

The Social Significance of Modern Trademarks: Authorizing the Appropriation of Marks as Source Identifiers for Expressive Works*

Dieuson Octave is a nineteen-year-old rapper from Florida that recently signed a deal with Atlantic Records. His YouTube videos have millions of views. He releases his music under the name Kodak Black.

Some graffiti writers use stickers in addition to spray paint. In San Francisco, a writer named Ther had stickers appropriating the The North Face logo. Instead of reading The North Face in stacked type, Ther's stickers read "Ther Norco Face." Norco is a brand of prescription painkiller.

Vaporwave is an obscure genre of music. Largely sample-based, it is characterized by an obsession with retro aesthetics, new technology, and consumerism. Songs range from upbeat to hypnagogic. They sometimes incorporate sound marks. Vaporwave musicians have monikers like Saint Pepsi and Macintosh Plus.

Gucci Mane is a rap star and actor from Atlanta. All nine of his studio albums have placed on the Billboard Top 200. In 2013, he starred alongside James Franco and Selena Gomez in *Spring Breakers*, which competed for the Golden Lion award at the sixty-ninth Venice International Film Festival.

Stuart Helm is an artist who formerly used the moniker King Velveeda. Until the early 2000s, he operated cheesygraphics.com, a website that sold his bawdy-themed art and advertised commercial art services.

Horst Simco is a recording artist from Houston who goes by Riff Raff. His collection of tattoos includes the NBA logo, the MTV logo, and the BET logo. *Neon Icon*, his 2014 album, debuted at number twenty-two on the Billboard Top 200 and contains a track called "Versace Python."

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Introduction

The social significance of trademarks continues to evolve. More than ever, trademarks find their way into everyday conversation and expression. Inherently, expressions are communicative. That expressive works today often reference, incorporate, and/or appropriate trademarks—one of society’s time-tested communicative tools—should come as no surprise. As a result, the tension between trademark law’s commercial purpose and the public’s interest in free expression is increasingly salient.

Interestingly, the clash appears to be reflective of the larger disparity between trademark law’s historical purpose and modern brand power. Historically, trademarks functioned merely as a signature that decreased search costs and encouraged manufacturers to make higher quality goods.¹ Today, however, they convey far more information than source and product quality.² That shift has altered trademarks’ social significance such that it often revolves around the particular mark’s expressive aspects in addition to its commercial aspects.

This tension is exemplified in the Federal Circuit’s recent en banc decision in *In re Tam*.³ Simon Shiao Tam, an Asian-American, chose THE SLANTS as his band’s mark to comment on racial and cultural issues.⁴ Agreeing that Tam’s band name achieved that goal, the majority observed that the decision to name a band THE SLANTS “conveys more about our society than many volumes of undisputedly protected speech.”⁵ Although the name surely offends some, the majority relied specifically on the offensive nature of the mark when it concluded that “Mr. Tam’s band name is expressive speech.”⁶ Because the commercial aspects and expressive aspects of the mark were inextricably intertwined, the commercial speech doctrine was inapplicable since the statutory prohibition regulated the expressive aspect.⁷

Additionally, acknowledging the expressive power that trademarks often wield, the majority in *Tam* conceded that “[c]ourts have been slow to

1. William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 268–69 (1987) (explaining that a trademark’s economizing function is to decrease search costs, which requires the trademark owner to maintain a consistent quality); see also STEVEN SHAVELL, FOUNDATIONS OF ECONOMIC ANALYSIS OF LAW 169 (2004) (asserting that trademark labels “enable consumers to make purchase decisions on the basis of product quality” and incentivize sellers “to produce goods and services of high quality”).

2. See Alex Kozinski, Essay, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 972–75 (1993) (discussing modern uses of trademarks in public discourse).

3. 808 F.3d 1321 (Fed. Cir. 2015), cert. granted sub nom. Lee v. Tam, 85 U.S.L.W. 3114 (U.S. Sept. 29, 2016) (No. 15-1293).

4. *Id.* at 1327–28.

5. *Id.* at 1328.

6. *Id.* at 1338.

7. *Id.* at 1339 (quoting *Riley v. Nat’l Fed’n of the Blind*, 487 U.S. 781, 796 (1988)).

appreciate the expressive power of trademarks.”⁸ Noting that “[w]ords—even a single word—can be powerful,” the majority recognized that “marks often have an expressive aspect over and above their commercial-speech aspect.”⁹ Although *Tam* appears to be the first occasion where a court has ruled that a trademark used as a source identifier can be expressive speech rather than commercial speech, the decision can be seen as consistent with the recent judicial trend toward expanding First Amendment protection in the realm of trademark law.¹⁰

Still, the majority’s conclusion raises a new question: If trademark appropriations used as source identifiers for expressive works are expressive speech instead of commercial speech, how far can trademark law bend to accommodate those uses? Prior to Congress passing the Federal Trademark Dilution Act,¹¹ the Lanham Act did not contain any provisions related to the First Amendment. Consequently, courts experimented with various devices to address expressive-speech concerns.¹² It is usually more difficult for trademark owners to stop expressive appropriation of their marks as long as the marks are not used as source identifiers. When an appropriation features direct commentary or criticism towards the mark or its owner, the law affords greater expressive leeway.

Accordingly, the appropriation of a trademark as a source identifier for expressive works, artificially defined in this Note as “expressive trademark use,” falls outside the current framework.¹³ Rather, when a trademark serves

8. *Id.* at 1327. It also fair to say that courts have long recognized trademark law’s complexity and proceeded with caution. See *HMH Publ’g Co. v. Brincat*, 504 F.2d 713, 716 (9th Cir. 1974) (“Trademark infringement is a peculiarly complex area of the law. Its hallmarks are doctrinal confusion, conflicting results, and judicial prolixity. . . . This case is no different from its kind, and we approach it with a keen awareness of its difficulty and our peril.”).

9. *In re Tam*, 808 F.3d at 1327, 1338.

10. *Compare Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) (holding that the First Amendment did not apply to expressive use where the defendant could have used alternative methods to express his concern), with *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425, 436 (S.D.N.Y. 2016) (declining to strictly require that there be no alternative methods of expression before allowing an expressive trademark appropriation).

11. Federal Trademark Dilution Act, 15 U.S.C. § 1125 (2012).

12. See, e.g., *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 776 (8th Cir. 1994) (admonishing that unnecessary confusion could be avoided with a disclaimer); *Rogers v. Grimaldi*, 875 F.2d 994, 998–99 (2d Cir. 1989) (balancing artistic relevance with consumer confusion); *Mut. of Omaha*, 836 F.2d at 402 (determining whether alternative avenues for expression were available).

13. This Note relies on specific definitions for “expressive use” and “expressive trademark use.” Some commentators have used the terms interchangeably to refer to expressive appropriations in a variety of contexts. See, e.g., Robert E. Pfeffer, *Who’s Fooling Whom: An Economic Analysis of Expressive Trademark Use*, 6 WAKE FOREST INTELL. PROP. L.J. 69, 69, 72 (2006) (using “expressive use” and “expressive trademark use” interchangeably). Here, “expressive use” refers to any trademark appropriation that is not used as a source identifier. For example, Riff Raff’s use of the VERSACE mark in his song title “Versace Python” is merely an expressive use because, unlike his stage name Riff Raff, the appropriation is used in the title of a song rather than as a source identifier for his music. “Expressive trademark use,” however, specifically refers to the use of another’s mark as a source identifier for expressive works. The artist King VelVeeda’s use of the

as a source identifier, it is considered commercial speech because its strict purpose is “to convey information about the type, price, and quality” related to a particular good or service.¹⁴ Unlike mere expressive uses that do not appropriate a mark for source identification, expressive trademark use directly conflicts with the trademark owner’s exclusive right to use the mark in commerce.¹⁵ Moreover, it risks confusion-based harm to consumers and dilution of the mark itself, both of which negatively impact the trademark owner and undermine trademark law’s fundamental policies. Therefore, “trademark law generally prevails over the First Amendment.”¹⁶

