*, 6 F.3d 1385 (9th Cir. 1993); *CG Roxanne LLC v. Fiji Water Co.*, No. C-07-02258, 2008 WL 2782745 (N.D. Cal. July 16, 2008); *Complaint, Am. Airlines, Inc. v. Google, Inc.*, No. 4:07-CV-00487 (N.D. Tex. Aug. 16, 2007); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007); *Complaint, Life is Good, Inc. v. KGR Kids, Inc.*, No. 1:01-CV-11789-NG (D. Mass. Oct. 3, 2006); Steve Bailey, *What Would Jake Say?*, BOSTON GLOBE, Sept. 5, 2007, http://www.boston.com/business/articles/2007/09/05/what_would_jake_say?mode=pf; Alex Beam, *Whose ‘Good Life’ is it Anyway*, BOSTON GLOBE, Oct. 9, 2006, http://www.boston.com/ae/media/articles/2006/10/09/whose_good_life_is_it_anyway/; Julie Moran Alterio, *Scarsdale Teen Jilted by Obama’s Slogan*, JOURNAL NEWS, Jan. 10, 2008, at 1A.

2. Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1841 (2007); J. THOMAS MCCARTHY, 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 5:2 (4th ed. 2008).

3. See, e.g., *Coca-Cola Co. v. Cahill*, 480 F.2d 153, 153-54 (10th Cir. 1973).

4. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 758-62 (1976).

ver, courts and commentators noted that restrictions on misleading commercial uses of trademarks are constitutional because misleading commercial speech is categorically unprotected by the First Amendment.⁵

Today, there are reasons to doubt the constitutionality of some trademark laws. The U.S. Supreme Court has recently increased constitutional scrutiny of commercial speech regulations and found some laws unconstitutional under *Central Hudson's* intermediate scrutiny test.⁶ At the same time, the legislature has extended trademark protection to descriptive terms that have acquired distinctiveness⁷ and allowed famous trademark holders to prevent diluting uses of their marks in nonmisleading commercial speech.⁸ Courts have interpreted trademark law's likelihood of confusion requirement to cover new types of confusion, such as initial interest confusion.⁹ Furthermore, trademark law is now applied to the use of marks in commentary, parody, and satire—including domain names, books, magazines, T-shirts, and films—because confusion regarding the markholder's sponsorship or approval of the expression is now actionable.¹⁰ Protected expression is frequently suppressed or chilled by

5. See, e.g., *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 1021-22 (9th Cir. 1985) (“Commercial speech may be regulated when its content is otherwise false or misleading.”) (citing *Va. Pharmacy*, 425 U.S. at 771-73); Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of the Trade Symbols*, 1982 WIS. L. REV. 158, 165-66; Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 221 (1998); see also *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 535 & n.12 (1987) (“The Government constitutionally may regulate ‘deceptive and misleading’ commercial speech.”) (citing *Va. Pharmacy*, 425 U.S. at 771; *Friedman v. Rogers*, 440 U.S. 1, 9-10 (1979)).

6. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 566 (1980); see also *infra* Part I.A. Moreover, some Supreme Court Justices have said they want to abandon this test and hold that truthful and nonmisleading commercial speech is fully protected by the First Amendment, just like noncommercial speech. See *infra* Part I.A. As noted by Professor McKenna, a higher level of review of commercial speech regulations will have “significant consequences for trademark protection.” Mark P. McKenna, *The Rehnquist Court and the Groundwork for Greater First Amendment Scrutiny of Intellectual Property*, 21 WASH. U. J.L. & POL'Y 11, 26-28 (2006).

7. 15 U.S.C. § 1052(e)(1), (f) (2000); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 171 (1995); see Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095, 1113-18 (2004) (discussing the evolution of trademark protection for descriptive terms).

8. 15 U.S.C. § 1125(c)(1) (2006) (covering use of a famous trademark in a manner “that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury”).

9. E.g., *Brookfield Commcn's, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1062-65 (9th Cir. 1999); see Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 CARDOZO L. REV. 105, 106-10 (2005).

10. E.g., *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 362 (4th Cir. 2001); *Dr. Seuss Enters., L.P. v. Penguins Books USA, Inc.*, 109 F.3d 1394, 1396 (9th Cir. 1997); *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 772 (8th Cir. 1994); *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 398 (8th Cir. 1987); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 202 (2d Cir. 1979); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 728 (D. Minn. 1998). In this Article, the term “commentary” is meant to encompass both positive and negative commentary, including criticism, that incorporates another's mark. A “parody” means use of a mark to poke fun at the markholder or its mark, products, services, or activities. “Satire”

trademark law because the law's current built-in First Amendment safeguards, such as the descriptive fair use doctrine, are limited and involve fact-specific determinations that often can only be resolved after discovery at summary judgment or trial—a cost many defendants cannot afford.¹¹

Although many current trademark doctrines raise First Amendment concerns, defendants often do not plead a First Amendment defense,¹² and courts do not generally apply constitutional analysis to trademark laws or injunctions. Some courts incorrectly conclude the constitutional requirement of state action is not satisfied in private civil trademark litigation.¹³ Others mistakenly hold certain actionable uses of a mark are not “speech” that implicates the First Amendment,¹⁴ characterize non-commercial speech as commercial,¹⁵ assume infringing commercial use of a mark is misleading commercial speech,¹⁶ or erroneously treat trademark laws like content-neutral speech regulations.¹⁷ Some courts do recognize that First Amendment values are relevant in trademark disputes.¹⁸

uses a mark to ridicule someone or something unrelated to the markholder, such as society. See *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 580-81 & n.15 (1994); *Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813 (2d Cir. 1999) (stating that the “Supreme Court’s parody explication as to copyrights. . . is relevant to trademarks”).

11. See generally Lisa P. Ramsey, *First Amendment Limitations on Trademark Rights*, in 3 *INTELLECTUAL PROPERTY AND INFORMATION WEALTH: ISSUES AND PRACTICES IN THE DIGITAL AGE* 147, 159 (Peter K. Yu ed., 2007); William McGeeveran, *Rethinking Trademark Fair Use*, 94 *IOWA L. REV.* (forthcoming 2008), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1160656; Ramsey, *supra* note 7, at 1167-69.

12. E.g., Answer at 18-19, *Am. Airlines, Inc. v. Google, Inc.*, No. 4:07-CV-00487 (N.D. Tex. Nov. 7, 2007).

13. E.g., *Empire Home Servs., L.L.C. v. Empire Iron Works, Inc.*, No. 05-CV-72584, 2007 WL 1218717, at *8 (E.D. Mich. April 23, 2007) (finding defendant’s constitutional argument unpersuasive because “government restraints on commercial speech” are “simply not present in an intellectual property dispute between two private parties”); *Reddy Comm’ns, Inc. v. Envtl. Action Found., Inc.*, 199 U.S.P.Q. 630, 633-34 (D.D.C. 1977); *Interbank Card Ass’n v. Simms*, 431 F. Supp. 131, 133-34 (M.D.N.C. 1977); see also *infra* Part II.A.

14. E.g., *SMJ Group, Inc. v. 417 Lafayette Restaurant LLC*, 439 F. Supp. 2d 281, 291 (S.D.N.Y. 2006); *Gucci Am., Inc. v. Hall & Assocs.*, 135 F. Supp. 2d 409, 418 (S.D.N.Y. 2001); *Planned Parenthood Fed’n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d 1430, 1440 (S.D.N.Y. 1997), *aff’d*, 152 F.3d 920 (2d Cir. 1998); see also *infra* Part II.B.

15. E.g., *World Wrestling Fed’n v. Bozell*, 142 F. Supp. 2d 514, 525-26 (S.D.N.Y. 2001); *People for the Ethical Treatment of Animals v. Doughney*, 113 F. Supp. 2d 915, 919 (E.D. Va. 2000), *aff’d on other grounds*, 263 F. 3d 359 (4th Cir. 2001); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 735 (D. Minn. 1998).

16. E.g., *Univ. of Kan. v. Sinks*, No. 06-2341-JAR, 2008 WL 755069, at *31 (D. Kan. Mar. 19, 2008); *Kelley Blue Book v. Car-Smarts, Inc.*, 802 F. Supp. 278, 291 (C.D. Cal. 1992).

17. E.g., *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979); *Univ. of Kan.*, 2008 WL 755069, at *31 (citing *Dallas Cowboys*, 604 F.3d at 206).

18. E.g., *Lamparello v. Falwell*, 420 F.3d 309, 313-14 (4th Cir. 2005); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900-02, 906-07 (9th Cir. 2002); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group, Inc.*, 886 F.2d 490, 493-97 (2d Cir. 1989); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29-34 (1st Cir. 1987); *Burnett v. Twentieth Century Fox Film Corp.*, 491 F. Supp. 2d 962, 972-74 (C.D. Cal. 2007); *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 444 F. Supp. 2d 1012, 1037-48 (C.D. Cal. 2006); *Charles Atlas, Ltd. v. D.C. Comics, Inc.*, 112 F. Supp. 2d 330, 337-39 (S.D.N.Y. 2000).

But usually these courts use trademark doctrine rather than constitutional analysis to rule for the defendant,¹⁹ or ignore the Supreme Court's First Amendment doctrine—such as strict scrutiny analysis for content-based regulations of noncommercial speech—and create and apply their own speech-protective common law trademark doctrines, such as the *Rogers* balancing test.²⁰ Trademark doctrine and this balancing test can protect expression when the court rules for the defendant. Yet sometimes plaintiffs prevail, and they do so without proving this application of trademark law satisfies true constitutional analysis.²¹

Scholars have noted the recent expansion of trademark rights may harm expression.²² Some argue specific trademark doctrines are unconstitutional, such as trademark protection for descriptive terms²³ or the current trademark dilution laws.²⁴ Yet judges and commentators generally believe courts should protect First Amendment interests in trademark disputes by applying speech-protective interpretations of trademark statutes rather than constitutional adjudication.²⁵ As a result of strict ap-

19. *E.g.*, *Lamparello*, 420 F.3d at 314 (finding there is no likelihood of confusion).

20. *E.g.*, *Mattel*, 296 F.3d at 901-02 (applying balancing test from *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989)).

21. *See e.g.*, *supra* notes 10, 13-17.

22. *E.g.*, Rochelle Cooper Dreyfuss, *Reconciling Trademark Rights and Expressive Values: How to Stop Worrying and Learn to Love Ambiguity*, in TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH 261, 261-67 (Graeme B. Dinwoodie & Mark D. Janis eds., 2008); Margreth Barrett, *Domain Names, Trademarks, and the First Amendment: Searching for Meaningful Boundaries*, 39 CONN. L. REV. 973, 975-77 (2007); Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721, 796-816 (2004); Michael K. Cantwell, *Confusion, Dilution, and Speech: First Amendment Limitations on the Trademark Estate*, 87 TRADEMARK REP. 48, 55-76 (1997); Denicola, *supra* note 5, at 158; Harriette K. Dorsen, *Satiric Appropriation and the Law of Libel, Trademark and Copyright: Remedies Without Wrongs*, 65 B.U. L. REV. 923, 939-52 (1986); Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 399-412 (1990); Pratheepan Gulasekaram, *Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works*, 80 WASH. L. REV. 887, 890-906 (2005); Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 972-78 (1993); Arlen W. Langvardt, *Protected Marks and Protected Speech: Establishing the First Amendment Boundaries in Trademark Parody Cases*, 36 VILL. L. REV. 1, 60-102 (1991); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1697-1713 (1999); Jacqueline Lipton, *Commerce Versus Commentary: Gripe Sites, Parody, and the First Amendment in Cyberspace*, 84 WASH. U.L. REV. 1327, 1331-32 (2006); Mimi Rajapakse, *Domain Names as Protected Speech: A Reexamination of the Fourth Circuit's Decision in People for the Ethical Treatment of Animals v. Doughney*, 31 AIPLA Q.J. 353, 356-72 (2003); Hannibal Travis, *The Battle for Mindshare: The Emerging Consensus that the First Amendment Protects Corporate Criticism and Parody on the Internet*, 10 VA. J.L. & TECH. 3, 8-31 (2005); Robert J. Shaughnessy, Note, *Trademark Parody: A Fair Use and First Amendment Analysis*, 72 VA. L. REV. 1079, 1082-99, 1107-16 (1986).

23. Ramsey, *supra* note at 7, at 1146-74.

24. *See infra* Part II.D.1 (citing scholarship evaluating the constitutionality of trademark dilution laws).

25. *E.g.*, *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 35 (1st Cir. 1987) (Campbell, C.J., dissenting); Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 COLUM. J.L. & ARTS 187, 188-89, 209 (2004); William McGeveran, *Four Free Speech Goals for Trademark Law*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1205, 1211-14 (2008); *see also* *Freecycle Network, Inc. v. Oey*, 505 F.3d 898, 906 n.16 (9th Cir. 2007) (declining to rule on the First Amendment challenge after finding for defendant on other grounds);

plication of the doctrine of constitutional avoidance, most courts protect free speech interests in trademark disputes by construing trademark claims narrowly and defenses broadly.²⁶ This approach can protect expression in individual cases, but certain statutory provisions may not permit a speech-protective interpretation or may suppress or chill protected expression more than necessary. Courts and legislatures may decide that they need to evaluate the constitutionality of a particular trademark law. Unfortunately, there is currently no detailed and systematic framework in the scholarship or case law for generally evaluating First Amendment challenges to trademark laws using the Court's First Amendment jurisprudence.

This Article provides such a First Amendment framework for trademark law.²⁷ Before I set forth this framework, Part I first explains why the Supreme Court's evolving commercial speech doctrine is extremely relevant to the constitutionality of trademark law. The Court no longer automatically defers to the legislature when it regulates nonmisleading commercial speech. Part II provides a comprehensive roadmap for evaluating the constitutionality of trademark law. It applies the Court's First Amendment doctrine to current trademark law and uncovers some interesting and unanticipated results.

Contrary to suggestions by some courts that there is no "state action" or First Amendment "speech" in trademark disputes, trademarks easily and clearly satisfy the threshold for First Amendment coverage.²⁸ Judicial enforcement of trademark law is state action. Moreover, I argue that the government regulates First Amendment "speech" in trademark cases when courts enjoin or punish any use of another's mark due to the harm caused by the content of the defendant's communication. Courts should find that First Amendment "speech" is implicated when the defendant is accused of conveying an allegedly infringing or diluting message by using another's distinctive trademark. If it is actionable, use of a mark is "speech" covered by the First Amendment. This includes use of a trademarked word or logo to identify a product source, as well as use of trademarked terms to trigger keyword advertising on the Internet and the use of another's protected trade dress, such as distinctive product designs or colors. Laws regulating such speech may be constitutional, but their constitutionality must at least be considered.

Davis v. Walt Disney Co., 430 F.3d 901, 903 (8th Cir. 2005) (same). *But see* L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26 (1st Cir. 1987) (holding a trademark injunction issued pursuant to the Maine anti-dilution statute violated the First Amendment).

26. *See infra* Part III.A.; *see also* Ramsey, *supra* note 11, at 154-63 (discussing cases).

27. This Article focuses on the constitutionality of trademark laws that regulate the use of language claimed as a trademark, with a primary focus on federal trademark law. It does not address the constitutionality of federal statutes allowing the U.S. Patent and Trademark Office to refuse to register certain trademarks, nor does it address whether false advertising laws or specific state trademark laws are constitutional. These important topics are beyond the scope of this Article.

28. *See infra* Part II.A.&B.

In the second half of Part II, I argue that courts should not dispose of First Amendment challenges to trademark laws and injunctions by summarily concluding that infringing use of a trademark is misleading commercial speech categorically excluded from First Amendment protection. Contrary to the assumption of most courts and scholars, I contend not every commercial use of a mark that is likely to cause confusion rises to the level of “misleading” speech.²⁹ As I have argued elsewhere,³⁰ the misleading commercial speech categorical exception should not apply to use of another’s trademarked term to accurately describe the attributes of the defendant’s product, even if the descriptive term is used in a brand name, slogan, domain name, or otherwise “as a mark.” The misleading commercial speech exception should also not be used to ignore First Amendment concerns in trademark cases involving keyword advertising and commentary, parody, or satire where the mark is used to express commercial information or ideas unrelated to identification of the source of the defendant’s products or services. Even if some consumers are likely to be confused, these commercial uses of a mark have some expressive constitutional value for other consumers, and thus do not satisfy the high First Amendment threshold of “misleading” speech. Like trademark dilution laws, the constitutionality of these speech restrictions should be evaluated under the last three factors of the *Central Hudson* intermediate scrutiny test for commercial speech regulations.³¹ Once these laws are subject to real First Amendment scrutiny, their constitutionality becomes seriously suspect.³²

At the end of Part II, I explain how courts try to minimize the impact of trademark law on the free flow of expression by incorrectly characterizing trademark laws as content-neutral speech regulations.³³ Professors Volokh and Lemley correctly argue that trademark laws are content-based speech regulations, even though they are generally viewpoint-neutral.³⁴ I supplement their excellent scholarship on this topic by providing a more detailed application of the Court’s content-based/content-neutral jurisprudence to trademark law and set forth additional arguments demonstrating why trademark laws are content-based speech regulations. I argue the government is engaging in “word choice discrimination”—not just subject matter discrimination—when it bans the unauthorized use of trademarked words and symbols in certain types of speech. Content-based restrictions of noncommercial speech are usually subject to strict scrutiny analysis, which is almost always fatal. If the Court’s current First Amendment jurisprudence is faithfully applied, this raises serious ques-

29. See *infra* Part II.C.

30. Ramsey, *supra* note 7, at 1148-52.

31. Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n, 447 U.S. 557, 566 (1980); see *infra* Part I.A., II.D.1.

32. See *infra* Part II.D.1.

33. See *infra* Part II.D.2.

34. Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After Eldred*, 44 *Liquormart, and Bartnicki*, 40 *Hous. L. Rev.* 697, 703, 707-13 (2003); Lemley & Volokh, *supra* note 5, at 218-20.

tions regarding the constitutionality of trademark laws and injunctions regulating noncommercial speech, including most noncommercial commentary, parody, and satire. Yet legislatures and courts will likely (and should) decide the First Amendment allows the government to prohibit some misleading uses of trademarks “as marks” in noncommercial speech, such as unauthorized use of the distinctive marks of political or religious organizations to falsely identify the defendant’s organization.³⁵

Courts may conclude that some trademark laws satisfy strict scrutiny or decide that trademark laws should be subject to less stringent constitutional scrutiny. Such a result would not be surprising since the goals of trademark law are less insidious compared to other content-based speech regulations.³⁶ The Supreme Court may adopt some version of the *Rogers* balancing test for trademark disputes or create a new First Amendment balancing test for trademark laws. Alternatively, the Court may instead decide that certain types of trademark laws—such as core trademark infringement laws—are categorically constitutional, like the Supreme Court did in *Eldred* for “the traditional contours of copyright protection.”³⁷ Any of these approaches to resolving the conflict between trademark and free speech rights is preferable to courts ignoring free speech concerns in trademark cases.

In Part III, I evaluate the various options for courts considering a First Amendment challenge to a trademark law. Courts may use contextual speech-protective interpretations of trademark law, constitutional analysis, or categorical trademark rules to protect expression in individual trademark disputes. Each method has its advantages and disadvantages. The best way to protect free speech in trademark law generally is for federal and state legislatures to enact more trademark rules or categorical safe harbors similar to the exemption for noncommercial use of a mark in federal dilution law.³⁸ If legislatures do not enact more speech-protective rules in the trademark statutes, courts should create them in the common law unless such a construction of the statute is plainly contrary to its terms or the intent of the legislature. When the statute does not permit an interpretation that would make it constitutional, courts should not hesitate to apply constitutional analysis and find that trademark law violates the First Amendment.

The First Amendment’s free expression clause is relevant in trademark disputes and may be a useful (although imperfect) tool for limiting the expansion of trademark law. First Amendment doctrine is complex, inconsistent, and problematic in a number of ways, but this is not sufficient reason to exclude trademarks from First Amendment protection or avoid constitutional analysis of unconstitutional trademark laws. The First Amendment is not an absolute defense to application of trademark law,

35. See *infra* Part II.D.2.d.

36. *Id.*

37. *Eldred v. Ashcroft*, 537 U.S. 186, 221 (2003).

38. 15 U.S.C. § 1125(c)(3)(C) (2006).

but it does require legislatures and courts to explicitly consider and protect free speech values when they regulate trademarks.

I. INCREASING FIRST AMENDMENT PROTECTION FOR COMMERCIAL SPEECH

Trademark laws, such as the Federal Trademark Act of 1946 (more commonly known as the Lanham Act), regulate the use of words, names, symbols, or devices as trademarks to communicate with the public.³⁹ They primarily regulate commercial speech. Commercial speech is within the scope of the First Amendment's free expression clause, but it is not fully protected today. This Part first provides background information regarding the Supreme Court's evolving commercial speech doctrine, and then explains how the Court's current definition of commercial speech applies to different uses of a trademark that may be actionable today under trademark law.

A. THE EVOLUTION OF THE U.S. SUPREME COURT'S COMMERCIAL SPEECH DOCTRINE

The Supreme Court's First Amendment jurisprudence has become increasingly protective of commercial speech. Back in 1942, in *Valentine v. Chrestensen*, the Court held that "the Constitution imposes no restraint on government as respects purely commercial advertising."⁴⁰ For over thirty years, the Court's view after *Valentine* was "that commercial advertising was unprotected by the First Amendment."⁴¹ The only issue during this period was "whether something was properly characterized as commercial speech."⁴²

A major shift in the Court's commercial speech doctrine occurred in 1976 in *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.*⁴³ This case involved a First Amendment challenge of a state statute prohibiting pharmacists from advertising the price of prescription drugs.⁴⁴ For the first time, the Court explicitly held that the First Amendment protects commercial speech.⁴⁵ It defined commercial speech as "speech which does no more than propose a commercial transaction."⁴⁶

39. See Trademark Act of 1946, Pub. L. No. 79-489, 60 Stat. 427 ("Lanham Act"); 15 U.S.C. § 1127 (2000) (defining the term "trademark").

40. 316 U.S. 52, 54 (1942).

41. *Greater New Orleans Broad. Ass'n, Inc. v. United States*, 527 U.S. 173, 176 (1999).

42. C. Edwin Baker, *The First Amendment and Commercial Speech 2* (Univ. of Pa. Law School, Public Law & Legal Theory Research Paper Series, Research Paper No. 07-42, 2008), available at <http://ssrn.com/abstract=1019264>. This article will be published in French in *Liberté d'expression en Europe et aux Etats-Unis* (Daloz, 2008). See <http://lsr.nellco.org/upenn/wps/papers/182/>.

43. 425 U.S. 748, 762 (1976). According to Professor Barendt, "[t]he Supreme Court has considered the case for commercial speech coverage in many subsequent cases, but has not significantly added to the arguments deployed in *Virginia Pharmacy*." ERIC BARENDT, *FREEDOM OF SPEECH* 401 (2d ed. 2005).

44. *Va. Pharmacy*, 425 U.S. at 749-50.

45. *Id.* at 762-65, 770.

46. *Id.* at 762 (internal quotations omitted).

In its reasoning, the Court adopted a marketplace of ideas theory of the First Amendment and emphasized the informative value of commercial speech to its audience.⁴⁷ For example, it noted “a particular consumer’s interest in the free flow of commercial information . . . may be as keen, if not keener by far, than his interest in the day’s most urgent political debate.”⁴⁸ Further, it noted that “society also may have a strong interest in the free flow of commercial information” because it is “indispensable” to “intelligent and well informed” private economic decisions and “to the formation of intelligent opinions as to how that system ought to be regulated or altered.”⁴⁹ The Court was also concerned that truthful commercial speech would be prohibited due to government paternalism; in this case, the government thought price advertising would cause consumers to focus on price rather than quality.⁵⁰ The government should “assume that this information is not in itself harmful, that people will perceive their own best interests if only they are well enough informed, and that the best means to that end is to open the channels of communication rather than to close them.”⁵¹

After *Virginia Pharmacy*, commercial speech was within the scope of the First Amendment. Yet the Court said some regulations of commercial speech were still constitutionally allowed, including bans on false or misleading commercial speech, restrictions on advertising for illegal products, and regulations related to the time, place, or manner of commercial speech.⁵² Today, the First Amendment protects commercial speech to a lesser degree than political speech and other constitutionally guaranteed expression, such as scientific and academic speech, news, editorial commentary, literature, art, entertainment, and other public discourse.⁵³ Courts evaluate the constitutionality of nonmisleading commercial speech regulations under the *Central Hudson* intermediate scrutiny test.⁵⁴ Compared to strict scrutiny analysis, this test is relatively lenient.⁵⁵ Both tests are discussed in Part II.D.

According to the Court, there is a “commonsense distinction between speech proposing a commercial transaction . . . and other varieties of speech.”⁵⁶ Yet when developing its commercial speech doctrine, the

47. Baker, *supra* note 42, at 2-3 (citing Martin H. Redish, *The First Amendment in the Marketplace of Ideas: Commercial Speech and the Values of Free Expression*, 39 GEO. WASH. L. REV. 429, 431-33 (1971)).

48. *Va. Pharmacy*, 425 U.S. at 763.

49. *Id.* at 764-65.

50. *Id.* at 769-70.

51. *Id.* at 770.

52. *Id.* at 771-72.

53. See *United States v. Edge Broad. Co.*, 509 U.S. 418, 426 (1993); Robert Post, *The Constitutional Status of Commercial Speech*, 48 UCLA L. REV. 1, 5 (2000) (defining commercial speech and explaining how it differs from other forms of expression entitled to greater First Amendment protection).

54. *E.g.*, *Fla. Bar v. Went For It, Inc.*, 515 U.S. 618, 623 (1995) (applying *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557, 566 (1980)).

55. See Ashutosh Bhagwat, *The Test That Ate Everything: Intermediate Scrutiny in First Amendment Jurisprudence*, 2007 U. ILL. L. REV. 783, 794.

56. *Cent. Hudson*, 447 U.S. at 562 (internal quotations omitted).

Court has struggled to provide a workable definition of this type of speech entitled to lesser constitutional protection. Immediately after *Virginia Pharmacy*, it continued to define commercial speech as speech that "does no more than propose a commercial transaction."⁵⁷ In *Central Hudson*, the Court expanded the definition for commercial speech to "expression related solely to the economic interests of the speaker and its audience."⁵⁸ Yet in later cases, it declined to apply this broad definition. In *Bolger*, the Court noted the "core notion of commercial speech" is "speech which does no more than propose a commercial transaction."⁵⁹ In that case, however, the Court held the combination of several characteristics provided strong support for the conclusion that informational pamphlets about contraceptives were properly characterized as commercial speech even though they "cannot be characterized merely as proposals to engage in commercial transactions": (1) the speech was an advertisement; (2) the ad referenced a specific commercial product; and (3) the defendant had an economic motivation for the speech.⁶⁰ In 1989, the Court reaffirmed in *Fox* that "the test for identifying commercial speech" is not whether speech is sold for a profit, but whether it "proposes a commercial transaction."⁶¹ As of this writing, the Court continues to define commercial speech using the *Virginia Pharmacy* definition.⁶²

According to the Court, the determination of whether speech is "commercial" turns on "a matter of degree."⁶³ Commercial speech clearly includes advertising that provides information about products to induce a commercial transaction, such as commercial price and product advertising.⁶⁴ Yet it does not include all advertising. Some paid advertising, such as political advertising, is fully protected political speech.⁶⁵ In addition, speech other than advertising, such as personal direct solicitation of potential customers, is classified as commercial speech.⁶⁶ Commentators debate whether corporate speech about political or social issues, statements in a company prospectus or annual report, lifestyle or image advertisements, viral marketing, product placement, and political or social

57. *E.g.*, *Friedman v. Rogers*, 440 U.S. 1, 10 n.9 (1979); *Linkmark Assocs., Inc. v. Willingboro*, 431 U.S. 85, 98 (1977).

