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What's Wrong with this Picture? When the Lanham Act Clashes with Artistic Expression

Tara J. Goldsmith*

A century or so ago, Paul Cezanne reached into a fruit basket and said, 'With this apple, I will astonish Paris.' So he did. He painted a picture of that apple so magnificent that it takes the breath away. If he tried that today, he'd probably have the apple growers suing him for royalties. Sillier things have happened.¹

INTRODUCTION

Photographer Chuck Gentile took another bite at the proverbial apple when he attempted to astonish Cleveland, a city, unlike Paris, not particularly renowned for its artistic achievement. Gentile photographed a downtown museum against a Lake Erie sunset, made it into a poster, entitled it "THE ROCK AND ROLL HALL OF FAME AND MUSEUM IN CLEVELAND," and offered it for sale throughout the metropolitan Cleveland area.² The Rock & Roll Hall of Fame

* J.D. Candidate, 1998, Fordham University School of Law. I would like to thank Professor William Treanor for his encouragement and support, and my family for their love. A previous version of this Comment received second place in the 1997 Judge Conner Writing Competition, awarded annually by the New York Intellectual Property Association for the paper judged best on the subject of intellectual property law.

1. Dan Lynch, *Artist a Loser at the Track*, TIMES UNION (Alb.), July 28, 1996, at B1.

2. *Rock & Roll Hall of Fame and Museum, Inc. v. Gentile Prods.*, 934 F. Supp. 868 (N.D. Ohio 1996).

and Museum (“Museum”), however, was less than thrilled; it sought to enjoin all publication and distribution of Gentile’s poster on the grounds that it violated the Museum’s trademark rights in both the building and the name, “ROCK AND ROLL HALL OF FAME.”³ To Gentile, the idea that the Museum would sue him over an artistic photograph seemed like the work of the “over-thirty crowd,” so mistrusted during the 1960s.⁴ Gentile asserted that he did not need the Museum’s permission to sell the posters because the building is in a public place.⁵

Unfortunately for Gentile, the United States District Court for the Northern District of Ohio disagreed.⁶ In *Rock and Roll Hall of Fame and Museum, Inc. v. Gentile Productions*,⁷ the court enjoined Gentile from selling and distributing his poster,⁸ finding a “likelihood of confusion”⁹ between Gen-

3. Michael Norman, *Rock Hall Sues Over Unlicensed Pictures*, PLAIN DEALER, May 1, 1996, at 3B.

4. Robyn Meredith, *Rock Hall of Fame Asserts Ownership of Image*, N.Y. TIMES, June 16, 1996, at 12A (referring to the “over-30 crowd” and its pro-war, anti-drug advocacy).

5. Michael Norman, *Rights to Image of Rock Hall at Stake*, PLAIN DEALER, Apr. 21, 1996, at 9K.

6. *Rock & Roll*, 934 F. Supp. at 873.

7. 934 F. Supp. 868 (N.D. Ohio 1996).

8. *Id.* at 873.

9. *Id.* It is well settled that the crucial issue in an action for trademark infringement or unfair competition is whether there is a likelihood that an appreciable number of ordinary prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question. See 15 U.S.C.A. §§ 1114(1)(a) (providing remedies for use in commerce of “any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive”), 1125(a) (defining “likelihood of confusion”) (West Supp. 1996); 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:1 (4th ed. 1996); MICHAEL A. EPSTEIN, MODERN INTELLECTUAL PROPERTY § 7.03[B][2] (3d ed. 1995); *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F.2d 44, 47 (2d Cir. 1978), cert. denied, 439 U.S. 1116 (1979); *Maternally Yours, Inc. v. Your Maternity Shop, Inc.*, 234 F.2d 538, 542 (2d Cir. 1956). For an in-depth treatment of the principles of likelihood of confusion in trademark law, see generally RICHARD L. KIRKPATRICK, LIKELIHOOD OF CONFUSION IN TRADEMARK LAW (1995); MCCARTHY, *supra*, § 23.

tile's poster and the Museum's trademark that, the court decided, would cause irreparable damage to the Museum's licensing program and revenues.¹⁰ After reading the decision, Gentile remarked, "I think Jerry Garcia would be rolling over in his grave."¹¹

The *Rock and Roll* controversy centered around the level of First Amendment protection that should be afforded by the fair use exception to artistic interpretation of a trademark. A trademark is any word, symbol, or device employed by a manufacturer or a merchant to identify his goods and to distinguish them from those of another.¹² Trademarks serve to help consumers identify the products they wish to purchase.¹³ Accordingly, trademark law historically has focused on protecting consumers from confusion due to false or misleading marks.¹⁴ The law thus pro-

10. *Rock & Roll*, 934 F. Supp. at 873.

11. Robyn Meredith, *Rock Hall of Fame Asserts Ownership of Image*, N.Y. TIMES, June 16, 1996, at 12A (referring to the late lead guitarist for the Grateful Dead).

12. 15 U.S.C.A. § 1127 (West Supp. 1996); see also *Towers v. Advent Software, Inc.*, 913 F.2d 942, 945 (D.C. Cir. 1990); *Hughes v. Design Look Inc.*, 693 F. Supp. 1500, 1505 (S.D.N.Y. 1988); Diane M. Reed, *Use of "Like/Love" Slogans in Advertising: Is the Trademark Owner Protected?*, 26 SAN DIEGO L. REV. 101 (1989) (citing Willis, *The Life and Death of a Trademark*, in CURRENT DEVELOPMENTS IN TRADEMARK LAW AND UNFAIR COMPETITION 7 (1988)).

13. *Societe Des Produits Nestle, S.A. v. Casa Helvetia, Inc.*, 982 F.2d 633, 636 (1st Cir. 1992). See Filippo M. Cinotti, *fair use of Comparative Advertising Under the 1995 Federal Dilution Act*, 37 IDEA 133, 133 (1996); Howard Gensler, *Property Law as an Optimal Economic Foundation*, 35 WASHBURN L.J. 50, 76 (1995); Patricia K. Fletcher, *Joint Registration of Trademarks and the Economic Value of a Trademark System*, 36 U. MIAMI L. REV. 297, 298 (1982); cf. Gregory W. Hotelling, *Ideal Standard v. IHT: In the European Union, Must a Company Surrender Its National Trademark Rights When It Assigns Its Trademark?*, 19 FORDHAM INT'L L.J. 1178, 1248 (1996) (explaining that patents and copyrights protect unique characteristics, but do not supply a communicative element and thus consumers do not rely on a patent or copyright to identify a product's quality in the same way they rely on a trademark).

14. See S. REP. NO. 1333, 79th Cong. 2d Sess. (1946), reprinted in 1946 U.S.C.A.N. 1274, 1274 (providing that the goal of federal trademark law, as set forth in the Lanham Act, Trademark Act of 1946 ("Lanham Act"), ch. 540, 60 Stat. 427 (codified as amended at 15 U.S.C.A. §§ 1051-1127 (West Supp. 1996)), is "to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it

hibits a free rider from using another's trademark to deceive consumers about the source and quality of the advertised product.¹⁵

Many courts and commentators have noted that trademark law inherently conflicts with principles of the First Amendment.¹⁶ Often, artistic expression requires the use of symbols and images otherwise protected by trademark law.¹⁷ This conflict of interests pits the rights of the artist in creating works against those of the trademark owner in having exclusive control over its valuable marks. In certain circumstances, courts have sided with the First Amendment, citing the overriding importance of free speech and free expression of ideas.¹⁸ From this jurisprudence has evolved a

asks for and wants to get").

15. See *Kenner Parker Toys Inc. v. Rose Art Indus.*, 963 F.2d 350, 353 (D.C. Cir.), *cert. denied*, 506 U.S. 862 (1992); *Planters Nut & Chocolate Co. v. Crown Nut Co.*, 305 F.2d 916, 920 (C.C.P.A. 1962); see also Reed, *supra* note 12, at 101.

16. See, e.g., George Vetter & Christopher C. Roche, *The First Amendment and the Artist—Part I*, R.I. B.J., Mar. 1996, at 7 ("An artist's freedom to use [icons from popular culture] against such legal protections ties into First Amendment concerns."); Robert J. Shaughnessy, *Trademark Parody: A Fair Use and First Amendment Analysis*, 72 VA. L. REV. 1079, 1094-96; Geri J. Yonover, *The Precarious Balance: Moral Rights, Parody, and Fair Use*, 14 CARDOZO ARTS & ENT. L.J. 79, 122 (1996); see also Russell A. Stamets, *Ain't Nothin' Like the Real Thing, Baby: The Right of Publicity and the Singing Voice*, 46 FED. COMM. L.J. 347 (1994) (criticizing the similar common law right of publicity as giving individuals too much protection for their voices).

17. See *infra* notes 315-27 and accompanying text (discussing the impact of images in artistic expression).

18. See, e.g., *White v. Samsung Electronics America*, 989 F.2d 1512 (9th Cir.), *cert. denied*, 508 U.S. 951 (1993). In *White*, Judge Kozinski of the Ninth Circuit Court of Appeals highlighted scenarios in which he felt the First Amendment should prevail:

Saddam Hussein wants to keep advertisers from using his picture in unflattering contexts. Clint Eastwood doesn't want tabloids to write about him. Rudolf Valentino's heirs want to control his film biography. The Girl Scouts don't want their image soiled by association with certain activities. George Lucas wants to keep Strategic Defense Initiative fans from calling it "Star Wars." Pepisco doesn't want singers to use the word "Pepsi" in their songs. Guy Lombardo wants an exclusive property right to ads that show big bands playing on New Year's Eve. Uri Geller thinks he should be paid for ads showing psychics bending metal through telekinesis. Paul Prudhomme, that household name, thinks the same about ads featuring corpulent bearded chefs. And scads of copy-

fair use exception to trademark law for some artistic interpretation of a mark.¹⁹ This doctrine recognizes that where the use of the trademark is not as a source identifier, it is a fair one to which the trademark laws simply do not apply.²⁰

In holding that the Museum's design is a protectable trademark and that Gentile's poster infringed upon the Museum's rights in that trademark, the court has put significant First Amendment rights at stake. Indeed, the *Rock and Roll* decision stands as persuasive authority against unauthorized photographs or other artistic interpretation of any famous building in the United States. This decision will inevitably rob the public of its enjoyment of a wide diversity of images and limit free expression of artistic works.²¹

This Comment argues that the *Rock and Roll* decision overly extends the protection offered to trademark owners and confers an unwarranted monopoly that will negatively impact society. Part I briefly introduces trademark and First Amendment law. Part II discusses the facts of *Rock and Roll* and the district court's decision to grant the preliminary injunction. Part III argues that the district court incorrectly decided *Rock and Roll* and proposes that works of art that contain trademarks or brand-names deserve protection as artistic expression and free speech under the First Amendment. Accordingly, this Comment concludes that the *Rock and Roll* decision should be reversed because it seriously impairs an artist's ability to freely express his ideas.

right holders see purple when their creations are made fun of. Something overly dangerous is going on here.