Nevertheless, this Note develops an argument in favor of authorizing expressive trademark use based on the relationship between the social significance of modern trademarks and expressive works. Modern marks possess immense communicative power and transmit an array of information, much of which is derived from characteristics of the trademark owner as well as any underlying activities associated with that owner. Those activities include any products, services, advertisements, sponsorships, charitable efforts, or scandals that are connected to the mark or its owner. For example, the CHIK-FIL-A mark is associated with fried chicken and opposition to same-sex marriage.¹⁷ Likewise, the MARLBORO mark relates to cigarettes and lung cancer.¹⁸

VELVEETA mark constitutes expressive trademark use because he used the mark as a moniker that identified the source of his comics. Put in more simple terms, expressive trademark use is the appropriation and use of another’s name (or some recognizable form of it) as your own. The term “trademark use” is itself a term of art and controversial doctrine. Compare Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669, 1673 (2007) (“The evolution of the trademark use doctrine reflects an attempt to ground trademark law in the kinds of claims it has traditionally countenanced, both by focusing its mission and by minimizing collateral damage from overly sweeping trademark claims.”), with Graeme B. Dinwoodie & Mark D. Janis, *Lessons from the Trademark Use Debate*, 92 IOWA L. REV. 1703, 1704 (2007) (“[W]e remain unconvinced that the trademark use doctrine will serve the goals of the trademark system, regardless of whether the doctrine can be cabined successfully in accord with the Dogan and Lemley reformulation.”). Nuance aside, virtually everyone would agree that a use like Kodak Black’s use of the KODAK mark or Saint Pepsi’s use of the PEPSI mark functions as a source identifier.

14. *Friedman v. Rogers*, 440 U.S. 1, 11 (1979).

15. See, e.g., *Yankee Publ’g Inc. v. News Am. Publ’g Inc.*, 809 F. Supp. 267, 275–76 (S.D.N.Y. 1992) (explaining the distinction between the use of a mark for the purpose of expression or communication, and the use of a mark “for the purpose of source identification”) (emphasis omitted).

16. *Id.* at 276.

17. See Sarah Aarthur, *Chick-fil-A Wades into a Fast-Food Fight over Same-Sex Marriage Rights*, CNN (July 28, 2012), <http://www.cnn.com/2012/07/27/us/chick-fil-a-controversy/> [<https://perma.cc/5LXR-K2UQ>].

18. See Rob Taylor, *Philip Morris Loses Latest Case Against Australia Cigarette-Pack Laws*, WALL STREET J. (Dec. 18, 2015), <http://www.wsj.com/articles/philip-morris-loses-latest-case-against-australia-cigarette-pack-laws-1450415295> [<https://perma.cc/GE7S-7Y6R>] (reporting that an Australian law aimed at reducing smoking-related cancer would remain in effect).

Therefore, whether the appropriation of a mark as a source identifier is expressive speech rather than commercial speech cannot be judged without looking to the content and meaning of the underlying activity. When the underlying activity is the creation, distribution, or performance of expressive works, the mark absorbs and reflects the expressive content. As a result, marks appropriated in this context are arguably expressive speech. Indeed, “[e]ntertainment, as well as political and ideological speech, is protected; motion pictures, programs broadcast by radio and television, and live entertainment, such as musical and dramatic works, fall within the First Amendment guarantee.”¹⁹

Because the public has a heightened interest in avoiding misleading speech and confusion-based harm, however, this Note focuses exclusively on claims under the federal dilution statute, which does not require consumer-confusion as a prerequisite for liability.²⁰ Although trademark owners certainly have an interest in avoiding the dilution of their marks, that interest is “inherently less weighty” than the interests served by trademark infringement.²¹ At any rate, expressive trademark use often involves famous marks where consumer confusion is unlikely. Absent consumer confusion, trademark owners will be unable to bring successful infringement claims, but they can still rely on dilution claims to stop unauthorized appropriations.

That said, the federal dilution statute has a provision containing exclusions from liability, which were specifically added in response to First Amendment concerns.²² The exclusions for noncommercial use and fair use are relevant to the following discussion. Given that “noncommercial use” refers to the commercial speech doctrine,²³ the exclusion may be applicable to expressive trademark use under the majority’s reasoning in *Tam*. If the use of a mark as a source identifier for expressive works is expressive speech rather than commercial speech, as the Majority in *Tam* concluded regarding THE SLANTS mark, the exclusion appears to authorize expressive trademark use. Still, other potential limitations that stem from the fair use exclusion are necessary to consider.

The discussion proceeds in three parts. Part I contextualizes the social significance of modern marks by outlining their development and evolution. Part II lays out the legal framework for trademark dilution and the statutory exclusions from liability, and covers the relevant limitations on applying the exclusions, including the commercial speech doctrine. Finally, Part III

19. *Schad v. Borough of Mt. Ephraim*, 452 U.S. 61, 65 (1981).

20. *See* 15 U.S.C. § 1125(c) (2012) (authorizing injunctive relief for owners of famous trademarks “regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury”).

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

22. 151 CONG. REC. 6,936 (2005) (statement of Rep. Berman) (explaining that the exclusion provision “balance[s] trademark law with first amendment concerns”).

23. *E.g.*, *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 331 (4th Cir. 2015).

argues in favor of applying the noncommercial use exclusion to expressive trademark use as consistent with congressional intent and the policies served by First Amendment protection for expressive speech. It also provides a framework to easily apply the exclusion.

I. The Evolution and Development of Trademarks

Today, trademarks are unavoidable. They are used on clothing, food products, household items, and various other goods that people encounter daily.²⁴ Consequently, everyone inherently knows how trademarks work. People rely on them constantly, not only for commercial purposes when it comes to differentiating between goods, but also for communicative purposes when it is easier to convey an idea embodied in a trademark by simply invoking the mark. Although the information conveyed by marks was previously limited to qualities about the good, modern trademarks communicate a wealth of meanings that are disconnected from any association with a particular product.

A. *Historical Framework for Trademark Protection*

The highly evolved communicative purpose of modern trademarks is rooted in trademark law's historical aim. Marks function as signatures that designate a good's source and assure a standard quality, which allows consumers to quickly locate familiar goods that are known to be reliable.²⁵ As a result, trademarks acquire and reflect reputational information about a source based on the attributes of goods originating from that source.²⁶

If a company begins selling peanut butter under the mark JIFFY, consumers interested in JIF or SKIPPY peanut butter might mistake one brand for the other and spend more time inspecting products to ensure that they make the right choice. Moreover, if JIFFY peanut butter is of inferior quality and a consumer accidentally buys it, the consumer might mistakenly associate the inferior quality with the wrong brand, which harms the trademark owner. Guarding against this kind of consumer confusion is the classic function of trademark law.²⁷

To enforce their trademark rights, owners of the JIF and SKIPPY marks would bring a claim for trademark infringement. Infringement is a confusion-based theory of liability that stems from a mark's use in

24. See ENCYCLOPEDIA OF NEW MEDIA: AN ESSENTIAL REFERENCE TO COMMUNICATION AND TECHNOLOGY 441 (Steve Jones ed., 2003) (describing the ubiquity of trademarks in people's lives).