58. *Cent. Hudson*, 447 U.S. at 561.

59. *Bolger v. Youngs Drugs Prods. Corp.*, 463 U.S. 60, 66-68 & n.13 (1983) (holding that informational pamphlets on topics such as "Condoms and Human Sexuality" were commercial speech, but noting that defendants conceded the pamphlets were product advertisements).

60. *Id.* at 66-67.

61. *Bd. of Trs. of the State Univ. of N.Y. v. Fox*, 492 U.S. 469, 473-74, 482 (1989) (holding that the "Tupperware parties" held in campus dormitory rooms were commercial speech because they "propose a commercial transaction").

62. *E.g.*, *United States v. United Foods, Inc.*, 533 U.S. 405, 409 (2001).

63. *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 423 (1993).

64. *See Metromedia, Inc. v. City of San Diego*, 453 U.S. 490, 505-07 (1981); *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 761-62 (1976).

65. *See N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 266 (1964).

66. *Edenfield v. Fane*, 507 U.S. 761, 765 (1993) (accountants); *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 473-75 (1989) (Tupperware salespersons).

commentary on blogs for business development purposes should be classified as commercial speech.⁶⁷

The Court acknowledged the inconsistency and indeterminacy of its commercial speech doctrine in *City of Cincinnati*.⁶⁸ Moreover, it emphasized that courts must be careful not to “place too much importance on the distinction between commercial and noncommercial speech.”⁶⁹ Justice Stevens has noted the “artificiality of a rigid commercial/non-commercial distinction.”⁷⁰ Justice Thomas doubts “whether it is even possible to draw a coherent distinction between commercial and noncommercial speech.”⁷¹ Similar concerns are raised by scholars.⁷² The failure of the Court to provide an effective definition for commercial speech has led some critics to argue that the Court should completely eliminate the First Amendment distinction between commercial and noncommercial speech.⁷³ The Court has not adopted this proposal, but it has increased First Amendment scrutiny of regulations of nonmisleading commercial speech. Recently, the Court applied the *Central Hudson* test to strike down several commercial speech regulations as unconstitutional.⁷⁴

Moreover, some Justices have argued that the Court should use stronger First Amendment scrutiny when evaluating the constitutionality of government restrictions of truthful and nonmisleading commercial speech. In *Central Hudson*, three members of the Court—Justices Brennan, Blackmun, and Stevens—stated that they would have held that any ban on truthful and nonmisleading commercial advertisements should be struck down regardless of whether it satisfied the *Central Hudson* test.⁷⁵ In the *Rubin* case in 1995, Justice Stevens argued in a concurring opinion that “the formulaic approach” of *Central Hudson* was “unsuited” for a speech regulation that “neither prevents misleading speech nor protects

67. E.g., BARENDT, *supra* note 43, at 395-99; ERWIN CHERMERINSKY, CONSTITUTIONAL LAW: PRINCIPLES AND POLICIES 1088-89 (3d ed. 2006); Erwin Chemerinsky & Catherine Fisk, *What is Commercial Speech? This Issue Not Decided in Nike v. Kasky*, 54 CASE W. RES. L. REV. 1143, 1143-45 (2004); Robert Sprague, *Business Blogs and Commercial Speech: A New Analytical Framework for the 21st Century*, 44 AM. BUS. L.J. 127 (2007).

68. See *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 422-23 (1993).

69. *Id.* at 424.

70. *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 494 (1995) (Stevens, J., concurring).

71. *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 575 (2001) (Thomas, J., concurring).

72. See, e.g., Alex Kozinski & Stuart Banner, *Who's Afraid of Commercial Speech?*, 76 VA. L. REV. 627, 627-28 (1990) (arguing “the commercial/noncommercial distinction makes no sense”); Post, *supra* note 53, at 5 (noting that the “boundaries” of commercial speech are “quite blurred”).

73. E.g., Kozinski & Banner, *supra* note 72, at 650-53. Other scholars disagree. See, e.g., BARENDT, *supra* note 43, at 398; Chemerinsky & Fisk, *supra* note 67, at 1156-60.

74. E.g., *Thompson v. W. States Med. Ctr.*, 535 U.S. 357, 367-77 (2002) (plurality opinion); *Lorillard*, 533 U.S. at 554-56, 561-66 (plurality opinion); *Greater New Orleans Broad. Ass'n, Inc. v. United States*, 527 U.S. 173, 183-96 (1999); *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 504-08 (1996) (plurality opinion); *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 482-91 (1995).

75. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 572 (1980) (Brennan, J., concurring); *id.* at 573 (Blackmun, J., with Brennan, J., concurring); *id.* at 579, 583 (Stevens, J., with Brennan, J., concurring).

consumers from the dangers of incomplete information.”⁷⁶ One year later in *44 Liquormart*, Justice Stevens, writing for a plurality of the Court, said when the government “entirely prohibits the dissemination of truthful, nonmisleading commercial messages for reasons unrelated to the preservation of a fair bargaining process, there is far less reason to depart from the rigorous review that the First Amendment generally demands.”⁷⁷ In concurring opinions in *44 Liquormart* and *Lorillard*, respectively, Justices Scalia and Kennedy also expressed concern that the *Central Hudson* test does not sufficiently protect truthful and nonmisleading commercial speech.⁷⁸ In 2002, a plurality of Justices in *Thompson* said the government is prohibited from suppressing commercial speech “in order to prevent members of the public from making bad decisions with the information.”⁷⁹

Justice Thomas is currently the Court’s most vocal critic of *Central Hudson*. In several concurring opinions, Justice Thomas expressed his disapproval of the *Central Hudson* test when applied to government bans on truthful and nonmisleading commercial speech. Where “the government’s asserted interest is to keep legal users of a product or service ignorant in order to manipulate their choices in the marketplace,” Justice Thomas concluded in *44 Liquormart* that, “such an ‘interest’ is *per se* illegitimate and can no more justify regulation of ‘commercial’ speech than it can justify regulation of ‘noncommercial’ speech.”⁸⁰ He did “not believe that [the *Central Hudson*] test should be applied to a restriction of ‘commercial’ speech, at least when, as here, the asserted interest is one that is to be achieved through keeping would-be recipients of the speech in the dark.”⁸¹ Justice Thomas quoted his statements from *44 Liquormart* with approval in subsequent concurring opinions in *Greater New Orleans* (1999), *Lorillard* (2001), and *Thompson* (2002).⁸² In *Lorillard*, he further argued that, “when the government seeks to restrict truthful speech in order to suppress the ideas it conveys, strict scrutiny is appropriate, whether or not the speech in question may be characterized as ‘commercial.’”⁸³ According to Justice Thomas, “there is no philosophical or historical basis for asserting that ‘commercial’ speech is of ‘lower value’ than ‘noncommercial’ speech.”⁸⁴

While acknowledging such criticisms of the *Central Hudson* test, the Court continues to apply the *Central Hudson* analysis to government re-

76. *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 491–92 (1995) (Stevens, J. concurring).

77. 517 U.S. at 501, 510-14 (joint opinion of Stevens, Kennedy, and Ginsburg, JJ.).

78. *Id.* at 517 (Scalia, J., concurring); *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 571-72 (Kennedy, J., concurring).

79. *Thompson v. W. States Med. Ctr.*, 535 U.S. 357, 374–76 (2001) (plurality opinion).

80. 517 U.S. at 518.

81. *Id.* at 523.

82. *Greater New Orleans Broad. Ass’n, Inc. v. United States*, 527 U.S. 173, 197 (1999) (Thomas, J., concurring); *Lorillard*, 533 U.S. at 572, 575 (Thomas, J., concurring); *Thompson*, 535 U.S. at 377 (Thomas, J., concurring).

83. 533 U.S. at 572.

84. *Id.* at 575 (internal quotation omitted).

strictions on truthful and nonmisleading commercial speech.⁸⁵ This may change given recent developments in the composition of the Court. Republican President George W. Bush recently appointed two new Justices to the Court: Chief Justice John Roberts and Justice Samuel Alito. If these Justices have a similar perspective on *Central Hudson* and the Court's commercial speech doctrine as Justices Thomas, Scalia, Kennedy, and Stevens (all appointed by Republican Presidents), then it is possible that the Court will abandon the *Central Hudson* test and further increase First Amendment scrutiny of commercial speech regulations. Those who reject the argument that certain trademark laws fail *Central Hudson* scrutiny would have to concede that strict scrutiny analysis will be fatal for many trademark laws regulating nonmisleading commercial speech.

Although some Justices advocate "repudiation of the *Central Hudson* standard and implementation of a more straightforward and stringent test for assessing the validity of governmental restrictions on commercial speech,"⁸⁶ these same justices have not argued in published opinions that *false or misleading* commercial speech should receive constitutional protection. Language in past opinions suggests that a majority of the Court is unlikely to conclude that untruthful commercial speech is protected by the First Amendment.⁸⁷ The categorical exclusion from First Amendment protection for misleading commercial speech makes much of trademark law constitutional, but it does not resolve every conflict between trademark and free speech rights. Trademark laws are also applied by courts to nonmisleading commercial speech and noncommercial speech.

B. TRADEMARKS AND COMMERCIAL SPEECH

Trademarks are used in both commercial and noncommercial speech. As commercial speech is currently entitled to less First Amendment protection, classification of a trademark use as commercial or noncommercial may be critical to a determination of the constitutionality of a trademark law regulating that speech. As discussed above, commercial speech is "usually defined as speech that does no more than propose a commercial transaction."⁸⁸ The discussion below assumes this statement defines commercial speech in the context of trademark law.⁸⁹ Although it may be difficult, if not impossible, to draw an exact line between commercial and noncommercial speech in trademark disputes, use of a mark

85. *E.g.*, *Thompson*, 535 U.S. at 367-68; *Greater New Orleans*, 527 U.S. at 183-84; 44 *Liquormart, Inc. v. Rhode Island*, 517 U.S. 484 (1996); *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 486-87 (1995); *Edenfield v. Fane*, 507 U.S. 761, 770 (1993).

86. *Greater New Orleans*, 527 U.S. at 184.

87. *E.g.*, *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 771-72 (1976); *see infra* Part II.C.2.

88. *United States v. United Foods, Inc.*, 533 U.S. 405, 409 (2001).

89. Whether this is the proper definition of commercial speech in trademark cases is beyond the scope of this Article. Some courts apply this definition of commercial speech in trademark cases while interpreting the noncommercial use exemption in the federal dilution statute. *E.g.*, *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1017 (9th Cir. 2004).

in commercial advertising and packaging for specific commercial products clearly fits within the definition of “pure commercial speech.” Other uses of a mark do not.

The expression is commercial when a word, name, symbol, or device is used as a trademark to identify and distinguish the source of commercial goods or services.⁹⁰ The trademark encourages consumers to enter into a commercial transaction by providing information as to who is producing or selling this commercial product advertised or sold under the mark.⁹¹ Like the use of a trade name, these source-identifying uses of a trademark are pure commercial speech because the “purpose is strictly business” and they “are used as part of a proposal of a commercial transaction.”⁹²

Trademarks are also used in commercial speech in other ways. One example is the use of trademarked descriptive terms in advertising or on product packaging to describe the qualities or characteristics of products, rather than identify their source. Other examples include use of the mark to refer to the trademark holder in comparative advertising or advertising for complementary goods or services, such as repair services.⁹³ A firm may also use its competitor’s mark in ads to parody the trademark holder, its products, or its mark, such as MTD’s parody of John Deere’s deer logo in a television advertisement, which showed an animated version of the deer “pursued by [MTD’s] Yard-Man lawn tractor and a barking dog.”⁹⁴ Use of another’s trademark to trigger the display of a commercial advertisement on the Internet, such as a pop-up ad or sponsored link, is also a commercial use of the mark.⁹⁵ Most trademark disputes involve commercial use of a mark that is identical or similar to another firm’s trademark.

Some words are used as trademarks but are not commercial speech. For example, political groups use trademarks, such as “United We Stand America” or “MoveOn.org,”⁹⁶ to identify the source of their activities

90. McCARTHY, *supra* note 2, § 31:139; Denicola, *supra* note 5, at 193; Lemley & Volokh, *supra* note 5, at 219.

91. See *Va. Pharmacy*, 425 U.S. at 765 (“Advertising . . . is . . . dissemination of information as to who is producing and selling what product, for what reason, and at what price.”); Ramsey, *supra* note 7, at 1137-38.

92. *Friedman v. Rogers*, 440 U.S. 1, 11 (1979) (“The use of trade names in connection with optometrical practice, then, is a form of commercial speech and nothing more.”); McCARTHY, *supra* note 2, §31:139 (“It would appear clear that a firm’s trademark is the most important element of commercial speech which is communicated to customers. All other elements of advertising revolve around, relate to and are symbolized by the trademark.”).

93. *Smith v. Chanel, Inc.*, 402 F.2d 562, 563 (9th Cir. 1968) (competitor’s advertisement for imitation perfume); *Volkswagenwerk Aktiengesellschaft v. Church*, 411 F.2d 350, 352 (9th Cir. 1969) (automobile repair shop advertises it repairs Volkswagens).

94. *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 41 (2d Cir. 1994).

95. *1-800 Contacts, Inc. v. WhenU.com, Inc.*, 414 F.3d 400, 412 (2d Cir. 2005).

96. *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 88 (2d Cir. 1997) (noting “United We Stand America” is a registered “service mark initially used by the principal campaign committee for Ross Perot’s 1992 presidential campaign”); U.S. Trademark Reg. No. 1,844,852 (cancelled) (registered by United We Stand America, Inc. for “conducting voter registration drives, voter forums, polls and referendums in the field of public policy, for non-business, non-marketing purposes; and issues and candidate research activities and dissemination of information in the field of public policy”); U.S.

and distinguish themselves from other organizations. Trademarks are also used in other ways to convey noncommercial information or ideas. Examples include unauthorized use of a trademark within the content of news reporting, news commentary, consumer product reviews, and dictionaries. When politicians use a trademarked term without authorization to convey political ideas, such as “Change Rocks,”⁹⁷ this is also noncommercial speech,⁹⁸ even if the term is displayed on T-shirts and other political memorabilia sold to the public by the political campaign. In no way does this speech propose a *commercial* transaction.

Courts disagree on the boundary between commercial and noncommercial speech in cases involving the entertainment industry’s use of words or logos claimed by others as trademarks in the titles or content of artistic or literary expression. Examples include use of the “Barbie” mark in the song and song title *Barbie Girl* by the rock band Aqua,⁹⁹ use of the trademarked word “Polo” for the title of a magazine *Polo*,¹⁰⁰ use of the “Dr. Seuss” and “The Cat in the Hat” marks and Cat’s stove-pipe hat logo in the book *The Cat Not in the Hat! A Parody by Dr. Juice* about the O.J. Simpson trial written in the style of Dr. Seuss,¹⁰¹ use of the “Spam” mark for luncheon meat for the name of a wild boar Muppet “Spa’am” in a children’s film,¹⁰² use of the “Michelob Dry” mark and related marks in a fake magazine ad for “Michelob Oily” beer commenting on water pollution,¹⁰³ use of L.L. Bean’s marks in a sexually-oriented parody of the L.L. Bean catalogue,¹⁰⁴ use of the “Star Wars” marks in the pornographic

Trademark Reg. No. 3,166,180 (registered by MoveOn.org Civil Action Corporation for “Organizing, planning, arranging and conducting events relating to politics, political campaigns, media relations, public policy, leadership, networking, and the legislative process”).

97. Moran Alterio, *Scarsdale Teen Jilted by Obama’s Slogan*, JOURNAL NEWS, Jan. 10, 2008, at 1A.

98. See, e.g., *MasterCard Int’l Inc. v. Nader 2000 Primary Comm., Inc.*, No. 00 Civ. 6068, 2004 WL 434404, *9 (S.D.N.Y. 2004) (finding no infringement or dilution of the marks when presidential candidate Ralph Nader used MasterCard’s trademarks in a political ad that criticized the other two presidential candidates); *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682, 695-701 (N.D. Ohio 2002) (discussing politician’s use of AFLAC’s trademarks to criticize his opponent in a political campaign, including using a duck similar to the AFLAC duck and the domain name www.taftquack.com).

99. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905-07 (9th Cir. 2002) (holding the parody was noncommercial even though the song recording was commercially sold).

100. *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 672 (5th Cir. 2001) (holding that “a magazine title is a hybrid between commercial and artistic speech” and noting the magistrate judge said the title was “commercial speech”).

101. *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403-06 (9th Cir. 1997) (noting the use of Dr. Seuss’s copyrighted works was “admittedly commercial” and characterizing the trademark use as “commercial use”).

102. *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 500-01 (2d Cir. 1996). The issue of the noncommercial nature of the film was not mentioned in the opinion, but the court did note the defendants planned to sell licensed products with scenes from the film. *Id.* at 501.

103. *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 772-73, 778 (8th Cir. 1994) (rejecting the magazine’s argument that the Missouri state anti-dilution statute could not be applied to noncommercial speech).

104. *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 32-33 (1st Cir. 1987) (holding this use was noncommercial).

animated film parody *Starballz*,¹⁰⁵ and use of the "Dairy Queen" mark in the title of the film *Dairy Queens* about beauty pageants in the Midwest.¹⁰⁶

The fact that artistic and literary expression is sold for profit does not make that expression *per se* commercial.¹⁰⁷ Newspapers and books are sold commercially, but they are traditional noncommercial speech fully protected by the First Amendment.¹⁰⁸ In *Burstyn*, the Court specifically held "that expression by means of motion pictures is included within the free speech and free press guaranty" in the Constitution even though the production, distribution, and exhibition of a film "is a large-scale business conducted for private profit."¹⁰⁹ As *Burstyn* was decided in 1952 before the Court held that commercial speech was entitled to First Amendment protection in 1976,¹¹⁰ the *Burstyn* Court implicitly characterized motion pictures as noncommercial speech when it held this expression is protected by the First Amendment. Unless the work is itself an advertisement selling a specific commercial product,¹¹¹ use of another's mark within the content of artistic or literary expression should generally be classified as noncommercial speech that is fully protected by the First Amendment. When it is used in this context, the trademark clearly does not propose a *commercial* transaction.¹¹²

The titles of artistic or literary works are also not "core" commercial speech regardless of whether they contain words claimed as trademarks. A title can be an integral part of the noncommercial expression. At most, an artistic or literary title could be characterized as "hybrid" or "mixed" speech with commercial and noncommercial components.¹¹³ An artistic or literary title may encourage consumers to purchase the movie ticket, song, or book. Yet a title is not pure commercial speech, even if it is used

105. *Lucasfilm Ltd. v. Media Mkt. Group, Ltd.*, 182 F. Supp. 2d 897, 900-01 (N.D. Cal. 2002) (concluding this parody was noncommercial speech exempted from liability under federal dilution law).

106. *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 735 (D. Minn. 1998) (characterizing this use of the mark as commercial).

107. *Bd. of Trs. of N.Y. v. Fox*, 492 U.S. 469, 482 (1989); *N.Y. Times v. Sullivan*, 376 U.S. 254, 266 (1964). See generally David McGowan, Comment, *A Critical Analysis of Commercial Speech*, 78 CAL. L. REV. 359 (1990).

108. *Sullivan*, 376 U.S. at 266; see also CHEMERINSKY, *supra* note 67, at 1088.

109. *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501-02 (1952).

110. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976).

111. *Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60, 66-67 (1983). It can be difficult to distinguish between commercial advertising and noncommercial speech, especially when advertisements are creative and resemble traditional artistic or literary works in format or style. See generally Lisa P. Ramsey, *Intellectual Property Rights in Advertising*, 12 MICH. TELECOMM. TECH. L. REV. 189, 237-46 (2006).

112. Artistic and literary works also do not fit within the broader definition of commercial speech set forth in *Central Hudson*: "expression related *solely* to the economic interests of the speaker and its audience." *Cent. Hudson Gas & Electric Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 561 (1980) (emphasis added).

113. *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989) ("Titles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion. The title of a movie may be both an integral element of the film-maker's expression as well as a significant means of marketing the film to the public.").

in advertising, because the title has an expressive function. When the commercial and noncommercial aspects of speech are “inextricably intertwined,” which is usually the case for titles,¹¹⁴ courts should evaluate the constitutionality of restrictions of that speech using the “test for fully protected expression.”¹¹⁵

As discussed later in Part II.D.2., content-based restrictions of noncommercial speech are usually subject to strict scrutiny analysis. Application of trademark law to uses of marks within the content or titles of artistic or literary works will likely not survive such heightened scrutiny.¹¹⁶ If the judges had used strict scrutiny analysis in the *Dr. Seuss, Anheuser-Busch*, and *American Dairy Queen* cases,¹¹⁷ they probably would have ruled for the defendants rather than the plaintiffs on the trademark infringement claims. Of course, it is possible the Supreme Court will adopt a less stringent constitutional standard for trademark law or even craft a trademark-specific First Amendment test to balance trademark and free speech rights.¹¹⁸ The latter approach has been used by lower courts in disputes over the unauthorized use of marks in artistic and literary expression. Rather than apply strict scrutiny analysis, courts instead state that the Lanham Act “should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”¹¹⁹ Under the “*Rogers* balancing test,” a title incorporating another’s mark does not violate the Lanham Act “unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.”¹²⁰ This test can protect speech in

114. *E.g.*, *Parks v. LaFace Records*, 329 F.3d 437, 449 (6th Cir. 2003) (“The names artists bestow on their art can be part and parcel of the artistic message The fact that Defendants use the Rosa Parks title in advertising does not automatically erase the expressive function of the title and render it mere commercial exploitation; if a song is sold, and the title is protected by the First Amendment, the title naturally will be ‘inextricably intertwined’ with the song’s commercial promotion.”); *Rogers*, 875 F.2d at 998 (noting “[t]he artistic and commercial elements of titles are inextricably intertwined” and holding that “the expressive element of titles requires more protection than the labeling of ordinary commercial products”).

115. *Riley v. Nat’l Fed’n of the Blind*, 487 U.S. 781, 796 (1988); *see also* DAVID S. WELKOWITZ, *TRADEMARK DILUTION: FEDERAL, STATE, AND INTERNATIONAL LAW* 328-31 (2002). Like a title, advertising that promotes noncommercial speech is hybrid speech with commercial and noncommercial components. It is more commercial than a title, however, because it is an advertisement and its primary purpose is to encourage the purchase of the expression rather than to identify it. On the other hand, this speech is less commercial than advertising for a commercial product. If the artistic and commercial elements of the advertisement are inextricably intertwined, restrictions of that ad may also be evaluated using the test for fully protected expression. *Id.*

116. *See infra* Part II.D.2.d.

117. *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997); *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769 (8th Cir. 1994); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727 (D. Minn. 1998).

118. *See infra* Part II.D.2.d.

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

120. *Id.*; *see also* *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901-02 (9th Cir. 2002) (adopting the *Rogers* balancing test in a trademark action). Some courts applying the *Rogers* balancing test hold that the likelihood of confusion must be particularly compelling to

individual trademark cases, although it has limitations¹²¹ and is more likely to permit restrictions of protected speech than strict scrutiny analysis.

Distinguishing between commercial and noncommercial uses of trademarks on T-shirts and other novelty or expressive merchandise is also complicated because trademarks can serve different communicative functions when displayed on merchandise. Context is important. As noted above, the expression is commercial if the mark is used to identify the source of the commercial product. Whether a certain use of trademarked language on a T-shirt proposes a commercial transaction to a consumer may depend on whether a reasonable consumer would think this language is source-identifying rather than expressive in this context. The display of a trademark symbol (® or ™) with the phrase suggests the mark is being primarily used in a commercial manner to identify source. The location of the mark on the T-shirt may also indicate whether the expression is commercial. When trademarked words, such as "Nike," "San Diego Padres," "UCLA," "Life is Good," or "No Fear" are used on the inside label of a T-shirt or a tag attached to the product to identify the source or licensor of that merchandise, this is pure commercial speech. The trademark use does no more than propose a commercial transaction because it identifies the source or licensor of this merchandise, which may induce consumers to purchase the product.

It is less clear that use of a trademark on merchandise is purely commercial, however, if the trademarked language or logo is displayed prominently on the front or back of the T-shirt. Expression is not inherently commercial just because it appears on a T-shirt, hat, or other expressive product sold to the public. Although trademark holders emblazon their marks on the front of T-shirts for promotional purposes, this practice does not make all expression on T-shirts commercial, especially when the words consist of common phrases that communicate ideas, such as "Life is Good" or "No Fear."¹²² If a manufacturer obtained trademark rights in the phrase "Freedom of Expression" for sportswear, and displayed this term on the front of T-shirts, would the display of this identical phrase on the front of T-shirts by third parties automatically be classified as commercial speech? The answer should be no if we truly believe in freedom of expression.

Unlike a trade name used on a sign to identify the source of services,¹²³ one cannot assume that language displayed on the front of a T-shirt is

outweigh the First Amendment interests at stake. *E.g.*, *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664-65 (5th Cir. 2001); *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir.1993).

121. *McGeveran*, *supra* note 11, at 56-64.

122. "Life is Good" and "No Fear" are registered marks for sportswear. *See No Fear, Inc. v. Imagine Films, Inc.*, 930 F. Supp. 1381, 1381 (C.D. Cal. 1995) (noting the plaintiff filed suit against producers of a film entitled "No Fear"); *supra* note 1 (citations relating to the "Life is Good" litigation).

123. *See Friedman v. Rogers*, 440 U.S. 1, 11 n.10 (1979) (noting "the mere solicitation of patronage implicit in a trade name").

used “as a mark” or is commercial speech. A consumer may purchase the merchandise because of the inherent meaning of the phrase claimed as a mark or because that trademark has intrinsic value—the mark is the product—not because it identifies the source or official sponsor of the merchandise.¹²⁴ As noted by one district judge, T-shirts often serve as personal billboards in our culture “carrying phrases that convey meanings that can range from entirely personal to political to humorous.”¹²⁵ Like T-shirts carrying messages advocating the legalization of marijuana, T-shirts carrying messages incorporating another’s trademark “are a medium of expression prima facie protected by the free-speech clause of the First Amendment, and they do not lose their protection by being sold rather than given away.”¹²⁶ T-shirts can be a “vehicle of . . . ideas and opinions” just like a newspaper.¹²⁷ Moreover, a message may reach a different segment of the public when disseminated on T-shirts and other expressive merchandise rather than in traditional media.

For all of these reasons, I believe expression publicly displayed on the front or back of a T-shirt or other expressive merchandise should generally be characterized as pure noncommercial speech unless reasonable consumers believe that language partly or primarily identifies the source or licensor of the product. If the expression does not serve any source-identifying function, it should be presumed noncommercial even if it is sold for profit. If that language is partly or primarily source-identifying, but still has an expressive function, it should be characterized as hybrid or mixed speech. Where the noncommercial nature of the speech predominates, or the commercial and noncommercial components are inextricably intertwined, restrictions on that expression should be evaluated under the test for fully protected expression.¹²⁸ An example is the display on T-shirts and other novelty merchandise of the terms “Walocaust” and “Wal-Queda,” which are parodies of Wal-Mart.¹²⁹ Although the Supreme Court and Eighth Circuit thought differently, I also believe that use of the term “Olympic” in the phrase “Gay Olympic Games”¹³⁰ and use of the

124. See generally Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 *EMORY L.J.* 461 (2005); Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 *YALE L.J.* 1717 (1999).

125. *Juicy Couture, Inc. v. L’Oreal USA, Inc.*, No. 04 Civ. 7203, 2006 WL 1012939, at *17-18 (S.D.N.Y. April 19, 2006) (holding the T-shirt “slogans Wear Juicy, Juicy Pop Princess, Be Juicy, Juicy Girls Rule, and the Joy of Juicy” were not sufficiently distinctive for trademark protection).