Id. at 1512-13 (Kozinski, J., dissenting) (footnotes omitted).

19. Lanham Act § 33(b), 15 U.S.C.A. § 1115(b)(4); 1 JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE § 4.03[3][c][iv] (1997).

20. 15 U.S.C.A. § 1115(b)(4).

21. See Vetter & Roche, *supra* note 16, at 7 ("When artists create radical, provocative or challenging work, offended people will often use established laws and regulations to stifle its creation or suppress its expression.").

I. TRADEMARK AND FIRST AMENDMENT LAW

Federal trademark law traces its origins to 1870, when Congress passed the Act of July 8, 1870.²² While the Supreme Court eventually struck down that statute,²³ subsequent legislation met with more success.²⁴ This part discusses the principles of trademark law and the First Amendment. First, this part discusses trademark law and policy. Second, this part explains defenses to trademark infringement, including fair use and the First Amendment. Finally, this part examines the overlapping law of the right to publicity.

A. Trademark Law and Policy

Intellectual property is the legal regime by which authors and inventors protect intellectual creations.²⁵ The principal objective of intellectual property law is to grant a limited monopoly to the originator of information.²⁶ Such monopolies take the form of patents, copyrights, and trademarks.²⁷

22. Act of July 8, 1870, ch. 230, 16 Stat. 198.

23. See *Trade-Mark Cases*, 100 U.S. 82, 86 (1879) (finding the Act of July 8 unconstitutional because Congress based its authority to regulate trademarks on the Patent and Copyright Clause, but noting that Congress could have constitutionally based its authority on the Commerce Clause).

24. Ethan Horwitz & Benjamin Levi, *Fifty Years of the Lanham Act: A Retrospective of Section 43(a)*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 59, 63 (1996).

25. *Intellectual Property—Patent and Trade Dress Law—Tenth Circuit Applies “Significant Inventive Aspect” Test to Determine Whether Utility Patent Precludes Trade Dress Protection*, 109 HARV. L. REV. 1457, 1457 (1996); David Friedman, *Standards as Intellectual Property: An Economic Approach*, 19 DAYTON L. REV. 1109, 1109 (1994); Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 291 (1988). For a comprehensive introduction to the field of intellectual property law, see FRANK H. FOSTER & ROBERT L. SHOOK, PATENTS, COPYRIGHTS, AND TRADEMARKS (2d ed. 1993).

26. See *Lasercomb Am., Inc. v. Reynolds*, 911 F.2d 970, 974-76 (4th Cir. 1990) (discussing the role of monopolies in both patent and copyright law).

27. Patent law deals with the concept of functional and design inventions, and grants monopolies in order to encourage investment in new technology and invention. See 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 6:7 (4th ed. 1996). Copyright, unlike a patent, “gives no exclusive rights to the art disclosed; protection is given only to the expression of the idea—

While these legal instruments share the common thread of safe-guarding innovation, they differ in many important respects; for example, whereas the proprietor of a patented invention or a valid copyright may make a negative and merely prohibitive use of its monopoly, the owner of a trademark may not.²⁸ This qualified protection of trademarks is designed to encourage creativity and fairness to the consuming public and to ensure commercial morality.²⁹ However, there is a growing concern that trademark law is being pushed beyond the boundaries of its intended purpose, as well as those of common sense.³⁰

Since at least the middle ages, trademarks have served primarily to identify the source of goods and services and “to facilitate the tracing of ‘false’ or defective wares and the punishment of the offending craftsman.”³¹ Trademarks cur-

not to the idea itself.” *Mazer v. Stein*, 347 U.S. 201 (1954). In contrast to copyright and patent law, trademark law is not concerned with the content of words or the development of new technology, but rather with the protection of identifying symbols. See *infra* notes 31-34; see also *American Footwear Corp. v. General Footwear Co.*, 609 F.2d 655 (2d Cir. 1979), *cert. denied*, 445 U.S. 951 (1980) (“Trademark rights, unlike statutory copyright or patents, are not rights in gross or at large.”).

28. *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97-98 (1918); see *United States v. Bell Tel. Co.*, 167 U.S. 224, 250 (1897) (explaining that because the inventor is one who has discovered something of value it is his absolute property and he may withhold the knowledge of it from the public); *Bement v. National Harrow Co.*, 186 U.S. 70, 90 (1902) (“The full benefit of the discovery, after its enjoyment by the discoverer for 14 years, is preserved; and for his exclusive enjoyment of it during that time that public faith is pledged.”); see also Neal R. Platt, *Is a Trademark Owner’s Right to Use its Mark Protected by the First Amendment?*, 11 *HOFSTRA L. REV.* 1261, 1294 (1983).

29. *United Drug Co.*, 248 U.S. at 98 (“[A trademark] is merely a convenient means for facilitating the protection of one’s good-will in trade by placing a distinguishing mark or symbol—a commercial signature—upon the merchandise or the package in which it is sold.”).

30. Don Luce, *Counterpoint . . . Chuck Gentile and the Rock and Roll Hall of Fame*, *ASMP BULL.*, Oct. 1996, at 9; see *Huber Baking Co. v. Stroehmann Bros.*, 252 F.2d 945, 955 (2d Cir.), *cert. denied*, 358 U.S. 829 (1958) (“Under modern conditions, with vastly increased means of communication and the use of advertising media of a far-reaching character, many recent cases have afforded the holder of a trademark protection.”); see, e.g., *Stork Restaurant v. Sahati*, 166 F.2d 348 (9th Cir. 1948); *Ambassador East v. Shelton Corners*, 120 F. Supp. 551 (S.D.N.Y. 1954).

31. *New Kids on the Block v. News Am. Publishing, Inc.*, 971 F.2d 302, 305

rently serve to differentiate brands from one another, allowing a consumer who wishes to purchase a particular product the ability to identify successfully that brand when she so desires.³² If the consumer is satisfied with the product's quality, she will continue to purchase that particular brand.³³ Thus, trademarks both encourage manufacturers to create quality products and reduce consumers' costs for market searches by informing the public of a good's source.³⁴

1. The Lanham Act

Whereas patents and copyrights exist because of an express constitutional grant,³⁵ trademarks do not enjoy such recognition.³⁶ In fact, the Supreme Court expressly held that the Patent and Copyright Clause of the Constitution does

(9th Cir. 1992) (quoting F. SCHECTER, *THE HISTORICAL FOUNDATIONS OF THE LAW RELATING TO TRADE-MARKS* 47 (1925)); see MCCARTHY, *supra* note 27, § 5:1; Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WISCONSIN L. REV. 158, 160 (1982).

32. See MCCARTHY, *supra* note 27, §§ 2:5, 3:6; *Door Sys., Inc. v. Pro-Line Door Sys., Inc.*, 83 F.3d 169, 170 (7th Cir. 1996); *Prudential Ins. Co. v. Gibraltar Fin. Corp.*, 694 F.2d 1150, 1155 (9th Cir. 1982), 463 U.S. 1208 (1983).

33. MCCARTHY, *supra* note 27, §§ 2:5, 2:18; *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 354 (D.C. Cir.), *cert. denied*, 506 U.S. 862 (1992).

34. *United Drug Co.*, 248 U.S. at 98; *Kenner Parker Toys*, 963 F.2d at 354. According to two noted authorities in law and economics:

In economic terms, trademarks reduce consumer search costs by informing people that trademarked products come from the same source. The benefit of the brand name is analogous to that of designating individuals by last as well as first names, so that, instead of having to say 'the Geoffrey who teaches constitutional law at the University of Chicago Law School—not the one who teaches corporations,' you can say 'Geoffrey Stone, not Geoffrey Miller.'

William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 269 (1987).

35. U.S. CONST. art. 1, § 8, cl. 8 ("[C]ongress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.").

36. Kenneth L. Port, *Foreword: Symposium on Intellectual Property Law Theory*, 68 CHI.-KENT L. REV. 585, 594 (1993); see *supra* note 23 and accompanying text (explaining that the Supreme Court, in the *Trade-Mark Cases*, struck down Congress' first foray into federal trademark law, due to the lack of an express Constitutional power).

not envision the protection of trademarks.³⁷ Instead, trademark protection is a common law concept which Congress codified in the Lanham Act.³⁸

The Lanham Act defines a trademark as “any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.”³⁹ The Lanham Act is premised on the recognition that when a party has expended resources to develop an identification for its product, it is not equitable to allow another, who has made no such expenditure, to use the unique symbol and to trade on that party’s goodwill and reputation to promote his or her own goods or services.⁴⁰

Accordingly, a trademark owner has the right to exclude others from using any mark when there is a likelihood of confusion as to the origin or sponsorship of goods or services.⁴¹ Confusingly similar marks may cause consumers to

37. Trade-Mark Cases, 100 U.S. 82, 94 (1879). The Supreme Court justified this exclusion on the basis that trademarks do not “depend upon novelty, invention, discovery, or any work of the brain . . . require[] no fancy or imagination, no genius, no laborious thought, . . . [but] simply founded on priority of appropriation.” *Id.*; Horowitz & Levi, *supra* note 24, at 60.

38. Port, *supra* note 36, at 594.

39. Trademark Act of 1946 (“Lanham Act”), ch. 540, 60 Stat. 427 (codified as amended at 15 U.S.C.A. §§ 1051-1127 (West Supp. 1996)); *see also* Towers v. Advent Software, Inc., 913 F.2d 942, 945 (D.C. Cir. 1990); Hughes v. Design Look Inc., 693 F. Supp. 1500, 1505 (S.D.N.Y. 1988). Exclusive rights to a particular symbol or word adopted as a trademark belong to the entity that first uses the mark to identify and distinguish its product from the products of others. MCCARTHY, *supra* note 27, § 16.1-2.

40. *See, e.g.*, Frisch’s Restaurant v. Shoney’s Inc., 759 F.2d 1261, 1264 (6th Cir. 1985); Federal-Mogul Bower Bearings, Inc. v. Azoff, 313 F.2d 405, 409 (6th Cir. 1963); Eastern Wine Corp. v. Winslow-Warren, Ltd., 137 F.2d 955, 958 (2d Cir.), *cert. denied*, 320 U.S. 758 (1943); Hanover Star Milling Co. v. Metcalf, 240 U.S. 403, 412-413 (1916); *see also* Ideal Toy Corp. v. Plawner Toy Mfg. Corp., 685 F.2d 78,84 (3d Cir. 1982); Dresser Indus. v. Heraeus Engelhard Vacuum, Inc., 395 F.2d 457, 461 (3d Cir.), *cert. denied*, 393 U.S. 934 (1968).