25. Landes & Posner, *supra* note 1, at 268–69.

26. SHAVELL, *supra* note 1, at 169.

27. See Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 160 (“The concept of customer confusion is thus the touchstone of traditional trademark theory.”).

connection with specific goods.²⁸ By prohibiting the use of confusingly similar marks on similar types of goods at the point of sale, infringement claims decrease consumer search costs by eliminating the need to inspect a particular good.²⁹ They also ensure that trademark owners will enjoy reputational gains as a result of their investment in higher product quality. Because firms will enjoy this reputational gain, they are more likely to invest in higher quality, which leads to a more competitive market.³⁰

If trademark law did not prohibit the use of the JIFFY mark on peanut-butter products, owners of the JIF and SKIPPY marks might be less inclined to invest in their brand because they could not capture reputational benefits from confused consumers. Consumers would then be hurt by fewer choices and unreliable quality. In short, trademarks historically derived their value through their association with specific goods or products and were primarily oriented around benefitting and protecting consumers.³¹

B. *Expanding Protection Beyond Point-of-Sale Confusion*

During the 20th century, however, trademark infringement expanded beyond consumer confusion at the point of sale.³² Now, trademark infringement can protect against things like post-sale confusion.³³ If a consumer sees someone walking down the street in Yves Saint Laurent heels that have a red bottom, the consumer might confuse them as coming from Christian Louboutin, a brand that is widely recognized for using red on the bottom of all its heels.³⁴ Here, the consumer is not a confused purchaser. Rather, the consumer is a confused member of the public, which is comprised of both potential purchasers and nonpurchasers.

Other expansions include theories of liability like merchandising rights and initial-interest confusion.³⁵ Ultimately, these expansions culminated in

28. See 15 U.S.C. § 1125(a)(1)(A) (2012) (creating civil liability where use “is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person”).

29. Landes & Posner, *supra* note 1, at 270.

30. *Id.*

31. *E.g.*, *Schneider v. Williams*, 44 N.J. Eq. 391, 394 (N.J. Ch. 1888) (“It would seem to be settled beyond question that there can be no such thing as a trade-mark distinct from and unconnected with a vendible commodity. . . . It is only when it is affixed to or associated with some vendible commodity, so as to distinguish that particular commodity from others of the same class or kind, that it is possible for it to possess the essential quality of a trade-mark.”).

32. Robert G. Bone, *Taking the Confusion Out of “Likelihood of Confusion”: Toward a More Sensible Approach to Trademark Infringement*, 106 NW. L. REV. 1307, 1339 (2012).

33. *E.g.*, *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 872 (2d Cir. 1986) (“[I]t is [] clear that post-sale confusion as to source is actionable under the Lanham Act.”).

34. *Christian Louboutin S.A. v. Yves St. Laurent Am. Holdings, Inc.*, 696 F.3d 206, 227 (2d Cir. 2012) (concluding that Christian Louboutin’s red soles are recognized by consumers as a source identifier).

35. See, *e.g.*, *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1066, 1078 (9th Cir. 2006) (rejecting the lower court’s ruling that the plaintiffs’ marks were not used as a source

the federal dilution statute, passed in 1995 and revised in 2006, which gives trademark owners the ability to bring claims even when there is no risk of confusion.³⁶ Unlike trademark infringement, dilution essentially protects the mark itself, outside of its relation to specific goods.

Generally speaking, these increased protections coincided with the evolution of trademarks' communicative power. As marks began to convey more types of information to consumers, the law increasingly preserved that ability. There is little doubt that consumers today draw far more information from marks than source and quality. Indeed, savvy trademark owners have branded their marks with a variety of meanings.

For example, the VICTORIA'S SECRET mark conveys the image of someone that is "sexy and playful" and urges consumers to be "bad for goodness sake."³⁷ PLAYBOY, on the other hand, invokes "romance and *joie de vivre*."³⁸ Also, whereas marks like ANN TAYLOR and BROOKS BROTHERS are considered "classic,"³⁹ JUICY COUTURE is for those interested in an "irreverent, fun, and on-trend lifestyle."⁴⁰ Similarly, the NIKE mark is associated with "explosive movement,"⁴¹ CARTIER is worn by "cosmopolitan" consumers,⁴² and FUBU represents the "multicultural youth generation."⁴³

C. Modern Trademarks and Their Social Significance

As illustrated by the examples above, brand power is a dominant force influencing individual behavior in modern society, and trademarks are the receptacles of that power. Marks are so thoroughly enmeshed in the cultural fabric that people frequently use them as shorthand devices.⁴⁴ Often, they efficiently and effectively illustrate or articulate something that is difficult or cumbersome to convey.

identifier on third-party accessories); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 203–04 (5th Cir. 1998) (affirming liability for infringement based on initial-interest confusion).

36. Federal Trademark Dilution Act, Pub. L. No. 104-98, 109 Stat. 985 (1996) (codified as amended at 15 U.S.C. §§ 1125(c)(1), 1127 (2000)); Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730 (2006) (amending 15 U.S.C. §§ 1125, 1127).

37. *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 394 & n.4 (6th Cir. 2010) (Moore, J., dissenting) (discussing content used in advertisements for Victoria's Secret and the company's explanation concerning the meanings behind the VICTORIA'S SECRET mark).

38. *Playboy Enters., Inc. v. Webbworld, Inc.*, 991 F. Supp. 543, 558 (N.D. Tex. 1997).

39. *Urban Outfitters, Inc. v. BCBG Max Azria Grp., Inc.*, 511 F. Supp. 2d 482, 499 (E.D. Pa. 2007).

40. *Juicy Couture, Inc. v. Bella Int'l Ltd.*, 930 F. Supp. 2d 489, 495 (S.D.N.Y. 2013).

41. *Tovey v. Nike, Inc.*, No. 1:12CV448, 2014 WL 3510975, at *5 (N.D. Ohio July 10, 2014).

42. *Cartier, Inc. v. Four Star Jewelry Creations, Inc.*, No. 01 Civ. 11295, 2003 WL 21056809, at *8 (S.D.N.Y. May 8, 2003).

43. *GTFM, LLC v. Universal Studios, Inc.*, No. 02 CV. 0506(RO), 2006 WL 1377048, at *1 (S.D.N.Y. May 16, 2006).

44. See Kozinski, *supra* note 2, at 972–75 (discussing modern uses of trademarks in public discourse).

Consider the following: Joanna's new road bike is the Bentley of bikes. Clark hopes Jessica is down to Netflix and chill tonight. The summer mosquito population in Texas is like Starbucks. Don't believe me? Google it. Each time, the invocation or referencing of a mark broadens the statement's implications because the speaker is able to tap into the meaning that popular culture associates with the mark. Undeniably, "some words, phrases or symbols better convey their intended meanings than others."⁴⁵

This change in trademarks' social significance is related, at least in part, to technological achievements.⁴⁶ Through channels like social media, consumers encounter an overwhelming amount of trademarks daily.⁴⁷ Given the frequency of these encounters and the variety of meanings that modern trademarks embody, appropriating them for expressive purposes comes naturally because it allows individuals to exploit that meaning for their work.

Additionally, the ease with which expressive works can be made is unprecedented. A significant amount of the global population has access to devices and software that enable expressive activities that used to be prohibitively expensive or require specialized skills.⁴⁸ Moreover, appropriating another's mark is as easy as speaking it, and digital copies can be quickly found online. All Kodak Black has to do to harness the KODAK mark's meaning is call himself that and release his music. Likewise, Ther can make his stickers simply by downloading THE NORTH FACE design mark and altering it with basic software.

Now that expressive works can be instantaneously disseminated over the Internet, individuals are able to engage large segments of the population in discourse using widely known words and symbols. Consequently, the social significance of modern trademarks increasingly revolves around their

45. *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992).

46. See generally Jack M. Balkin, *Digital Speech and Democratic Culture: A Theory of Freedom of Expression for the Information Society*, 79 N.Y.U. L. REV. 1 (2004) (examining how digital technologies have altered the social conditions of speech).

47. See Sydney Ember & Rachel Abrams, *On Instagram and Other Social Media, Redefining 'User Engagement'*, N.Y. TIMES (Sept. 20, 2015) http://www.nytimes.com/2015/09/21/business/media/retailers-use-of-their-fans-photos-draws-scrutiny.html?_r=0 [<https://perma.cc/X3AC-9WRK>] (detailing efforts by brands to engage consumers through social media).