126. *Ayres v. City of Chicago*, 125 F.3d 1010, 1014 (7th Cir. 1997) (Posner, C.J.) (citing *Heffrom v. Int’l Soc’y for Krishna Consciousness, Inc.*, 452 U.S. 640, 647 (1981)).

127. *Id.* at 1017 (stating that defendant’s T-shirts “are to [the seller] what the *New York Times* is to the Sulzbergers and the Ochs—the vehicle of her ideas and opinions”).

128. See *Riley v. Nat’l Fed’n of the Blind*, 487 U.S. 781, 796 (1988).

129. *E.g., Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302, 1340 (N.D. Ga. 2008) (granting defendant’s motion for summary judgment after finding this “parodic work is considered noncommercial speech and therefore not subject to Wal-Mart’s trademark dilution claims, despite the fact that Smith sold the designs to the public on t-shirts and other novelty merchandise”).

130. *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 535, 539 (1987) (“In this case, the SFAA sought to sell T-shirts, buttons, bumper stickers, and other items,

Mutual of Omaha mark and Indian Head logo in the “Mutant of Omaha” design to convey an anti-nuclear message¹³¹ on T-shirts and other merchandise should have been treated like noncommercial speech for purposes of First Amendment analysis. If the source-identifying nature of the expression predominates, only then should restrictions of this language on T-shirts be subject to intermediate constitutional scrutiny under *Central Hudson*.

Finally, in cases where the defendant uses a parodic or satirical variation of another’s mark “as its own designation of source, i.e., as a *trade-mark*,” for commercial products such as Haute Diggity Dog’s use of “Chewy Vuiton” as a mark for dog toys,¹³² this speech should be deemed commercial speech. The defendant is clearly using this mark to identify who is producing or selling a commercial product when it applies to register the term as a mark with the U.S. Patent and Trademark Office or uses trademark symbols (® or ™) with the phrase. This source-identifying expression, although humorous, is commercial and primarily proposes a commercial transaction.

Although the boundaries between commercial and non-commercial expression are uncertain, classification of a trademark use as commercial or noncommercial may be determinative on the issue of liability for some trademark claims. Congress explicitly excluded “any noncommercial use of a mark” from coverage of the Federal Trademark Dilution Act of 1995 (“FTDA”)¹³³ and the Trademark Dilution Revision Act of 2006 (“TDRA”), and thus federal dilution law only applies to uses of trademarks in commercial speech.¹³⁴ Courts have applied the noncommercial

all emblazoned with the title ‘Gay Olympic Games.’ The possibility for confusion as to sponsorship is obvious. Moreover, it is clear that the SFAA sought to exploit the ‘commercial magnetism . . . of the word given value in the USOC . . . [T]he application of the Act [which banned use of the word to induce the sale of goods] to this commercial speech is not broader than necessary . . .”).

131. *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 398, 402-03 & n.8-9 (8th Cir. 1987) (characterizing as “commercial” the defendant’s use of plaintiff’s marks “to market, advertise, or identify [defendant’s] services or products,” and noting the injunction allowed the defendant “to use the design in other ways—such as anti-nuclear pamphlets and the like”).

132. *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 266-67 (4th Cir. 2007); see also *Tommy Hilfiger Licensing, Inc. v. Nature Labs*, 221 F. Supp. 2d 410, 415-16 (S.D.N.Y. 2002) (“In this case, Nature Labs arguably uses an adaptation of the Hilfiger mark[—“Timmy Holedigger” for pet perfumes—]for the dual purpose of making an expressive comment and selling a non-competing product, an area where it has been noted that line-drawing becomes rather difficult However, because the mark is being used at least in part to promote a somewhat non-expressive, noncommercial product, the First Amendment does not extend to such use, or to the extent that it does, the balance tips in favor of allowing trademark recovery, if in fact consumers are likely to be confused When a parodist makes trademark use of another’s mark, it should be entitled to less indulgence, even if this results in some residual effect on the free speech rights of commercial actors.”) (citations and footnotes omitted).

133. Pub. L. No. 104-98, 109 Stat. 985 (1995) (codified at 15 U.S.C. § 1125(c)).

134. Pub. L. No. 109-312, 120 Stat. 1730 (2006) (amending 15 U.S.C. § 1125(c)); 15 U.S.C. § 1125(c)(3)(C) (2006). The legislative history of the FTDA suggests this provision “expressly incorporates the concept of ‘commercial’ speech from the ‘commercial speech’ doctrine, and proscribes dilution actions that seek to enjoin use of famous marks in ‘non-commercial’ uses (such as consumer product reviews).” H.R. REP. NO. 104-374, at 8

use exemption in dilution cases based on the use of trademarks in domain names for cybergrape websites,¹³⁵ the titles or content of artistic or literary expression,¹³⁶ and political advertisements.¹³⁷

Other federal trademark statutes do not explicitly contain a “commercial use” requirement or “noncommercial use” exemption. The noncommercial nature of the trademark use is only one of several factors considered for liability under the Anticybersquatting Consumer Protection Act of 1999 (“ACPA”).¹³⁸ The federal trademark registration and infringement statutes do not prohibit organizations from registering trademarks, or from suing others or being sued, for trademark infringement when the mark is used in noncommercial speech.¹³⁹ Although the infringement statutes require use of the mark “in commerce,”¹⁴⁰ some courts and scholars believe this phrase is jurisdictional—Congress may only regulate “commerce” within its control—and does not limit application of federal trademark law to commercial speech.¹⁴¹

Citing First Amendment concerns, a few courts have held that commercial use of the mark is required for an infringement claim under the Lanham Act.¹⁴² Others correctly note it is unclear from the legislative history whether Congress intended to limit application of the Lanham Act to commercial speech.¹⁴³ Regardless of the legislature’s true intent, some courts have held the Lanham Act is not limited to commercial speech and have applied trademark infringement statutes to uses of trademarks in noncommercial speech, including political and religious ex-

(1995). This Article assumes Congress meant to exclude noncommercial speech in this exemption. Whether this was its true intent is beyond the scope of this Article.

135. *Bosley Med. Inst., Inc.*, 403 F.3d 672, 679-80 (9th Cir. 2005); *TMI, Inc. v. Maxwell*, 368 F.3d 433, 438-40 (5th Cir. 2004); *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1167 (C.D. Cal. 1998).

136. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905-07 (9th Cir. 2002); *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 812 (9th Cir. 2003); *Lucasfilm Ltd. v. Media Mkt. Group, Ltd.*, 182 F. Supp. 2d 897, 900-01 (N.D. Cal. 2002).

137. *MasterCard Int'l Inc. v. Nader 2000 Primary Comm.*, No. 00 Civ. 6068, 2004 WL 434404, *9 (S.D.N.Y. 2004).

138. Pub. L. No. 106-113, 113 Stat. 1501 (1999) (codified at 15 U.S.C. § 1125(d)). Under the ACPA, a markholder can sue a person who “registers, traffics in, or uses a domain name” that is “identical or confusingly similar to” its distinctive mark, or “is identical or confusingly similar to or dilutive of” its famous mark, where that person has “a bad faith intent to profit from” the plaintiff’s mark. 15 U.S.C. § 1125(d)(1)(A) (2000). The defendant’s “bona fide noncommercial or fair use of the mark in a site accessible under the domain name” is one of nine nonexclusive factors relevant to the determination of whether the defendant has such a bad faith intent. 15 U.S.C. § 1125(d)(1)(B)(i)(IV).

139. See 15 U.S.C. §§ 1052, 1114(1), 1125(a)(1)(A) (2006).

140. 15 U.S.C. §§ 1114(1), 1125(a)(1)(A) (2000). The dilution statute also requires use of the mark or trade name “in commerce.” 15 U.S.C. § 1125(c) (2006).

141. See U.S. CONST., art. I, § 8, cl. 3, 8; 15 U.S.C. § 1127 (2000) (stating the Lanham Act “regulate[s] commerce within the control of Congress”); *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 92-93 (2d Cir. 1997); *WELKOWITZ*, *supra* note 115, at 333-34.

142. *E.g.*, *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 676-77 (9th Cir. 2005); *Taubman Co. v. Webfeats*, 319 F.3d 770, 774-75 (6th Cir. 2003).

143. *E.g.*, *Lamparello v. Falwell*, 420 F.3d 309, 313-14 (4th Cir. 2005); *Semco, Inc. v. Amcast, Inc.*, 52 F.3d 108, 111-12 (6th Cir. 1995).

pression.¹⁴⁴ It will be more difficult to prove government restrictions on use of a mark are constitutionally justified if the speech is noncommercial. The next Part explains why.

II. A FRAMEWORK FOR EVALUATING THE CONSTITUTIONALITY OF TRADEMARK LAWS UNDER THE FIRST AMENDMENT

Failure to recognize the potential conflict between trademark law and the First Amendment can harm protected speech and lead to more dubious assertions of trademark rights in language. It is easy to send a cease and desist letter to a competitor claiming trademark rights in a common word or phrase, such as "CyberLaw" for legal services,¹⁴⁵ "Pet Friendly" for products and services for pets and pet owners,¹⁴⁶ or "Beef Stick" or "Turkey Stick" for food products.¹⁴⁷ Descriptive terms can be protected as trademarks if they acquire distinctiveness and firms have sued to enforce trademark rights in them, such as "Thirst Aid" for a beverage.¹⁴⁸ As it is difficult to know whether a court will find a term to be descriptive or an unprotected generic term, the threat of a lawsuit may be sufficient to deter further use of descriptive or generic terms claimed as trademarks by competitors. Firms also sue to stop criticism or parody that incorporates their trademarks, such as Wal-Mart's lawsuit against the man who used "Walocaust" and "Wal-Queda" on T-shirts and other novelty merchandise.¹⁴⁹ Trademark law stifles protected speech if it restricts, or is

144. *E.g., United We Stand*, 128 F.3d at 92-93 (holding the Lanham Act's "use in commerce" language does not limit the Lanham Act to profit-seeking uses of a mark and applying the infringement statute to defendant's use of the mark "United We Stand America" to associate itself with the political movement that sponsored Ross Perot's political campaign); *Gen. Conference Corp. of Seventh-Day Adventists v. Perez*, 97 F. Supp. 2d 1154, 1164 (S.D. Fla. 2000) (holding use of the "Seventh-day Adventist" and "SDA" marks by an unaffiliated church infringed the marks of the national religious organization).

145. Eric Menhart, an attorney at the law firm CyberLaw P.C. with a blog called "CyberLawg," filed a trademark application on December 1, 2007 for the term "CyberLaw" for legal services and asserted alleged trademark rights against Michael Grossman, a Chicago attorney who runs a blog with the name "CyberBlawg." U.S. Trademark Serial No. 77,341,910 (filed Dec. 1, 2007); *Of CyberLaw and CyberLawg*, <http://www.cyberlaw.pro/cyberlawg/general-interest/of-cyberlaw-andcyberlawg.html> (Jan. 19, 2008) (stating that "[t]he firm issued one informal notice to one attorney, Michael Grossman, about a potential dilution of the name of the firm's blog, CyberLawg(TM)"); *see* Posting of Corynne McSherry to Electronic Frontier Foundation Deeplinks Blog, <http://www.eff.org/deeplinks/2008/01/cyberlaw-and-cyberlawgs> (Jan. 18, 2008) ("Menhart has demanded that attorney Michael Grossman change the title of his blog about technology law, 'CyberBlawg.'").

146. *See* Letter from Pet Friendly, Inc. to Pet Friendly Travel (May 19, 2006) (posted at <http://www.chillingeffects.org/trademark/notice.cgi?NoticeID=4156>) (claiming rights in registered mark "Pet Friendly" for pet products); Letter from Pet Friendly, Inc. to Pet Friendly Rentals (Jan. 27, 2004) (posted at <http://www.chillingeffects.org/trademark/notice.cgi?NoticeID=1065>).

147. *Hickory Farms, Inc. v. Snackmasters, Inc.*, 500 F. Supp. 2d 789 (N.D. Ill. 2007) (granting summary judgment to defendant on the ground that the plaintiff's registered trademarks "Beef Stick" and "Turkey Stick" for food products were generic).

148. *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 949 (7th Cir. 1992).

149. *E.g., Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302, 1340 (N.D. Ga. 2008) (granting defendant's motion for summary judgment after finding "a reasonable juror

vague enough to possibly restrict, such expression about products, services, or markholders.¹⁵⁰

The recipient of a cease and desist letter or complaint may opt to settle the case and self-censor its speech rather than fight in court for the right to use particular language because litigation is expensive and attorneys' fees are only awarded in exceptional circumstances. In the Louis Vuitton trademark lawsuit against Haute Diggity Dog based on its line of "Chewy Vuitton" dog toys, newspapers reported the defendants spent more than \$300,000 in legal fees to achieve a favorable ruling in the Fourth Circuit; the judges held this was a successful parody, not infringement or dilution.¹⁵¹ Bank of America sent a cease and desist letter to a small entrepreneur who sells ceramic piggy banks on a website located at the domain name www.piggybankofamerica.com and only backed off after it received a well-researched reply from Stanford's Cyberlaw Clinic sent on behalf of the entrepreneur.¹⁵² Many individuals and small firms will not be able to find pro-bono representation, and cannot afford to pay an attorney a large sum of money to protect their right of free expression. If a defendant elects to litigate, the court may be reluctant to dispose of the case early on a motion to dismiss because of factual questions in the case.¹⁵³ That means the dispute may not be resolved until after discovery at summary judgment or trial, which will be even more expensive.

Another problem for defendants is that the chance of success in trademark litigation is uncertain. Evaluations of the distinctiveness of a descriptive term, whether a mark is famous, and infringement or dilution liability all depend on application of fact-specific multi-factor tests.¹⁵⁴ Trademark protection covers uses of marks that are identical *and* similar

could only find that Smith primarily intended to express himself with his Walocaust and Wal-Queda concepts and that his commercial success was a secondary motive at most").

150. As noted by the Court, "[c]ompetition is deterred . . . not merely by successful suit but by the plausible threat of successful suit." *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 214 (2000).

151. *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 256-57, 263, 268-69 (4th Cir. 2007); Associated Press, *Louis Vuitton Loses 'Chewy Vuitton' Appeal*, MSNBC (Nov. 14, 2007), <http://www.msnbc.msn.com/id/21793188/>.

152. Letter from Bank of America Corp. to Pei-Ling Ceramics (Oct. 21, 2002) (posted at <http://www.chillingeffects.org/trademark/notice.cgi?NoticeID=460>); Marjorie Heins, *Fair Use It or Lose It: Copyright Owners' Threats Erode Free Expression* (May/June 2006), <http://www.fair.org/index.php?page=3066>.

153. *Burke v. Mars, Inc.*, No. 08 Civ. 1330(DC), 2008 WL 2485524, at *8 (S.D.N.Y. June 23, 2008) (declining to grant motion to dismiss false endorsement claim under the Lanham Act because "[w]hether the M&M Cowboy characters were parodies of The Naked Cowboy. . . raises factual questions that are not for the Court to decide at this stage of the litigation"); *Films of Distinction, Inc. v. Allegro Film Prod.*, 12 F. Supp. 2d 1068, 1075 (C.D. Cal. 1998) (denying motion to dismiss on lack of distinctiveness grounds because whether an alleged mark is generic or a descriptive mark has acquired secondary meaning is a question of fact); *Schieffelin & Co. v. Jack Co. of Boca, Inc.*, 725 F. Supp. 1314, 1324 (S.D.N.Y. 1989) (denying motion to dismiss for failure to state a claim because whether the parody is sufficiently strong to destroy consumer confusion is an issue for the jury).

154. *Japan Telecom, Inc. v. Japan Telecom Am., Inc.*, 287 F.3d 866, 873 (9th Cir. 2002) (secondary meaning factors); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979) (likelihood of confusion factors); 15 U.S.C. § 1125(c)(2) (2006) (multi-factor tests for dilution liability).

to the plaintiff's mark.¹⁵⁵ It may be difficult to anticipate how a judge or jury will rule, especially if the mark is used in unsavory or unpopular ways. The cost of litigation combined with unpredictable trademark laws make it easy for markholders to use cease and desist letters and trademark lawsuits to stifle competition¹⁵⁶ and generally chill speech protected by the First Amendment.¹⁵⁷

Trademark statutes do contain some built-in First Amendment safeguards, but they are limited and do not sufficiently protect speech today.¹⁵⁸ For this reason, legislatures and courts should increase First Amendment scrutiny of trademark law. Legislators should revise trademark statutes in ways that reduce the potential or actual harm to free speech. Courts should interpret trademark claims narrowly to avoid a conflict with the First Amendment. They also should not hesitate to apply constitutional analysis to a trademark law if a speech-protective interpretation of the statute is contrary to the text or clear intent of Congress. When First Amendment rights are at stake, courts should not simply defer to the judgment of the legislature on the constitutionality of a statute.¹⁵⁹ Courts serve as a check on the legislature in our constitutional system; both branches of the government must confirm this trademark regulation does not harm protected expression.

Although the U.S. Supreme Court's First Amendment jurisprudence is much criticized,¹⁶⁰ these "legal doctrines nevertheless *are* the daily stuff of legal life, the concerns of students, lawyers, litigants, and judges working their way through First Amendment conflicts in real life."¹⁶¹ This Article therefore applies the Court's current First Amendment doctrine to trademark law and sets up a framework for evaluating possible objections to increasing First Amendment scrutiny of trademark law. In a First Amendment challenge to a trademark law or injunction, the trademark holder may argue: (A) the constitutional requirement of state action is not satisfied in private civil trademark litigation; (B) this use of a trademark is not "speech" within the coverage of the First Amendment; (C) this trademark use is categorically excluded from First Amendment protection; or (D) this trademark regulation survives constitutional scrutiny. Below, I introduce the relevant First Amendment doctrines and apply them to trademark law. This framework applies to claims for trademark

155. McCARTHY, *supra* note 2, § 23:20 (noting exact identity is not necessary between confusingly similar marks).

156. See Kenneth Port, *Trademark Extortion: The End of Trademark Law*, 65 WASH. & LEE L. REV. 865 (2008).

157. See generally McGeveran, *supra* note 11.

158. Ramsey, *supra* note 11, at 147.

159. Landmark Commc'ns, Inc. v. Virginia, 435 U.S. 829, 843-44 (1978).

160. See, e.g., LARRY ALEXANDER, IS THERE A RIGHT OF FREEDOM OF EXPRESSION? 121-22 (2005); see generally LARRY A. ALEXANDER, *Trouble on Track Two: Incidental Regulations of Speech and Free Speech Theory*, 44 HASTINGS L.J. 921 (1993); Robert Post, *Recuperating First Amendment Doctrine*, 47 STAN. L. REV. 1249 (1995); Jed Rubenfeld, *The First Amendment's Purpose*, 53 STAN. L. REV. 767 (2001).

161. RODNEY A. SMOLLA, SMOLLA AND NIMMER ON FREEDOM OF SPEECH § 2:13 (2008).

infringement, dilution, and cybersquatting under the Lanham Act and state trademark statutes and common law, and it may also apply to other laws that restrict the use of trademarks to communicate information or ideas.¹⁶²

A. STATE ACTION

The state action doctrine provides that the U.S. Constitution generally applies only to actions of the government and its officers and not to conduct by private parties. A trademark holder may argue there is no state action that implicates the First Amendment when trademarks are enforced in civil litigation initiated by private citizens rather than government officials. A few courts have concluded that the Constitution's state action requirement is not satisfied in private trademark litigation.¹⁶³ As recently as 2007, one court found a defendant's constitutional argument unpersuasive in a trademark dispute because it believed "government restraints on commercial speech" are "simply not present in an intellectual property dispute between two private parties."¹⁶⁴ This is incorrect. There is state action in every trademark lawsuit. The First Amendment is implicated anytime the government restricts speech, such as a law or court order prohibiting speech, or significantly burdens speech by allowing civil liability for expression.¹⁶⁵

In the paradigm trademark case, a private trademark holder sues a person or business in federal or state court for violations of its trademark rights under the relevant trademark statutes and common law. The plaintiff asks the court for damages and an injunction banning further use of the mark by the defendant, among other remedies. The Constitution's state action requirement is satisfied when federal and state legislatures enact statutes that regulate the use of trademarks, and when courts enjoin

162. *E.g.*, Utah Spyware Control Act, UTAH CODE ANN. § 13-40-201(1) (2005) (pop-up ads); Alaska's Anti-Adware Law, ALASKA STAT. §§ 45.45.792, 45.45.794, 45.45.798 (Supp. 2005) (pop-up ads); Truth in Domain Names Act, 18 U.S.C. § 2252B (2006) (domain names). Thanks to Professor Eric Goldman for these examples.

163. *E.g.*, Reddy Commc'ns, Inc. v. Envtl. Action Found., 199 U.S.P.Q. 630, 633-34 (D.D.C. 1977); Interbank Card Ass'n v. Simms, 431 F. Supp. 131, 133-34 (M.D.N.C. 1977).

164. Empire Home Servs., L.L.C. v. Empire Iron Works, Inc., No. 05-CV-72584, 2007 WL 1218717, at *8 (E.D. Mich. 2007 April 23, 2007) (denying defendant's motion for summary judgment on various grounds, including a First Amendment affirmative defense, where plaintiff Empire Home Services owned the trademark "Empire Today" and sued defendant Empire Iron Works based on its use of the slogan "Call Empire Today").

165. *See* U.S. CONST. amend. I ("Congress shall make no law . . . abridging the freedom of speech"); 44 Liquormart, Inc. v. Rhode Island, 517 U.S. 484, 489 n.1 (1996) (noting that the First Amendment applies to state and local governments under the Fourteenth Amendment's Due Process Clause); Cohen v. Cowles Media, Co., 501 U.S. 663, 668 (1991) (holding "a private cause of action for promissory estoppel involves 'state action' within the meaning of the Fourteenth Amendment such that the protections of the First Amendment are triggered"); N.Y. Times Co. v. Sullivan, 376 U.S. 254, 265 (1964) (judicial enforcement of Alabama state defamation claim was subject to constitutional scrutiny); *cf.* Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562, 574-75 (1977) (assuming enforcement of right of publicity claim was state action); ALEXANDER, *supra* note 160, at 120-23; *see generally* LARRY ALEXANDER & PAUL HORTON, WHOM DOES THE CONSTITUTION COMMAND? (1988); CHEMERINSKY, *supra* note 67, at 507-39, 956-70.

the defendant from further use of a trademark and/or punish the defendant based on its use of a trademark.¹⁶⁶ Even though “they are qualitatively and constitutionally distinct,” government suppression of speech and government enforcement of private suppression of speech are still both state action.¹⁶⁷ After *New York Times v. Sullivan*,¹⁶⁸ judicial enforcement of civil trademark laws should be sufficient “state action” to trigger First Amendment scrutiny even in suits initiated by private parties.¹⁶⁹ In *Sullivan*, the Court rejected the state’s argument that the judgment of Alabama courts in this private defamation lawsuit was insulated from constitutional scrutiny: “Although this is a civil lawsuit between private parties, the Alabama courts have applied a state rule of law which petitioners claim to impose invalid restrictions on their constitutional freedoms of speech and press.”¹⁷⁰ The government restriction on speech may ultimately be constitutional, but it is still state action.¹⁷¹

Under some circumstances, however, a restriction on use of a trademark can be purely private. For example, there is no state action when a private party refuses to allow certain uses of a trademark on the Internet.¹⁷² A private website operator may prohibit the unauthorized use of trademarks on its website. An Internet search engine provider, such as Google, may refuse to allow advertisers to use certain trademarked terms in the text of advertisements displayed near organic search results. While some individuals or firms may complain that their First Amendment rights are violated when they are prevented from using trademarks in certain ways, there is no state action when private parties prohibit use of a mark without government involvement. It is only when private parties rely on the power of the state to restrict speech that the state action requirement is met and the constitutional right of free expression is implicated. Trademark holders concerned about a First Amendment challenge to a trademark claim under federal or state law should consider pursuing private enforcement of their trademark rights outside of the judicial system.

The state action inquiry should be quite simple in trademark cases. If a markholder files a lawsuit and asks the court to enjoin or punish the defendant’s use of a trademark, the state action requirement is satisfied. While a speech restriction is more likely to be constitutionally suspect if the decision to initiate litigation is made by government officials rather

166. *Id.*

167. See ALEXANDER, *supra* note 160, at 121-22.

168. *N.Y. Times Co. v. Sullivan*, 76 U.S. 254, 265 (1964).

169. *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 30 n.2 (1st Cir. 1987); *U.S. Jaycees v. Phila. Jaycees*, 639 F.2d 134 n.9 (3d Cir. 1981); McCARTHY, *supra* note 2, §31:143; Denicola, *supra* note 5, at 190 n.146.

170. *Sullivan*, 376 U.S. at 265. The Court further said it “matters not that that law has been applied in a civil action and that it is common law only, though supplemented by statute The test is not the form in which state power has been applied but, whatever the form, whether such power has in fact been exercised.” *Id.*

171. *Cf. Cohen*, 501 U.S. at 668.

172. See Dawn C. Nunziato, *The Death of the Public Forum in Cyberspace*, 20 BERKELEY TECH. L.J. 1115, 1130-42 (2005).

than private citizens, this fact is not relevant to the state action determination.

B. FIRST AMENDMENT “SPEECH”

Trademark holders may also explicitly or implicitly argue that certain uses of a trademark do not qualify as First Amendment “speech.” They may say the First Amendment is not implicated when courts enjoin or punish use of a trademark to identify the source of a product, rather than as part of a communicative message.¹⁷³ Markholders may also argue that the unauthorized use of their protected trade dress (such as product designs or colors) or non-traditional trademarks (such as a scent mark) does not qualify as “speech” because these marks do not contain words. In cases involving the use of trademarks to trigger keyword advertising, the markholder may contend this use of a mark is not “speech.” If the First Amendment does not apply to a restriction on the use of a trademark, that regulation is only subject to “the negligible scrutiny of rationality review.”¹⁷⁴ For the reasons explained below, the First Amendment should cover any use of a mark or trade dress that is actionable under trademark law because the defendant is only liable if its use of the mark or trade dress conveys a certain message to consumers—the government perceives the harm to come from the content of that infringing or diluting expression.

Most trademarks consist of language that not only falls within the dictionary definition of “speech” but also indisputably communicates a message. Trademarks can consist of words (“Nike”), names (“McDonald’s”), and symbols (the Nike swoosh logo) that identify the source or sponsor of the product. When a firm uses a *distinctive* trademark to identify and distinguish its products or services, it intends to convey (and likely conveys) information to consumers about the source of the product, among other things.¹⁷⁵ A trademark, such as “Coca-Cola,” can provide information about who is manufacturing or selling this product, or about the quality of products sold under this brand. A trademark may be used in a domain name to identify the owner or operator of a certain website or provide other information. All of these uses of a trademark are “speech,” regardless of whether the markholder *or a third party* uses the mark to communicate in these ways. The trademark use may not be protected by the First Amendment—it may be misleading commercial

173. See *SMJ Group, Inc. v. 417 Lafayette Restaurant LLC*, 439 F. Supp. 2d 281, 291 (S.D.N.Y. 2006); *Gucci America, Inc. v. Hall & Associates*, 135 F. Supp. 2d 409, 418 (S.D.N.Y. 2001); *Planned Parenthood Fed’n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d 1430, 1440 (S.D.N.Y. 1997), *aff’d*, 152 F.3d 920 (2d Cir. 1998); see also *Yankee Publ’g. Inc. v. News Am. Publ’g. Inc.*, 809 F. Supp. 267, 275 (S.D.N.Y. 1992).

174. Frederick Schauer, *The Boundaries of the First Amendment: A Preliminary Exploration of Constitutional Salience*, 117 HARV. L. REV. 1765, 1770 (2004).