41. 15 U.S.C.A. § 1114. Specifically, the Act states:

- (1) Any person who shall, without consent of the registrant—
 - (a) use in commerce any reproduction, counterfeit, copy or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or ser-

unwittingly purchase goods or services of a different or inferior quality or reliability, thus depriving them of free choice, even when the goods or services are in fact of equal or superior quality.⁴² Thus, the important test is whether the defendant's practice is likely to cause confusion.⁴³

2. Trademark Protection of Buildings

Trademark owners have invoked the Lanham Act to obtain trademark protection for a variety of formats, including word marks,⁴⁴ designs,⁴⁵ colors,⁴⁶ clothing,⁴⁷ sounds,⁴⁸ and

vices on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive shall be liable in a civil action by the registrant for the remedies hereinafter provided.

Id.; see also *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924).

42. See *Truck Equip. Serv. v. Fruehauf Corp.*, 536 F.2d 1210, 1216 (8th Cir.), *cert. denied*, 429 U.S. 861 (1976) (finding a Lanham Act violation even though plaintiff's and defendant's goods were "of equal quality"); see also MCCARTHY, *supra* note 27, § 2:4 (explaining that trademark law embodies consumers' expectations of consistent quality "whether that quality is high, low or mediocre"); John C. Yates & Michael W. Mattox, *Intellectual Property*, 42 MERCER L. REV. 295, 312 (1990).

43. See *Kohler Co. v. Moen Inc.*, 12 F.3d 632, 643 (7th Cir. 1993) (noting that others can produce designs similar to the trademark so long as there is no likelihood of consumer confusion); *WCBV-TV v. Boston Athletic Ass'n*, 926 F.2d 42, 45 (1st Cir. 1991) ("The trademark statute does not give the appellants any 'property right' in their mark *except* 'the right to prevent confusion.'" (quoting *Quabaug Rubber Co. v. Fabiano Shoe Co.*, 567 F.2d 154, 160 (1st Cir. 1977))); *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 918 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981); *Boston Athletic Ass'n v. Sullivan*, 867 F.2d 22, 35 (1st Cir. 1989) ("When the mark is used in such a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth."); *Continental Motors Corp. v. Continental Aviation Corp.*, 375 F.2d 857, 861 (5th Cir. 1967) ("Confusion, or the likelihood of confusion . . . is the real test of trademark infringement."); see also MCCARTHY, *supra* note 9, § 23:1.

44. See, e.g., *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976); *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786 (5th Cir. 1983).

buildings.⁴⁹ A building's design functions as a mark when used to identify and distinguish the goods or services of the owner.⁵⁰ For example, in *White Tower System, Inc. v. White Castle System of Eating Houses Corp.*,⁵¹ the Court of Appeals for the Sixth Circuit found that a uniquely designed building could serve as a distinctive mark.⁵² The appellant, White Tower, used White Castle's unique, castle-shaped hamburger stand as a model for its own design.⁵³ When White Castle expanded its business to a locale near that of White Tower's, White Tower demanded an injunction.⁵⁴ The court found that the deliberate copying of the peculiar characteristics of White Castle's business precluded White Tower from obtaining an injunction under the doctrine of unfair competition.⁵⁵ In fact, "the federal decisions generally hold that a junior user . . . will not only be refused relief, but will itself

45. See, e.g., *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279 (2d Cir. 1929), cert. denied, 281 U.S. 728 (1930); *Bonito Boats v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989).

46. See, e.g., *Qualitex Co. v. Jacobson Prods.*, 514 U.S. 159 (1995); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (D.C. Cir. 1985).

47. See, e.g., *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979); *National Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651 (W.D. Wash. 1982).

48. See, e.g., *In re General Elec. Broadcasting Co.*, 199 U.S.P.Q. (BNA) 560 (T.T.A.B. 1978).

49. See, e.g., *Associated Hosts of California, Inc. v. Moss*, 207 U.S.P.Q. (BNA) 973 (W.D.N.C. 1979); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992). About 100 buildings are registered trademarks in the United States, including the Citicorp Center in Manhattan and San Francisco's Transamerica tower. Bradford McKee, *Architectural Trademarks*, ARCHITECTURE, Feb. 1, 1997, at 148. Most trademarked architecture, however, belongs to franchises, such as McDonald's mansard roof; Pizza Hut's colonnade, and Wendy's yellow cornice. *Id.*

50. MCCARTHY, *supra* note 27, § 7:100-02; see, e.g., *House of Hunan, Inc. v. Hunan at Pavilion*, 227 U.S.P.Q. (BNA) 803 (D.D.C. 1985).

51. 90 F.2d 67 (6th Cir.), cert. denied, 302 U.S. 720 (1937).

52. *Id.* at 69; see, e.g., *Fotomat Corp. v. Ace Corp.*, 208 U.S.P.Q. (BNA) 92 (S.D. Cal. 1980) (finding that little film huts in parking lots rise to the level of an arbitrary and fanciful design).

53. *White Tower*, 90 F.2d at 68.

54. *Id.*

55. *Id.* at 68-69. Unfair competition is "a convenient name for the doctrine that no one should be allowed to sell his goods as those of another." *Id.* (citing *Vogue Co. v. Thompson-Hudson Co.*, 300 F. 509, 512 (6th Cir. 1924)).

be enjoined.”⁵⁶

Trademark protection for buildings, however, is not absolute. Specifically, courts have limited trademark protection to instances where the buildings themselves are part of a scheme and a competitor trades on the building design in an attempt to pawn off his products as those of another.⁵⁷ Trademark protection is thus limited to precluding another party from designing a building of the same shape.⁵⁸

3. Standard for Issuing a Preliminary Injunction

A plaintiff initiating a trademark infringement suit will first file for a preliminary injunction. In order to obtain a preliminary injunction, the plaintiff must show: (1) a reasonable probability of success on the merits; (2) that it will suffer irreparable injury if relief is withheld; (3) that there will not be substantial harm to others if the injunction is granted; and (4) that the public interest would be served by issuing a preliminary injunction.⁵⁹ While the application of these standards varies among the circuits, the two most important factors are irreparable harm and the likelihood of success on the merits.⁶⁰ In trademark cases, these factors are generally satisfied by showing a likelihood of confusion.⁶¹

In determining whether a likelihood of confusion exists,

56. *Id.* at 70 (citing *Western Oil Refining Co. v. Jones*, 27 F.2d 205 (6th Cir. 1928)).

57. *See, e.g., Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 763 (1992).

58. MCCARTHY, *supra* note 27, § 7:1000.

59. *Frisch's Restaurant*, 759 F.2d at 1263.

60. DONALD S. CHISUM, UNDERSTANDING INTELLECTUAL PROPERTY LAW § 5F[3][a] (1995); *see, e.g., Keds Corp. v. Renee Int'l Trading Corp.*, 888 F.2d 215, 220 (1st Cir. 1989) (explaining that, in a trademark case, “the key issue is the likelihood of success on the merits because the other decisions will flow from that ruling.”); *Dallas Cowboys Cheerleaders v. Pussycat Cinema*, 604 F.2d 200 (2d Cir. 1979); *A.J. Canfield Co. v. Vess Beverages*, 796 F.2d 903 (7th Cir. 1986); *California Cedar Prods. v. Pine Mountain Corp.*, 724 F.2d 827 (9th Cir. 1984).

61. *Id.*; 15 U.S.C.A. § 1114; *see Hasbro, Inc. v. Lanard Toys, Ltd.*, 858 F.2d 70, 73 (2d Cir. 1988); *Home Box Office v. Showtime/The Movie Channel*, 832 F.2d 1311, 1314 (2d Cir. 1987).

courts generally consider the factors enunciated in *Polaroid Corp. v. Polarad Electronics Corp.*⁶² These factors are: (1) the strength of the plaintiff's mark; (2) the relatedness of the plaintiff's and defendant's services; (3) the similarity of the marks; (4) the usages; (5) the marketing channels used; (6) the evidence of actual confusion; (7) the defendant's good faith; (8) the likelihood of expansion of the product line using the mark; and (9) the sophistication of relevant buyers.⁶³ These nine factors "imply no mathematical precision, but are simply a guide to help determine whether confusion is likely."⁶⁴ Not all the factors are present or equally weighed in each case.⁶⁵ In fact, the fact-finder is given latitude in considering and weighing the traditional factors.⁶⁶

62. 287 F.2d 492 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961).

63. *Id.* at 495. The Second Circuit's *Polaroid* decision influenced other circuits to adopt similar multiple factor tests for proving a likelihood of confusion. While the factors are generally the same, circuits vary as to the wording and number of factors. *See, e.g.*, *Keds Corp. v. Renee Int'l Trading Corp.*, 888 F.2d 215, 222 (1st Cir. 1989); *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1229 (3d Cir. 1978); *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984); *Sno-Wizard Mfg. v. Eisemann Prods.*, 791 F.2d 423, 428 (5th Cir. 1986); *Champions Golf Club, Inc. v. Champions Golf Club*, 78 F.3d 1111, 1116 (6th Cir. 1996).

64. *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1107 (6th Cir. 1991); *see* Jacqueline Pasquarella, *Trademark Law—Confusion Over the Likelihood of Confusion?*, 38 VILL. L. REV. 1317, 1324 (1993) (discussing the conflict over the standard of review for determining likelihood of confusion); Patricia J. Kaeding, *Clearly Erroneous Review of Mixed Questions of Law and Fact: The Likelihood of Confusion Determination in Trademark Law*, 59 U. CHI. L. REV. 1291, 1292 (1992) (arguing that likelihood of confusion is a mixed question of law and fact that should be treated as a factual issue for review purposes).

65. *Fisons Horticulture, Inc. v. Vigoro Indus.*, 30 F.3d 466, 476 n.11 (3d Cir. 1994); *see Pizzeria Uno Corp.*, 747 F.2d at 1527; *Falcon Rice Mill, Inc. v. Community Rice Mill, Inc.*, 725 F.2d 336, 345 n.9 (5th Cir. 1984); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1538 (11th Cir. 1986), *cert. denied*, 481 U.S. 1041 (1987).

66. *Brandtjen & Kluge, Inc. v. Prudhomme*, 765 F. Supp. 1551, 1565 (N.D. Tex. 1991). One court deployed the factors as follows:

[T]he Court is of the view that certain of the *Polaroid* factors are probative of likelihood of confusion, others assist analysis of the balance of the equities, and still others serve to aid both inquiries. The Court also believes that it is important, in making use of the various *Polaroid* factors, to consider not merely *whether* any particular factor is implicated in the case at hand, but the *degree* to which that factor is implicated. . . .