48. See *ICT Facts and Figures 2016*, INT'L TELECOMM. UNION (June 2016), <http://www.itu.int/en/ITU-D/Statistics/Documents/facts/ICTFactsFigures2016.pdf> [<https://perma.cc/47DP-HQ3R>] (concluding that 47% of the world population will be using the Internet by the end of 2016); *Internet User Demographics*, PEW RES. CTR. (Jan. 2014), <http://www.pewinternet.org/data-trend/internet-use/latest-stats/> [<https://perma.cc/KML3-FE6X>] (reporting that 87% of American adults use the Internet); Art Tavana, *Democracy of Sound: Is GarageBand Good for Music?*, PITCHFORK (Sept. 30, 2015), <http://pitchfork.com/features/article/9728-democracy-of-sound-is-garageband-good-for-music/> [<https://perma.cc/7659-RCH7>] (listing examples of popular songs that were created on free computer software).

expressive qualities, and that shift seems both obvious and unavoidable. From this perspective, the result in *Tam* appears to align with reality.

Like the majority's observation that Tam's choice to adopt an allegedly disparaging mark conveys "more about our society than many volumes of undisputedly protected speech," a person's choice to appropriate another's trademark for his or her expressive work can be similarly reflective outside of the disparagement context.⁴⁹ What does it say about modern society when a mark like PEPSI is beatified in a moniker like Saint Pepsi? Is Gucci Mane's decision to appropriate the GUCCI mark for his works not indicative of certain values promoted in popular culture? As trademarks continue to grow in communicative power, it will become increasingly difficult to argue that these appropriations cannot be "fairly considered as relating to . . . matter[s] of political, social, or other concern to the community."⁵⁰

II. The Federal Trademark Dilution Statute

Confronted by unauthorized appropriations in contexts where consumer confusion is nonexistent, trademark owners can turn to the federal dilution statute to enjoin unwanted uses. Available only to famous marks, trademark dilution is not limited to claims involving similar goods or services.⁵¹ Although the statutory exclusions from liability are generally effective for protecting expressive use, they have not been applied to expressive trademark use. The following discussion first outlines liability under the statute. It then describes the relevant statutory exclusions from liability. Afterwards, it considers what limitations on applying the noncommercial use exclusion are necessary by examining the forms of expression allowed by the fair use exclusion.

A. Trademark Dilution

A trademark owner's rights effectively expand once a mark becomes as well-known as the VELVEETA or VERSACE marks. As discussed above, federal dilution claims protect against unauthorized uses in contexts completely unrelated to the mark's original public association.⁵² The statute's purpose is to stop unauthorized appropriations that "seize upon the popularity of a trademark at the expense of the rightful owner and the public."⁵³ Importantly, both expressive use and expressive trademark use

49. *In re Tam*, 808 F.3d 1321, 1328 (Fed. Cir. 2015), *cert. granted sub nom.* Lee v. Tam, 85 U.S.L.W. 3114 (U.S. Sept. 29, 2016) (No. 15-1293).

50. *Id.* at 1339 (quoting *Snyder v. Phelps*, 562 U.S. 443, 453 (2011)).

51. *See* 15 U.S.C. § 1125(e) (2012) (authorizing injunctive relief for owners of famous trademarks, regardless of actual or likely confusion or competition).

52. *See id.* (creating liability where a person begins to use a famous mark "at any time after the owner's mark has become famous").

53. 152 CONG. REC. H6,963 (daily ed. Sept. 25, 2006) (statement of Rep. Sensenbrenner).

often involve famous marks because the public's familiarity with them allows the party appropriating the mark to harness its communicative power.

Two kinds of dilution are possible under the statute: blurring and tarnishment.⁵⁴ Blurring addresses harm that occurs when other trademarks exist that are similar to a well-known, unique mark.⁵⁵ Because the public overwhelmingly associates famous marks with "one source and only one source," unauthorized appropriations of those marks for unrelated goods or services "blur[s] the association in the public mind between the famous mark and its original source."⁵⁶ Kodak Black's appropriation of the KODAK mark is an example of blurring.

By comparison, tarnishment occurs when someone uses a mark that is similar to the famous mark in such a way that consumers might develop negative associations with the famous one.⁵⁷ Here, the new use risks harming the brand's reputation among consumers.⁵⁸ For example, the injunction that barred Stuart Helm from using his King VelVeeda moniker in connection with his work was aimed at stopping the public from "associat[ing] Velveeta[®] with Mr. Helm's arguably offensive product, thereby tarnishing the Velveeta[®] mark."⁵⁹

To bring a successful dilution claim, trademark owners need not definitively prove dilution. Instead, demonstrating a likelihood of dilution is sufficient.⁶⁰ Concerning remedies, trademark owners can recover profits, damages, and attorney's fees if the party appropriating the mark did so willfully for the purpose of trading on its widespread recognition or harming its reputation.⁶¹ Otherwise, trademark owners are generally entitled only to injunctive relief regardless of actual economic harm.⁶² Still, an injunction is a powerful tool that is available as soon as the trademark owner can prove he or she has a "better than negligible chance of success on the merits."⁶³

54. 15 U.S.C. § 1125(c).

55. William G. Barber, *The Trademark Dilution Revision Act of 2005: Breathing Life Back into the Federal Dilution Statute*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1113, 1134 (2006).

56. *Id.*

57. *Id.* at 1123–24.

58. See *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 507 (2d Cir. 1996) ("The sine qua non of tarnishment is a finding that plaintiff's mark will suffer negative associations through defendant's use.").

59. *Kraft Foods Holdings, Inc. v. Helm*, 205 F. Supp. 2d 942, 949–50 (N.D. Ill. 2002).

60. 15 U.S.C. § 1125(c)(1) (2012).

61. *Id.* § 1125(c)(5).

62. *Id.* § 1125(c)(1).

63. *Helm*, 205 F. Supp. 2d at 945–46 (internal quotation omitted).

B. *Statutory Exclusions from Liability*

To “balance trademark law with first amendment concerns,” the federal dilution statute includes several exclusions from liability.⁶⁴ If applicable, they prohibit liability for both blurring dilution and tarnishment dilution.⁶⁵ Although the argument in favor of expressive trademark use relies on the exclusion for noncommercial use, its reach is implicated by limitations on the exclusion for fair use. Accordingly, each is discussed in turn.

1. The Noncommercial Use Exclusion.—The statutory text outlining the noncommercial use exclusion is minimal. It merely states that trademark appropriations “shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection” concerning “any noncommercial use of a mark.”⁶⁶ The legislative history explains that noncommercial use should be read “as that term has been defined by the courts.”⁶⁷ Courts have concluded that the term is “a somewhat inexact, shorthand reference to ‘speech protected by the First Amendment.’”⁶⁸ In other words, the exclusion limits liability to speech that falls under the commercial speech doctrine.⁶⁹

The commercial speech doctrine concerns speech that is not entitled to full First Amendment protection when balanced against the state’s compelling interest in ensuring the truthfulness of speech in the commercial arena.⁷⁰ Its roots can be traced as far back as 1942 when the Supreme Court suggested that the Constitution does not impose restraints on regulations that restrict “purely commercial advertising.”⁷¹ Rather than developing along a clear path, however, the doctrine’s applicability has shifted in different directions.⁷²

64. 151 CONG. REC. 6,936 (2005) (statement of Rep. Berman).

65. 15 U.S.C. § 1125(c)(3).

66. *Id.* § 1125(c)(3)(C).

67. H.R. REP. NO. 104-374, at 4 (1995).

68. *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682, 695 (N.D. Ohio 2002); *see, e.g., Radianc Found., Inc. v. NAACP*, 786 F.3d 316, 332 (4th Cir. 2015) (noting that trademark law is not a proper tool for thwarting speech that one does not agree with, and that the use of trademark law to prevent noncommercial speech would cause many social commentators and websites to be silenced); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 907 (9th Cir. 2002) (holding that partially commercial speech that serves a noncommercial purpose, such as humor, is fully protected under the First Amendment).