175. Cf. *Friedman v. Rogers*, 440 U.S. 1, 12, 16 (1979) (noting a trade name conveys information about the price and nature of the services offered once “it acquires meaning over a period of time by associations formed in the minds of the public between the name and some standard of price or quality”).

speech (a topic discussed next)—but it is still “speech” within the coverage of the First Amendment. A trademark conveys a message to consumers even when it is used in a brand name or domain name to identify the source of a product, service, or website.

Some trademarks consist of symbols or devices, such as the distinctive shape of a Coca-Cola bottle,¹⁷⁶ that are not traditionally characterized as “language.” Distinctive product colors, product packaging, product designs, restaurant décor, and other trade dress may all qualify as protectable trademarks under the Lanham Act. Firms can even obtain trademark rights in non-traditional trademarks, such as NBC’s three chimes or the scent of plumeria blossoms on sewing thread.¹⁷⁷ Although trade dress and non-traditional trademarks may not consist of words, they can still qualify as First Amendment speech depending on the circumstances.

All forms of expression or communication—including spoken and written language, as well as symbolic speech and expressive conduct—are covered by the concept of freedom of speech.¹⁷⁸ Among other things, the Court has held that flag burning, armband wearing, and nude dancing all qualify as “speech” under the First Amendment.¹⁷⁹ According to the Court, the use of “symbolic speech” can be communicative and qualify as speech within the First Amendment’s scope if “[a]n intent to convey a particularized message was present, and in the surrounding circumstances the likelihood was great that the message would be understood by those who viewed it.”¹⁸⁰

These criterion are generally satisfied when a trade dress or non-traditional trademark is used to communicate information regarding product source to the public and thereafter acquires distinctiveness for the senior user of that mark. Once it conveys a message regarding source, the trade dress or mark is protectable under trademark law and use of this symbol can qualify as “speech” under the First Amendment. Junior users of the trade dress or mark are also engaging in First Amendment “speech” when they use this protected symbol to communicate a message regarding product source; the trademark use is only actionable if the fact-finder determines it conveyed a message.

If a defendant argues or admits in trademark litigation that it had *no* intent to communicate a message when it used a particular trade dress or non-traditional trademark, the court may question whether a First Amendment defense is available to the defendant. According to the Supreme Court, there can be no communicative “speech” without intent to

176. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

177. *Id.*

178. ALEXANDER, *supra* note 160, at 7-8.

179. *Texas v. Johnson*, 491 U.S. 397, 399 (1989); *Tinker v. Des Moines Indep. Cmty. Sch. Dist.*, 393 U.S. 503, 514 (1969); *Schad v. Borough of Mount Ephraim*, 452 U.S. 61, 66 (1981).

180. *Spence v. Washington*, 418 U.S. 405, 410-11 (1974); *see also Johnson*, 491 U.S. at 397, 403-04 (1989). Scholars have criticized this test. *E.g.*, Post, *supra* note 160, at 1250-60.

communicate by a speaker.¹⁸¹ A judge may conclude that a defendant who claims no intent to communicate is not entitled to a First Amendment defense. The better view is that the First Amendment is still implicated in that trademark case if the government restricts this use of the mark or trade dress because of the harm caused by the misleading or diluting message it communicates.¹⁸² As use of a trademark is only actionable infringement or dilution if it communicates a certain message to the audience, the First Amendment should cover all actionable uses of a trademark, even if the defendant is using the trade dress or non-traditional trademark randomly or for aesthetic reasons to attract consumers to the product.

Courts may also question whether First Amendment “speech” is implicated in trademark litigation involving the unauthorized use of trademarks to trigger keyword advertising on the Internet, such as sponsored links or pop-up ads. Internet search engine providers like Google use the trademark “behind the scenes” when they program computer software to trigger sponsored links to be listed near the organic search results when consumers type a particular trademarked term into the search box, such as “American Airlines.”¹⁸³ Because the defendant’s use of the mark in internal computer code is not visible to the audience, markholders may argue that First Amendment speech is not implicated. This argument should fail if this trademark use is actionable.

In keyword advertising cases, the Internet search engine provider and advertiser are generally not liable unless their use of the trademark to trigger keyword advertising communicates an infringing or diluting message to consumers. The plaintiff usually argues that the defendant’s use of its mark to trigger a specific ad is actionable because it communicates information about the relationship between the trademarked term and this ad. It may inform the consumer that the trademark holder is the source or sponsor of the ad, the advertiser is a competitor of the trademark holder, or the advertiser’s product is a substitute for the trademarked product, among other things.¹⁸⁴ If it is actionable under trademark law, use of another firm’s trademarks to trigger sponsored ads is “speech” within the coverage of the First Amendment. Application of trademark law implicates the First Amendment because the court is regu-

181. *Spence*, 418 U.S. at 410-11; cf. *State v. Waterman*, 190 N.W.2d 809, 811 (Iowa 1971) (affirming the conviction of a defendant for wearing a flag as a poncho in part because the defendant testified he “had no purpose” in wearing the garment); see SMOLLA, *supra* note 161, § 11:4.

182. Cf. SMOLLA, *supra* note 161, § 1:6 (arguing that a homeless person who burned a flag for warmth “could not be prosecuted under a flag-desecration statute, even if his burning of the flag was not intended as expression,” where a flag desecration law is explicitly content-based and not just an anti-burning law). Thanks to Larry Alexander for his discussions with me on this issue, among others.

183. Complaint at 38, *Am. Airlines, Inc. v. Google, Inc.*, No. 4:07-CV-00487 (N.D. Tex. Aug. 16, 2007).

184. See Eric Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 EMORY L.J. 507, 521-25, 540-41 (2005).

lating this use of the mark due to its communication of a message deemed harmful by the government.

C. CATEGORICAL EXCEPTIONS TO FIRST AMENDMENT PROTECTION

Even though they are government regulations of First Amendment speech, trademark laws are constitutional when they restrict certain types of speech categorically unprotected by the First Amendment. As explained below, trademarks do not generally fall into such a category. Misleading commercial speech does, but not every infringing commercial use of a mark is misleading commercial speech.

1. *No Categorical Exception for Trademarks*

Trademarks are not currently a type of speech that is categorically unprotected by the First Amendment. Speech is generally presumed to have "high" value, and is fully protected by the Constitution, unless it falls within one of the "low" value categories of speech that is entitled to lesser or no First Amendment protection.¹⁸⁵ As noted by Professor Bollinger, "'high' value speech is virtually ensured protection against government regulation directed at its 'content.'"¹⁸⁶ Examples include political speech, scientific and academic speech, art, and literature. "Low" value speech can be prohibited entirely, such as incitement of illegal activity, fighting words, obscenity, and child pornography,¹⁸⁷ or can be regulated more easily by the government based on its content, such as non-obscene sexually explicit material, profanity,¹⁸⁸ and defamation.¹⁸⁹ The Court has said that these categories of speech "can, consistently with the First Amendment, be regulated because of their constitutionally proscribable content."¹⁹⁰ The Court is unlikely to (and should not) conclude that trademarks are categorically excluded from First Amendment protection.

By themselves, trademarks generally are harmless, unlike child pornography. Trademarks are just words, names, symbols, or devices, or combinations of these, that are used to quickly and easily identify the source of a product, among other uses. Although *Friedman* suggests that trade names (and thus trademarks) are not as valued as political speech or even

185. Geoffrey R. Stone, *Dialogue, in* ETERNALLY VIGILANT 9 (L. Bollinger & G. Stone eds., 2001).

186. Lee C. Bollinger, *Dialogue, in* ETERNALLY VIGILANT, *supra* note 185, at 17 (discussing *N.Y. Times Co. v. United States*, 403 U.S. 713 (1971)).

187. *New York v. Ferber*, 458 U.S. 747, 773-74 (1982); *Brandenburg v. Ohio*, 395 U.S. 444, 447 (1969); *Chaplinsky v. New Hampshire*, 315 U.S. 568, 571-72 (1942); *Roth v. United States*, 354 U.S. 476, 483 (1957).

188. *City of Renton v. Playtime Theaters, Inc.*, 475 U.S. 41, 48 (1986); *Bethel Sch. Dist. No. 403 v. Fraser*, 478 U.S. 675, 685-86 (1986); *F.C.C. v. Pacifica Found.*, 438 U.S. 726, 744-48 (1978); *Young v. Am. Mini-Theaters, Inc.*, 427 U.S. 50, 70-71 (1976); *see also* CHEMERINSKY, *supra* note 67, at 1036-44 (discussing "indecent" speech).

189. *Gertz v. Welch*, 418 U.S. 323, 342-45 (1974).

190. *R.A.V. v. City of St. Paul*, 505 U.S. 377, 383 (1992). These content-based speech regulations are not subject to strict scrutiny analysis. *Id.* at 404 (White, J., concurring in the judgment).

other types of commercial speech, such as price or product advertising,¹⁹¹ the Court's main concern in that case was that trade names would be used "to mislead the public."¹⁹² Similarly, it is only when trademarks are used in certain ways by certain speakers that this speech is harmful and lacks value, such as misleading commercial uses of trademarks. At most, the Court is likely to say that trademarks are speech that is protected by the First Amendment but subject to more regulation than other types of fully protected speech.¹⁹³ The Court currently uses this approach for nonmisleading commercial speech.¹⁹⁴

Of course, the Court might instead decide to treat trademarks like other language deemed outside the boundaries of the First Amendment for various political, economic, social, and cultural reasons.¹⁹⁵ As noted by Professor Schauer,

Little case law and not much more commentary explain why the content-based restrictions of speech in the Securities Act of 1933, the Sherman Antitrust Act, the National Labor Relations Act, the Uniform Commercial Code, the law of fraud, conspiracy law, the law of evidence, and countless other areas of statutory and common law do not, at the least, present serious First Amendment issues.¹⁹⁶

In many cases involving legal control of speech, "the First Amendment does not even show up in the analysis."¹⁹⁷

While the Court has not evaluated the constitutionality of trademark law, it has never said trademarks are categorically outside the boundaries of the First Amendment. To the contrary, the Court applied First Amendment scrutiny (albeit weak intermediate scrutiny) to a law protecting trademark-like rights in the word Olympic and related symbols.¹⁹⁸ Recently, in a case involving the scope of the fair use defense in trademark law, the Court mentioned "the undesirability of allowing anyone to obtain a complete monopoly on use of a descriptive term simply by grabbing it first."¹⁹⁹ In addition, the legislative history of the Lanham Act suggests at least some members of Congress believe the First Amendment constrains trademark law, as House and Senate reports contain ref-

191. *Friedman v. Rogers*, 440 U.S. 1, 12 (1979) (holding a trade name is "a form of commercial speech that has no intrinsic meaning" and thus is significantly different from advertising that contains statements about the price and quality of the products or services). Per the Court, a trade name is implicitly only a "mere solicitation of patronage" – it simply proposes a commercial transaction. *Id.* at 11 n.10.

192. *Id.* at 13-16.

193. See *infra* Part II.D.2.d.

194. *Cent. Hudson Gas & Electric Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 566 (1980).

195. Schauer, *supra* note 174, at 1765.

196. *Id.* at 1768; see also BARENDT, *supra* note 43, at 254-55; Robert Post, *Reconciling Theory and Doctrine in First Amendment Jurisprudence*, in *ETERNALLY VIGILANT*, *supra* note 185, at 162; David McGowan, *Approximately Speech*, 89 MINN. L. REV. 1416, 1416-17 (2005); Post, *supra* note 160, at 1250-60.

197. Schauer, *supra* note 174, at 1765.

198. *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 536-41 (1987).

199. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122 (2004).

erences to this constitutional provision.²⁰⁰

Moreover, the Supreme Court recently refused to hold that another type of intellectual property—copyright—is completely outside the boundaries of the First Amendment. In *Eldred*, the Court rejected the argument that copyright law is categorically immune from a First Amendment challenge.²⁰¹ As Congress's power to regulate trademarks comes from the Commerce Clause of the Constitution and not a specific constitutional provision (unlike copyright law),²⁰² it is unlikely the Court will conclude trademark law—but not copyright law—is categorically excluded from constitutional scrutiny. There should be a strong presumption in favor of First Amendment coverage of trademarks to avoid suppressing or chilling protected speech.²⁰³ As trademarks convey information about the source of products or services, among other things, courts should conclude that trademarks are generally within the boundaries of the First Amendment even if they conclude trademarks are less protected than political speech.

2. *Misleading Uses of Trademarks in Commercial Speech*

While trademarks are generally protected by the First Amendment, misleading use of a trademark in commercial speech is not.²⁰⁴ As noted in Part I.A., the government may regulate misleading commercial speech without violating the First Amendment.²⁰⁵ The misleading commercial speech exception can quickly dispose of a First Amendment challenge in many core trademark infringement disputes between competitors.²⁰⁶ Yet due to the protection of trademark rights in descriptive terms and the expansion of trademark infringement law to new areas of confusion,

200. *E.g.*, H.R. REP. NO. 104-374, at 4, 8 (1995); 141 CONG. REC. S19306-10, S19310-12 (daily ed. Dec. 29, 1995); 141 CONG. REC. H14317-01, H14318 (daily ed. Dec. 12, 1995).

201. *Eldred v. Ashcroft*, 537 U.S. 186, 221 (2003). At the same time, the Court refused to engage in further First Amendment scrutiny of the Copyright Term Extension Act because "Congress ha[d] not altered the traditional contours of copyright protection." *Id.* Professor McKenna believes "the *Eldred* decision seems to have placed copyright predominantly outside the First Amendment scheme, at least as long as Congress does not alter the 'traditional contours of copyright protection.'" McKenna, *supra* note 6, at 17-18.

202. *See* U.S. CONST., art. I, § 8, cl. 3; *In re Trade-Mark Cases*, 100 U.S. 82, 93-94 (1879).

203. *Cf.* BARENDT, *supra* note 43, at 256, 405; Frederick Schauer, *Categories and the First Amendment: A Play in Three Acts*, 34 VAND. L. REV. 265, 281 (1981) (noting "perhaps the preferable course is to begin with the presumption that all communication is covered by the first amendment and then create areas of noncoverage, regarding which the burden of proof of nonapplicability of first amendment principles can be met").

204. As noted by Professor Post, "[i]t is not clear whether misleading speech is simply 'commercial speech' that can be regulated by the state, or whether it is instead excluded even from the category of 'commercial speech.'" Post, *supra* note 53, at 21; *see also* Schauer, *supra* note 174, at 1776 n.49 (suggesting that "misleading commercial advertisements are akin to legally obscene materials in that they are regulable under minimal rational basis scrutiny without regard to First Amendment standards or values").

205. *See In re R.M.J.*, 455 U.S. 191, 203 (1982) ("Misleading advertising may be prohibited entirely."); *Edenfeld v. Fane*, 507 U.S. 761, 768 (1993) (noting the government "may ban commercial expression that is fraudulent or deceptive without further justification").

206. *See* McCARTHY, *supra* note 2, § 31:142 ("In the run-of-the-mill civil trademark lawsuit, a First Amendment defense would not seem to have much, if any, impact on the question of liability.").

some courts now find infringement when the speech is not sufficiently misleading to justify categorical exclusion from First Amendment protection.

After finding trademark infringement, many courts quickly dispense of a First Amendment challenge in a cursory analysis by stating that “[c]ommercial speech may be regulated when its content is otherwise false or misleading.”²⁰⁷ I believe the misleading commercial speech exception should not be applied automatically and rigidly in trademark cases without considering why this type of speech is categorically excluded from First Amendment protection. Not all infringing commercial uses of a mark meet the First Amendment’s high threshold of “misleading.” In such cases, the restriction must satisfy intermediate constitutional scrutiny. The circumstances must warrant application of this extraordinary exception to First Amendment scrutiny.

According to the Court, there are specific reasons why the government can ban misleading commercial speech so easily. “Untruthful speech, commercial or otherwise, has never been protected for its own sake.”²⁰⁸ “The First Amendment . . . does not prohibit the State from insuring that the stream of commercial information flow cleanly as well as freely.”²⁰⁹ According to the Court, “there can be no constitutional objection to the suppression of commercial messages that do not accurately inform the public about lawful activity. The government may ban forms of communication more likely to deceive the public than to inform it. . . .”²¹⁰ Rational consumers prefer not to receive or rely on false or misleading commercial information. Many regulations of untruthful commercial speech would likely satisfy constitutional analysis if they were subjected to it, so the Court may believe it is more efficient to characterize misleading commercial speech as a categorical exception to First Amendment scrutiny and avoid this complicated and time-consuming analysis.

207. *E.g.*, *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 1021-22 (9th Cir. 1985) (noting “[s]ubstantial evidence was presented at trial to show that [defendant’s] use of the words ‘shift’ and ‘kit’ was misleading”) (citing *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 771-73 (1976)); *see also* *E & J Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1297 (9th Cir. 1992); *Univ. of Kan. v. Sinks*, No. 06-2341-JAR, 2008 WL 755069, at *31 (D. Kan. Mar. 19, 2008) (granting plaintiff summary judgment on the First Amendment affirmative defense because “the Government may constitutionally regulate ‘deceptive or misleading’ commercial speech”) (citing *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 535 (1987)); *Kelley Blue Book v. CarSmarts, Inc.*, 802 F. Supp. 278, 291 (C.D. Cal. 1992) (holding that the First Amendment defense lacked merit because “substantial evidence was introduced at trial indicating that defendants’ use of their ‘1-900-BLU-BOOK’ and ‘1-800-BLUE-BOOK’ designations is misleading in that it is likely to cause confusion among consumers”). Some courts do engage in a more detailed discussion of the misleading nature of the commercial speech. *E.g.*, *HER, Inc. v. RE/MAX First Choice, LLC*, 468 F. Supp. 2d 964 (S.D. Ohio 2007) (granting request by real estate firm and members for preliminary injunction to prevent competitor from using Internet domain names incorporating personal names and registered marks of plaintiffs).

208. *Va. Pharmacy*, 425 U.S. at 771.

209. *Id.* at 771-72.

210. *Cent. Hudson Gas & Electric Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557, 563 (1980).

In the trademark law context, courts should consider why this infringing speech should be labeled “misleading commercial speech,” especially if it is unclear whether the speech restriction would actually satisfy First Amendment scrutiny.²¹¹ Courts should ask if this use of a mark is a form “of communication more likely to deceive the public than to inform it.”²¹² If this use of a trademark contains “accurate commercial information”²¹³ rather than a misleading or “false statement of fact” that has “no constitutional value,”²¹⁴ courts should not classify that speech as misleading.

In other contexts outside of trademark law, the Court has attempted to explain what it means by “misleading” speech in its commercial speech doctrine. The Court has distinguished between speech that is actually or inherently misleading, and potentially misleading commercial speech.²¹⁵ Commercial speech is “actually misleading” where the record contains actual evidence of deception.²¹⁶ The speech is “inherently misleading” when “the particular method by which the information is imparted to consumers is inherently conducive to deception and coercion.”²¹⁷ If “advertising is inherently likely to deceive or where the record indicates that a particular form or method of advertising has in fact been deceptive,” the speech is unprotected by the First Amendment.²¹⁸ If the speech is only “potentially misleading,” any restriction of that speech must satisfy the remaining three factors of the *Central Hudson* test.²¹⁹ The Court has said the government “may not place an absolute prohibition on certain types of potentially misleading information. . . if the information also may be presented in a way that is not deceptive. . . .”²²⁰

In trademark law, proof of actual confusion by consumers is not necessary for a finding of infringement.²²¹ Moreover, like advertising of legal services,²²² use of language claimed as a mark by another is not “inher-

211. For an excellent discussion of the differences between false advertising law and trademark law, and some implications for trademark law if courts apply real First Amendment scrutiny to trademark law, see generally Rebecca Tushnet, *Trademark Law as Commercial Speech Regulation*, 58 S.C. L. REV. 737 (2007).

212. *Cent. Hudson*, 447 U.S. at 563.

213. 44 *Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 496 (1996).

214. *Gertz v. Welch*, 418 U.S. 323, 340 (1974) (“[T]here is no constitutional value in false statements of fact. Neither the intentional lie nor the careless error materially advances society’s interest in ‘uninhibited, robust, and wide-open’ debate on public issues.”); see also *Bose Corp. v. Consumers Union of U.S., Inc.* 466 U.S. 485, 504 n.22 (1984).

215. *Peel v. Attorney Registration & Disciplinary Comm.*, 496 U.S. 91, 100 (1990) (plurality); *In re R.M.J.*, 455 U.S. 191, 203 (1982); *Zauderer v. Office of Disciplinary Counsel of the Supreme Court of Ohio*, 471 U.S. 626, 643-47 (1985); see also *Katsky v. Nike*, 27 Cal. 4th 939, 954 (2002) (noting the United States Supreme Court has drawn this distinction).

216. *Peel*, 496 U.S. at 106.

217. *Id.* at 112 (Marshall, J. & Brennan, J., concurring)

218. *In re R.M.J.*, 455 U.S. at 202.

219. *Id.* at 203.

220. *Id.* (emphasis added), quoted in *Peel v. Attorney Registration & Disciplinary Comm.*, 496 U.S. 91, 100 (1990) (plurality).

221. MCCARTHY, *supra* note 2, § 23:12 (citing cases).

222. *Bates v. State Bar of Ariz.*, 433 U.S. 350, 372-73 (1977) (“We are not persuaded that restrained professional advertising by lawyers inevitably will be misleading.”); see also

ently misleading.”²²³ As infringement doctrine has expanded beyond confusion regarding the source of products and services, courts may find that there is a likelihood of confusion where the trademark use is only potentially misleading and not inherently conducive to deception. Certain types of confusion, such as confusion regarding sponsorship or approval of expression incorporating another’s mark, may be more likely to convey constitutionally valuable information and ideas than harm the public in any material way. Courts should be wary about labeling all infringing commercial uses of trademarks “misleading,” as this could suppress or chill nonmisleading commercial speech. While the Court has said it is easier to determine the truth or falsity of commercial speech compared to other types of speech—it said the truth of commercial speech is “more easily verifiable by its disseminator”²²⁴—that is not the case for uses of trademarks alleged to be infringing. Without conducting a consumer survey and engaging in fact-intensive discovery, a company may not know whether its mark is likely to cause confusion with another firm’s mark. The Court has correctly noted that “distinguishing deceptive from nondeceptive advertising in virtually any field of commerce may require resolution of exceedingly complex and technical factual issues and the consideration of nice questions of semantics.”²²⁵ Use of a trademark is not like advertising about price or product qualities, where the truth of the commercial representation may actually be objectively verifiable.²²⁶ As noted by Professor Austin, “Implying that the First Amendment is

Peel, 496 U.S. at 100 (noting the attorney’s “letterhead was neither actually nor inherently misleading”).

223. Although the Court in *Friedman* noted that “there is a significant possibility that trade names will be used to mislead the public” due to “ill-defined associations of trade names with price and quality information” that could “be manipulated by the users of trade names,” *Friedman v. Rogers*, 440 U.S. 1, 12-13 (1979), this case involved a state ban on optometrists advertising and using trade names rather than personal names, not a ban on unauthorized infringing use of one firm’s mark by a third party. It should be limited to its facts and not used to conclude that infringing use of a mark is always misleading. The Court discounted the communicative value of trade names in that case. The case might come out differently today, as the Court more recently said: “If the ‘protections afforded commercial speech are to retain their force,’ . . . we cannot allow rote invocation of the words ‘potentially misleading’ to supplant the [government’s] burden to ‘demonstrate that the harms it recites are real and that its restriction will in fact alleviate them to a material degree.’” *Ibanez v. Fla. Dept. of Business and Prof. Reg.*, 512 U.S. 136, 146 (1994) (citations omitted). Governmental “concern about the possibility of deception in hypothetical cases is not sufficient to rebut the constitutional presumption favoring disclosure over concealment.” *Peel*, 496 U.S. at 111.

224. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 772 n.24 (1976). This statement has been criticized by scholars. *E.g.*, BARENDT, *supra* note 43, at 399 (noting that much commercial advertising and marketing today contains little verifiable factual content).

225. *Zauderer v. Office of Disciplinary Counsel of Supreme Court of Ohio*, 471 U.S. 626, 645 (1985).

226. *Bose*, 466 U.S. at 504 n.22 (“Moreover, since a commercial advertiser usually ‘seeks to disseminate information about a specific product or service he himself provides and presumably knows more about than anyone else,’ . . . there is a minimal ‘danger that governmental regulation of false or misleading price or product advertising will chill accurate and nondeceptive commercial expression’”) (quoting *Va. Pharmacy*, 425 U.S. at 772 n.24, 777); Tushnet, *supra* note 211, at 739.

safe from trademark law because trademark law prohibits only those uses of marks that are likely to cause confusion puts enormous faith in tests for trademark infringement, faith that might not always be warranted.”²²⁷

There are other reasons why it is troubling to conclude that infringing use of a mark is always “misleading” speech. Sometimes only a small percentage of consumers surveyed—less than twenty percent—are confused by the defendant’s speech.²²⁸ For example, only twelve percent of consumers surveyed were confused regarding Mutual of Omaha’s sponsorship of the anti-nuclear message “Mutant of Omaha” displayed on T-shirts.²²⁹ When a large percentage of consumers surveyed—a majority—are *not* confused, it is problematic to avoid further constitutional scrutiny of a law that prohibits this expression. Speech should also not be labeled “misleading” under the First Amendment when the government may be partly responsible for making that trademark use misleading. Distinctiveness of a descriptive term used as a trademark and consumer confusion regarding source or sponsorship all depend on the perceptions of consumers.²³⁰ Yet trademark law can influence what consumers think. The government’s past trademark protection for descriptive terms and strong enforcement of trademark rights in a variety of contexts outside the core of trademark law may be the reason certain trademarks are now distinctive or certain uses of a trademark are now confusing.²³¹ In such circumstances, the government and trademark holders should not be able to avoid the burden of proving real harm by simply invoking the misleading commercial speech exception.

For all of these reasons, courts in trademark cases should only conclude that infringing commercial use of a mark is “misleading” under the First Amendment if the trademark use is actually misleading or inherently likely to mislead reasonable consumers *and* the speech has “no constitutional value.”²³² An example of misleading commercial speech would be a competitor’s confusing use of the “Coca-Cola” mark as a brand name for its own low-quality soft drink. If use of another’s mark is only potentially misleading and/or has some positive communicative value to con-

227. Graeme W. Austin, *Tolerating Confusion About Confusion: Trademark Policies and Fair Use*, 50 ARIZ. L. REV. 157, 186 (2008).

228. MCCARTHY, *supra* note 2, § 32:185.

229. Mut. of Omaha Ins. Co. v. Novak, 836 F.2d 397, 400 (8th Cir. 1987); *Id.* at 404 (Heaney, J., dissenting); *see also* James Burrough Ltd. v. Sign of the Beefeater, Inc., 540 F.2d 266, 278-79 (7th Cir. 1976) (reversing a directed verdict for the defendant where a survey established that fifteen percent of consumers were confused regarding sponsorship by plaintiff).

230. James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 YALE L.J. 882, 907-27 (2007); Mark P. McKenna, *Trademark Use and the Problem of Source*, 2009 U. Ill. L. Rev. (forthcoming 2009) available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1088479#PaperDownload; Ramsey, *supra* note 11, at 1150.

231. *Id.*

232. *See* Bose Corp. v. Consumers Union of U.S., Inc. 466 U.S. 485, 504 n.22 (1984) (“Though false and misleading commercial speech could be deemed to represent a category of unprotected speech, . . . , the rationale for doing so would be essentially the same as that involved in the libel area, viz, ‘there is no constitutional value in false statements of fact.’”) (quoting *Gertz v. Welch*, 418 U.S. 323, 340 (1974)).

sumers, this speech—even if confusing to some—does not rise to the level of “misleading” commercial speech that is automatically refused First Amendment protection.²³³ In such cases, further constitutional scrutiny of the trademark restriction is required because the speech also conveys useful information or ideas to consumers. Examples of the types of infringement claims to which the categorical exception for misleading commercial speech should not apply include cases involving the accurate descriptive use of trademarked terms, keyword advertising, and use of a mark in commercial commentary, parody, and satire to express something unrelated to the identification of the source of the defendant’s products or services.