4. Trademark Dilution

Dilution is a special kind of damage to a trademark that is different from trademark infringement.⁶⁷ Dilution occurs when the distinctive quality of a mark is lessened by its use on a dissimilar product.⁶⁸ For example, if the ROLLS ROYCE trademark were used with impunity by different companies on paper towels, wines, cat food and other products, the distinctiveness of the mark could become lessened and ultimately its scope of protection reduced.⁶⁹ Unlike trademark infringement, trademark dilution can occur even in the absence of consumer confusion, when a mark is used

[T]he fact that one or more of the *Polaroid* factors is not implicated by a given case does not determine the infringement issue, particularly if other of the *Polaroid* factors are strongly implicated by the situation presented. At the same time, no single factor is a sufficient condition to finding infringement. Rather, all the factors must be considered together according to the degree to which each is implicated by the case at hand.

Lambda Elecs. Corp. v. Lambda Technology, Inc., 515 F. Supp. 915, 924-25 (S.D.N.Y. 1981).

67. See *Mortellito v. Nina of California, Inc.*, 335 F. Supp. 1288, 1296 (S.D.N.Y. 1972) (“Confusion leads to immediate injury, while dilution is an infection which if allowed to spread, will inevitably destroy the advertising value of the mark.”); *Allied Maintenance Corp. v. Allied Mechanical Trades, Inc.*, 42 N.Y.2d 538, 543, 198 U.S.P.Q. (BNA) 418, 422 (1977) (distinguishing dilution as “[n]ot public confusion caused by similar products or services sold by competitors, but a cancer-like growth of dissimilar products or services which feeds upon the business reputation of an established distinctive trade-mark or name.”).

68. *Allied Maintenance*, 42 N.Y.2d at 544-46, 198 U.S.P.Q. (BNA) at 422; see Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 825 (1927). The definition of dilution is designed to encompass all forms of dilution recognized by the courts, including dilution by blurring and by tarnishment. *Sally Gee, Inc. v. Myra Hogan, Inc.*, 699 F.2d 621, 625 (2d Cir. 1983). In contrast to dilution, “blurring” typically has involved the “whittling away of an established trademark’s selling power and value through its unauthorized use by others upon dissimilar products.” *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1031 (2d Cir. 1989). Examples of this form of dilution would hypothetically include CANON pianos, MARS shoes, LISTERINE lipstick, and EDDIE BAUER cigars. “Tarnishment” is another similar concept which arises when a famous trademark is linked to goods of poor quality, or is portrayed in an unwholesome or unsavory context likely to evoke unflattering beliefs about the owner or its products. *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1191 (E.D.N.Y. 1972).

69. 1 JEROME GILSON, TRADEMARK PROTECTION & PRACTICE § 5.12[2].

on unrelated goods.⁷⁰ The damage is manifested not with confused customers, but rather “in the harm to the mark itself—to its uniqueness, to its singularity, to its capacity to identify the source of goods sold under it.”⁷¹

Prior to the Federal Trademark Dilution Act of 1995 (“Dilution Act”),⁷² dilution was actionable only under state law.⁷³ Whereas state dilution statutes typically protect “distinctive” marks, the federal statute applies only to “famous” marks—a

70. See, e.g., *Credit Counseling Ctrs. Am. v. Budget & Credit Counseling Servs.*, 1997 U.S. Dist. LEXIS 2828, *14-15 (S.D.N.Y. Mar. 5, 1997) (“The [anti-dilution] statute prevents the unauthorized use of a name or mark which is identical to an established mark and precludes a party from using the established mark to attract new customers, even in the absence of consumer confusion or direct competition.”); see also Eric A. Prager, *The Federal Trademark Dilution Act of 1995: Substantial Likelihood of Confusion*, 7 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 121, 123 (1996). The consumer may subliminally or subconsciously “identify the properties and reputation of one product with those of another, although he can identify the particular manufacturer of each.” RICHARD L. KIRKPATRICK, *LIKELIHOOD OF CONFUSION IN TRADEMARK LAW* § 1.4.D (1995). Even if consumers do not consciously assume that the defendant’s product is somehow affiliated with the plaintiff’s product, there is the likelihood that consumers will be attracted to the defendant’s product on the strength of the goodwill and positive image established by the plaintiff. *Stern’s Miracle-Gro Prods. v. Shark Prods.*, 823 F. Supp. 1077, 1090 (S.D.N.Y. 1993).

71. Prager, *supra* note 70, at 123. When the public sees the same mark on different products, the advertising impact and value of the mark deteriorates, and the business reputation of the trademark owner may, through undesirable mental associations by consumers, become tarnished. MCCARTHY, *supra* note 9, § 24:70.

72. Pub. L. No. 104-98, 109 Stat. 985 (1996) (codified at 15 U.S.C.A. §§ 1125(c), 1127).

73. The Dilution Act adds a new definition to 15 U.S.C.A. § 1127 for “dilution” as the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of: (1) competition between the owner of a famous mark and other parties, or (2) likelihood of confusion, mistake, or deception. It also adds new subsection (c) to section 43 of the Lanham Act, 15 U.S.C.A. § 1125, to create a federal cause of action “to protect famous marks from unauthorized uses that attempt to trade upon the goodwill and established renown of such marks and, thereby, dilute their distinctive quality.” See 15 U.S.C.A. § 1125. For examples of cases that have been litigated under the 1995 Act, see *Dr. Seuss Enter. v. Penguin Books U.S.A.*, 42 U.S.P.Q.2d (BNA) 1184 (9th Cir. 1997); *Intermatic Inc. v. Toeppen*, 947 F. Supp. 1227 (N.D. Ill. 1996); *WAWA Inc. v. Haaf*, 40 U.S.P.Q.2d (BNA) 1629 (E.D. Pa. 1996); *Ringling Bros.-Barnum & Bailey Combined Shows v. B.E. Windows Corp.*, 937 F. Supp. 204 (S.D.N.Y. 1996).

significant departure from state dilution laws.⁷⁴ The federal act leaves the question of whether a mark is “famous” to the court, offering a list of six factors to consider: (1) similarity of the marks; (2) similarity of the products covered by the marks; (3) sophistication of consumers; (4) predatory intent; (5) renown of the senior mark; and (6) renown of the junior mark.⁷⁵

B. *Defenses to Trademark Infringement*

There are two types of defenses to trademark infringement charges. The first defense is that the plaintiff has failed to prove that a likelihood of confusion exists—that use of a mark by another is unlikely to obfuscate the source of certain identified goods.⁷⁶ The second defense includes “affirmative defenses,”⁷⁷ which, when successful, preclude a plaintiff’s recovery even where the plaintiff demonstrates a likelihood of confusion.⁷⁸ This section discusses two affirmative defenses: fair use and free speech.⁷⁹

1. Fair Use

Just as the importance of protecting intellectual property rights has evolved, so too has the role of trademarks.⁸⁰

74. See *Mead Data Cent.*, 875 F.2d at 1030. The Dilution Act’s legislative history reveals that the rationale for granting protection only to “famous” marks is to provide protection only to those marks most likely to be adversely affected by dilution. MCCARTHY, *supra* note 9, § 24.95.

75. 15 U.S.C.A. 1125; *Mead Data Cent.*, 875 F.2d at 1035 (Sweet, J., concurring).

76. SIEGRUN D. KANE, *TRADEMARK LAW: A PRACTITIONER’S GUIDE* 153 (2d ed. 1991).

77. *Id.*

78. *Id.*

79. An “affirmative defense” is defined as a “matter asserted by defendant which, assuming the complaint to be true, constitutes a defense to it.” BLACK’S LAW DICTIONARY 60 (6th ed. 1990). Other affirmative defenses that must be pleaded and proven by the defendant include: laches, acquiescence and estoppel; abandonment; genericness; fraud; unclean hands; trademark misuse; and violation of the antitrust laws. KRANE, *supra* note 76, at 156.

80. See Patricia K. Fletcher, *Joint Registration of Trademarks and the Economic*

While trademarks once merely identified product sources, many marks have become part of the products themselves.⁸¹ When used in this manner, trademarks acquire certain functional characteristics that are different from, and sometimes inconsistent with, their traditional role as source identifiers.⁸² This phenomenon gave birth to the fair use doctrine of trademark law.⁸³

The fair use doctrine balances society's interest in using words or images in their primary descriptive sense with a trademark owner's right to exclusivity.⁸⁴ Under the Lanham Act, fair and good faith use of another's mark to describe a second comer's goods or services, or the geographic origin

Value of a Trademark System, 36 U. MIAMI L. REV. 297, 302 (1982).

81. See Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 960-61 (1993) (listing, as examples of this phenomenon, "McDonald's Treasure Adventure," a video game by Sega and McDonald's and "Cool Spot," a Sega Genesis video game where tiny bottles of 7-UP show up on the screen in order for the main character to regain vigor). According to Judge Kozinski: "Here a portion of a trademark—the big red dot that's part of the 7-UP logo—had been turned into a separate commodity, totally distinct from its original and traditional function. That's an interesting transmutation, though not really an unusual one." *Id.* at 961.

82. *Id.* at 962; see *W.T. Rogers Co. v. Keene*, 778 F.2d 334 (7th Cir. 1985). As the *W.T. Rogers* court explained:

In an age when fashion-conscious consumers wear T-shirts emblazoned with the trademarks of consumer products and owners of Volkswagens buy conversion kits to enable them to put a Rolls Royce grille on their car, it is apparent that trade names, symbols, and design features often serve a dual purpose, one part of which is functional in the sense of making the product more attractive, and is distinct from identifying the manufacturer or his brand to the consumer.

Id. at 340.

83. 15 U.S.C.A. § 1115(b)(4). Specifically, the Lanham Act states:

[T]he use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, 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 such party, or their geographic origin.

Id.

84. *Id.*; *Car-Freshener Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 269 (2d Cir. 1995); MCCARTHY, *supra* note 27, § 11:45-:49 ("No one competitor can use trademark law to exclude others from use of a word in its primary, descriptive and non-trademark sense.").

thereof, is an affirmative defense to trademark infringement.⁸⁵ This fair use defense “allows a competitor to use another’s registered trademark to describe aspects of one’s own goods.”⁸⁶ Such instances are best understood as non-trademark uses of a mark, to which infringement principles simply do not apply.⁸⁷ As such, the fair use defense is available when the trademark’s use does not attempt to capitalize on consumer confusion or to appropriate the first product’s cachet for a different one.⁸⁸

*Volkswagenwerk Aktiengesellschaft v. Church*⁸⁹ demonstrates this principle.⁹⁰ In *Volkswagenwerk*, the Court of Appeals for the Ninth Circuit held that the use of another’s trademark to describe one’s services does not rise to the level of infringement if the use is not in a manner that tends to deceive the public.⁹¹ In *Volkswagenwerk*, a car repair shop used the name “Volkswagen” in a sign advertising its business.⁹² The court recognized that it “would be difficult, if not impossible,” to avoid using the word “Volkswagen” or

85. 15 U.S.C.A. § 1115(b)(4); see also *New Kids on the Block v. News Am. Publishing, Inc.*, 971 F.2d 302, 306 (9th Cir. 1991).