69. *See Radianc Found.*, 786 F.3d at 331 (“The term ‘noncommercial’ refers to the First Amendment commercial speech doctrine.”).

70. *See, e.g., Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 563 n.5 (1980) (explaining that the state has an interest in regulating speech in the context of commercial transactions so that information not only flows “freely” but also “cleanly”).

71. *See Valentine v. Chrestensen*, 316 U.S. 52, 54–55 (1942) (upholding an ordinance that prohibited distribution of commercial handbills).

72. *See, e.g., Bigelow v. Virginia*, 421 U.S. 809, 822–25 (1975) (explaining that courts in Virginia erred in their assumption that advertisements were not entitled to First Amendment protection).

Ultimately recognizing that commercial speech is not a zero-sum proposition, the Supreme Court subsequently explained that an advertisement that does “more than simply propose a commercial transaction” is entitled to full First Amendment protection.⁷³ Moreover, it later held in *Riley v. National Federation of the Blind*⁷⁴ that those protections apply to mixed speech if its commercial and expressive aspects are “inextricably intertwined” and the expressive aspect is targeted by a regulation.⁷⁵ The fact that the mark may be used in a for-profit enterprise is of no consequence.⁷⁶ Because trademarks “necessarily pertain to commercial transactions,” however, they have historically been treated as strictly commercial speech.⁷⁷

Nevertheless courts have, on multiple occasions, ruled that certain appropriations did more than simply “propose a commercial transaction” and concluded that the appropriations were not commercial speech.⁷⁸ Accordingly the courts applied the dilution statute’s exclusion for noncommercial use.⁷⁹ Although those cases involved expressive use rather than expressive trademark use, the increasing reality that marks “often have an expressive aspect over and above their commercial-speech aspect” suggests that the exclusion can be applied more broadly if expressive trademark use is not commercial speech.⁸⁰ Indeed, Kodak Black’s use of the KODAK mark and Macintosh Plus’s use of the MACINTOSH mark certainly

73. *See id.* at 822, 829 (holding that an advertisement for abortions was entitled to First Amendment protection because it was not wholly commercial speech).

74. 487 U.S. 781 (1988).

75. *Id.* at 796.

76. *See, e.g.,* Ayres v. City of Chicago, 125 F.3d 1010, 1014 (7th Cir. 1997) (“[T]here is no question that the T-shirts 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.”).

77. *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 457 n.6 (E.D. Va. 2015) (“A trademark, however, is commercial speech.”); *see also* *Friedman v. Rogers*, 440 U.S. 1, 11 (1979) (holding that the trade name of an optometrist was commercial speech); *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 415 (S.D.N.Y. 2002) (noting that, to the extent expressive trademark use of another’s mark on a commercial product causes confusion, it is not protected).

78. *See, e.g.,* *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 906–07 (9th Cir. 2002) (finding that the “Barbie Girl” song by the band Aqua was parodic noncommercial use).

79. *See* *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 332 (4th Cir. 2015) (relying on the federal dilution statute’s exclusion for noncommercial use to conclude that the appropriation of the NAACP’s mark for the purpose of criticism was not subject to dilution liability); *Mattel*, 296 F.3d at 907 (finding that “Barbie Girl” song’s parodic noncommercial use did not dilute the Barbie trademark); *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302, 1340 (N.D. Ga. 2008) (explaining that the federal dilution statute did not apply to t-shirts appropriating the WAL-MART logo to criticize Wal-Mart’s business practices because such criticism was noncommercial use); *Kiedis v. Showtime Networks, Inc.*, No. CV 07-8185 DSF (MANx), 2008 WL 11173143, at *5 (C.D. Cal. Feb. 19, 2008) (“The Court has no doubt that the title ‘Californication,’ as used by Defendants, has sufficient artistic qualities to take it out of the realm of purely commercial speech.”).

80. *In re Tam*, 808 F.3d 1321, 1338 (Fed. Cir. 2015), *cert. granted sub nom.* *Lee v. Tam*, 85 U.S.L.W. 3114 (U.S. Sept. 29, 2016) (No. 15-1293).

communicate more than “type, price, and quality,” especially in light of their underlying activity.⁸¹

2. *The Fair Use Exclusion.*—While the noncommercial use exclusion on its face appears applicable to expressive trademark use where the appropriation is expressive speech rather than commercial speech, limitations on the fair use exclusion’s applicability are necessary to consider. Unlike the exclusion for noncommercial use, the fair use exclusion’s statutory language limits its application to specific circumstances. These limitations are relevant because applying the exclusion for noncommercial use without reference to them potentially casts too broad a net.

The fair use exclusion is inapplicable to appropriations that are used “as a designation of source for the person’s own goods or services.”⁸² Therefore, expressive trademark use is clearly prohibited by the exclusion’s plain language. Moreover, protection extends only to appropriations that are used “in connection with . . . identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.”⁸³ An appropriation that does not specifically address the trademark owner’s practices, products, or services does not trigger the exclusion.

To illustrate, consider the difference between parody and satire. Unlike parody, which clearly fits within the exclusion, satire is a grey area. The difference between the two relates to purpose and necessity. Parody appropriates a trademark to directly poke fun at the mark or its owner.⁸⁴ By nature, a parody must mimic what it criticizes—while simultaneously communicating that it is different—to have its intended effect.⁸⁵ Satire, on the other hand, appropriates a mark to comment on a broader social issue that the mark is only one part of, which means the appropriation is not necessarily required.⁸⁶

81. *Friedman v. Rogers*, 440 U.S. 1, 11 (1979).

82. 15 U.S.C. § 1125(c)(3)(A) (2012).

83. *Id.* § 1125(c)(3)(A)(ii). The fair use exclusion also permits advertising or promotion that permits consumers to compare goods or services, but that exclusion necessarily applies to commercial speech rather than expressive speech. *Id.* § 1125(c)(3)(A)(i).

84. *See* *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260–61 (4th Cir. 2007) (holding that an inexpensive dog toy modelled after a Louis Vuitton handbag successfully parodied the handbag by poking fun at the handbag’s elegance and expensiveness).

85. *Id.*

86. *See, e.g., Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 113 (2nd Cir. 2009) (holding that defendant’s use of “Charbucks” was at most a “subtle satire” of Starbucks that did not rise to the level of a successful parody protected in *Haute Diggity Dog*, 507 F.3d at 260); *see also* *Louis Vuitton Malletier, S.A. v. Hyundai Motor Am.*, No. 10 Civ. 1611(PKC), 2012 WL 1022247, at *20 (S.D.N.Y. Mar. 22, 2012) (“Courts have, however, not applied fair use when the defendant’s mark is instead ‘a subtle satire’ of the original.”) (quoting *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 113 (2nd Cir. 2009)).

Consequently, expressive trademark use would not qualify for protection under the fair use exclusion even if the appropriation of a mark as a source identifier were not flatly prohibited. Often, expressive trademark use involves appropriations that lack an obvious intent to directly criticize or comment on the trademark owner. In fact, Saint Pepsi claimed in an interview that his work has nothing to do with PepsiCo or the PEPSI mark.⁸⁷ Additionally, the requisite intent does not become visible when considering the underlying activity. Kodak Black has yet to write a track praising Eastman Kodak for surviving its bankruptcy woes⁸⁸ or criticizing it for allegedly polluting New York waterways.⁸⁹

C. *Limitations on the Noncommercial Use Exclusion*

Given the differences between the exclusions for noncommercial and fair use, it is apparent that the noncommercial use exclusion ought to be applied with the limitations on the fair use provision in mind. By limiting protection to appropriations which directly comment on or criticize the trademark owner, the fair use exclusion attempts to preserve the balance between expressive freedom and the trademark owner's rights.⁹⁰ Functionally, the requirement ensures that a particular appropriation embodies sufficient expressive value to merit First Amendment protection. It would therefore be troubling to apply the noncommercial use exclusion when the exclusion for fair use would deem the appropriation unworthy of protection.