When another’s trademark is used without authorization to accurately describe the qualities or characteristics of the defendant’s products, that use of the mark should never rise to the level of “misleading” speech regardless of whether the term is used as part of a brand name, slogan, domain name, or in other ways deemed to be use “as a mark.”²³⁴ Even if some consumers are confused by this use of the trademarked term, the descriptive words provide useful information to other consumers about the attributes of the defendant’s product.²³⁵ This commercial speech has constitutional value and thus does not meet the high threshold of “misleading” speech that is categorically unprotected by the First Amendment.²³⁶

It is also not “misleading” under the First Amendment when words claimed as trademarks are used to trigger pop-up ads or sponsored links on the Internet. Keyword advertising can result in the display of comparative ads, communicate information about goods or services related to the markholder, or provide commentary regarding the trademark holder and its products. This is all useful information to consumers.²³⁷ It has “constitutional value” even if it confuses some consumers, including those consumers who believe the law grants markholders control over

233. See 44 *Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 496 (1996) (noting “the public’s interest in receiving accurate commercial information” is an “interest that supports regulation of potentially misleading advertising” yet also “supports an interpretation of the First Amendment that provides constitutional protection for the dissemination of accurate and nonmisleading commercial messages”) (citing *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 765 (1976)).

234. To qualify for the fair use defense, the defendant’s use of the descriptive term must be “a use, otherwise than as a mark.” 15 U.S.C. §1115(b)(4) (2000); see also, e.g., *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 953-54 (7th Cir. 1992) (holding that the defendant was not entitled to the fair use defense because it used the plaintiff’s mark “Thirst Aid” as an attention-getting symbol in advertising and not in a sentence describing Gatorade’s sports drink); Ramsey, *supra* note 7, at 1167-69 (explaining why this defense is limited).

235. Ramsey, *supra* note 7, at 1148-52; Tushnet, *supra* note 211, at 748-49 (noting that protecting trademark rights in descriptive terms that have acquired secondary meaning may result in the suppression of partially useful information and chill speech).

236. Ramsey, *supra* note 7, at 1148-52; *Ibanez v. Fla. Dept. of Bus. and Prof. Reg.*, 512 U.S. 136, 145-46 (1994); *Peel v. Attorney Registration & Disciplinary Comm.*, 496 U.S. 91, 100-11 (1990); *In re R.M.J.*, 455 U.S. 191, 203 (1982).

237. See Rothman, *supra* note 9, at 158.

most uses of their trademarks. Neither current trademark law nor the First Amendment answers the policy question of whether the markholder or Internet search engine provider should profit from keyword advertising that uses trademarked words. Yet the First Amendment does require consideration of the effect on expression of a trademark injunction banning unauthorized use of trademarked language in keyword advertising. If given total control over this use of their marks, many trademark holders are unlikely to license their marks to trigger comparative advertisements, negative commentary, parody, or satire incorporating the mark. Especially where the trademark consists of common words (such as American Airlines), and is not a fanciful term, expression is harmed if courts automatically label infringing use of that term “misleading” and refuse to engage in further constitutional scrutiny of this speech restriction.

Moreover, a conclusion that commercial speech is “misleading”—and therefore categorically excluded from First Amendment protection—is very troublesome when the finding of infringement is based only on initial interest confusion on the Internet. In some cases, courts find infringement where consumers are only initially confused regarding the trademark holder’s affiliation with the triggered ad.²³⁸ If this confusion is dispelled upon viewing the ad or website, it is problematic to call this use of the mark “misleading” speech because the harm (if any) to consumers is minimal.²³⁹ The value of this use of the mark may be high and may inform the public rather than deceive it.²⁴⁰ The misleading commercial speech exception should not be used to avoid constitutional analysis of the doctrine of initial interest confusion.

Use of another’s mark to express commentary, parody, or satire on clothing and other expressive merchandise should also not be deemed “misleading” speech (and may also not be commercial speech) where it does not cause confusion regarding the product source.²⁴¹ Third parties may use a variation of another’s trademark to poke fun at or comment on the trademark holder or society, or otherwise convey a humorous message, rather than identify the source of the product. Examples include use of the General Electric mark in the pun “Genital Electric” displayed on T-shirts and underwear²⁴² and use of a design similar to the American

238. See, e.g., *Playboy Enters. v. Netscape Commc'ns Corp.*, 354 F.3d 1020 (9th Cir. 2004); *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d 1430 (S.D.N.Y. 1997), *aff'd*, 152 F.3d 920 (2d Cir. 1998); *Jews for Jesus v. Brodsky*, 993 F. Supp. 282 (D.N.J.), *aff'd* 159 F.3d 1351 (3d Cir. 1998).

239. Cf. *Lamparello v. Falwell*, 420 F.3d 309, 318 n.6 (4th Cir. 2005) (The court thought the *Planned Parenthood* and *Jews for Jesus* cases “were wrongly decided to the extent that in determining whether the domain names were confusing, the courts did not consider whether the websites’ content would dispel any confusion. In expanding the initial interest confusion theory of liability, these cases cut it off from its moorings to the detriment of the First Amendment.”).

240. See Rothman, *supra* note 9, at 158.

241. See *supra* Part I.B.

242. *Gen. Elec. Co. v. Alumpa Coal Co.*, 205 U.S.P.Q. 1036 (D. Mass. 1979) (finding infringement of General Electric logo).

Express card design, slogan “Don’t Leave Home Without It,” and other marks of American Express Company on “condom card” packaging for condoms with the phrase “Never Leave Home Without It.”²⁴³ Although a clever pun incorporating another’s mark may just be funny and not as valued as political speech, humorous expression is not excluded from the protection of the First Amendment. All of these uses of a mark can have value even if some consumers are confused regarding whether the markholder consented to this use of the mark. Confusion about sponsorship or approval by the markholder in such circumstances should not satisfy the high threshold of misleading speech because this speech has constitutional value that should be balanced against the markholder’s trademark rights and any real harm caused by this expression.

When a trademark use is infringing but not misleading commercial speech, courts will need to engage in a more nuanced analysis of the constitutionality of the law or injunction before they allow the plaintiff to prevail. Moreover, the burden of proof on the misleading or commercial nature of the speech should remain with the trademark holder or the government.²⁴⁴ In some cases, the court has erroneously stated that the burden of proof was on the defendant when it raised a First Amendment challenge, probably because the First Amendment was listed as an “affirmative defense.”²⁴⁵ Unless convinced otherwise, courts should presume the speech is nonmisleading and/or noncommercial—not the other way around. These classifications will lead to increased constitutional scrutiny of the trademark regulation and will better protect the free flow of commercial and noncommercial expression.

D. FIRST AMENDMENT SCRUTINY

If a trademark use is not misleading commercial speech categorically excluded from constitutional protection, then the U.S. Supreme Court’s First Amendment jurisprudence requires courts to subject the trademark law or injunction to constitutional scrutiny if the defendant raises a First Amendment challenge and the court rules for the plaintiff. As explained

243. *Am. Express Co. v. Vibra Approved Lab. Corp.*, 10 U.S.P.Q.2d 2006, 1989 WL 39679 (S.D.N.Y. 1989) (granting preliminary injunction due to likelihood of success on claim under New York anti-dilution law).

244. See *Edenfield v. Fane*, 507 U.S. 761, 768-71 (1993); *Zauderer v. Office of Disciplinary Counsel of the Supreme Court of Ohio*, 471 U.S. 626, 646 (1985) (stating “the free flow of commercial information is valuable enough to justify imposing on would-be regulators the costs of distinguishing the truthful from the false, the helpful from the misleading, and the harmless from the harmful”). The government should not be able to simply assert this commercial speech is misleading. See Tushnet, *supra* note 211, at 744-47.

245. *E.g.*, *Univ. of Kan. v. Sinks*, No. 06-2341-JAR, 2008 WL 755069, at *30-31 (D. Kan. Mar. 19, 2008) (stating that “defendants have the ultimate burden of proof” on the affirmative defenses and failed “to meet their burden of coming forward with specific facts that would demonstrate genuine issues of material fact on the essential elements of any of these affirmative defenses,” including the affirmative defense that defendants’ “use of the marks at issue is protected by the First Amendment”; the court granted summary judgment to plaintiffs on this claim after finding defendants’ use of the marks to be misleading commercial speech).

below, the applicable level of First Amendment scrutiny usually depends on the type of speech (for example, nonmisleading commercial speech) or the type of regulation of speech (for example, a content-based regulation of noncommercial speech).²⁴⁶ Courts may also consider whether a trademark injunction is a prior restraint of speech, or whether the trademark law is unconstitutionally vague or overbroad.

Constitutional analysis of trademark law requires an inquiry into the government's reasons for regulating this expression. For speech restrictions to be constitutional, the government interest must generally be "substantial" for commercial speech and "compelling" for noncommercial speech.²⁴⁷ For this reason, legislatures and courts should clearly articulate the purpose of each new trademark statute or common law trademark doctrine. In Section 45 of the Lanham Act, codified at 15 U.S.C. § 1127, Congress explicitly set forth its "intent" in regulating trademarks:

The intent of this chapter is [1] to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in commerce; [2] to protect registered marks used in such commerce from interference by State, or territorial legislation; [3] to protect persons engaged in such commerce against unfair competition; [4] to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and [5] to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.²⁴⁸

Regardless of whether this provision embodies Congress's actual legislative purpose when it passed the Lanham Act and made subsequent revisions to it, this paragraph contains some evidence of Congress's intent in regulating trademarks.²⁴⁹

In trademark disputes, the Supreme Court has examined the legislative history of the federal trademark statute to determine its purpose and concluded that "[t]he Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers."²⁵⁰ It also said "[n]ational protection of trademarks is desirable, Congress concluded, because trademarks foster competition and the maintenance of quality by securing to the producer the

246. Stone, *Dialogue*, in *ETERNALLY VIGILANT*, *supra* note 185, at 9.

247. *See infra* Part II.D.1&2.

248. 15 U.S.C. § 1127 (2000).

249. *See* Edward S. Rogers, *Introduction to, DAPHNE ROBERT, THE NEW TRADEMARK MANUAL* (1947), at xiv-xxi ("Here we have a direct statement of a national policy by the Congress.") (quoted in *Application of Nat'l Distillers & Chem. Corp.*, 297 F.2d 947, 952 (CCPA 1962) (Rich, J., concurring) (noting that Edward S. Rogers was one of the chief architects of the Lanham Act).

250. *Park 'N Fly, Inc. v. Dollar Park & Fly*, 469 U.S. 189, 198 (1985) (citing *S. Rep. No. 1333*, at 3, 5 (1946)).

benefits of a good reputation.”²⁵¹ Scholars and jurists note that the standard economic arguments for protecting trademarks include the benefit of reduced consumer search costs and the creation of incentives for markholders to maintain and improve product quality.²⁵² Some courts believe that markholders have property (or quasi-property) rights in their distinctive trademarks, and the government should protect such property interests from unauthorized use by third parties.²⁵³

Although the Supreme Court was concerned about free riding on the goodwill invested in the Olympic word and symbols in *San Francisco Arts & Athletics*,²⁵⁴ it is not clear the Court would hold today that prohibiting free riding on the goodwill in a trademark is a substantial goal where use of the mark is not misleading.²⁵⁵ The Court may have accepted the gov-

251. *Id.* (citing S. Rep. No. 1333, at 4).

252. *Ty Inc. v. Perryman*, 306 F.3d 509, 510 (7th Cir. 2002); WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 168, 173 (2003); Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2101, 2105-08 (2004); Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1197 (2006); Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 11 HOUS. L. REV. 777, 790 (2004); Dogan & Lemley, *supra* note 124, at 493; see generally Daniel Klerman, *Trademark Dilution, Search Costs, and Naked Licensing*, 74 FORDHAM L. REV. 1759 (2006); J. Thomas McCarthy, *Proving a Trademark Has Been Diluted: Theories or Facts?*, 41 HOUS. L. REV. 713, 727-28 (2004).

253. *E.g.*, *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1188 (E.D.N.Y. 1972) (“Plaintiff’s property right in its mark clearly extends to its reproduction and publication in advertising and for other promotional uses regarding its products.”). This trademark goal is used by some to justify dilution laws. As noted by Professor Austin, “dilution doctrine seems more palatable from a policy perspective if it does something positive for consumers rather than just protecting the property interests of proprietors of famous trademarks.” Graeme W. Austin, *Trademarks and the Burdened Imagination*, 69 BROOK. L. REV. 827, 891 n.276 (2004). Professor Pollack argues that courts concerned about property rights should also consider the public “ownership interest in the communicative power of a trademark” when marks “become communicative symbols standing for something *besides* the source or sponsorship of the product in whose service they originated.” Malla Pollack, *Your Image Is My Image: When Advertising Dedicates Trademarks to the Public Domain—With an Example from the Trademark Counterfeiting Act of 1984*, 14 CARDOZO L. REV. 1391, 1393 (1993). According to the Court, “a property interest in a means of communication does not enlarge or diminish the First Amendment protection of that communication.” *Friedman v. Rogers*, 440 U.S. 1, 12 n.11 (1979).

254. *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 539-41 (1987) (quoting *Int’l News Serv. v. Associated Press*, 248 U.S. 215, 239-40). According to Professor Welkowitz, “The [SFAA] Court clearly believed that dilution protection, at least in some contexts, is permitted by the First Amendment.” WELKOWITZ, *supra* note 115, at 333.

255. Free riding off of the goodwill in another’s mark can be procompetitive if a competitor’s use of the mark is not misleading. See Margreth Barrett, *Internet Trademark Suits and the Demise of “Trademark Use,”* 39 U.C. DAVIS L. REV. 371, 393, 417-18 (2006); Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEX. L. REV. 1031, 1033-69 (2005); Glynn S. Lunney, *Trademark Monopolies*, 48 EMORY L.J. 367, 455-61 (1999). According to a recent plurality of the Court, “[i]t is the State’s interest in protecting consumers from ‘commercial harms’ that provides the ‘typical reason why commercial speech can be subject to greater governmental regulation than noncommercial speech.’ Yet bans that target truthful, nonmisleading commercial messages rarely protect consumers from such harms. Instead, such bans often serve only to obscure an ‘underlying governmental policy’ that could be implemented without regulating speech. In this way, these commercial speech bans not only hinder consumer choice, but also impede debate over central issues

ernment's asserted goals at face value or assumed they were a substantial government interest in the past, but the Court is more closely evaluating the constitutionality of commercial speech regulations today.²⁵⁶ It may (and should) look more closely at the reasons for regulating trademarks and not simply defer to the judgment of the legislature that our constitutional freedoms are sufficiently protected. Prevention of free riding and other proposed goals of trademark law may not satisfy constitutional scrutiny.

A broad trademark goal, such as protecting consumers from harm, is more likely to be found substantial or compelling, but this particular trademark law must be sufficiently narrowly tailored to prevent the suppression or chill of protected expression. If the goals of trademark law are defined more narrowly, such as preventing confusion about sponsorship or approval of use of a mark in artistic or literary works, some may question whether the alleged harm to consumers is real and sufficiently material to justify restricting this expression.

Although a full discussion of this issue is beyond the scope of this Article, I believe there is usually no substantial (let alone compelling) government interest in preventing confusion regarding the markholder's sponsorship or approval of use of its mark in artistic or literary works and other commentary, parody, or satire where there is no confusion regarding source.²⁵⁷ Confusion about whether trademark law requires consent to use another's mark in a magazine or whether the markholder consented to this design displayed on a T-shirt²⁵⁸ should not be equated with confusion caused by the misleading use of a mark that dupes consumers seeking the plaintiff's product into buying the defendant's product. If there is no evidence consumers actually relied, or are likely to rely, on

of public policy." 44 *Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 502-03 (1996) (plural opinion) (citations and footnotes omitted).

256. See *supra* Part I.A.

257. I include satire here even though some courts "elevate parody as a favored form of literary or artistic comment and devalue satire" in intellectual property cases, both because the difference between parody and satire is unclear and because excluding satire does not take into account the "First Amendment values served by satires as well as parodies." Bruce P. Keller & Rebecca Tushnet, *Even More Parodic Than the Real Thing: Parody Lawsuits Revisited*, 94 *TRADEMARK REP.* 979, 979, 999-1009 (2004). Satire is entitled to First Amendment protection just like parody. See *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 444 F. Supp. 2d 1012, 1042 n.142 (C.D. Cal. 2006) (declining to decide whether use in a video game of a strip club's "Play Pen" mark was a parody of the strip club or part of a larger parody of Los Angeles because "parody is not the exclusive form of expression protected under the First Amendment"); *Tommy Hilfiger Licensing, Inc. v. Nature Labs*, 221 F. Supp. 2d 410, 415 (S.D.N.Y. 2002) ("Even if not technically a parody, Nature Labs' use [of "Timmy Holedigger" for pet perfumes] is at least a pun or comical expression—ideas also held to be entitled to First Amendment protection.").

258. *E.g.*, *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 775-76 (8th Cir. 1994) (noting that fifty-eight percent of consumers surveyed thought the defendant "needed Anheuser-Busch's approval" to publish the parody and six percent believed the ad was a product of Anheuser-Busch; some said the markholder must have consented or "they'd never get away with it"); *Mut. of Omaha*, 836 F.2d at 400 (noting that twelve percent of the sample population said yes to the question "[w]ould you say that Mutual of Omaha goes along or does not go along with these T-shirts in order to make people aware of the nuclear war problem?").

this third party use of the mark *to their detriment* or were otherwise harmed by this expression, trademark holders must identify another constitutionally sufficient reason for restricting expression that incorporates their marks. Preventing trademark free riding or a markholder's loss of control over the mark or its brand image does not qualify; there is no substantial government interest in protecting "the unfettered right [of markholders] to suppress the use of [their marks] in any context, commercial or noncommercial, found to be offensive, negative, or unwholesome."²⁵⁹ To conclude otherwise would give trademark holders too much control over language.

These goals of trademark law should be evaluated using intermediate scrutiny analysis when they regulate nonmisleading commercial uses of marks and strict constitutional scrutiny when they regulate noncommercial speech, as explained in more detail below.

1. *Intermediate Scrutiny for Commercial Speech Regulations*

Regulations of nonmisleading commercial speech are currently subject to *Central Hudson's* intermediate scrutiny test: Assuming the speech is not misleading and concerns a lawful activity, the trademark regulation violates the First Amendment unless the government interest in regulating the expression is substantial, the regulation directly advances that government interest, and the speech regulation is not more extensive than necessary to serve that interest.²⁶⁰ The regulation need not be the least restrictive means to achieve the government's goal.²⁶¹

The government has the burden to prove the *Central Hudson* test is satisfied.²⁶² Among other things, the government must "demonstrate that the harms it recites are real."²⁶³ In private trademark litigation, this burden is on the trademark holder, as it is asking the court to punish or enjoin the defendant's use of the mark.²⁶⁴ The *Central Hudson* test is not toothless; the Court has recently struck down several laws under this test.²⁶⁵ Moreover, the Court has said the government "retains less regu-

259. *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 30 (1st Cir. 1987); *see also* *Taubman Co. v. Webfeats*, 319 F.3d 770, 778 (6th Cir. 2003) (stating "although economic damage might be an intended effect of [defendant's use of the domain name *taubman-sucks.com*], the First Amendment protects critical commentary when there is no confusion as to source, even when it involves the criticism of a business"); *Cantwell*, *supra* note 22, at 69-71 (noting that the defendant may claim that it is ridiculing the markholder "because trademarks have come to assume a significance that is out of all proportion to their societal function as commercial identifiers, and that there is some public benefit to be derived from deflating these pretensions").

260. *Cent. Hudson Gas & Electric Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 566 (1980).

261. *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 476-81 (1989).

262. *Edenfield v. Fane*, 507 U.S. 761, 768-71 (1993).

263. *Id.*

264. *Id.* at 770 ("It is well established that '[t]he party seeking to uphold a restriction on commercial speech carries the burden of justifying it.'" (quoting *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 71 n.20 (1983)); *Zauderer v. Office of Disciplinary Counsel of the Supreme Court of Ohio*, 471 U.S. 626, 646 (1985)).

265. *See supra* note 74.

latory authority when its commercial speech restrictions strike at the substance of the information communicated,"²⁶⁶ which is the case for trademark laws.²⁶⁷

Scholars contend that some trademark laws regulating commercial speech do not survive *Central Hudson* scrutiny, such as trademark protection for descriptive terms,²⁶⁸ the current trademark dilution laws,²⁶⁹ and the doctrine of initial interest confusion, which is applied to the use of trademarks to trigger keyword advertising, among other uses of marks.²⁷⁰ Moreover, Professor Rebecca Tushnet has argued that the constitutionality of "the core of the Lanham Act—its prohibition of commercial uses of words and symbols that are confusingly similar to words and symbols used by other commercial entities"—cannot even be taken for granted if trademark infringement laws are subject to real First Amendment analysis.²⁷¹ Rather than summarize this constitutional analysis here, for the sake of brevity readers are encouraged to consult the above-cited scholarship. These scholars raise serious questions about the constitutionality of some current trademark statutes and common law doctrines.

Due to the doctrine of constitutional avoidance, courts may be hesitant to engage in constitutional analysis of these trademark laws. The court must do so, however, if a defendant directly challenges the constitutionality of a trademark law and the court is unable to rule for the defendant on other grounds. For example, if the defendant argues on a motion to dis-

266. 44 *Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 499 (1996) (citations and internal quotations omitted); *see also id.* at 502 ("Regulations that suppress the truth are no less troubling because they target objectively verifiable information, nor are they less effective because they aim at durable messages. As a result, neither the 'greater objectivity' nor the 'greater hardiness' of truthful, nonmisleading commercial speech justifies reviewing its complete suppression with added deference.").

267. *See infra* Part II.D.2.c.

268. Ramsey, *supra* note 7, at 1146-74.

269. *See, e.g.*, Rebecca Tushnet, *Truth and Advertising: The Lanham Act and Commercial Speech Doctrine*, in *TRADEMARK LAW & THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH* 294, 312-22 (Graeme B. Dinwoodie & Mark D. Janis eds., 2008); Mary LaFrance, *No Reason to Live: Dilution Laws as Unconstitutional Restrictions on Commercial Speech*, 58 S.C. L. REV. 709, 711 (2007); Paul Alan Levy, *The Trademark Dilution Revision Act—A Consumer Perspective*, 16 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 1189, 1193 (2006); *see also* Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 *TEX. L. REV.* 507 (2008). Commentators have also discussed the constitutionality of federal and state dilution laws before Congress enacted the Trademark Dilution Revision Act of 2006. *See, e.g.*, Richard B. Biagi, *The Intersection of First Amendment Commercial Speech Analysis and the Federal Trademark Dilution Act: A Jurisprudential Roadmap*, 91 *TRADEMARK REP.* 867, 875-889 (2001); Denicola, *supra* note 5, at 194-95; Megan E. Gray, *Defending Against a Dilution Claim: A Practitioner's Guide*, 4 *TEX. INTELL. PROP. L.J.* 205, 225-27 (1996); Robert N. Kravitz, *Trademarks, Speech, and the Gay Olympics Case*, 69 *B.U. L. REV.* 131, 147-48 (1989); Malla Pollack, *Time to Dilute the Dilution Statute and What Not to Do When Opposing Legislation*, 78 *J. PAT. & TRADEMARK OFF. SOC'Y* 518, 540-41 (1996); Kenneth L. Port, *The "Unnatural" Expansion of Trademark Rights: Is a Federal Dilution Statute Necessary?*, 18 *SETON HALL LEGIS. J.* 433, 446-47 (1994); Simone A. Rose, *Will Atlas Shrug? Dilution Protection for 'Famous' Trademarks: Anti-Competitive 'Monopoly' or Earned 'Property' Right?*, 47 *FLA. L. REV.* 653, 739-40 (1995); Volokh, *supra* note 34, at 732-39.

270. Rothman, *supra* note 9, at 150-59.

271. Tushnet, *supra* note 211, at 739, 748-556.

miss that the federal and state dilution laws are unconstitutional restrictions of nonmisleading commercial speech under the First Amendment, the court cannot ignore this constitutional argument unless it rules for the defendant on other grounds. If the commercial speech is not misleading and concerns lawful activity, the court must apply each of the *Central Hudson* factors and articulate why this law is constitutional before it can deny the motion to dismiss. Engaging in this analysis will consume some judicial and litigant resources, but it can also protect expression in individual cases and generally raise awareness of the potential or actual conflict between certain trademark laws and free expression. Moreover, this constitutional analysis—however complicated or time-consuming—is required by the Court’s First Amendment jurisprudence when trademark law regulates nonmisleading commercial speech because trademarks are not categorically unprotected by the First Amendment.

2. *Strict Scrutiny for Content-Based Trademark Laws*

If the government is regulating noncommercial speech in trademark law, the Court’s First Amendment jurisprudence dictates that the constitutionality of that trademark regulation will usually depend on whether it is content-based or content-neutral. This classification may also be important for evaluating the constitutionality of commercial speech regulations if the Court abandons *Central Hudson’s* intermediate scrutiny test.²⁷² As explained below, trademark laws are content-based speech regulations subject to rigorous constitutional scrutiny when they are not restricting commercial speech.

a. The Level of Constitutional Scrutiny

Unless a categorical exception to full First Amendment protection applies, content-based regulations of speech are generally evaluated using strict scrutiny analysis, while content-neutral regulations are subjected to intermediate constitutional scrutiny.²⁷³ A content-based speech regulation survives strict scrutiny if it is narrowly tailored and is the least restrictive means to promote a compelling government interest.²⁷⁴ Even if alternative avenues of communication exist for the speaker to convey its message, “time, place, and manner” intermediate scrutiny analysis is inappropriate if a speech regulation is content-based.²⁷⁵ The Court has said content-based restrictions of speech are presumptively invalid.²⁷⁶ When the Court applies strict scrutiny analysis, the regulations are usually held to be unconstitutional. Strict scrutiny analysis is almost always “fatal in

272. Of course, if the Court abandons the *Central Hudson* test for commercial speech regulations generally, it could still retain an intermediate scrutiny test for evaluating the constitutionality of trademark laws. See *supra* Part II.D.2.d.

273. *Turner Broad. Sys. v. F.C.C.*, 512 U.S. 622, 642 (1994).

274. *United States v. Playboy Entm’t Group, Inc.*, 529 U.S. 803, 813 (2000).

275. *Reno v. ACLU*, 521 U.S. 844, 879 (1997).

276. *Playboy*, 529 U.S. at 817.

fact.”²⁷⁷ That does not mean, however, that all content-based regulations are unconstitutional.

As discussed in Part II.C., many content-based speech regulations, such as antitrust, securities, labor, and evidence laws, are never subjected to any constitutional analysis. Moreover, other content-based regulations of speech are found constitutional because the subject matter of the speech falls within a categorical exception to First Amendment protection, such as obscenity. Although such regulations of speech discriminate based on content, the Court has said “strict scrutiny is unwarranted” because the risk that “the Government may effectively drive certain ideas or viewpoints from the marketplace” is “inconsequential.”²⁷⁸ If they were subjected to constitutional scrutiny, it is possible courts would find that these speech regulations satisfy the highest burden of justification imposed by the First Amendment.²⁷⁹ Content-based laws are therefore subject to strict constitutional scrutiny unless the Court decides—for whatever reason—that heightened scrutiny is unwarranted for this particular restriction of speech.