86. *Mattel, Inc. v. Azrak-Hamway Int’l, Inc.*, 724 F.2d 357, 361 (2d Cir. 1983); see *Société Comptoir de L’Industrie Cotonniere Etablissements Boussac v. Alexander’s Dep’t Stores, Inc.*, 299 F.2d 33, 36 (2d Cir. 1962).

87. *New Kids on the Block*, 971 F.2d at 307. Similarly, in copyright law, videotaping television shows for private home use does not implicate the copyright holder’s exclusive right to reproduction. See *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 447-51 (1984).

88. *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407, 412 (9th Cir. 1996).

89. 411 F.2d 350 (9th Cir. 1969).

90. See also *WCVB-TV v. Boston Athletic Ass’n*, 926 F.2d 42 (1st Cir. 1991) (holding that use of the words “Boston Marathon” to describe television coverage of the Boston Marathon is a fair one).

91. *Volkswagenwerk*, 411 F.2d at 352. For other examples of the fair use doctrine used as a defense to a trademark infringement, see *Car-Freshener Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 269 (2d Cir. 1995); *Trippe Mfg. Co. v. American Power Conversion Corp.*, 46 F.3d 624 (7th Cir. 1995); *In re Dual-Deck Video Cassette Recorder Antitrust Litig.*, 11 F.3d 1460 (9th Cir. 1993); *Shakespeare Co. v. Silstar Corp. Am., Inc.*, 9 F.3d 1091 (4th Cir. 1993), cert. denied, 511 U.S. 1127 (1994); and *A.J. Canfield Co. v. Vess Beverages, Inc.*, 796 F.2d 903 (7th Cir. 1986).

92. *Volkswagenwerk*, 411 F.2d at 351.

its abbreviation, "VW," to signify the appellant's cars.⁹³ The court noted that the appellant could not use the mark in a manner likely to suggest to prospective customers that the two uses emanate from the same source.⁹⁴

As the *Volkswagenwerk* court explained, such use lies outside the boundaries of trademark law because it does not implicate the source-identification function of a trademark.⁹⁵ Furthermore, this manifestation does not imply the trademark holder's sponsorship or endorsement.⁹⁶ Consequently, such use does not constitute unfair competition and is thus permissible.⁹⁷

2. The First Amendment

Because intellectual property laws provide both incentives for, and restrictions of, the public expression of ideas, it is not surprising that litigants have challenged particular applications of those laws as contrary to the First Amendment guarantees of free speech and free press.⁹⁸ Accordingly, courts have recognized affirmative defenses of artistic and commercial speech to charges of trademark infringement.

a. Artistic Speech

The First Amendment stands as the primary constitutional protection against government censorship.⁹⁹ Courts

93. *Id.* at 352.

94. *Id.* (citing *Ford Motor Co. v. Helms*, 25 F. Supp. 698 (E.D.N.Y. 1938); *Yale & Towne Mfg. Co. v. Haber*, 7 F. Supp. 791, 792 (E.D.N.Y. 1934)).

95. *Id.*; see *supra* notes 31-34 and accompanying text.

96. *Abdul-Jabbar*, 85 F.3d at 412.

97. *Volkswagenwerk*, 411 F.2d at 352.

98. CHISUM, *supra* note 58, § 1D[4].

99. *Chicago v. Mosley*, 408 U.S. 92 (1972); *New York Times Co. v. Sullivan*, 376 U.S. 254, 270 (1964); *Near v. Minnesota*, 283 U.S. 697, 713 (1931); see John D. Bessler, *Televised Executions and the Constitution: Recognizing a First Amendment Right of Access to State Executions*, 45 FED. COMM. L.J. 355, 401 (1993); Jessica M. Karner, *Political Speech, Sexual Harassment, and a Captive Workforce*, 83 CALIF. L. REV. 637, 652 (1995).

have unequivocally established that “[a]ny prior restraint on expression comes . . . with a ‘heavy presumption’ against its constitutional validity.”¹⁰⁰ Thus, only where expression “is so dangerous to fundamental government interests” will a prior restraint be constitutionally justified.¹⁰¹

The Constitution “looks beyond written or spoken words as mediums of expression.”¹⁰² If the First Amendment reached only expressions carrying a certain message, its protection would never reach the paintings of Jackson Pollock, the music of Arnold Schonberg, or the Jabberwocky verse of Lewis Carroll.¹⁰³ While many have primarily valued the First Amendment’s role in preserving democracy,¹⁰⁴ its fundamental purpose is to protect all forms of peaceful expression in its myriad of manifestations.¹⁰⁵

For example, in *Bery v. City of New York*,¹⁰⁶ the Second Circuit Court of Appeals reaffirmed that visual artists have

100. *Organization for a Better Austin v. Keefe*, 402 U.S. 415, 419 (1971) (quoting *Carroll v. Princess Anne*, 393 U.S. 175, 181 (1968)); *see also Nebraska Press Ass’n v. Stuart*, 427 U.S. 539, 559 (1976) (holding that prior restraints are particularly disfavored).

101. *See Procter & Gamble Co. v. Bankers Trust Co.*, 78 F.3d 219, 275 (6th Cir. 1996); *New York Times Co. v. United States*, 403 U.S. 713, 726 (1971) (Brennan, J., concurring).

102. *Bery v. City of New York*, 97 F.3d 689, 694 (2d Cir. 1996) (quoting *Hurley v. Irish-Am. Gay, Lesbian & Bisexual Group of Boston*, 115 S. Ct. 2338, 2345 (1995)); *see, e.g., West Virginia State Bd. of Educ. v. Barnette*, 319 U.S. 624, 632 (1943); *Southeastern Promotions, Ltd. v. Conrad*, 420 U.S. 546 (1975); *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501-02 (1952); *Winters v. New York*, 333 U.S. 507, 510 (1948); *Contemporary Arts Center v. Ney*, 735 F. Supp. 743, 744 (S.D. Ohio 1990).

103. *Bery*, 97 F.3d at 694 (quoting *Spence v. Washington*, 418 U.S. 405, 411 (1974) (per curiam)).

104. *Id.*; *see, e.g., Whitney v. California*, 274 U.S. 357, 376 (1927) (Brandeis, J., concurring) (“[E]ven advocacy of violation [of the law], however reprehensible morally, is not a justification for denying free speech where the advocacy falls short of incitement and there is nothing to indicate that the advocacy would be immediately acted on.”).

105. *Abood v. Detroit Bd. of Educ.*, 431 U.S. 209, 231 (1977) (finding that expression about philosophical, social, artistic, economic, literary, or ethical matters may be entitled to full First Amendment protection).

106. 97 F.3d 689, 695 (2d Cir. 1996).

full First Amendment protection for the sale of their works in public places.¹⁰⁷ In *Bery*, the appellants, visual artists, moved for a preliminary injunction to enjoin enforcement of a New York City law¹⁰⁸ barring visual artists from exhibiting, selling, or offering their work for sale in public places without first obtaining a general vendors license.¹⁰⁹ The Second Circuit reversed the district court's ruling for the city, and noted that the lower court's view of the First Amendment and of visual art itself was unduly restrictive:¹¹⁰

Such myopic vision not only overlooks case law central to First Amendment jurisprudence but fundamentally misperceives the essence of visual communication and artistic expression. Visual art is as wide ranging in its depiction of ideas, concepts and emotions as any book, treatise, pamphlet or other writing, and is similarly entitled to full First Amendment protection. . . . The ideas and concepts embodied in visual art have the power to transcend . . . language limitations and reach beyond a particular language group to both the educated and the illiterate. . . . One cannot look at Winslow Homer's paintings on the Civil War without seeing, in his depictions of the boredom and hardship of the individual soldier, expressions of anti-war sentiments, the idea that war is not heroic.¹¹¹

Thus, courts have granted visual art the same full First Amendment protection afforded to written language, as both are embodiments of the artist's expression.¹¹²

107. *Id.*

108. N.Y. CITY ADMIN. CODE § 20-452 (McKinney 1996).

109. *Bery*, 97 F.3d at 692.

110. *Id.* at 694.

111. *Id.* at 692.

112. See U.S. CONST. amend. I; see generally AMERICAN CIVIL LIBERTIES UNION, ARTISTIC FREEDOM (1996).

b. Commercial Speech

Visual art, or any form of expression, is afforded a different degree of protection if it is commercial in nature.¹¹³

In *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.*,¹¹⁴ the Supreme Court held that commercial speech may be “more durable” than other types of speech and that, as a result, “there is little likelihood of its being chilled by proper regulation.”¹¹⁵ The Court later explained that two features of commercial speech permit regulation of its content: first, commercial speakers are well-situated to evaluate the accuracy of their messages; and second, commercial speech is not particularly susceptible to being crushed by overbroad regulation.¹¹⁶ These two rationales have never been questioned, “as if further explication of these differences would be beneath the dignity of the Court.”¹¹⁷

While the Supreme Court has explained that there are

113. See, e.g., *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447 (1978); *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 557 (1980). While commercial speech is a category of speech that receives less protection than other forms of speech, it is not wholly without protection. See *San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 535 (1987) (“Commercial speech ‘receives a limited form of First Amendment Protection.’”); *Posadas de Puerto Rico Ass'n v. Tourism Co. of Puerto Rico*, 478 U.S. 557, 562-63 (1980). The Supreme Court frames its decisions concerning restrictions on commercial speech in terms of a four-part analysis. See *Central Hudson*, 447 U.S. at 566 (formulating a four-part test to determine whether a restriction on commercial speech will be upheld, the Court looked to whether: (1) the speech concerned a lawful activity and was not misleading; (2) the state government interest is substantial; (3) the regulation directly advances the government interest; and (4) the regulation is no more extensive than necessary to save that interest).

114. 425 U.S. 748 (1976).

115. *Id.* at 772 n.24.

116. *Central Hudson Gas & Elec. Corp. v. Pubic Serv. Comm'n*, 447 U.S. 557, 564 n.6 (1980).