In essence, requiring that appropriations directly address the trademark owner achieves its purpose by discriminating on the basis of the form of expression. Consider again the difference between parody and satire. Parody is allowed because it must, by nature, directly address the trademark owner. Satire, by comparison, is prohibited because the owner is, at most, peripheral to the purpose of the appropriation. Expressive trademark use—further away from the spectrum of permissible uses than satire—is a completely different

87. See *Saint Pepsi: An Interview With BC's Up and Coming Music Producer*, GAVEL (Aug. 27, 2013), <http://bcgavel.com/2013/08/27/saint-pepsi-an-interview-with-bcs-up-and-coming-music-producer/> [<https://perma.cc/2SD5-8FU9>] (“SAINT PEPSI just sorta came into my head when I was discussing the name for a ‘future project’ with my best friend . . .”).

88. Maggie McGrath, *Kodak Is Back on the Big Board After Bankruptcy*, FORBES (Nov. 1, 2013), <http://www.forbes.com/sites/maggiemcgrath/2013/11/01/there-and-back-again-10-companies-that-returned-to-the-market-after-bankruptcy/#2d11c3fc1ce3> [<https://perma.cc/A3HY-F7ET>].

89. Thomas Adams, *Report: Kodak Helped Make N.Y.'s Waterways Among Most Toxic*, ROCHESTER BUS. J. (June 20, 2014), <http://rbj.net/article.asp?aID=209728> [<https://perma.cc/7VVZ-NZNZ>].

90. *Cf. Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) (rejecting a First Amendment defense to trademark infringement because the trademark owner's rights “need not yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist . . . for it would diminish [those] rights without significantly enhancing the asserted right of free speech”) (internal quotations omitted).

form of expression. Rather, it is a “post-parody” form of expression that resembles pastiche, which undoubtedly violates the terms for protection under the fair use exclusion.⁹¹

Pastiche is really just a fancy word for “hodgepodge” that refers to works that incorporate styles and elements from other works, artists, or time periods.⁹² Whereas parody and satire reference specific features of the materials that they appropriate to serve their critical purposes, pastiche neither criticizes nor celebrates the appropriated material.⁹³ Instead, different materials are more like artifacts that can be combined to constitute a new, distinctive style. Although pastiche is surely different, it suffers from the same problem as satire concerning the fair use exclusion. If it neither criticizes nor celebrates the appropriated materials, it cannot be described as directly addressing the trademark owner.

Vaporwave music released by Saint Pepsi or Macintosh Plus is an example of pastiche.⁹⁴ The use of those marks as monikers to release music seemingly has nothing to do with the trademark owner’s products or practices. Accordingly, application of the noncommercial use exclusion to expressive trademark use is potentially inappropriate if it undermines the limitations on the exclusion for fair use. Unless an alternative basis ensures that appropriations for expressive trademark use are consistent with First Amendment protection, authorizing those appropriations under the noncommercial use exclusion.

III. Arguments in Favor of Allowing Expressive Trademark Use Under the Noncommercial Use Exclusion

To summarize the preceding discussion, modern trademarks differ in their communicative power from trademarks historically, largely because they relate to the entirety of the trademark owner’s underlying activity rather than only a particular good or service. As a result, they are thoroughly

91. See generally Charles E. Colman, *Trademark Law and the Prickly Ambivalence of Post-Parodies*, 163 U. PA. L. REV. ONLINE 11 (2014) (referring to new expressive activities like pastiche as “post-parody” and discussing post-parody in the context of trademark law and fashion).

92. See *id.* at 26 n.37 (explaining that “[p]astiche is, like parody, the imitation of a peculiar or unique, idiosyncratic style, the wearing of a linguistic mask, speech in a dead language”) (quoting FREDRIC JAMESON, *POSTMODERNISM, OR, THE CULTURAL LOGIC OF LATE CAPITALISM* 17 (1991)).

93. *Id.*

94. See Christian Ward, *Vaporwave: Soundtrack to Austerity*, *STYLUS* (Jan. 29, 2014), <http://www.stylus.com/hzwtl5> [<https://perma.cc/M57G-EP59>] (explaining that “Vaporwave is a micro-genre of electronic music that draws on the corporate sonic ephemera of the 80s and 90s—such as lift muzak, ad soundtracks, ‘hold’ music, and cocktail jazz—to satirise the emptiness of a hyper-capitalist society”); see also Michelle Lhoq, *Is Vaporwave the Next Seapunk?*, *THUMP* (Dec. 27, 2013), http://thump.vice.com/en_us/article/is-vaporwave-the-next-seapunk [<https://perma.cc/48EU-55KY>] (noting that many commentators and producers within the Vaporwave genre have considered as central to the genre a satirical but not necessarily critical preoccupation with consumer capitalism, popular culture, and new-age tropes).

enmeshed in the popular culture and appropriated for expressive works, which, by virtue of modern trademarks' expressive features, often constitute expressive speech rather than commercial speech. As expressive speech, these appropriations should be excluded from liability under the dilution statute's noncommercial use provision.

Several things must be addressed to establish that the provision's application is appropriate. Most importantly, it cannot contravene Congress's intent as expressed in the statutory text or legislative history. If Congress has clearly spoken on the issue, an alternative interpretation is *per se* unreasonable. Additionally, there has to be expressive value associated with expressive trademark use that justifies First Amendment protection. Finally, a principle that clearly defines the new boundaries is necessary to ensure that the provision does not ultimately undermine the statute's legitimate functions.

A. *Consistency with the Statutory Text and Legislative History*

As noted above, the noncommercial use exclusion's language differs from the language of the fair use provision. Whereas the exclusion for fair use does not apply to marks used "as a designation of source," the noncommercial use exclusion does not have the same limiting language.⁹⁵ The absence of such language suggests that Congress did not intend for the noncommercial use exclusion to be read as narrowly as the exclusion for fair use.

Unlike claims for trademark infringement, claims for dilution do not have a built-in mechanism that limits a trademark owner's ability to stop expressive appropriations. There is no consumer-confusion requirement for dilution, which lessens the trademark owner's burden of proof and allows dilution to reach across different markets.⁹⁶ Relatedly, distinct from an injunction for trademark infringement that is necessarily based on consumer-confusion concerns, an injunction for dilution is premised on protecting a mark's value, which is "inherently less weighty."⁹⁷ Consequently, there is good reason to read the exclusion broadly on the basis of the text alone given dilution's broad reach and the public's decreased interest in prohibiting it.

Moreover, the dilution statute's legislative history contains clear statements clarifying that Congress intended the exclusion to alleviate First Amendment concerns. Although the exclusion was initially pulled from the

95. See 15 U.S.C. §§ 1125(c)(3)(A)(ii), (C) (2012) ("The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection: (A) Any fair use . . . other than as a designation of source . . . in connection with . . . (ii) identifying and parodying, criticizing, or commenting upon the famous mark owner. . . . (C) Any noncommercial use of a mark.").

96. See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 904–05 (9th Cir. 2002) ("A dilution injunction . . . will generally sweep across broad vistas of the economy.").

97. *Id.* at 905.

statute during the 2005 revisions, the Senate Judiciary Committee added it back in for added protection before the revisions were passed.⁹⁸ During deliberations for the pre-revision version statute, Congress explained that the dilution statute would not “prohibit or threaten noncommercial expression, such as parody, satire, editorial and other forms of expression that are not a part of a commercial transaction.”⁹⁹ Further, it noted that the statute would not “prohibit or threaten ‘noncommercial’ expression, as that term has been defined by the courts.”¹⁰⁰ Therefore, Congress expressly delegated authority to the courts to determine the exclusion’s scope.