Less constitutional scrutiny is required for content-neutral regulations of speech. They “are subject to an intermediate level of scrutiny.”²⁸⁰ Under the *United States v. O’Brien* test for regulations of expressive conduct, the government may regulate conduct with speech components if the restriction furthers an important or substantial government interest, that interest is unrelated to the suppression of free expression, and the speech restriction is no greater than is essential to further that interest.²⁸¹ Laws regulating the time, place, or manner of speech are constitutional under the *Ward v. Rock Against Racism* test if they are justified without reference to the speech’s content, are narrowly tailored to serve a significant government interest, and leave open ample alternative channels for communication of the information.²⁸² The *O’Brien* and *Ward* tests are similar in analysis to the intermediate scrutiny test in *Central Hudson* and much less rigorous than strict scrutiny analysis.²⁸³

277. Richard H. Fallon, Jr., *Strict Judicial Scrutiny*, 54 UCLA L. REV. 1267, 1313 (2007) (citing Gerald Gunther, *The Supreme Court, 1971 Term—Forward: In Search of Evolving Doctrine on a Changing Court: A Model for a Newer Equal Protection*, 86 HARV. L. REV. 1, 8 (1972)).

278. *Davenport v. Wash. Educ. Ass’n*, 127 S. Ct. 2372, 2381 (2007).

279. Schauer, *supra* note 174, at 1765-68.

280. *Turner Broad. Sys. v. F.C.C.*, 512 U.S. 622, 641 (1994).

281. *United States v. O’Brien*, 391 U.S. 367, 377 (1968).

282. *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989). The “narrowly tailored” element here does not require the least restrictive means to further the government’s goal, but only requires that the chosen restriction is not “substantially broader than necessary to achieve the government’s interest.” *Id.* at 798, 800.

283. See Bhagwat, *supra* note 55, at 801; S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm., 483 U.S. 522, 535-36, 541 (1987) (applying the *Central Hudson* and *O’Brien* tests in the same analysis).

b. The Distinction Between Content-Based and Content-Neutral Regulations of Speech

According to Professor Mark Tushnet, “the central organizing concept of First Amendment doctrine is the distinction between content-based regulations and content-neutral ones.”²⁸⁴ Classification of a trademark regulation as content-based or content-neutral may be critical to that law’s constitutionality, but the Court’s content-based/content-neutral doctrine is unclear, complicated, and inconsistent.²⁸⁵ As there is no indication the Court will abandon this doctrine, below I briefly summarize the Court’s principles for evaluating the content-neutrality of speech regulations and then, in the next section, explain in detail why trademark laws are content-based speech regulations.

In 1972, the Supreme Court said “[a]bove all else, the First Amendment means that government has no power to restrict expression because of its message, its ideas, its subject matter or its content.”²⁸⁶ While this statement is not entirely true under the Court’s current First Amendment jurisprudence—Congress may, for example, ban obscene speech because of its subject matter—the point is clear. Government regulation of speech based on its message, ideas, subject matter, or content is disfavored under the First Amendment.

More than twenty years later in *Turner*, the Court explained in detail why content-based regulations of expression may harm free speech values:

At the heart of the First Amendment lies the principle that each person should decide for himself or herself the ideas and beliefs deserving of expression, consideration, and adherence. Our political system and cultural life rest upon this ideal . . . Government action that stifles speech on account of its message, or that requires the utterance of a particular message favored by the Government, contravenes this essential right. Laws of this sort pose the inherent risk that the Government seeks not to advance a legitimate regulatory goal, but to suppress unpopular ideas or information or manipulate the public debate through coercion rather than persuasion. These restrictions ‘rais[e] the specter that the Government may effectively drive certain ideas or viewpoints from the marketplace.’ . . . For these reasons, the First Amendment, subject only to narrow and well-understood exceptions, does not countenance governmental control over the content of messages expressed by private individuals . . . [The Court’s] precedents thus apply the most exacting scrutiny to regulations that suppress, disadvantage, or impose differential bur-

284. Mark Tushnet, *The Supreme Court and Its First Amendment Constituency*, 44 *HASTINGS L.J.* 881, 882 (1993).

285. See generally, e.g., Paul B. Stephan, *The First Amendment and Content Discrimination*, 68 *VA. L. REV.* 203 (1982); Geoffrey Stone, *Content-Neutral Restrictions*, 54 *U. CHI. L. REV.* 46 (1987); Geoffrey R. Stone, *Content Regulation and the First Amendment*, 25 *WM. & MARY L. REV.* 189 (1983); Susan H. Williams, *Content Discrimination and the First Amendment*, 139 *U. PA. L. REV.* 615, 636 (1991).

286. *Police Dep’t of Chicago v. Mosley*, 408 U.S. 92, 95-96 (1972).

dens upon speech because of its content In contrast, regulations that are unrelated to the content of speech are subject to an intermediate level of scrutiny, . . . because in most cases they pose a less substantial risk of excising certain ideas or viewpoints from the public dialogue.²⁸⁷

The Court admits that “[d]eciding whether a particular regulation is content based or content neutral is not always a simple task.”²⁸⁸ In *Turner*, and more recently in *Bartnicki*, the Court discussed the relevant inquiry: “In determining whether a regulation is content based or content neutral, the Court looks to the purpose behind the regulation; typically, government regulation of expressive activity is content neutral so long as it is justified without reference to the content of the regulated speech.”²⁸⁹ “As a general rule, laws that by their terms distinguish favored speech from disfavored speech on the basis of the ideas or views expressed are content based.”²⁹⁰ “By contrast, laws that confer benefits or impose burdens on speech without reference to the ideas or views expressed are in most instances content neutral.”²⁹¹

Although the Court stated in *Ward* that the government purpose or justification behind a law is the “principal inquiry” and the “controlling consideration” in determining content-neutrality,²⁹² this is not the only inquiry.²⁹³ Sometimes it may be difficult, if not impossible, to determine the government’s true purpose in regulating this speech because motivation is easily concealed.²⁹⁴ A stated purpose in the text of a statute, or statements in the legislative history, may not be the actual purpose of every member, or even a majority, of the legislature. In *Turner*, the Court emphasized that a content-based purpose “is not necessary” to show that a regulation is based on the content of speech; a regulation may be content-based even if the legislator’s asserted purpose is content-neutral.²⁹⁵ “[T]he mere assertion of a content-neutral purpose” is not “enough to save a law which, on its face, discriminates based on content.”²⁹⁶ In some circumstances, the statute’s operational text may provide the best evidence of the government’s content-based purpose in enacting this legislation.²⁹⁷

287. *Turner Broad. Sys. v. F.C.C.*, 512 U.S. 622, 641-42 (1994) (internal citations omitted).

288. *Id.* at 642.

289. *Bartnicki v. Vopper*, 532 U.S. 514, 526 (2001) (internal quotations and brackets omitted).

290. *Turner*, 512 U.S. at 643.

291. *Id.*

292. *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989).

293. See *Police Dep’t of Chicago v. Mosley*, 408 U.S. 92, 96 (1972) (“Selective exclusions from a public forum may not be based on content alone, and may not be justified by reference to content alone.”) (emphasis added).

294. See Richard A. Posner, *The Speech Market and the Legacy of Schenck*, in *ETERNALLY VIGILANT*, *supra* note 185, at 128.

295. *Turner*, 512 U.S. at 642-43 (quoted in *Bartnicki v. Vopper*, 532 U.S. 514, 526 n.9).

296. *Id.*

297. See *id.* at 642 (“The purpose, or justification, of a regulation will often be evident on its face.”).

Applying the Court's First Amendment jurisprudence summarized above, a speech regulation is content-based if (1) the government's purpose behind the law is content-based *or* (2) the law discriminates on its face based on the speech's content. Trademark laws are content-based speech regulations for both of these reasons.

c. Trademark Laws Are Content-Based Regulations of Speech

The few courts and scholars that have discussed the content-neutrality of government regulations of trademarks disagree on whether they are content-based or content-neutral. Courts generally engage in a cursory analysis of the issue, if they address it at all. In one sentence, the Second Circuit summarily concluded that the federal trademark statute is a content-neutral speech regulation in *Dallas Cowboys*: "The prohibition of the Lanham Act is content neutral . . . and therefore does not arouse the fears that trigger the application of constitutional 'prior restraint' principles."²⁹⁸ This conclusion was cited with approval by the Ninth Circuit in *Dr. Seuss*.²⁹⁹ Both decisions are criticized by Professors Volokh and Lemley as confusing viewpoint-neutrality with content-neutrality.³⁰⁰ Later, in *Nissan*, the Ninth Circuit held that an injunction prohibiting use of the Nissan mark to make disparaging remarks or negative commentary about Nissan "is a content-based restriction because the purpose behind it is to control the message and [the restriction] is not 'justified without reference to the content of the regulated speech.'"³⁰¹ The Eighth Circuit admits there may be merit to the argument that courts "restrict the content of speech" when they "forbid the use of trademarks as the grist for parody," but thought this argument did not apply to an injunction prohibiting use of a particular design on T-shirts and other novelty merchandise.³⁰²

The U.S. Supreme Court has not expressed its opinion on the content-neutrality of the Lanham Act or state trademark laws. The Court did, however, implicitly suggest that a law similar to trademark law was a content-neutral regulation in *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*.³⁰³ In this case, a 7-2 majority of the Court upheld the constitutionality of the Amateur Sports Act, which prohibits certain uses of the word "Olympic" and related symbols without authori-

298. *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979).

299. *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403 n.11 (9th Cir. 1997) (rejecting the defendants' "claim that the injunction in this case constitutes a prior restraint in violation of free speech guaranteed by the United States Constitution"). See generally Tyler Ochoa, *Dr. Seuss, The Juice, and Fair Use: How the Grinch Silenced a Parody*, 45 J. COPYRIGHT SOC'Y U.S.A. 546 (1998).

300. Lemley & Volokh, *supra* note 5, at 218.

301. *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1016 (9th Cir. 2004).

302. *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 & n.8 (8th Cir. 1987).

303. 483 U.S. 522, 561, 570 (1987) (Brennan, J. dissenting) (arguing that the majority's analysis was not proper because the speech restriction was content-based); see Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity—Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471, 484 (2003).

zation by the United States Olympic Committee. The Court held that the ban on particular uses of the word "Olympic" by the sponsors of the "Gay Olympic Games" in noncommercial speech satisfied constitutional scrutiny under *O'Brien*, the intermediate-scrutiny test for evaluating content-neutral regulations of expressive conduct.³⁰⁴ According to the Court, this speech restriction should not be evaluated using heightened constitutional scrutiny because the Act did not restrict the content of the message conveyed, but only the "manner" in which the sponsors could identify and promote their games.³⁰⁵ The analysis and conclusion in this decision have been applied by lower courts in trademark disputes³⁰⁶ and aptly criticized by commentators and Justice Brennan.³⁰⁷

Only a few scholars have engaged in serious analysis of the content-neutrality of trademark law. In the best and most thorough discussion of the issue, Professors Lemley and Volokh, and later Professor Volokh alone in his *Houston Law Review* article, argue that trademark laws are content-based regulations of speech.³⁰⁸ In the copyright law area, scholars strongly disagree on whether copyright law is content-based³⁰⁹ or content-neutral.³¹⁰ The Court did not explicitly resolve this issue in *Eldred*,

304. *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 535-36, 541 (1987). It also found the commercial speech restrictions satisfied *Central Hudson* scrutiny. *Id.* at 535-36.

305. *Id.* at 568.

306. *E.g.*, *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559, 1171-73 (S.D. Cal. 1996), *aff'd*, 109 F.3d 1394 (9th Cir. 1997).

307. *E.g.*, *S.F. Arts & Athletics, Inc. v. U.S. Olympic Committee*, 483 U.S. 522, 570 (1987) (Brennan, J., dissenting); Denicola, *supra* note 5, at 206; Dreyfuss, *supra* note 22, at 411-12; Kravitz, *supra* note 269, at 146, 166-77; Volokh, *supra* note 34, at 712, 736-37.

308. Volokh, *supra* note 34, at 712; Lemley & Volokh, *supra* note 5, at 219-20. Some scholars mention briefly that trademark regulations are generally content-based, e.g., Schauer, *supra* note 174, at 1783 (noting that "much the same degree of First Amendment irrelevance holds true for the content-based regulation of trademarks") (citing *Friedman v. Rogers*, 440 U.S. 1, 15-16 (1979)), or content-neutral speech regulations, e.g., Paul Bender, *The Constitutionality of Proposed Federal Database Protection*, 28 U. DAYTON L. REV. 143, 153-54 (2002) (stating that "the protection that has been given by statute and common law to trademarks" is a "content neutral misappropriation restriction[] that can be seen as being narrowly tailored to serve substantial governmental interests"), but do not provide an explanation for their conclusions. Some commentators have discussed whether specific trademark provisions, such as the ban on registration of "immoral, deceptive, or scandalous matter," 15 U.S.C. § 1052(a) (2000), are content-based or content-neutral speech restrictions, see e.g., Llewellyn J. Gibbons, *Trademarking the Immoral and Scandalous: Section 2(a) of the Lanham Act*, in 3 INTELLECTUAL PROPERTY AND INFORMATION WEALTH: ISSUES AND PRACTICES IN THE DIGITAL AGE 147 (Peter K. Yu ed., 2007) ("Section 2(a) is not a content-neutral regulation of speech."); Jeffrey Leftsin, Note, *Does the First Amendment Bar Cancellation of Redskins?*, 52 STAN. L. REV. 665, 706 (2000).

309. *E.g.*, Volokh, *supra* note 34, at 702-10; C. Edwin Baker, *First Amendment Limits on Copyright*, 55 VAND. L. REV. 891, 939-40 (2002); Lemley & Volokh, *supra* note 5, at 169, 186; Brett McDonnell and Eugene Volokh, *Freedom of Speech and Independent Judgment Review in Copyright Cases*, 107 YALE L.J. 2431, 2447 (1998); cf. Jed Rubenfeld, *The Freedom of Imagination: Copyright's Constitutionality*, 112 YALE L.J. 1, 49 (2002) (noting that copyright law is generally content-based, except copyright rules regulating verbatim copying are content-neutral).

310. *E.g.*, Yochai Benkler, *Constitutional Bounds of Database Protection: The Role of Judicial Review in the Creation and Definition of Private Rights in Information*, 15 BERKELEY TECH. L.J. 535, 555-56, 588 (2000); Erwin Chemerinsky, *Balancing Copyright Protections and Freedom of Speech: Why the Copyright Extension Act Is Unconstitutional*, 36

although it did reject the “plea for imposition of uncommonly strict scrutiny on a copyright scheme that incorporates its own speech-protective purposes and safeguards.”³¹¹

I agree with Professors Lemley and Volokh that trademark laws are generally content-based speech regulations. Trademark laws define the speech they prohibit or allow based on the content of the speech.³¹² As noted by the Court, a law is content-based if it “is the content of the speech that determines whether it is within or without the statute’s blunt prohibition.”³¹³ Below, this Article adds to the scholarship on this topic by providing a more detailed application of the Court’s content-based/content-neutral jurisprudence to trademark law and additional arguments demonstrating why trademark laws are content-based speech regulations. It proposes and develops the concept of “word choice discrimination” in trademark law, discusses the various ways trademark law discriminates based on subject matter, and explains why trademark laws are generally viewpoint neutral. Trademark laws that discriminate based on word choice and subject matter may ultimately be constitutional, but they are still content-based regulations of speech.

i. Word Choice Discrimination

To evaluate whether a violation of trademark law has occurred, the trier of fact must examine the content of the defendant’s expression to determine if the defendant is using a word, name, symbol, or device (hereinafter “word” for brevity) that is identical or similar to the plaintiff’s protected trademark in a manner that is likely to cause consumer confusion, dilution, or some other trademark violation. This examination of the defendant’s speech is a two-part inquiry that focuses on the word choice of the defendant and the subject matter of the message conveyed.

The trier of fact must first consult the content of the defendant’s speech to determine whether the defendant is even using a word that is identical or similar in some way to the plaintiff’s trademark. In most trademark cases this criteria will be satisfied. Without some use by the defendant of

LOY. L.A. L. REV. 83, 93–94 (2002); David McGowan, *Why the First Amendment Cannot Dictate Copyright Policy*, 65 U. PITT. L. REV. 281, 294–96 (2004); cf. Rebecca Tushnet, *Copyright as a Model for Free Speech Law: What Copyright Has in Common with Campaign Finance Reform, Hate Speech and Pornography Regulation, and Telecommunications Regulation*, 42 B.C. L. REV. 1, 54 (2001) (noting that copyright law “seems content- and viewpoint-neutral on its face”). Professor Netanel believes that copyright laws are content-neutral speech regulations and that courts should apply *Turner*’s heightened form of *O’Brien/Ward* intermediate scrutiny analysis because the government is allocating speech entitlements. Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1, 4-5 (2001) (citing *Turner Broadcast System v. F.C.C.*, 512 U.S. 622 (1994)); NEIL W. NETANEL, *COPYRIGHT’S PARADOX* 120 & n.31 (2007). In *Eldred*, the petitioners principally relied on *Turner* to support their First Amendment argument, but the Court concluded that *Turner* “bears little on copyright.” *Eldred v. Ashcroft*, 537 U.S. 186, 220-21 (2003); see generally NETANEL, *COPYRIGHT’S PARADOX*, *supra*, at 172-94 (discussing *Eldred* and arguing for “First Amendment intervention in copyright law”).

311. *Eldred*, 537 U.S. at 218-19.

312. Volokh, *supra* note 34, at 703; Lemley & Volokh, *supra* note 5, at 218–20.

313. *Carey v. Brown*, 447 U.S. 455, 462 (1980).

a word that evokes the plaintiff's mark, there is no legitimate reason for the plaintiff to file suit or for the judge or jury to find a trademark violation. If the defendant is using a completely different word as a mark, then the defendant is not liable for a trademark violation in a suit *by this plaintiff* because it has not used the plaintiff's trademark. By allowing the use of some words but not others, trademark law discriminates based on word choice. I call this type of content discrimination "word choice discrimination."³¹⁴ Trademark liability depends on the content of the defendant's speech because the defendant is not liable unless the exact words it uses are identical or sufficiently similar to the plaintiff's trademark.³¹⁵

Government prohibitions on the use of certain words can have a significant effect on the communicative impact of expression. Some words may be more effective than others in conveying the speaker's intended message.³¹⁶ Most people would agree that Paul Cohen's message³¹⁷ would not be as strong if his jacket displayed the statement "I Strongly Resent the Draft" or "Ban the Draft" rather than the more emotive statement "Fuck the Draft."³¹⁸ An anti-war message is more powerful when the peace sign is superimposed on the American flag rather than white poster board.³¹⁹ Although the Court disagreed,³²⁰ the San Francisco Athletics Association believed the term "Gay Olympic Games" communicated its message about the treatment of gays in society better than the phrase "Gay Games."³²¹ When punishment or liability depends on what word or symbol is used by the speaker (a profane word, the American flag, the Olympic word and symbols or another's trademark), that speech regulation is content-based regardless of whether the law is constitutionally justified. There is always a chance that word choice matters in the communication of a particular idea. As noted by the Court in *Cohen*,

314. Although I use the phrase "word choice discrimination," I intend for the term to also apply to trademarked names, symbols, and devices.

315. For this reason, trademark law is different than the Colorado statute in *Hill*, where the content of the speech was examined but the Court said that "it is unlikely that there would often be any need to know exactly what words were spoken in order to determine whether 'sidewalk counselors' are engaging in 'oral protest, education, or counseling' rather than pure social or random conversation." *Hill v. Colorado*, 530 U.S. 703, 720 (2000).

316. *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 306 (9th Cir. 2002) ("[A]lthough English is a language rich in imagery, we need not belabor the point that some words, phrases or symbols better convey their intended meanings than others."); Volokh, *supra* note 34, at 712.

317. *Cohen v. California*, 403 U.S. 15, 16 (1971) (noting that Cohen was in the Los Angeles County Courthouse corridor wearing a jacket bearing the words "Fuck the Draft" and testified that this message was intended to inform the public of the depth of his feelings against the Vietnam war and the draft).

318. See *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 569 (1987) (Brennan, J., dissenting); Frank Haiman, *Speech and Privacy: Is There a Right Not to Be Spoken To?*, 67 Nw. U. L. REV. 153, 189 (1972); Volokh, *supra* note 34, at 703.

319. *Spence v. Washington*, 418 U.S. 405, 406 (1974).

320. *S.F. Arts & Athletics v. U.S. Olympic Comm.*, 483 U.S. 522, 536 (1987).

321. *Id.* at 525, 535 n.13; see also Wendy Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533, 1591 (1993).

“[w]e cannot indulge the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process.”³²²

Trademark law regulates word choice in different ways. A domain name can express ideas and information, so using trademark law to ban the use of language claimed as a mark in that domain name is a content-based regulation that may make the domain name less effective.³²³ A prohibition on the unauthorized use of trademarks on the front of T-shirts or in the titles or content of artistic or literary works changes the content of the words or symbols used in that message.³²⁴ “Mutant of Omaha” with the distorted logo of Mutual of Omaha conveys the message in a different and more attention-grabbing way than the phrase “Nuclear War Causes Mutations” displayed on T-shirts. When applied to commentary, parody, or satire, trademark law deprives artists, authors, activists, and humorists the ability to use particular words. Prohibiting the use of trademarked descriptive terms in part of a brand name, slogan, or domain name or the use of trademarks to trigger keyword advertising may stifle the efficient communication of commercial information to consumers about competing products. Granting strong trademark rights across several industries in common words that are inherently catchy or interesting, such as “Virgin,”³²⁵ reduces the amount of language with natural selling power that is available for use as a mark by new entrants to the marketplace.

By restricting the use of particular words, trademark laws are simply not analogous to other speech restrictions found to be content-neutral. Trademark laws are different from government restrictions on sound amplification devices on trucks,³²⁶ prohibitions of speech near schools that are disruptive of the schools,³²⁷ regulations restricting speech on public sidewalks surrounding the Supreme Court building,³²⁸ laws regulating the

322. *Cohen*, 403 U.S. at 26.

323. See, e.g., *People for the Ethical Treatment of Animals v. Doughney*, 113 F. Supp. 2d 915, 919 (E.D. Va. 2000) (*peta.org*), *aff'd on other grounds*, 263 F. 3d 359 (4th Cir. 2001); *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176, 184, 192 (W.D.N.Y. 2000) (*buffalonews.com*); *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 308 (D.N.J.), *aff'd* 159 F.3d 1351 (3d Cir. 1998) (*jewsforjesus.org*).

324. See, e.g., *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997); *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987); *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769 (8th Cir. 1994); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727 (D. Minn. 1998).

325. *Virgin Enters. v. So Collective*, No. 04-08964 (S.D.N.Y. Nov. 12, 2004); see Paul Alan Levy, *The Trademark Dilution Revision Act—A Consumer Perspective*, 16 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 1189, 1201-02 (2006) (discussing the dilution claims filed by Virgin Enterprises against several small companies that use the term “Virgin” in their brand names); see also Amanda Cantrell, *Branson trademark suit sparks debate: ‘Rebel billionaire’ sues small companies using word ‘Virgin’—and often wins. But is it right?*, *CNNMONEY* (June 29, 2005), http://money.cnn.com/2005/06/29/news/newsmakers/branson_suit/index.htm.

326. *Kovacs v. Cooper*, 336 U.S. 77 (1949).

327. *Grayned v. Rockford*, 408 U.S. 104 (1972).

328. *United States v. Grace*, 461 U.S. 171 (1983).

noise level at concerts,³²⁹ a sales tax which applies to all purchases, including cable television,³³⁰ or state fair regulations regarding the distribution of materials.³³¹ The restrictions on word choice in trademark law are one reason trademark law is a content-based speech restriction. As the government does not disapprove of the word itself, such restrictions are more like content-based flag desecration laws³³² rather than profanity laws, but they are still content-based.

A few courts explicitly or implicitly conclude that trademark laws are content-neutral regulations of speech because the government is not prohibiting, and does not intend to prohibit, the speaker's ultimate message in any form. Under this view, use of the trademarked word is banned in this context, but alternative words may be used to communicate the same message. These courts say the trademark regulation is constitutional because adequate "alternative avenues of communication"—*i.e.* other words—exist for the defendant to convey its message.³³³ In *Friedman, San Francisco Arts & Athletics*, and *Pacifica*, the Court has similarly suggested that government prohibitions on word choice only have an incidental effect on the content of the message,³³⁴ and primarily affect the "manner" or "form" of speech rather than its message.³³⁵

329. *Ward v. Rock Against Racism*, 491 U.S. 781 (1989).

330. *Leathers v. Medlock*, 499 U.S. 439 (1991).

331. *Heffron v. Int'l Soc. for Krishna Consciousness, Inc.*, 452 U.S. 640 (1981).

332. *E.g.*, *United States v. Eichman*, 496 U.S. 310, 315-17 (1990) ("Although the Flag Protection Act contains no explicit content-based limitation on the scope of prohibited conduct, it is nevertheless clear that the Government's asserted interest is related to the suppression of free expression, . . . and concerned with the content of such expression.") (citations and internal quotations omitted); *Spence v. Washington*, 418 U.S. 405, 414 n.8 (1974) (noting that the purpose of the flag desecration law "is directly related to expression in the context of activity like that undertaken by" the defendant and thus the *O'Brien* test was inapplicable).

333. *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979); *Univ. of Kan. v. Sinks*, No. 06-2341-JAR, 2008 WL 755069, at *31 (D. Kan. Mar. 19, 2008) ("While defendants have a right to express whatever views they purport to be expressing in printing these T-shirts, KU's marks 'need not yield to the exercise of First Amendment rights under these circumstances where adequate alternative avenues of communication exist.'"); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 734-35 (D. Minn. 1998); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559, 1571-77 (S.D. Cal. 1996); *Reddy Commc'ns, Inc. v. Envtl. Action Found.*, 199 U.S.P.Q. 630, 634 (D.D.C. 1977). The Second Circuit later rejected this standard in "the context of titles" in *Rogers* and said it did "not read *Dallas Cowboys Cheerleaders* as generally precluding all consideration of First Amendment concerns whenever an allegedly infringing author has 'alternative avenues of communication.'" *Rogers v. Grimaldi*, 875 F.2d 994, 999 & n.4 (2d Cir. 1989).

334. *Friedman v. Rogers*, 440 U.S. 1, 15-16 (1979) (stating "that the restriction on the use of trade names has the most incidental effect on the content of the commercial speech of Texas optometrists").

335. *S.F. Arts & Athletics*, 483 U.S. at 536 (holding that the statute banning unauthorized use of the word Olympic and related symbols did not prevent the defendant "from conveying its message," as it held the same event under a different name (the Gay Games I), and thus the law "restricts only the manner in which the SFAA may convey its message"); *Fed. Comm'n's Comm'n v. Pacifica Found.*, 438 U.S. 726, 743 & n.18 (1978) (holding that an afternoon radio broadcast of comedian George Carlin's "Seven Dirty Words" monologue violated a restriction against broadcasting indecent language at certain times

The problem with this analysis is that these speech restrictions regulating word choice are “aimed precisely at the content of speech, and not at some problem, such as noise or litter—problems afflicting property, not words—that occur as a byproduct of speech.”³³⁶ For the restriction to be content neutral, the term “manner” in “time, place, or manner” must be interpreted to mean the way in which speech is communicated—such as the decibel level of the speech—not the language used to convey the message. When trademark laws prohibit use of a word claimed as a trademark in brand names, slogans, domain names, artistic and literary works, and on T-shirts, there are no “alternative avenues” for using the exact same words in these particular ways.³³⁷ Because the choice of words can be critical to the message—some firms spend large sums of money to select the perfect brand name—any restriction on use of a trademark may have a significant effect on the content of speech. The primary—not incidental—effect of trademark law is to ban certain uses of trademarked words by speakers other than the trademark holder because of the direct impact of the speech’s content on the public.

ii. Subject Matter Discrimination

When the government bans the use of trademarked words to convey certain information or ideas, these speech restrictions are also content-based because they discriminate based on the subject matter of speech. Laws regulating certain subjects or categories of speech that are unprotected or less protected by the First Amendment are, by definition, content-based speech regulations.³³⁸ Trademark laws discriminate based on subject matter, and thus content, when they target uses of trademarks that are misleading, diluting, or commercial. Trademark law’s content-based exceptions to trademark liability also make it content-based.³³⁹

a. Misleading Uses of Trademarks

Section 45 of the Lanham Act contains evidence of an intent by Congress to regulate misleading uses of trademarks: “The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in commerce . . . [and] to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks.”³⁴⁰ Whether “use of marks” is “deceptive and misleading” or

and stating that “[a] requirement that indecent language be avoided will have its primary effect on the form, rather than the content, of serious communication”).