117. Alex Kozinski & Stuart Banner, *Who's Afraid of Commercial Speech?*, 76 VA. L. REV. 627, 634 (1990). The authors question the notion that it is easier to ascertain the truth of commercial speech as not all commercial speech is objective, as well as the contention that durability should deem speech worthy of less protection. *Id.*

“commonsense differences” between commercial and non-commercial speech,¹¹⁸ it has offered multiple definitions of what constitutes commercial speech.¹¹⁹ In *Valentine v. Chrestensen*,¹²⁰ the first case in which the Supreme Court applied the commercial speech doctrine, the Court neither cited authority for its ruling that the speech at issue was commercial, nor discussed the purposes underlying the First Amendment.¹²¹

Similarly, in *Virginia State Board of Pharmacy*,¹²² the Court held that commercial speech falls under constitutional protection,¹²³ yet offered little guidance for determining whether speech is commercial or not, focusing instead on distinguishing protected from unprotected commercial

118. *Virginia State Bd.*, 425 U.S. at 771 n.24 (quoting *Pittsburgh Press Co. v. Human Relations Comm'n*, 413 U.S. 376, 385 (1973)); see also *Zauderer v. Office of Disciplinary Counsel*, 471 U.S. 626, 637 (1985); *Bates v. State Bar of Arizona*, 433 U.S. 350, 381 (1977).

119. William Van Alstyne, *Remembering Melville Nimmer: Some Cautionary Notes on Commercial Speech*, 43 UCLA L. REV. 1635, 1635 (1996); Michael W. Field, *On Tap*, 44 *Liquormart, Inc. v. Rhode Island: Last Call for the Commercial Speech Doctrine*, 2 ROGER WILLIAMS U. L. REV. 57, 70 (1996). When asked to define hardcore pornography, Justice Stewart answered, “[I] could never succeed in intelligibly doing so. But I know it when I see it.” *Jacobellis v. Ohio*, 378 U.S. 184, 197 (1964) (Stewart, J., concurring). Much of the same can be said of the Court’s approach to defining commercial speech. See Allan Tananbaum, “*New and Improved*”: *Procedural Safeguards for Distinguishing Commercial from Noncommercial Speech*, 88 COLUM. L. REV. 1821, 1829 (1988); Steven Helle, *Attorney Advertising After Peel*, 78 ILL. B.J. 543, 546 (1990) (“The dividing line between commercial and noncommercial speech is astonishingly fuzzy . . . especially given the importance of the distinction.”); Howell A. Burkhalter, *Advertorial Advertising and the Commercial Speech Doctrine*, 25 WAKE FOREST L. REV. 861 (1990) (“The ambiguous ‘common sense’ standard prevents commercial speakers from knowing whether their speech will be protected by the court and discourages the distribution of important commercial information.”). *Id.* at 867. According to one pair of commentators, “[i]n our experience, the more frequently common sense is invoked to support a proposition, the less likely it is to reflect common sense.” Kozinski & Banner, *supra* note 117, at 634 n.37.

120. 316 U.S. 52 (1942).

121. Justice Douglas later called the *Chrestensen* ruling “casual, almost off-hand” and noted that it “has not survived reflection.” *Cammarano v. United States*, 358 U.S. 498, 514 (1959) (Douglas J., concurring).

122. 425 U.S. 748 (1976).

123. *Id.* at 762.

speech.¹²⁴ Thus, from a mere footnote in the case emerged the *Virginia Pharmacy* test for defining commercial speech: whether the speech does “no more than propose a commercial transaction.”¹²⁵

The Supreme Court proposed a second test for defining commercial speech in *Central Hudson Gas & Electric Corp. v. Public Service Commission*.¹²⁶ Central Hudson, an electric utility, challenged the New York Public Service Commission’s (“PSC”) order enjoining state electric utilities from promotional advertising.¹²⁷ Although the order was prompted by the 1973 energy crisis, the PSC continued its ban on advertising even after the shortage eased, in order “to stimulate the purchase of utility services.”¹²⁸ The trial and appellate courts upheld the order on the grounds that commercial speech had little value when the speaker enjoyed a monopoly in its field.¹²⁹ In reversing the lower courts’ rulings,¹³⁰ the Supreme Court defined commercial speech as “expression related solely to the economic interests of the speaker and its audience”¹³¹ and found the utility’s advertisements to be commercial speech.¹³²

124. *Id.* at 773; see Michael E. Rosman, *Ambiguity and the First Amendment: Some Thoughts on All-White Advertising*, 61 TENN. L. REV. 289, 338-39 (1993).

125. *Virginia State Bd.*, 425 U.S. at 771 n.24; see *Pittsburgh Press Co. v. Pittsburgh Comm’n on Human Relations*, 413 U.S. 376, 385 (1973); Arlen W. Langvardt, *Trademark Rights and First Amendment Wrongs: Protecting the Former Without Committing the Latter*, 83 TRADEMARK REP. 633, 643 (1993).

126. 447 U.S. 557 (1980).

127. *Id.* at 559. The order was challenged in state court as an unconstitutional restraint on commercial speech in violation of the First and Fourteenth Amendments. *Id.* at 560.

128. *Id.* at 559.

129. *Id.* at 560-61.

130. *Central Hudson*, 447 U.S. at 572.

131. *Id.* at 561.

132. *Id.* This definition of commercial speech has been criticized as too flexible. See Steven Helle, *Attorney Advertising After Peel*, 78 ILL. B.J. 543 (1990) (“[I]ts very indefiniteness and potentially all-encompassing scope easily could yield result-oriented conclusions. Everything from a politician’s fund-raising speech to a minister’s call for tithing could be said to implicate economic interests.”). *Id.* at 547.

In sum, the Supreme Court has defined commercial speech as a very narrow category of expression: that which proposes a commercial transaction (including commercial handbills,¹³³ advertising of retail prices of alcoholic beverages,¹³⁴ “for sale” signs,¹³⁵ advertising of prescription drug prices,¹³⁶ and beer labels¹³⁷), or is related *solely* to the economic interest of the speaker and its audience (including advertising by electric utilities that promotes use of electricity,¹³⁸ or a trade magazine article that blatantly promotes product manufactured by author/manufacturer’s president¹³⁹).

3. Reconciling the First Amendment to the Lanham Act

Because trademarks carry so much communicative freight, allowing trademark holders to restrict their use can implicate society’s interest in free and open communication.¹⁴⁰ The grant to one person of the exclusive right to use a set of words or symbols in trade can collide with the free speech rights of others.¹⁴¹ The Lanham Act’s legislative history indicates that Congress was mindful of the act’s potential intrusion into expression protected by the First Amendment.¹⁴²

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

134. *44 Liquormart, Inc. v. Rhode Island*, 116 S. Ct. 1495 (1996).

135. *Linmark Assocs. v. Willingboro*, 431 U.S. 85 (1977).

136. *Virginia State Bd. of Pharmacy v. Virginia Citizens Ctr.*, 425 U.S. 748 (1976).

137. *Rubin v. Coors Brewing Co.*, 514 U.S. 476 (1995).

138. *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm’n*, 447 U.S. 557 (1980).

139. *Semco, Inc. v. Amcast, Inc.*, 52 F.3d 108, 112-13 (6th Cir. 1995).

140. *Yankee Publishing Inc. v. News Am. Publishing Corp.*, 809 F. Supp. 267, 276 (S.D.N.Y. 1992); see Arlen W. Langvardt, *Trademark Rights and First Amendment Wrongs: Protecting the Former Without Committing the Latter*, 83 TRADEMARK REP. 633 (1993).

141. *Yankee Publishing*, 809 F. Supp. at 275-76.

142. Representative Kastenmeier stated: “The proposed change in section [1125(a)] should not be read in any way to limit political speech, consumer or

In recent cases involving claims of trademark infringement, courts have provided defendants with greater latitude in using another's mark or similar marks in the context of parody or other forms of artistic expression.¹⁴³ For example, in *Girl Scouts of America v. Bantam Doubleday Dell Publishing Group, Inc.*,¹⁴⁴ the Southern District of New York held that the likelihood that consumers might be confused was not significant enough to overcome First Amendment concerns.¹⁴⁵ In this case, the appellants brought action against the author and publisher of a series of children's books bearing titles that allegedly infringed upon their registered trademarks.¹⁴⁶ The court explained that a trademark owner does not possess a property right that is superior to the First Amendment rights accorded to artistic expression:

The overwhelming consideration in balancing Plaintiffs' Lanham Act trademark rights with Defendants' interests is in preserving the public's and Defendants' First Amendment interests. In considering the sub-

editorial comment, parodies, satires, or other constitutionally protected material" 135 CONG. REC. H1216-17 (daily ed. Apr. 13, 1989).

143. See, e.g., *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490 (2d Cir. 1989); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir.), cert. denied, 483 U.S. 1013 (1987) (editorial parody in *High Society* magazine of L.L. Bean's seasonal catalog, consisting of nude models and fake products held not a violation of antidilution laws); *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) (title of movie gave no indication that Rogers had endorsed the film and thus was not false advertising); *Pillsbury Co. v. Milky Way Prods.*, 215 U.S.P.Q. (BNA) 124 (N.D. Ga. 1981) (parody ad showing "Poppin Fresh" and "Poppie Fresh" engaged in sexual intercourse was not trademark infringement); *Girl Scouts of Am. v. Personality Posters Mfg.*, 304 F. Supp. 1228 (S.D.N.Y. 1969) (poster depicting pregnant woman in a Junior Girl Scout uniform would not confuse the public as to its source).

144. 808 F. Supp. 1112 (S.D.N.Y. 1992), *aff'd*, 996 F.2d 1477 (2d Cir. 1993).

145. *Id.* at 1122. George Vetter & Christopher C. Roche, *The First Amendment and the Artist—Part II*, R.I. B.J., Apr. 1996, at 9, 39; see *Yankee Publishing, Inc. v. News Am. Publishing, Inc.*, 809 F. Supp. 272, 275-79 (S.D.N.Y. 1992); Dorean M. Koenig, *Joe Camel and the First Amendment: The Dark Side of Copyrighted and Trademark-Protected Icons*, 11 T.M. COOLEY L. REV. 803, 837-38 (1994); see generally *New Kids on the Block v. News Am. Publishing, Inc.*, 971 F.2d 302 (9th Cir. 1991) (suggesting that the First Amendment may trump any claim that the plaintiffs have for trademark infringement).

146. *Girl Scouts*, 808 F. Supp. at 1114.

stantial evidence resulting from the parties' completed discovery, this Court is unable to find that there is a likelihood of confusion between Plaintiffs' protected trademarks and Defendants' children books sufficient to overcome the First Amendment value of protecting creative works such as Defendants' books.¹⁴⁷

The Court of Appeals for the Second Circuit similarly noted the need for an analysis sensitive to the First Amendment in evaluating a trademark claim that involves artistic expression.¹⁴⁸ The court stated that, ordinarily, the use of a trademark to identify a commodity or a business is merely a form of commercial speech; however, in the area of artistic speech, enforcement of trademark rights carries a risk of inhibiting free expression.¹⁴⁹ The court concluded that this risk demands limits on the extent to which trademark rights can and will be enforced.