That delegation especially makes sense in light of the role courts have played concerning the appropriate balance between trademark law and the First Amendment. Early cases like *L.L. Bean v. Drake Publishers, Inc.*¹⁰¹ and *Rogers v. Grimaldi*¹⁰² recognized the tension that arises when trademark owners attempt to enforce their rights against expressive appropriations and took great pains to protect the public’s interest in free expression.¹⁰³ Subsequently, courts have expanded expressive protections for new appropriations emerging in unfamiliar places.¹⁰⁴

Admittedly, *Tam* appears to be the first court to hold that a trademark used as a source identifier can be expressive speech entitled to First Amendment protection. That said, the majority’s conclusion represents merely another occasion where courts have adjusted the doctrine to account for modern conditions. By expressly stating that the exclusion is based on commercial speech as defined by the courts, Congress demonstrated not only its intent but also its reliance on the judiciary to define the boundaries of the exclusion’s application.

98. See Paul Alan Levy, *The Trademark Dilution Revision Act—A Consumer Perspective*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1189, 1211–12 (2006) (“[O]n the eve of the Senate Judiciary Committee’s markup, the Senators agreed to restore the non-commercial use exception to section 43(c)(3).”).

99. 141 CONG. REC. S19,310 (daily ed. Dec. 29, 1995) (statement of Sen. Hatch).

100. H.R. REP. NO. 104-374, at 4 (1995).

101. 811 F.2d 26 (1st Cir. 1987).

102. 875 F.2d 994 (2d Cir. 1989).

103. See *Rogers*, 875 F.2d at 1000 (“Where a title with at least some artistic relevance to the work is not explicitly misleading as to the content of the work, it is not false advertising This construction of the Lanham Act accommodates consumer and artistic interests.”); *L.L. Bean*, 811 F.2d at 33–34 (“The district court’s injunction falls not only because it trammels upon a protected form of expression, but also because it depends upon an untoward judicial evaluation of the offensiveness or unwholesomeness of the appellant’s materials.”).

104. See, e.g., *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) (applying the rule from *Rogers* beyond the title of an expressive work to content within in the work itself).

B. Consistency with the First Amendment

Nevertheless, even if applying the noncommercial use exclusion to expressive trademark use is consistent with Congress's intent, courts have overwhelmingly applied the exclusion where the appropriation was directed at the trademark owner and its activities. For example, in *Smith v. Wal-Mart Stores*¹⁰⁵ the appropriation of the WAL-MART mark in works referring to Wal-Mart as "Wal-qaeda" or "Walocaust" was allowed under the exclusion because the works expressed the defendant's "strongly adverse positions" concerning Wal-Mart's business practices.¹⁰⁶ As discussed above, allowing trademark appropriation only when it directly targets the owner functionally ensures that the appropriation has sufficient expressive value to merit First Amendment protection.

While that limitation applies only to the fair use exclusion and is absent from the noncommercial use exclusion's statutory language, its foundation cannot be overlooked. Expressive trademark use cannot be authorized unless there is expressive value associated with it. Generally, speech that implicates the "public concern" merits First Amendment protection because it relates to "political, social, or other concern[s] to the community."¹⁰⁷ Although appropriating the mark is not necessary for expressive trademark use in the same sense as parody, allowing expressive trademark use nonetheless nurtures the kind of discourse that the First Amendment endeavors to protect. Individuals encounter numerous trademarks every day and absorb the vast array of different meanings imbued in them. Consequently, marks are often appropriated for expressive works, which are then publicly disseminated into the cultural sphere. As the public begins to engage and respond to those works, the process becomes increasingly synonymous with the kind of political discourse that merits protection.¹⁰⁸

Ultimately, trademarks are part of "the cultural resources available to us (and within us)" that individuals use to express, critique, revise, and consider new ideas.¹⁰⁹ By disseminating expressive works that contribute to discourse in the cultural sphere, "ordinary people gain a greater say over the institutions

105. 537 F. Supp. 2d 1302 (N.D. Ga. 2008).

106. *Id.* at 1340.

107. *In re Tam*, 808 F.3d 1321, 1339 (Fed. Cir. 2015) (quoting *Snyder v. Phelps*, 562 U.S. 443, 453 (2011)), *cert. granted sub nom.* *Lee v. Tam*, 85 U.S.L.W. 3114 (U.S. Sept. 29, 2016) (No. 15-1293).

108. See Neil Weinstock Netanel, *Copyright and A Democratic Civil Society*, 106 YALE L.J. 283, 350–51 (1996) ("Even seemingly innocuous cartoon characters, like Bart Simpson and Mickey Mouse, may be used to subvert (or reinforce) prevailing cultural values and assumptions—and with greater social impact than the most carefully considered Habermasian dialogue.").

109. Rosemary J. Coombe, *Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue*, 69 TEXAS L. REV. 1853, 1866 (1991); see Oren Bracha & Talha Syed, *Beyond Efficiency: Consequence-Sensitive Theories of Copyright*, 29 BERKELEY TECH. L.J. 229, 253–56 (2014) (describing the effects of particular democratic theories of copyright).

and practices that shape them and their futures.”¹¹⁰ Regardless of whether those ideas are ultimately accepted or rejected, that participation “lies at the heart of a democratic civil society.”¹¹¹ Trademarks are especially effective at enabling that participation because of the public’s familiarity with them.¹¹² For example, Stuart Helm’s use of Kraft’s VELVEETA mark allowed him to comically masquerade as a well-known corporate identity and, at the same time, subversively comment on the norms embodied in that identity. Indeed, the references to sexuality and drug use in King VelVeeda’s works stands in stark contrast to the image of a “wholesome, family-oriented product” cultivated by Kraft.¹¹³ It is precisely that contrast—achieved, in part, through the appropriation—that evidences political discourse. The appropriation aided Helm’s participation in the cultural dialogue, and while his ideas may not be completely clear, the opportunity to disseminate those ideas into the cultural sphere merits protection.

Correspondingly, whether individuals specifically intend for their works to carry direct commentary or criticism is irrelevant to that participation. Often, the act of appropriation alone conveys meaning. Whether or not Macintosh Plus took the MACINTOSH mark as a source identifier to criticize Apple, the act alone bespeaks Apple’s overwhelming significance in society. In the context of the vaporwave music it identifies, the moniker Macintosh Plus just as easily implies admiration regarding the positive benefits engendered by Apple’s inventive prowess as it suggests aversion concerning Apple’s seemingly insurmountable dominance in the marketplace. What difference does it make if individuals encountering the work are unsure which meaning was intended? Rather, “First Amendment protections do not apply only to those who speak clearly, whose jokes are funny, and whose parodies succeed.”¹¹⁴

C. *Framework for Protection*

Having established a basis for authorizing expressive trademark use under the federal dilution statute, a framework is necessary to guide the noncommercial use exclusion’s application. Artistic relevance—a concept that is largely applied to claims for infringement rather than dilution—is an attractive candidate.¹¹⁵ It is the heart of the rule originating from *Rogers v.*

110. See Balkin, *supra* note 46, at 35.

111. Netanel, *supra* note 108, at 348.

112. See Balkin, *supra* note 46, at 12. (“Mass media products—popular movies, popular music, trademarks, commercial slogans, and commercial iconography—have become the common reference points of popular culture.”).

113. Kraft Foods Holdings, Inc. v. Helm, 205 F. Supp. 2d 942, 949 (N.D. Ill. 2002).

114. Yankee Publ’g Inc. v. News Am. Publ’g Inc., 809 F. Supp. 267, 280 (S.D.N.Y. 1992).

115. See *Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc.*, 868 F. Supp. 2d 172, 178 (S.D.N.Y. 2012) (“The artistic relevance prong ensures that the defendant intended an artistic—i.e., noncommercial—association with the plaintiff’s mark, as opposed to one in which the defendant

Grimaldi, which has been widely adopted.¹¹⁶ Referred to as the *Rogers* rule, it is relevant for trademark appropriation in the context of expressive works like movies, music, paintings, and video games.