336. Dreyfuss, *Expressive Genericity*, *supra* note 22, at 412.

337. See Denicola, *supra* note 5, at 206; Dreyfuss, *Expressive Genericity*, *supra* note 22, at 411-12; Kravitz, *supra* note 269, at 146, 166-77; Volokh, *supra* note 34, at 711-12.

338. See *Republican Party of Minn. v. White*, 536 U.S. 765 (2002); CHEMERINSKY, *supra* note 67, at 933; see also Amy Sabrin, *Thinking About Content: Can It Play an Appropriate Role in Government Funding of the Arts?*, 102 *YALE L.J.* 1209, 1217 (1993).

339. Volokh, *supra* note 34, at 703; Lemley & Volokh, *supra* note 5, at 218-20.

340. 15 U.S.C. § 1127 (2000).

causes “fraud and deception” depends on the speech’s content. Moreover, certain federal trademark provisions discriminate on their face against misleading speech. The federal trademark infringement statutes ban use of a trademark that is “likely to cause confusion, or to cause mistake, or to deceive.”³⁴¹ If a domain name is “identical or confusingly similar to” a distinctive mark, registration or use of that domain name may create liability under the cybersquatting statute if the other elements of the ACPA are satisfied.³⁴² The statement of statutory intent in Section 45, along with operational provisions of the federal trademark statute, provides strong proof that Congress regulates trademarks in part because it disapproves of misleading messages conveyed by certain unauthorized uses of a trademark.

This goal of preventing misleading speech is worthy, and most federal and state laws enacted by legislatures to achieve this goal are probably constitutional if they regulate misleading commercial speech, but such laws are still content-based speech regulations. Just like defamation laws which ban false and defamatory statements about people, any prohibition on the misleading use of a trademark is content-based.³⁴³

b. Diluting Uses of Trademarks

The federal dilution statute covers use of a famous trademark in a manner “that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.”³⁴⁴ It is clear from the text of this statute that Congress disapproves of the harm caused by trademark uses that are likely to cause dilution. Dilution by blurring “is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.”³⁴⁵ Dilution by tarnishment “is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”³⁴⁶ Moreover, if the defendant has registered or is using a domain name that is “dilutive of” another’s famous mark, it might also be liable under the ACPA.³⁴⁷

In all of these circumstances, the government perceives the harm to be coming from the association conveyed by a diluting use of the mark. Moreover, the fact-finder must examine the content of the defendant’s speech to determine if the defendant’s use of the word in this context causes one of these forms of dilution. This is another reason trademark dilution laws are content-based speech regulations.

341. 15 U.S.C. §§ 1114(1) (2000); 15 U.S.C. § 1125(a)(1)(A) (2000).

342. 15 U.S.C. § 1125(d)(1)(A) (2000).

343. Volokh, *supra* note 34, at 703.

344. 15 U.S.C. § 1125(c)(1) (2006).

345. 15 U.S.C. § 1125(c)(2)(B) (2006).

346. 15 U.S.C. § 1125(c)(2)(C) (2006).

347. 15 U.S.C. § 1125(d)(1)(A) (2000).

c. Commercial Uses of Trademarks

The government generally intends to burden commercial speech more than noncommercial speech in trademark law. While there is no explicit statement by Congress in Section 45 of the Lanham Act of an intent to restrict commercial uses of trademarks, the operational text of certain statutory provisions indicates the government prefers to primarily regulate commercial speech. As discussed earlier in Part I.B, the text of the federal trademark dilution statute explicitly states that the law only applies to commercial speech; it exempts noncommercial uses of trademarks from dilution liability.³⁴⁸ The commercial nature of the trademark use may also be relevant in actions for violations of trademark infringement law and the ACPA.³⁴⁹ Some courts have even said that “[t]he Lanham Act is constitutional because it only regulates commercial speech.”³⁵⁰

Applying the Court’s analysis in *City of Cincinnati v. Discovery Network*, dilution law is content-based because whether any particular trademark use falls within its coverage (or an exception to the law) is determined by the content of the speech in which that trademark is used.³⁵¹ If application of a trademark law depends on the commercial nature of the speech, the ban is content-based by any “commonsense understanding of the term.”³⁵² There is a content-based purpose if the government exempts noncommercial speech from application of the law because it believes this speech is valuable.³⁵³ If the government intends to burden commercial speech because it has less value, this is not a neutral justification for selectively regulating commercial uses of trademarks. That justification makes the law content-based.³⁵⁴ Targeting commercial speech in trademark law is speech protective, and may ultimately be constitutional under *Central Hudson*, but this subject matter discrimination

348. 15 U.S.C. § 1125(c)(3)(C) (2006).

349. See *supra* Part I.B.2.

350. *Taubman Co. v. Webfeats*, 319 F.3d 770, 774-75 (6th Cir. 2003).

351. *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 429-30 (1993) (holding that the city’s news rack policy was content-based because “whether any particular news rack falls within the ban is determined by the content of the publication resting inside that news rack”); see also *Volokh, supra* note 34, at 706-09.

352. *City of Cincinnati*, 507 U.S. at 430.

353. *Id.* at 429-30; see also *Regan v. Time, Inc.*, 468 U.S. 641, 647-48 (1984) (exception “for philatelic, numismatic, educational, historical, or newsworthy purposes” in law banning photographic reproductions of currency); *Metromedia, Inc. v. City of San Diego*, 453 U.S. 490, 494-95, 515-16 (1981) (exception for “commemorative historical plaques,” “signs depicting time, temperature, and news,” and “[t]emporary political campaign signs” in law prohibiting billboards); *Carey v. Brown*, 447 U.S. 455 (1980) (exception for labor picketing in Chicago ordinance prohibiting picketing in residential neighborhoods); *Volokh, supra* note 34, at 706-09. The legislative history of the FTDA indicates some members of Congress were concerned a dilution law regulating “artistic and expressive” uses of a mark would violate the First Amendment, and thus some legislators said the noncommercial use exemption was included to address “legitimate First Amendment concerns.” H.R. REP. NO. 104-374, at 4, 8 (1995); 141 CONG. REC. S19306-10, S19310-12 (daily ed. Dec. 29, 1995); 141 CONG. REC. H14317-01, H14318 (daily ed. Dec. 12, 1995).

354. *City of Cincinnati*, 507 U.S. at 429-30.

makes trademark law a content-based speech restriction.³⁵⁵

d. Other Content-Based Exceptions to Trademark Liability

In addition to the exemption for noncommercial use of a trademark in dilution law, the Lanham Act also contains other content-based exceptions to trademark liability that make trademark law content-based. The federal dilution statute provides that “[a]ll forms of news reporting and news commentary” are not “actionable as dilution by blurring or dilution by tarnishment under this subsection.”³⁵⁶ Nor does the dilution statute apply to “[a]ny fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person’s own goods or services, including use in connection with—(i) advertising or promotion that permits consumers to compare goods or services; or (ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.”³⁵⁷ The legislative history suggests Congress made this revision to address concerns that the dilution statute did not sufficiently protect “traditional First Amendment uses, such as parody and criticism.”³⁵⁸

Another speech-protective exception to trademark liability in the Lanham Act is the “classic” fair use defense. This defense applies if the defendant can prove its use of the plaintiff’s mark “is a use, otherwise than as a mark, of the party’s individual name in his own business, or . . . of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of [the defendant], or their geographic origin.”³⁵⁹ This expression is allowed because it promotes competition and the free flow of commercial information.

Like the noncommercial use exemption in dilution law, these built-in First Amendment safeguards make trademark law content-based because the provisions were enacted due to the value of the content of this expression. Whether use of a trademark qualifies for these exemptions or defenses can only be determined by examining the content of the defendant’s speech.³⁶⁰ These exceptions are another reason that trademark law is a content-based speech regulation.

All of the content-based distinctions in trademark law may seem benign; there are compelling reasons for discriminating against misleading commercial speech, allowing the diluting use of trademarks in noncommercial speech, and permitting certain fair uses of trademarks.³⁶¹ Yet these laws are still content-based (unlike regulations of the noise level at

355. Volokh, *supra* note 34, at 706-09.

356. 15 U.S.C. § 1125(c)(3)(B) (2006).

357. 15 U.S.C. § 1125(c)(3)(A) (2006).

358. 152 CONG. REC. H6963, H6965 (daily ed. Sept. 25, 2006); *see also* 152 CONG. REC. S1921, S1923 (daily ed. Mar. 8, 2006).

359. 15 U.S.C. § 1115(b)(4) (2000); *see* MCCARTHY, *supra* note 2, § 11:49.

360. *See* Volokh, *supra* note 34, at 706-10.

361. *See id.* at 709-10.

concerts), and this fact makes trademark law constitutionally suspect. “The vice of content-based legislation—what renders it *deserving* of the high standard of strict scrutiny—is not that it is *always* used for invidious, thought-control purposes, but that it *lends itself* to use for those purposes.”³⁶² Trademark laws give judges and juries considerable discretion when they evaluate the content of the defendant’s speech and decide if this use of a mark violates trademark law. The trier of fact does more than just mechanically compare the trademarks used by the plaintiff and defendant. It may—consciously or unconsciously—rule for the plaintiff because the trademark is used by the defendant to convey a message that is unwholesome (such as sex or drug-related expression) or unpopular.³⁶³ As trademark laws discriminate based on subject matter, these content-based speech restrictions should be subject to more constitutional scrutiny per the Court’s First Amendment doctrine when they regulate non-commercial speech.

iii. Viewpoint Discrimination

Restrictions on the use of trademarks are also content-based if they discriminate based on viewpoint. Generally the government engages in viewpoint discrimination if it regulates speech based on the views taken by speakers on a subject.³⁶⁴ Examples include laws banning statements against the war or advocating communism, as well as laws allowing commendation but not criticism of public officials. Viewpoint discrimination “is considered virtually unconstitutional per se” in First Amendment jurisprudence.³⁶⁵

Scholars have said that trademark law is viewpoint-neutral.³⁶⁶ Trademark laws generally apply on their face to all firms and individuals regardless of their identity and ideology. Anyone can be the “senior,” or first, user of a trademark and benefit from certain trademark rights in that mark. Anyone can be the “junior,” or later, user of another’s trademark that faces liability for violations of the trademark laws. The trademark statutes do not target the use of another’s trademarks to advocate or oppose war, communism, abortion rights, immigration, gun control, drug use, pornography, and other political or social issues, nor do the statutes discriminate between trademark uses that disparage or celebrate the trademark holder. Although trademark statutes do not discriminate based on ideology on their face, courts may engage in such viewpoint discrimination when they craft language in a trademark injunction.³⁶⁷ When they do, the injunction is content-based.

362. *Madsen v. Women’s Health Ctr., Inc.*, 512 U.S. 753, 794 (1994).

363. *Bartow*, *supra* note 22, at 812; *Volokh*, *supra* note 34, at 710.

364. *Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U.S. 819, 828-29 (1995).

365. *Rubinfeld*, *supra* note 309, at 6.

366. *Lemley & Volokh*, *supra* note 5, at 186, 218 & n.313; *Volokh*, *supra* note 34, at 703, 709-10.

367. *E.g.*, *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1016 (9th Cir. 2004) (holding the lower court’s injunction prohibiting use of the Nissan trademark to

Finally, trademark laws do discriminate between senior and junior users of a trademark. Trademark law grants to the senior user of a mark the exclusive right to use trademarked language “as a mark.” It denies this right to junior users of that trademark. For example, the holder of the trademark registration for Park ‘N Fly can use this descriptive term as a mark for long-term parking lot services for airports, but the government bans competitors from using identical or similar words in their own brand names, such as Dollar Park & Fly.³⁶⁸ Trademark law thus provides a competitive advantage to the senior markholder when potential new customers consult phone books and other lists that only contain the brand names of companies. Moreover, markholders often argue their exclusive rights extend to slogans (such as “Gatorade is Thirst Aid”), domain names (thechildrensplace.com), keyword advertising (“American Airlines”), and other uses of the descriptive term.³⁶⁹ Regardless of whether the government is constitutionally justified in restricting speech in this way, it is allowing the senior markholder (and its authorized licensees) to use this trademarked word in certain ways, but not third parties. This type of discrimination among speakers is troublesome from a free speech perspective,³⁷⁰ but it has not traditionally been characterized as “viewpoint discrimination” under the Court’s First Amendment jurisprudence.

d. Constitutional Analysis of Trademark Laws Regulating Noncommercial Speech

As trademark laws regulating noncommercial speech are content-based speech regulations, the Court’s First Amendment jurisprudence dictates that they should be subject to strict scrutiny analysis. The resolution of speech-harmful trademark disputes would be more predictable, and the free speech principle of evaluative neutrality would be furthered, with a categorical rule that content-based trademark laws are automatically unconstitutional when subject to strict scrutiny analysis. As explained by Professor Alexander, at its core, the meaning of freedom of expression “requires regulators to abstain from acting on the basis of their own assessments of a message’s truth or value.”³⁷¹ This principle is called “eval-

make disparaging remarks and negative comments about Nissan was a viewpoint-based, and thus a content-based, regulation of speech).

368. See *Park ‘N Fly, Inc. v. Dollar Park & Fly*, 469 U.S. 189 (1985).

369. See *TCPIP Holding Co., Inc. v. Haar Commc’ns, Inc.*, 244 F.3d 88 (2d Cir. 2001); *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947 (7th Cir. 1992); *Am. Airlines, Inc. v. Google, Inc.*, No. 4:2007CV00487 (N.D. Tex. Aug. 16, 2007).

370. *United States v. Playboy*, 529 U.S. 803, 812 (“Laws designed or intended to suppress or restrict the expression of specific speakers contradict basic First Amendment principles.”). I thank Professor David McGowan for his helpful discussions with me on this point, among others.

371. ALEXANDER, *supra* note 160, at 11. “For we could not credit a regime with honoring freedom of expression if it announces that any ideas can be freely expressed so long as the government believes the ideas to be true and valuable. In other words, anything recognizable as a conception of freedom of expression must entail a requirement that government, at least in its capacity as regulator, maintain a stance of evaluative neutrality vis-à-vis messages.” *Id.*

uative neutrality.”³⁷² The courts need not concern themselves with the truth or value of noncommercial uses of trademarks if the Supreme Court adopts a categorical rule that trademark laws always violate the right of freedom of expression when they regulate noncommercial speech.³⁷³ Professor Volokh argues that a *per se* ban on content-based speech restrictions is generally preferable to means-ends constitutional scrutiny.³⁷⁴ Justice Kennedy also prefers a categorical framework; he said “that content-based speech restrictions that do not fall within any traditional exception [to First Amendment protection] should be invalidated without inquiry into narrow tailoring or compelling government interests.”³⁷⁵ Should all trademark laws regulating the use of marks in noncommercial speech be found *per se* unconstitutional because a categorical exception to full First Amendment protection does not apply?

For a number of reasons, the Court is unlikely to hold that strict scrutiny analysis is automatically fatal when applied to content-based trademark laws or that trademark laws are categorically unconstitutional when they regulate noncommercial speech (including misleading noncommercial speech). As noted by the Court, “[n]ot all content-based regulations are alike; . . . some content-based restrictions raise more constitutional questions than others.”³⁷⁶ Trademark laws, and the government purposes behind them, are not as dangerous to free speech values as many other content-based speech regulations. On their face, trademark statutes do not ban the use of trademarks to criticize the U.S. or foreign governments or government officers.³⁷⁷ Nor do they target the use of another firm’s trademarks to discuss, advocate, or oppose certain political or social issues. While some judges or juries may find a trademark violation because the defendant’s expression has an unwholesome subject matter or a certain ideology, such cases are uncommon in trademark litigation.

There are other reasons that trademark laws are less constitutionally suspect than other content-based regulations of speech. There is less risk of government censorship in trademark law because Congress and state legislatures generally do not list the words to be regulated in the trademark statutes. Private parties can obtain rights in words used as trademarks based on use or registration of the mark, or by filing an intent-to-use application for the trademark.³⁷⁸ There is also less concern about

372. *Id.*

373. *Cf. id.* at 66, 176-81.

374. Eugene Volokh, *Freedom of Speech, Permissible Tailoring, and Transcending Strict Scrutiny*, 144 U. PENN. L. REV. 2417, 2418 (1996).

375. *Republican Party of Minn. v. White*, 536 U.S. 765, 793 (2002) (Kennedy, J., concurring); *Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 124 (1991) (Kennedy, J., concurring).

376. *R.A.V. v. City of St. Paul*, 505 U.S. 377, 429 (1992).

377. *Cf. Boos v. Berry*, 485 U.S. 312, 322 (1988) (holding that a restriction of speech critical of foreign governments near their embassies was unconstitutional).

378. The government can also obtain trademark rights in words. The Department of the Army has registered the mark “Be All You Can Be,” among other trademarks, for career guidance and counseling services. U.S. Trademark Reg. No. 75,159,117 (filed May 15, 1996).

governmental misconduct in trademark cases because most trademark suits are initiated by private parties, not the government. Trademark holders decide whether to file suit and what causes of action and remedies to pursue.

On the other hand, legislatures do say what types of words can become protected trademarks. Moreover, they set forth what types of trademarks can be registered in the U.S. Patent and Trademark Office and state trademark registration offices. Registration alone likely deters certain uses of the mark by third parties, as it provides certain benefits to the trademark holder, such as a presumption of validity for marks on the federal principal trademark register.³⁷⁹ Courts also determine that certain trademarks are protectable in trademark litigation. Moreover, in preliminary and permanent injunctions, courts list the plaintiff's trademarks and order the defendant to refrain from using words identical or similar to these trademarks in certain contexts. These content-based restrictions on use of a trademark can still harm speech, but they are often less problematic than other content-based laws because the words restricted are generally selected by private parties.

Another reason trademark laws are less insidious than other content-based restrictions is that the government does not ban all public uses of a trademarked word. Trademark laws usually allow certain nontrademark or noncommercial uses of trademarked words by third parties. For this reason, they are *content-based* time, place, or manner regulations.³⁸⁰ Trademark laws raise First Amendment concerns because the government disagrees with how the mark is used in the defendant's expression and seeks to prevent the communicative impact of this word used in a certain context. Yet trademark laws pose less risk of excising certain ideas or viewpoints from the public dialogue compared to a complete restriction on use of a word by anyone in any context.

I believe some trademark laws could satisfy strict scrutiny even though they regulate noncommercial speech. Many will not. A narrowly-tailored trademark law regulating noncommercial speech could satisfy strict scrutiny if it were the least restrictive means to further a compelling government interest. For example, trademark infringement laws banning the misleading use in noncommercial speech of the distinctive marks of political, religious, or other noncommercial groups could satisfy strict scrutiny analysis if the marks were used by the defendant as marks to falsely designate the source of its activities. Protecting the ability of consumers to identify and distinguish among the activities of noncommercial entities is a compelling government interest. If these laws are narrowly tailored to protect expression and the least restrictive means to further this interest, they should be found constitutional.

379. Once a mark is registered, the fact of registration suggests that the trademark holder is more likely to enforce its alleged trademark rights, as it has spent the time and money to obtain a trademark registration.

380. Thanks to Paul Horton for his discussions with me on this point, among others.

Yet serious questions regarding the constitutionality of other trademark laws regulating noncommercial speech will be raised if the Court's current First Amendment jurisprudence is faithfully applied. An example would be trademark laws aimed at preventing consumer confusion regarding sponsorship or approval of the use of a mark in artistic or literary works³⁸¹ and other commentary, parody, or satire, including use of another's mark in domain names linked to noncommercial websites with social commentary,³⁸² and noncommercial expression on T-shirts and other novelty merchandise.³⁸³ In cases involving the unauthorized use of trademarks in the content or titles of artistic or literary expression, strict scrutiny analysis will be more speech protective than the *Rogers* balancing test.³⁸⁴ Unlike strict scrutiny analysis, the *Rogers* test does not require proof that the purpose of this particular speech restriction is compelling, nor does it require the speech restriction to be narrowly-tailored and the least restrictive means to further this goal. Moreover, strict scrutiny analysis does not limit constitutional protection only to uses of trademarked language that have some artistic relevance to the underlying work. Restrictions of marks allowed under the *Rogers* test³⁸⁵ would be unconstitutional under strict scrutiny analysis, especially in trademark disputes involving satire where the defendant is not criticizing, commenting on, or parodying the markholder.

For whatever reason, courts have generally not applied strict scrutiny analysis to trademark laws regulating noncommercial speech. If judges believe that trademark laws should be subject to less stringent constitutional scrutiny, they should say so. They should not achieve the same result by improperly characterizing content-based trademark laws as content-neutral speech regulations.³⁸⁶ Courts may be hesitant to hold that some trademark laws survive strict scrutiny analysis because such a finding could weaken First Amendment protection for speech generally. If strict scrutiny of content-based speech regulations was no longer fatal in fact, this result could devalue strict scrutiny analysis and make it easier for the government to justify other regulations of core First Amendment speech based on the content of the speech.³⁸⁷ Possibly for this reason, the Supreme Court has applied lesser constitutional scrutiny to other con-

381. Trademark rights may be claimed in artistic or literary titles, and the markholder may argue that another artist's or author's use of an identical or similar mark violates trademark law. See generally 2 MCCARTHY, *supra* note 2, § 10.1-40. Whether a law prohibiting such a trademark use would satisfy strict scrutiny analysis is beyond the scope of this Article.

382. *Coca-Cola Co. v. Purdy*, 382 F.3d 774, 787-90 (8th Cir. 2004).

383. *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987). The court thought this speech was commercial, *Id.* at 402-03 & n.8 & 9, but I believe it is noncommercial. See *supra* Part I.B.

384. *Rogers v. Grimaldi*, 875 F.2d 994, 998-99 (2d Cir. 1989).

385. See, e.g., *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727 (D. Minn. 1998).

386. *E.g.*, *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979).

387. *Cf.* Stone, *supra* note 185, at 9.

tent-based speech regulations where the risk that “the Government may effectively drive certain ideas or viewpoints from the marketplace” is “inconsequential.”³⁸⁸ The Court may come to the same conclusion about trademark law, and hold that the constitutionality of trademark laws should be evaluated under intermediate scrutiny or some other lesser constitutional standard—possibly a version of the *Rogers* balancing test—in cases involving noncommercial uses of trademarks. Whether the Court should do this is beyond the scope of this Article.

The Court may be tempted to follow the approach it used in *Eldred*. As noted previously, the Court refused to impose “uncommonly strict scrutiny on a copyright scheme that incorporates its own speech-protective purposes and safeguards.”³⁸⁹ The Court held the Copyright Term Extension Act need not be subject to further constitutional scrutiny because “Congress ha[d] not altered the traditional contours of copyright protection.”³⁹⁰ The problem with directly applying *Eldred’s* analysis to trademark law is that copyright and trademark laws have very different goals and operational provisions. Trademark law does not have a speech-protective purpose³⁹¹ and trademark law’s built-in First Amendment safeguards are limited.³⁹² Could the “traditional contours” language provide some guidance? Traditional trademark law primarily regulated deceptive uses of marks by competitors to divert trade.³⁹³ If the “traditional contours” of trademark law are constitutional, trademark infringement laws prohibiting misleading uses of marks in commercial speech would be consistent with the First Amendment, but much of current trademark law would still be subject to First Amendment scrutiny.

3. Other First Amendment Doctrines

When faced with a First Amendment challenge to a trademark law, courts should also consider whether other First Amendment doctrines apply. A defendant may challenge a trademark injunction as an unconstitutional prior restraint of speech,³⁹⁴ although this argument has not fared well in trademark cases.³⁹⁵ At a minimum, courts should take First Amendment values into account when determining the breadth of injunctive relief; a narrowly-drafted injunction, or even requiring a disclaimer in

388. *E.g.*, *Davenport v. Wash. Educ. Ass’n*, 127 S. Ct. 2372, 2381 (2007).

389. *Eldred v. Ashcroft*, 537 U.S. 186, 218-19 (2003).

390. *Id.* at 221.

391. Although use of a mark by a markholder can be “speech,” *see supra* Part II.B., encouraging the creation of new marks is not the goal of trademark law. *See supra* Part II.D.

392. *See generally* Ramsey, *supra* note 11, at 149-63.

393. *See supra* note 2.

394. *Lemley & Volokh, supra* note 5, at 158-65; *see Neb. Press Ass’n v. Stuart*, 427 U.S. 539, 559 (1976). The Court has suggested in dicta that this rule may not apply to restrictions on commercial speech. *See Freidman v. Rogers*, 440 U.S. 1, 10 (1979).

395. *E.g.*, *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403 n.11 (9th Cir. 1997); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979).

lieu of an injunction, may be necessary to protect expression.³⁹⁶ A defendant may also argue that a particular trademark law is unconstitutionally vague or overbroad and therefore chills speech.³⁹⁷ A full discussion of these topics is beyond the scope of this Article.

In conclusion, trademark laws regulate, and are intended to regulate, the use of particular words in certain messages by someone other than the trademark holder. For this reason, trademark laws and injunctions may conflict with the First Amendment in trademark disputes. If they do, constitutional analysis is only one way the court can protect expression in trademark law, as discussed next.

III. OPTIONS FOR INCREASING FIRST AMENDMENT SCRUTINY OF TRADEMARK LAW

Legislatures may believe their trademark statutes are constitutional because they primarily regulate commercial speech or include certain defenses and exemptions from liability. Courts must confirm these built-in First Amendment safeguards are constitutionally sufficient.³⁹⁸ In every trademark case, courts should seriously consider free speech interests when interpreting the trademark statute. If a trademark provision harms protected expression and the statute does not permit a speech-protective construction, courts should apply constitutional analysis to the trademark law using the framework in Part II. Free expression will be best protected in trademark law if legislatures and courts adopt more speech-protective trademark rules in trademark law. Among other benefits, categorical safe harbors can increase predictability in trademark disputes and enable judges to dispose of trademark claims that are harmful to free speech early in the case.³⁹⁹ The different methods for preventing trademark law from encroaching on protected expression are discussed below.⁴⁰⁰

A. CONTEXTUAL SPEECH-PROTECTIVE INTERPRETATIONS OF TRADEMARK LAW

It is appropriate for courts to construe trademark law's internal safeguards to accommodate First Amendment concerns.⁴⁰¹ Courts should

396. *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 672 (5th Cir. 2001).

397. *See Smith v. Goguen*, 415 U.S. 566, 569, 572-73 (1974) (void for vagueness doctrine); *Schad v. Borough of Mt. Ephraim*, 452 U.S. 61 (1981) (overbreadth doctrine); *see also CHEMERINSKY, supra* note 67, at 942-47. The Court has said overbreadth analysis does not normally apply to commercial speech regulations. *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 481 (1989).

398. *See Landmark Comm'ns, Inc. v. Virginia*, 435 U.S. 829, 843-44 (1978).