In *L.L. Bean, Inc. v. Drake Publishers, Inc.*,¹⁵⁰ the Court of Appeals for the First Circuit observed that trademark rights do not entitle the owner to quash the unauthorized use of a mark by another who is communicating ideas or expressing points of view.¹⁵¹ In *L.L. Bean*, a trademark holder sought to enjoin the defendants from publishing a magazine containing a noncommercial parody of its trademark.¹⁵² The court found that enforcement of a trademark claim under Maine's anti-dilution statute,¹⁵³ a law substantially similar to the

147. *Id.* at 1130.

148. *Silverman v. CBS Inc.*, 870 F.2d 40 (2d Cir.), *cert. denied*, 492 U.S. 907 (1989).

149. *Id.* at 48.

150. 811 F.2d 26 (1st Cir.), *cert. denied*, 483 U.S. 1013 (1987).

151. *Id.* at 29.

152. *Id.* at 27.

153. ME. REV. STAT. ANN. tit. 10, § 1530 (West 1996). Maine's anti-dilution statute provides:

Likelihood of injury to business reputation or of dilution of a mark registered under this chapter . . . shall be a ground for injunctive relief notwithstanding the absence of competition between the parties or the

Lanham Act, to suppress noncommercial speech offended the First Amendment.¹⁵⁴ The court explained that First Amendment concerns were tantamount because the magazine had not used the mark either to identify or to market goods or services, but rather solely to identify the owner of the trademark as the object of its parody.¹⁵⁵

Thus, only when another's trademark is used without permission for the sole purpose of identifying its source does trademark law prevail over the First Amendment.¹⁵⁶ Free speech rights do not extend to labeling or advertising products in a manner that conflicts with the trademark rights of others.¹⁵⁷ In such circumstances, the exclusive right guaranteed by trademark law is generally superior to the general free speech rights of others.¹⁵⁸ When an unauthorized use of another's mark is part of a communicative message and not a source identifier, however, the First Amendment is tantamount to the trademark right.¹⁵⁹

absence of confusion as to the source of the goods or services.

Id.

154. *L.L. Bean*, 811 F.2d at 33. ("The Constitution does not . . . permit the range of the anti-dilution statute to encompass the unauthorized use of a trademark in a noncommercial setting such as an editorial or *artistic context*.") (emphasis added).

155. *Id.* at 32.

156. 15 U.S.C.A. §§ 1114(1), 1125(a); Kozinski, *supra* note 81, at 973; Tammi A. Gauthier, *Fun & Profit: When Commercial Parodies Constitute Copyright or Trademark Infringement*, 21 PEPP. L. REV. 165, 172 (1993); Marla J. Kaplan, *Antidilution Statutes and the First Amendment*, 21 SW. U. L. REV. 1139, 1139 (1992); see *Brach Van Houten Holding, Inc. v. Save Brach's Coalition for Chicago*, 856 F. Supp. 472, 476 (N.D. Ill. 1994); *Yankee Publishing Inc. v. News Am. Publishing Corp.*, 809 F. Supp. 267, 276 (S.D.N.Y. 1992).

157. *Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc.*, 600 F.2d 1184, 1187-88 (5th Cir. 1979) (stating that the First Amendment is not a license to trammel on legally recognized intellectual property rights).

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

159. *Cliff's Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490 (1989); *Rogers*, 875 F.2d at 994.

4. *New York Racing Authority v. Perlmutter Productions*

*New York Racing Authority v. Perlmutter Productions*¹⁶⁰ provides an excellent analysis of First Amendment and fair use defenses to claims of trademark infringement. *Perlmutter* involved Jeness Cortez, a well-known painter from upstate New York, who had focused her artistic endeavors on the Saratoga Race Course for many years.¹⁶¹ Her paintings often contained New York Racing Authority's ("NYRA") registered trademarks, including NYRA banners hanging from the grandstand, complete with NYRA's logo of a jockey on a horse.¹⁶² The NYRA claimed that it was entitled to monetary damages because its registered trademarks, including the logo, appear in Cortez' work.¹⁶³

Judge Fred Scullin of the Northern District of New York disagreed, holding that Cortez' use of the images is protected under both the First Amendment and the fair use doctrine: "Not only does the interest of free expression outweigh the interest of avoiding consumer confusion as to the source of products displaying these images, the evidence in the record shows that defendants use the images to describe Saratoga horse racing and not as an indication of source."¹⁶⁴

In so holding, the *Perlmutter* court also explained that the First Amendment gave Cortez broad immunity for use of registered words and logos in the artist's paintings of the

160. 1996 WL 465298 (N.D.N.Y. 1996).

161. Dale M. Crisafulli, *NYRA Should Stop Picking on Cortez*, TIMES UNION (Alb.), Aug. 5, 1995, at A6. Instead of infringing on her artistic rights, NYRA should be thanking her for all of the priceless publicity she has brought to them many years. *Id.* The good will and positive advertising her work has generated for Saratoga and its racetrack would be impossible to repay. *Id.*

162. *Perlmutter*, 1996 WL 465298, at *1. Cortez said that she "put that in as a little show of gratitude for their cooperation," illustrating vividly that we live in a world where no good deed is likely to go unpunished. Dan Lynch, *Welcome to the Dopey Place to Be*, TIMES UNION (Alb.), Nov. 15, 1995, at B1.

163. *Perlmutter*, 1996 WL 465298, at *2.

164. *Id.* at *3 (citations omitted).

Saratoga Race Course.¹⁶⁵ Cortez' decision to include NYRA's registered marks in her artwork as they actually appear at the track, and the name "Saratoga" on a scoreboard or the NYRA logo on a banner, "serves the artistically relevant purpose of accurately depicting that scene."¹⁶⁶ In such cases, "the interest of free expression weighs conclusively in [the artist's] favor for products displaying these paintings."¹⁶⁷

The *Perlmutter* court was, however, more critical of the defendant's fair use defense.¹⁶⁸ In evaluating this claim, the court noted that the crucial issue under the fair use doctrine is whether the defendant is using the protected word or image descriptively.¹⁶⁹ The court found that, because the trademarked images in question were depicted where they did not actually exist in the scene portrayed, the use of the marks is not descriptive as required by the fair use doctrine.¹⁷⁰ Therefore, the court denied a fair use defense for products displaying Cortez' paintings.

C. *The Right of Publicity*

In many respects, the right of publicity functions like a trademark, in that it helps to identify the origin of the celebrity's services.¹⁷¹ The right of publicity is limited to "com-

165. *Id.*

166. *Id.* at *4.

167. *Id.*

168. *Perlmutter*, 1996 WL 465298, at *6.

169. *Id.* (citing *Car-Freshener Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 269 (2d Cir. 1995)).

170. *Id.*

171. See Nicholas J. Jollymore, *Expiration of the Right of Publicity—When Symbolic Names and Images Pass Into the Public Domain*, 84 TRADEMARK REP. 125, 146 (1994). According to Professor Jollymore:

In general, trademark law is an apt analogy for the right of publicity, since both bodies of law share a common purpose. They both create a limited monopoly for the use of a mark (or persona). Both are concerned with the quality associated with a mark (or persona) and the dilution of the distinctiveness of the mark (or persona).

Id.

mercial" uses of the celebrity's name, likeness, or identity, which generally encompasses use in advertising, on merchandise, or in promotion or selling.¹⁷² Thus, the right generally does not reach uses that are deemed "news," "commentary," "entertainment," "fiction or nonfiction," and the like.¹⁷³

One pair of commentators have suggested that the fair use defense to trademark infringement is analogous to a defense in right of publicity cases.¹⁷⁴ They argue that as long as an individual's public persona is used honestly and in a nondeceptive manner, others may utilize the persona for proper First Amendment or collateral use objectives.¹⁷⁵ Many courts have held that the First Amendment justifies the use, without consent, of a celebrity's name or image.¹⁷⁶

The Second Circuit's recent decision in *Rogers v. Grimaldi*¹⁷⁷ illustrates this point. In *Rogers*, Ginger Rogers sued the producer of a feature film entitled "Ginger and Fred" for

172. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 44-49 (1995).

173. *Id.* § 47; see *Benavidez v. Anheuser Busch, Inc.*, 873 F.2d 102, 103 (5th Cir. 1989) (documentary film); *Ann-Margret v. High Society Magazine*, 498 F. Supp. 401, 406 (S.D.N.Y. 1980) (magazine). Professor Stephen Barnett explained the limits on the right of publicity as follows:

[It] cannot be employed to prevent use of a celebrity's name, picture, or identity in news reporting (even by the kind of 'newspapers' found at supermarket checkout stands), in jokes on television talk shows or 'Saturday Night Live,' or in unauthorized 'life stories' of the celebrity on television or movie screens.

Stephen R. Barnett, *The Right of Publicity Versus Free Speech in Advertising: Some Counter-Points to Professor McCarthy*, 18 HASTINGS COMM. & ENT. L.J. 593, 594 (1996).

174. Armand Cifelli & Walter McMurray, *The Right of Publicity—A Trademark Model for Its Temporal Scope*, 66 J. PAT. OFF. SOC'Y 455, 467 (1984).

175. *Id.* at 473-74.

176. See, e.g., *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964); *Friends of Phil Gramm v. Americans for Phil Gramm* in '84, 587 F. Supp. 769, 774 (E.D. Va. 1984) (holding that First Amendment protects the use, without consent, of a candidate's name in promotional campaign literature); *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1356 (D.N.J. 1981) (holding that First Amendment prohibits a celebrity's estate from stopping a stage performance using the celebrity's persona if the performance contributes to society's enrichment).

177. 875 F.2d 994 (2d Cir. 1989).

violating her right of publicity.¹⁷⁸ While the film told the story of two dancers who imitated Rogers and Fred Astaire and became known in Italy as “Ginger and Fred,”¹⁷⁹ the director of the film stated that he chose the title of the film for its symbolic meaning.¹⁸⁰ The court agreed with the director and held that Ginger Rogers’ right of publicity must bow to the superior interest in allowing her name to be used as a symbol to communicate ideas.¹⁸¹ The right of publicity expires and enters the public domain when the name or image of the celebrity involved has become a symbol.¹⁸²

II. *ROCK AND ROLL HALL OF FAME, INC. v. GENTILE PRODUCTIONS*

A. *Facts*

The \$92 million Rock and Roll Hall of Fame and Museum was built to provide an educational facility to collect, exhibit, preserve, and interpret the history, art, and culture of rock and roll music.¹⁸³ In 1991, the Museum commissioned I.M. Pei¹⁸⁴ to design the building to be located in downtown Cleveland’s inner harbor area.¹⁸⁵ A portion of the Museum’s

178. *Id.* at 997.

179. *Id.* at 996-97.