The rule was initially crafted to address First Amendment concerns related to the titles of expressive works. In *Rogers*, the Second Circuit considered trademark appropriation in the context of a movie title. The court agreed that the title of an expressive work can be an “integral element” of the work’s expressive value and that “the expressive element of titles requires more protection than the labeling of ordinary commercial products.”¹¹⁷ Moreover, it rejected the argument that First Amendment protection applies to trademark appropriations only when there is no alternative avenue of expression, reasoning that the restriction provided insufficient leeway for the creation of expressive works.¹¹⁸ Because the Lanham Act should “apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression,” the court concluded that risk of confusion in the context of titles is minimal since consumers “do not regard titles of artistic works in the same way as the names of ordinary commercial products.”¹¹⁹ Still, the court acknowledged that appropriations in the titles of works may nonetheless create confusion.¹²⁰ In such a case, “the slight risk that such use . . . might implicitly suggest endorsement or sponsorship to some people is outweighed by the danger of restricting artistic expression.”¹²¹ Therefore, if the appropriation has at least “some artistic relevance,” it is permissible as long as it does nothing to explicitly mislead or add to any potential confusion.¹²²

More recently, the rule has been applied beyond titles to trademark appropriations within the work itself. For example, the Sixth Circuit applied the rule to a painting commemorating Tiger Woods’s historic victory at the 1997 Masters Tournament in Augusta that included a rendering of Woods and the use of his name.¹²³ Likewise, the Ninth Circuit held that the rule precluded liability for trademark infringement in a case involving the virtual re-creation of a Los Angeles strip club in the *Grand Theft Auto: San Andreas* video game.¹²⁴ Concluding that the threshold amount of artistic relevance to

intends to associate with the mark to exploit the mark’s popularity and good will.”).

116. *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989); see generally David M. Kelly & Lynn M. Jordan, *Twenty Years of Rogers v. Grimaldi: Balancing the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 99 TRADEMARK REP. 1360 (2009) (discussing the evolution and expansion of the *Rogers* rule).

117. *Rogers*, 875 F.2d at 998.

118. *Id.* at 999.

119. *Id.* at 999–1000.

120. *Id.*

121. *Id.* at 1000.

122. *Id.*

123. *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 936–37 (6th Cir. 2003).

124. *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1096, 1101 (9th Cir. 2008).

trigger First Amendment protection is quite low, the Ninth Circuit explained that it “merely must be above zero.”¹²⁵ More interestingly, the court acknowledged that the game was not directly criticizing or commenting on the trademark owner but considered that fact “hardly dispositive” considering the low threshold of artistic relevance required for First Amendment protection.¹²⁶

Taken together, the concept of artistic relevance and its subsequent evolution offer a convenient framework for authorizing expressive trademark use under the federal dilution statute. Although it has not been applied to infringement or dilution claims where the appropriation functions as a source identifier, the underlying policy considerations from *Rogers* are applicable to expressive trademark use. An artist’s name is as much an “integral element” of the work’s expressive content as the title.¹²⁷ Indeed, the name of the artist is as closely associated with an individual work as the title of the work. In that way, expressive trademark use adds to the work’s expressive value.

Moreover, the observation made by the court in *Rogers* that the public is highly unlikely to be confused in the context of titles remains true regarding expressive trademark use.¹²⁸ Consumers are bombarded by trademarks daily, and they understand how marks function in the context of expressive works. It should be immediately apparent to anyone encountering works by Kodak Black, Gucci Mane, or Macintosh Plus that there is no affiliation or sponsorship between them and the owners of the trademarks that they appropriate.

Admittedly, authorizing expressive trademark use would potentially dilute the appropriated marks, but the interest in avoiding dilution alone cannot outweigh the public’s interest in expressive freedom. Despite its assertion that the public is unlikely to be confused, the court in *Rogers* explained that the existence of consumer confusion was insufficient to justify application of the Lanham Act in the context of expressive works unless the appropriation does something explicitly misleading.¹²⁹ If the interest in avoiding dilution is not as weighty as the interest in avoiding confusion, it would not make sense to preclude liability for infringement where confusion exists but allow liability for dilution.

Finally, there is no reason to limit application of artistic relevance to claims for infringement. In fact, several district courts have relied on the concept to dispose of both infringement and dilution claims.¹³⁰ For example,

125. *Id.* at 1100.

126. *Id.*

127. *Rogers*, 875 F.2d at 998.

128. *Id.* at 999.

129. *Id.* at 998–1000.

130. *See* *Stewart Surfboards, Inc. v. Disney Book Grp.*, CV 10-2982 GAF (SSx), 2011 WL 12877019, at *8 (C.D. Cal. May 11, 2011) (citing the noncommercial use exclusion and explaining that “[t]he Ninth Circuit has not applied the *Rogers* test to trademark dilution claims under 15 U.S.C.

in *Roxbury Entertainment v. Penthouse Media Group*,¹³¹ the court analyzed the plaintiff's infringement claim using the *Rogers* Rule, and then disposed the plaintiff's dilution claim in a footnote, reasoning that the noncommercial use exclusion applied.¹³² Although these cases involved expressive use, the reasoning applies to appropriations for expressive trademark use if those appropriations constitute expressive speech.

Accordingly, to apply artistic relevance to expressive trademark use, a court would examine the expressive activity identified by the appropriated mark. The inquiry might include reviewing the content of the individual works and any performance or distribution of those works. Mirroring the *Rogers* rule and its evolution, whether the activity is directed at the trademark owner or whether alternative avenues of expression exist would be irrelevant. As long as there is some artistic relevance, the appropriation would be permissible. Applied in this way, the framework would provide robust protection in favor of the public interest in free expression without causing any material harm to the trademark owner's interests.

Conclusion

The social significance of modern trademarks has evolved. Historically commercial tools, marks today are imbued with a wealth of different meanings, and their appropriation for expressive trademark use will become more commonplace. Although these appropriations conflict with trademark owners' exclusive rights, the public has a competing interest in expressive freedom. Trademark law will continue to be tasked with discerning the appropriate balance between the two, and in the context of expressive trademark use, the arguments in this Note resolve that conflict in favor of the public's interest in expressive freedom based on trademarks' increasingly expressive significance. Trademarks have indeed evolved into effective vehicles for participation in the cultural sphere, which shapes political discourse and, ultimately, society as a whole. Favoring expressive freedom in this context largely aligns not only with the Lanham Act's statutory provisions but also with the body of judicial precedent that has recently developed to address the issue. Nevertheless, as the majority in *Tam* acknowledged, courts have been slow to evolve. Moving forward, sensitivity

§ 1125(c), but artistic trademark uses are protected from trademark dilution liability for similar reasons"); *Kiedis v. Showtime Networks, Inc.*, No. CV 07-8185 DSF (MANx), 2008 WL 11173143, at *5 (C.D. Cal. Feb. 19, 2008) ("The Court has no doubt that the title 'Californication,' as used by Defendants, has sufficient artistic qualities to take it out of the realm of purely commercial speech.").

131. 669 F. Supp. 2d 1170 (C.D. Cal. 2009).

132. *Id.* at 1175 n.8 ("Although the analysis detailed here focuses on the First Amendment defense to Plaintiff's *infringement* claims, the result is the same with respect to Plaintiff's dilution claims, because Defendants' use of 'Route 66' in the movie title falls within the noncommercial use exemption for federal trademark dilution claims.").

to trademark law's complexities is warranted, but so is sensitivity to the expressive value embodied by modern marks, much of which may be subtle or initially difficult to discern. Expressive trademark use provides a valuable opportunity for individual participation. Whether or not it should be considered expressive speech and excluded from dilution liability is a difficult question that deserves careful consideration.

—*Giulio Ernesto Yaquinto*