399. *See generally McGeveran, supra* note 11; *McGeveran, supra* note 25.

400. If legislatures and courts protect free expression in trademark law using one or more of these methods, it is possible other countries will argue that the United States is not meeting its international obligations to protect trademark rights under intellectual property treaties and international trade agreements covering trademarks. This topic is beyond the scope of this Article.

401. *Cf. Eldred v. Ashcroft*, 537 U.S. 156, 221 n.24 (2003).

generally avoid constitutional analysis of trademark law if the dispute can be resolved on doctrinal grounds.⁴⁰² If “an otherwise acceptable construction of a statute would raise serious constitutional problems,” the canon of constitutional avoidance dictates that courts should “construe the statute to avoid such problems unless such a construction is plainly contrary to the intent of Congress.”⁴⁰³ Courts must first attempt to resolve any conflict between trademark law and the First Amendment by interpreting trademark claims narrowly and trademark defenses broadly in ways that protect expression.⁴⁰⁴

This is the current approach by most courts sympathetic to free speech interests in trademark cases. For example, courts protect the free flow of commercial information when they determine that a certain term is descriptive without secondary meaning and, thus, is not a protectable mark.⁴⁰⁵ Courts guard First Amendment values when they conclude that an effective parody (such as “Chewy Vuiton” dog toys) is not likely to cause confusion or dilution in this particular case⁴⁰⁶ or hold that a certain use of the mark qualifies for the descriptive or nominative fair use defense.⁴⁰⁷ Courts protect noncommercial expression when they find there is no infringement after applying the *Rogers* balancing test in cases involving the use of trademarks in artistic or literary expression.⁴⁰⁸ First Amendment speech is protected in these cases.

402. Leval, *supra* note 25, at 210. Courts will often decline to analyze a First Amendment defense if they can find for the defendant on other grounds. *E.g.*, *Davis v. Walt Disney Co.*, 430 F.3d 901, 903 (8th Cir. 2005) (affirming the district court’s finding of no likelihood of confusion where the founder of an environmental organization sued the producer and broadcaster of a television movie that used “Earth Protector” as the name for a fictional organization in the film).

403. *Edward J. DeBartolo Corp. v. Fla. Gulf Coast Bldg. & Const. Trades Council*, 485 U.S. 568, 575 (1988); *see also* *Rescue Army v. Mun. Court*, 331 U.S. 549, 568-72 (1947) (explaining why courts should avoid unnecessary constitutional adjudication); *Ashwander v. Tenn. Valley Auth.*, 297 U.S. 288, 347 (1936) (Brandeis, J., concurring).

404. *See* *Tommy Hilfiger Licensing, Inc. v. Nature Labs*, 221 F. Supp. 2d 410, 414 (S.D.N.Y. 2002) (“[W]here the unauthorized use of a trademark is part of an expressive work, such as a parody, the Lanham Act must be construed narrowly.”); *cf.* *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group*, 886 F.2d 490, 495 n.3 (2d Cir. 1989) (As the likelihood of confusion test “is at best awkward in the context of parody, which must evoke the original and constitutes artistic expression,” courts should apply the factors “with proper weight given to First Amendment considerations.”); *RESTATEMENT (THIRD) OF UNFAIR COMPETITION* § 25, cmt. I (1995) (“The expression of an idea by means of the use of another’s trademark as a parody, for example, will often lie within the substantial constitutional protection accorded noncommercial speech and may thus be the subject of liability only in the most narrow circumstances.”) (quoted in *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813 n.14 (2d Cir. 1999)).

405. *E.g.*, *Japan Telecom, Inc. v. Japan Telecom Am., Inc.*, 287 F.3d 866, 873-75 (9th Cir. 2002) (“Japan Telecom”); *In re Boston Beer Co.*, 198 F.3d 1370, 1373-74 (Fed. Cir. 1999) (“The Best Beer in America”).

406. *E.g.*, *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007); *Cliffs Notes*, 886 F.2d at 495 & n.3; *World Wrestling Fed’n Entm’t, Inc. v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413, 430-43 (W.D. Penn. 2003); *Tommy Hilfiger Licensing, Inc. v. Nature Labs*, 221 F. Supp. 2d 410 (S.D.N.Y. 2002).

407. *See, e.g.*, *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302 (9th Cir. 2002); *Zatarian’s, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786 (5th Cir. 1983).

408. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905-06 (9th Cir. 2002) (citing *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989)).

Moreover, there are advantages to using a contextual speech-protective interpretation of trademark law. This method of protecting expression is usually more fair and just for the individual parties in most trademark cases. Case-by-case analysis provides the fact-finder with more flexibility to consider the unique circumstances of a particular trademark dispute. The judge can balance the benefits of trademark protection in this case for this mark against the free speech interests, and other interests, of the defendant, competitors, and the rest of the public in allowing the defendant's trademark use to continue. Contextual analysis also allows courts to avoid constitutional analysis and the complicated First Amendment doctrines that come with it.

Yet there are serious disadvantages to solely using a contextual approach in trademark law to protect expression. Unless a previous case has very similar facts, it will be difficult for new trademark litigants to predict the outcome of the court's application of the various multi-factor, fact-specific tests. Moreover, the judge may be reluctant to rule on a motion to dismiss. For example, one court refused to grant a motion to dismiss trademark claims based on alleged rights in the phrase "The Crime Channel" for television programming because, among other things, the generic nature of the mark and whether the term had acquired secondary meaning were questions of fact.⁴⁰⁹ Individuals and small firms who cannot predict a successful outcome with certainty and/or who are unable to afford the cost of litigation will likely settle and agree to stop using the trademarked words.

Another problem with a contextual speech-protective approach to trademark disputes is that some fact-finders may discount the value of the defendant's speech in certain cases and refuse to interpret trademark law through a "First Amendment lens." If the plaintiff's mark is a well-known brand and the defendant is sleazy or the message incorporating the mark is distasteful, the judge or jury may rule for the plaintiff despite its speech-harmful trademark claims. For example, courts punished and enjoined further use of the Dallas Cowboys Cheerleader's trademarked outfits in a pornographic film and use of the Coca-Cola marks and logos in a poster with the phrase "Enjoy Cocaine."⁴¹⁰ A fact-finder may deem a certain trademark distinctive or a certain use of a trademark confusing, diluting, or commercial because he or she dislikes the defendant or its expression.

Finally, if a court believes it is interpreting trademark claims narrowly and trademark defenses broadly in ways that protect expression, but it still rules for the plaintiff, it is not clear how the court knows its statutory construction is truly and sufficiently speech-protective without engaging in some sort of constitutional analysis. If the defendant raises a First

409. *Films of Distinction, Inc. v. Allegro Film Prod.*, 12 F. Supp. 2d 1068, 1074-75 (C.D. Cal. 1998).

410. See *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979); *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972).

Amendment challenge, the Supreme Court's current First Amendment jurisprudence requires the judge to engage in constitutional analysis of this speech restriction and explain in the opinion why this law does not violate the First Amendment if the judge rules for the plaintiff.

If the court believes the *defendant* should prevail as a matter of law under the trademark statute, it can avoid constitutional analysis by ruling on other grounds. Yet when courts dispose of a case on purely doctrinal grounds, such as where the plaintiff's mark is clearly generic or the defendant's use of the mark plainly qualifies for the fair use defense, courts are just interpreting the statute. The built-in First Amendment safeguards of the statute already protect expression, and thus a speech-protective interpretation of the statute is not necessary.

That means a speech-protective statutory interpretation (and the canon of constitutional avoidance) only matters in close cases when it is not entirely clear who should prevail under the trademark statute. For example, the court may find it difficult to decide whether this descriptive term has acquired distinctiveness, this parody is likely to cause confusion or dilution of the mark, or this use of a mark qualifies for the fair use or nominative use defense. It may be unclear whether the infringement statute requires a commercial or trademark use of a mark. If the trademark use is noncommercial speech or nonmisleading commercial speech, this application of trademark law could raise serious First Amendment concerns. In such circumstances, how will the court know it needs to interpret the law in a speech-protective manner, rather than just rely on the burden of proof to decide the case, without evaluating the constitutionality of that law? Do judges apply intermediate or strict scrutiny analysis in their chambers and then use a speech-protective interpretation of the statute in the opinion? Do they consult law review articles written by scholars on the topic? Do judges rely on intuition? In such cases, the parties and public will likely benefit if the court's constitutional analysis is transparently set forth in the opinion.

When courts apply multi-factor balancing tests to the unique factual circumstances in each case, they can protect speech in individual trademark disputes and still further the goals of trademark law. Yet this approach may generally suppress and chill protected speech more than necessary when many small firms and individuals cannot afford to litigate and courts refuse to dismiss speech-harmful claims before discovery. Moreover, sometimes a trademark statute does not permit a construction by courts that is sufficiently speech-protective. In such cases, courts should apply First Amendment scrutiny to that trademark law.

B. CONSTITUTIONAL ANALYSIS

Courts can also protect expression in trademark disputes by considering whether trademark laws or injunctions satisfy First Amendment scrutiny. As discussed in Part II, trademark laws should be subject to intermediate constitutional analysis under *Central Hudson* when they

regulate nonmisleading commercial speech and strict scrutiny analysis when they regulate noncommercial speech unless the Court determines that lesser constitutional scrutiny is required.

Like contextual analysis in trademark law, constitutional analysis allows courts to consider the unique circumstances of a particular trademark case. It can be more fair and just than a rigid trademark rule. Yet constitutional analysis is usually more speech protective than contextual analysis in difficult cases where the goals of trademark law and free expression significantly conflict but the plaintiff should clearly prevail under the trademark doctrine. First Amendment scrutiny requires courts to identify the government interest behind this particular speech restriction and determine whether that goal is substantial or compelling. Some of the alleged goals of trademark law will not withstand such scrutiny, such as protection of the goodwill invested in a descriptive mark from misappropriation.⁴¹¹ The court must also determine whether this law is sufficiently narrowly tailored and, under strict scrutiny analysis, whether the law is the least restrictive means of furthering this goal. Except for the *Rogers* balancing test (which only applies in limited circumstances), no other trademark doctrine requires the court to explicitly balance the goals of trademark law against the interest in free expression.

If courts engage in constitutional analysis, it will be more difficult for them to allow speech-harmful trademark claims to proceed without sufficient justification. Because the judge sets forth the First Amendment analysis in the opinion, the evaluation of the constitutionality of that trademark law is explicit and transparent. More importantly, constitutional analysis may be the only means for courts to truly prevent certain trademark laws from suppressing and chilling protected expression. If a court believes (as I do) that it is unconstitutional to protect trademark rights in descriptive terms, it has several options. It can hold that a descriptive term in a particular case has not acquired distinctiveness or that the defendant has not committed a trademark violation. This contextual speech-protective interpretation of the law will avoid constitutional analysis and protect this individual defendant's right of commercial expression. Yet it will not protect future defendants who want to use different descriptive terms claimed by others as trademarks, but whose speech is chilled by current descriptive trademark laws. Speech will be better protected in trademark law generally if the court applies constitutional scrutiny and holds that this federal or state trademark statute is unconstitutional when applied to descriptive terms.⁴¹² This court's constitutional analysis could then be cited by trademark defendants and the recipients of cease and desist letters in support of the argument that trademark laws are unconstitutional when applied to descriptive terms.

411. Ramsey, *supra* note 7, at 1152-56.

412. It is clear from the provisions of the Lanham Act that Congress intends to protect descriptive terms used as marks if they acquire distinctiveness, 15 U.S.C. § 1052(e)(1) & (f) (2000), so courts cannot simply hold the Lanham Act does not apply to descriptive terms. Constitutional analysis is required.

Increasing First Amendment scrutiny of trademark law will not stop all frivolous allegations, but it should discourage at least some unfounded, speech-harmful trademark claims.

Although constitutional analysis can protect speech in trademark cases, there are various disadvantages to explicitly considering First Amendment interests in trademark disputes. First, unnecessary constitutional adjudication will consume valuable resources. If the case can be resolved in favor of the defendant on other grounds, it may be more costly and time consuming if the parties and judge also consider a First Amendment challenge in the trademark dispute. Such concerns are valid, but these burdens on the judicial system must be balanced against the benefits of the free flow of information and ideas, as well as increased competition when firms can use the full range of language to sell their wares. Increased First Amendment scrutiny of trademark law in judicial opinions may create incentives for legislatures to draft leaner and more effective laws that further the goals of trademark law while still protecting expression from unnecessary restriction. Once a court has engaged in a complete constitutional analysis of a particular trademark law, future courts may be able to cite this opinion to support their conclusion that a law is constitutional or unconstitutional. (Although a constitutional law may be unconstitutional as applied to particular circumstances). Over time, not only may trademark statutes become more constitutional as legislatures pay closer attention to First Amendment concerns, but parties and courts may consume less resources on First Amendment analysis in trademark disputes because they can free ride on the constitutional arguments and analysis made in past trademark cases.

Another significant problem with constitutional analysis in trademark cases is that “[c]onstitutional rulings have far-reaching implications and are not easily undone.”⁴¹³ As noted by Judge Leval, “[a] gradual incremental process of adjudication enables courts to understand legal doctrine better and better. Postponing constitutional adjudication until it is unavoidable guards against making constitutional rules before the subject is well understood.”⁴¹⁴ Furthermore, he explains

[t]he relationship between legislature and courts . . . involves a dialogue in which the legislature retains the ultimate power to override statutory interpretations that it does not favor, but, as soon as the court rules that the reach of a statute violates the Constitution, a large portion of the legislature’s role in the dialogue is precluded.⁴¹⁵

These are all good reasons for judges to primarily rely on “the free speech-protecting policies of the trademark law” rather than constitutional adjudication when they can rule for the defendant on other grounds.⁴¹⁶ Yet courts should not hesitate to find certain trademark laws

413. Leval, *supra* note 25, at 209.

414. *Id.*

415. *Id.*

416. *Id.*

unconstitutional if they significantly suppress or chill protected speech. In addition, if the plaintiff markholder is the one that will prevail upon application of the trademark statute, a First Amendment challenge must be addressed, even if only briefly, if it is pled and raised by the defendant.

Another disadvantage with constitutional scrutiny of trademark law is that such an analysis violates the principle of evaluative neutrality that is central to the concept of freedom of expression.⁴¹⁷ Scholars have criticized the “ad hoc balancing” that occurs with much constitutional analysis.⁴¹⁸ The court must decide whether the goals of trademark law are substantial or compelling—a point on which reasonable persons may disagree—and apply the multi-factor *Central Hudson* test or strict scrutiny analysis to this speech restriction. When the court balances the goals of trademark law and free expression, there is no clear method for assigning value to each of these interests or deciding which should prevail. The court may ultimately hold the speech regulation is constitutional (or unconstitutional) due to its dislike (or support) of the particular expression incorporating the trademark. As discussed in the next section, adopting speech-protective trademark rules is one way to partially address this problem because it reduces the fact-finder’s analysis to a decision about whether a particular rule applies.

One final problem with constitutional balancing in trademark cases is that First Amendment analysis may not actually be fully speech-protective in the real world. The defendant must spend money and time on the trademark litigation to achieve a favorable result. If the court refuses to evaluate a First Amendment challenge on a motion to dismiss, the defendant will have to proceed through discovery to summary judgment or trial, which will be even more costly and time consuming. Due to the expense of litigation, the defendant may settle rather than litigate for the right to use the trademarked language. Constitutional analysis of trademark law is not speech protective if courts never get a chance to consider the constitutionality of the law due to settlement of the litigation.

First Amendment analysis is definitely not perfect, but it can protect speech interests in individual trademark cases. Moreover, it may actually be used by courts behind the scenes when they “avoid” constitutional analysis and construe the trademark statutes in speech-protective ways. Either approach is better than ignoring free speech interests when trademark claims conflict with the First Amendment. The next section discusses a third approach to this conflict that may do a better job protecting speech globally in trademark law.

417. ALEXANDER, *supra* note 160, at 11, 66, 176-81.

418. See, e.g., Melville B. Nimmer, *The Right to Speak From Times to Time: First Amendment Theory Applied to Libel and Misapplied to Privacy*, 56 CAL. L. REV. 935 (1968).

C. SPEECH-PROTECTIVE TRADEMARK RULES

A third way to address the potential conflict between trademark law and the First Amendment is for legislatures and courts to craft more speech-protective rules for trademark law. Such trademark rules are also called “categorical safe harbors” or “carve outs from liability.”⁴¹⁹ The noncommercial use exemption in the federal trademark dilution statute is an example of a statutory trademark rule.⁴²⁰ So is the exemption in the dilution statute for “news reporting and news commentary”⁴²¹ and for certain nontrademark fair uses of a mark, such as “advertising or promotion that permits consumers to compare goods or services” and “identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.”⁴²² Courts also craft speech-protective trademark rules when they hold that application of a trademark provision to a certain type of speech “offends the Constitution,” such as invoking Maine’s “anti-dilution statute as a basis for enjoining the noncommercial use of a trademark by a defendant engaged in a protected form of expression.”⁴²³

Courts and legislatures often explicitly or implicitly use “definitional balancing” rather than ad hoc constitutional balancing when they create a speech-protective categorical rule.⁴²⁴ In the trademark context, they balance the relevant goals of trademark law against the value of free speech generally, not just in this specific case.⁴²⁵ They decide that this particular trademark restriction harms protected speech—using constitutional analysis, or some other method—and exempt all speech within the defined category from liability, or subject restrictions of this speech to different rules. Thereafter, courts determine whether the defendant’s expression falls within the rule. If it does, the rule applies. The Court used this approach for defamation law in *New York Times v. Sullivan* and later defamation cases.⁴²⁶

It would be best if legislatures enacted more speech-protective trademark rules. If they do not, courts should implement them in the common law. This may force the legislature to enact a statute that clarifies the

419. McGeeveran, *supra* note 25, at 1225-26.

420. 15 U.S.C. § 1125(c)(3)(C) (2006).

421. 15 U.S.C. § 1125(c)(3)(B) (2006).

422. 15 U.S.C. § 1125(c)(3)(A) (2006).

423. *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 32-33 (1st Cir. 1987).

424. *See Nimmer, supra* note 418, at 935 (discussing the benefits of definitional balancing compared to ad hoc balancing); *cf. Volokh, supra* note 374, at 2418 (arguing that the Court should “shift away from means-ends scrutiny, and toward an approach that operates through categorical rules”).

425. *Cf. Nimmer, supra* note 418, at 935.

426. 376 U.S. 254, 279-80 (1964) (“The constitutional guarantees [of freedom of speech and press] require . . . a federal rule that prohibits a public official from recovering damages for a defamatory falsehood relating to his official conduct unless he proves that the statement was made with ‘actual malice’—that is, with knowledge that it was false or with reckless disregard of whether it was false or not.”); *see Curtis Publ’g Co. v. Butts*, 388 U.S. 130 (1967) (adopting a similar rule for public figures); *Gertz v. Robert Welch, Inc.*, 418 U.S. 323 (1974) (applying different rules for defamation of private figures).

doctrine, such as whether trademark use is an element for a prima facie trademark claim.⁴²⁷ Legislatures have allowed, if not encouraged, courts to develop the common law of trademarks. They have also acknowledged that trademark laws can raise legitimate First Amendment concerns. For this reason, lawmakers may not object if courts create trademark rules that make trademark statutes more speech-protective. If the legislature does not like a new trademark rule crafted by the court, it can enact a statute eliminating that rule. If that statute is clearly unconstitutional, then the court should no longer avoid constitutional analysis; it should apply intermediate or strict scrutiny analysis and find the law unconstitutional.

Examples of potential trademark rules include a ban on trademark protection for descriptive terms,⁴²⁸ and blanket exemptions from trademark infringement liability for news reporting and news commentary, among other proposals.⁴²⁹ Some scholars argue that “trademark use” of the plaintiff’s mark currently is, or should be, a requirement for a prima facie trademark claim.⁴³⁰ Such a rule was embraced by the Second Circuit.⁴³¹ This rule would exempt from trademark liability all non-trademark uses of another’s mark, including use of a mark to trigger keyword advertising, use of marks in artistic or literary works, and other uses of a mark that do not identify the source of the product or service.⁴³² Critics argue such a broad rule could result in less transparent decision-making and elevate formalism over contextual analysis in trademark rulemaking.⁴³³ Moreover, some scholars note that trademark use may not serve a true gatekeeper function on motions to dismiss if courts need to consider consumer perceptions when deciding whether this use of the mark actually designates a product source.⁴³⁴ A nontrademark use exemption could offer significant free speech benefits in many trademark disputes, however, if legislatures or courts deemed certain uses of a mark

427. See *1-800 Contacts, Inc. v. WhenU.com, Inc.*, 414 F.3d 400 (2d Cir. 2005); see also *Rescuecom Corp. v. Google*, 456 F.Supp.2d 393 (N.D.N.Y. 2006) (noting courts disagree on “whether the purchase or sale of a trademark as a keyword that triggers the appearance of an advertisement is a trademark infringement”).

428. See Ramsey, *supra* note 7, for an explanation of why descriptive trademark laws are unconstitutional.

429. McGeeveran, *supra* note 25, at 1225-26; McGeeveran, *supra* note 11, at 77-84.

430. See, e.g., Barrett, *supra* note 255, at 378-79; Barrett, *supra* note 22, at 979-87; Mark A. Lemley & Stacey L. Dogan, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669, 1694-98 (2007); Uli Widmaier, *Use, Liability, and the Structure of Trademark Law*, 33 HOFSTRA L. REV. 603 (2004).

431. See *1-800 Contacts*, 414 F.3d 400.

432. This rule would make the fair use defense, 15 U.S.C. § 1115(b)(4) (2000), nominative fair use defense, *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 2002), and exemptions from dilution liability “for fair use, including a nominative or descriptive fair use, or facilitation of such fair use,” 15 U.S.C. § 1125(c)(3)(A) (2006), superfluous. See Ramsey, *supra* note 11, at 155 n.66 (making this point with regard to the fair use defense).

433. See, e.g., Graeme B. Dinwoodie & Mark D. Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597 (2007); Graeme B. Dinwoodie & Mark D. Janis, *Lessons from the Trademark Use Debate*, 92 IOWA L. REV. 1703 (2007).

434. See McKenna, *supra* note 230.

to be a nontrademark use. This would add more predictability and clarity to the law.

Rather than adopt a broad trademark use requirement, legislatures or courts could also create and use a more narrow trademark rule. For example, categorical safe harbors could be designed to protect particular trademark defendants, such as Internet service providers, or specific activities from regulation, such as keyword advertising.⁴³⁵ The government could also craft a categorical exemption from trademark liability for any nontrademark use of a mark in commentary, parody or satire, regardless of whether the mark is used in commercial or noncommercial speech.⁴³⁶ The First Amendment rights of third parties and the public would benefit if the government adopted some sort of trademark use requirement in trademark law, whether broad or narrow in scope.

Clear and fixed rules have some advantages.⁴³⁷ They allow courts to avoid the interpretive fray of multi-factor balancing tests and constitutional analysis. Trademark rules make it easier for defendants to predict in advance whether a trademark holder is likely to prevail in a trademark lawsuit. Defendants may be more successful in recovering Rule 11 sanctions for frivolous claims that ignore a trademark rule.⁴³⁸ Categorical safe harbors give courts the tools to dispose of speech-harmful trademark claims early on a motion to dismiss. This will safeguard the right of expression of individuals and small companies who cannot afford to litigate through discovery to summary judgment or trial or pay for an expensive trademark survey. Because rules provide more guidance to decision-makers, they may also be more speech-protective in cases involving unsavory defendants or unwholesome speech where the judge or jury may be tempted to rule against the person or speech they dislike.

435. See Dinwoodie & Janis, *Confusion*, *supra* note 433, at 1664-66; see also Eric Goldman, *Online Word of Mouth and its Implications for Trademark Law*, in TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH 404 (Graeme B. Dinwoodie & Mark D. Janis, eds., 2008).

436. Such a rule would not apply in cases where the defendant used the parodic or satirical term as a mark, such as the defendant's use of the term "Chewy Vuiton" for dog toys. *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 266-67 (4th Cir. 2007).

437. See Bollinger, *Dialogue*, in ETERNALLY VIGILANT, *supra* note 185, at 16-18; see also Louis Kaplow, *Rules Verses Standards: An Economic Analysis*, 42 DUKE L.J. 557 (1992); Volokh, *supra* note 374, at 2418.

438. See *Charles Atlas, Ltd. v. D.C. Comics, Inc.*, 112 F. Supp. 2d 330, 337-41 & 341 n.17 (S.D.N.Y. 2000) (refusing defendant's motion for Rule 11 sanctions). In California, the court may also be willing to dismiss the trademark claims under California's Anti-Strategic Lawsuit Against Public Participation (Anti-SLAPP) statute. See Cal. Code Civ. Proc. § 425.16(b)(1) (stating a defendant may move to strike a claim arising from any "act in furtherance of a person's right of petition or free speech under the United States or California Constitution in connection with a public issue"). In *Bosley*, the district court granted the defendant's Anti-SLAPP motion to strike Bosley's state law trademark claims, but the Ninth Circuit reversed and remanded for further proceedings on these claims. *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 682 (2005) (stating "[a]n infringement lawsuit by a trademark owner over a defendant's unauthorized use of the mark as his domain name does not necessarily impair the defendant's free speech rights").

Yet speech-protective trademark rules also have their disadvantages.⁴³⁹ They are not flexible in individual trademark cases. They may be unfair to trademark holders and allow some socially harmful trademark uses to continue if courts permit some uses of a mark that would otherwise be restricted under a multi-factor trademark test or constitutional scrutiny. Free speech may suffer if courts enforce speech-harmful trademark laws or injunctions just because they fit outside a particular rule. Adopting trademark rules also does not completely eliminate subjectivity and the possible risk of bias in trademark cases, as the judge must still determine whether a particular use of a trademark fits within a rule.⁴⁴⁰

Another problem is determining the appropriate level of specificity or generality for the trademark rule. Specific rules, such as an exemption for use of a mark within news reporting or news commentary, are only useful in limited circumstances. Protected expression not covered by a specific statutory trademark rule could be suppressed by courts that assume the legislature only seeks to exempt the expression specifically listed. On the other hand, general rules may not properly balance the rights of markholders and those who use their marks, and may apply to new circumstances in unanticipated and undesirable ways. It may be difficult to draft narrowly-tailored trademark rules that further the goals of trademark law and protect the right of freedom of expression.

Trademark law should retain some flexible trademark doctrines, such as the likelihood of confusion analysis, because they give judges the discretion to achieve justice in each individual case based on its unique facts. Yet in particularly troublesome areas of the law where protected speech is more likely to be suppressed or chilled, courts should adopt speech-protective trademark rules. They may be effective in deterring some unfounded trademark claims, increasing predictability in trademark cases, and enabling judges to quickly and easily dispose of trademark disputes that threaten to harm free speech. The next time it has the chance, the Supreme Court should say what specific trademark laws are constitutional and unconstitutional under the First Amendment and craft speech-protective trademark rules if legislatures refuse to adequately protect expression in trademark statutes.

CONCLUSION

Trademark laws restrict and punish the use of language. For this reason, some trademark laws conflict with the First Amendment right of free expression. Increasing First Amendment scrutiny of trademark law will be complicated and will consume some scarce judicial resources. Yet robust examination of the potential conflict between free speech and trademark law will benefit society if it encourages Congress, state legislatures, and courts to craft leaner, more effective trademark laws that do not stifle

439. Cf. Schauer, *supra* note 203, at 288-99.

440. Cf. *id.* at 299; McGowan, *supra* note 310, at 294-95.

the free flow of information and ideas. Application of the First Amendment in trademark cases today can discourage frivolous, speech-harmful trademark claims in the future.⁴⁴¹

441. See generally Chilling Effects Clearinghouse, <http://www.chillingeffects.org/trademark>.