180. *Id.* at 1001. To the producer, Ginger Rogers and Fred Astaire represented “a glamorous and care-free symbol of what American cinema represented during the harsh times which Italy experienced in the 1930s and 1940s.” *Id.*

181. *Rogers*, 875 F.2d at 1004-05.

182. *Id.*

183. *Rock & Roll Hall of Fame and Museum, Inc. v. Gentile Prods.*, 934 F. Supp. 868, 870 (N.D. Ohio 1996).

184. Pei’s other works include the East Building of the National Gallery of Art in Washington, the John F. Kennedy Library in Boston, and the pyramid section of the Louvre in Paris. Benjamin Forgey, *PBS’s “I.M. Pei”: Just Another Pretty Facade*, WASH. POST, Mar. 5, 1997, at D1.

185. The Museum contains one of Pei’s “trademark” pyramids, a 117-foot-tall “tent” made of glass and steel, and a tower with cantilevered wings. Karen D. Stein, *Cleveland Rocks*, ARCHITECTURAL REC., Nov. 30, 1995, at 82. Museum design director Peter Arendt called it an “architectural, sculptural interpretation of the explosiveness of the music.” *Museum of Rock Almost Lost its Famous Architect*, STAR TRIB., July 20, 1995, at 10E. But according to one commentator:

financing was obtained through government-issued tax-exempt bonds, and the Museum is obligated to service the debt on a portion of those bonds.¹⁸⁶ The Museum opened in September, 1995 with a spectacular “all-star concert” featuring Bruce Springsteen, Chuck Berry, and Bob Dylan.¹⁸⁷

Like many of Pei's creations, photographers throughout the world were drawn to the Museum's architectural beauty.¹⁸⁸ It was not unusual, therefore, that Chuck Gentile—a widely-known commercial photographer who had been photographing Cleveland landmarks and selling them as posters for several years—would choose the Museum as the subject of his next work.¹⁸⁹ Soon after the Museum opened, Gentile photographed the Museum against the backdrop of Lake Erie at sunset, “when the colors of the spectrum stretched up to fill the background.”¹⁹⁰ Without consulting the Museum, Gentile transformed his picture into

I would describe the shape in question as that of a warped storm door leaning against a refrigerator. . . . Even King Tut wouldn't have said Tut-tut to Gentile's camera. But the pharaohs were as soft-hearted as the Little Sisters of the Poor compared to the emperors of America's music dynasty.

Dick Feagler, *Rock Hall is Poster Child for the Power of Money*, PLAIN DEALER, June 10, 1996, at 2A.

186. *Rock and Roll*, 934 F. Supp. at 870. According to the Museum's President, the project was financed both through public and private means. *Rock N' Roll Heaven Has its Own Price Tag*, CHI. SUN-TIMES, July 5, 1995, at 57. About one-half of the funding came from a bond sponsored by the Cleveland-Cuyahoga County Port Authority, and two local bonds and private sponsors provided the rest of the money. *Id.* The bonds include a \$12 million county general obligation issue, a \$11.5 million city tax increment financing bond, and the \$39 million Port Authority bond. *Id.*

187. Dave Barry, 1995: *Over and Out*, BALT. SUN, Dec. 31, 1995, at 6. Since its opening, the Museum continues to expand. J. Freedom Du Lac, *Rock Museum Rolling Out On Tour*, MILWAUKEE J. SENTINEL, Apr. 13, 1997, at 8. In April of 1997, the Museum decided to take its show on the road for a tour in an effort to raise its profile and its visitor count. *Id.*

188. MICHAEL CANNELL, I.M. PEI: MANDARIN OF MODERNISM (1995); Withold Rybczynski, *Rough Sketch of the Architect I.M. Pei*, S.F. EXAMINER, Dec. 8, 1995, at B21.

189. *Rock & Roll*, 934 F. Supp. at 871.

190. Robyn Meredith, *Rock Hall of Fame Asserts Ownership of Image*, N.Y. TIMES, June 16, 1996, at 12A.

a color poster, captioned “Rock ‘N Roll Hall of Fame,” which he sold in Cleveland frame shops.¹⁹¹ The photograph bears Gentile’s signature in the lower right corner and lists various attributions for those businesses involved in its production.¹⁹² The print does not bear the Museum’s stylized logo of the glass pyramid building design that appears on officially licensed merchandise.¹⁹³

Unfortunately for Gentile, the poster raised more legal questions than money.¹⁹⁴ Before Gentile sold his first poster, the Museum’s licensing department sent him a letter informing him that the building’s shape was protected under federal trademark law.¹⁹⁵ The letter also alleged that commercial use of the Museum’s trademarks was prohibited without approval and payment of royalties.¹⁹⁶ The controversy had begun.

The Museum contended that its trademark rights in the name “ROCK AND ROLL HALL OF FAME” and in its building design not only allowed it to prevent others from selling merchandise bearing the Museum’s trademarks, but also granted it a monopoly in all photographic images of the Museum.¹⁹⁷ Essentially, the Museum maintained that its trademarks preclude publication and distribution of all photographs featuring the Museum that are not produced or authorized by the plaintiffs themselves.¹⁹⁸

The Museum further claimed that the unauthorized use of its name and image diluted the value of its mark, a result

191. *Rock & Roll*, 934 F. Supp. at 871.

192. Appellant’s Brief at 3, *Rock & Roll* (No. 96-3759).

193. *Id.*

194. Meredith, *supra* note 190, at 12A. One commentator explains that “[n]ews of [Gentile’s merchandise] reached the moguls of rock and dismayed them . . . [t]he idea of anybody but them making any money from the hall was intolerable.” Dick Feagler, *Rock Hall Horror Over Picture Show*, PLAIN DEALER, May 9, 1997, at 2A.

195. Appellant’s Brief at 3, *Rock & Roll* (No. 96-3759).

196. *Id.*

197. *Id.* at 4; *see also* Feagler, *supra* note 194, at 2A.

198. Appellant’s Brief at 4, *Rock & Roll* (No. 96-3759)

which made it more difficult for the Museum to sell official sponsorships and merchandise.¹⁹⁹ Because monies from the license and merchandise agreements serve as operating income for the Museum, it argued that “if the trademark portfolio were put in jeopardy, it would adversely impact the success of the sponsorship program and the success of the merchandising program.”²⁰⁰ According to the Museum, any decline in revenues would make it difficult to repay the taxpayer guaranteed bonds that financed its construction.²⁰¹

Consequently, the Museum filed a complaint against Gentile in the Northern District of Ohio, Eastern Division. The Museum sought damages and injunctive relief for trademark infringement based on the publication and distribution of Gentile’s photograph.²⁰²

Gentile appeared at the hearing *pro se* and responded to these allegations by explaining that he had simply created a photograph that included the Museum and had accurately entitled it “Rock N’ Roll Hall of Fame—Cleveland.”²⁰³ He noted that the poster was his own “interpretation of the sky, the mood, the feelings of the night.”²⁰⁴ He argued that his decision to photograph a trademarked building falls beyond the Lanham Act’s reach and that his photo is protected speech which cannot be constitutionally enjoined.²⁰⁵ He pointed out that he stood on a public sidewalk when he took his photo.²⁰⁶ Additionally, Gentile told the court that he had

199. *Id.* at 6.

200. *Id.* at 7.

201. *Id.*

202. The Museum filed claims for relief under 15 U.S.C.A. § 1114(1) (federal trademark infringement); 15 U.S.C.A. § 1125(a) (false designation of origin and unlawful dilution of trademark); and OHIO REV. CODE § 4165.01 (Anderson 1996) (unfair competition and trademark infringement under Ohio state law). *Id.* at 4 n.2.

203. Appellee’s Brief at 9, *Rock & Roll* (No. 96-3759).

204. *Id.*

205. *Id.* at 17.

206. Dick Feagler, *Rock Hall Horror Over Picture Show*, PLAIN DEALER, May 9, 1997, at 2A. Gentile argued that, as a taxpayer, he was taking a picture of some-

sought and received copyright protection of his photograph, and that, under Section 120 of the Copyright Act,²⁰⁷ Congress specifically authorized pictorial representations of buildings like the Rock Hall which “are located in or ordinarily visible from a public place.”²⁰⁸

B. *The District Court*

After reviewing all relevant facts, District Judge George W. White found that the Museum had met its burden of proving a likelihood of confusion and therefore issued a preliminary injunction against Gentile’s selling the posters.²⁰⁹ The court held that the Lanham Act does not require a showing of actual confusion when the plaintiff demonstrates evidence that the defendant had actually copied a registered trademark.²¹⁰ The court noted that, although the building design’s federal registration was currently pending, the Museum already owned a state trademark for that purpose²¹¹ and had a federal trademark for the name, “ROCK AND ROLL HALL OF FAME.”²¹² In granting the order, Judge White held the Museum’s pyramidal shape was “unique and inherently distinctive” and thus a fanciful mark.²¹³ The court

thing that was partly his, not to mention that the Museum was partially built with public funds and its bonds were backed with tax money. *Id.*

207. 17 U.S.C.A. § 120 (West Supp. 1996). Specifically, the Act states: Pictorial representations permitted. The copyright in an architectural work that has been constructed does not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place.

Id.

208. Appellant’s Brief at 9, *Rock & Roll* (No. 96-3759).

209. *Rock & Roll*, 934 F. Supp. at 873.

210. *Id.* at 872 (citing Volkswagenwerk Aktiengesellschaft v. Wheeler, 814 F.2d 812 (1st Cir. 1987); DAP Prods., Inc. v. Color Tile Mfg., 821 F. Supp. 488 (S.D. Ohio 1993)).

211. *Id.* at 870.

212. *Id.*

213. *Id.* at 872 (citing White Tower Sys., Inc. v. White Castle Sys. of Eating Houses Corp., 90 F.2d 67 (6th Cir.), *cert. denied*, 302 U.S. 720 (1937)). A fanciful mark is the strongest of marks, and thus, it is more likely that encroachment on

concluded that the Museum had met its burden of showing a likelihood of success in proving its claims.²¹⁴

The court presumed the presence of irreparable injury upon the showing of trademark infringement, as well as irreparable damage of the plaintiff's licensing program and revenues from continued infringement.²¹⁵ In so finding, the court rejected Gentile's argument that the preliminary injunction would deprive him of a First Amendment right to free speech; instead, the court determined that the poster seriously harmed the Museum by diluting its trademarks and by encouraging other potential infringers to do the same.²¹⁶ The court found this possibility of future harm outweighed the harm to Gentile, which the court determined was only the deprivation of his First Amendment right to free speech.²¹⁷

Finally, the court recognized that a preliminary injunction would protect the public interest,²¹⁸ because Gentile's infringement of the Museum's trademark would likely confuse the public as to its source of sponsorship.²¹⁹ In addition, the court was concerned that the unauthorized use of the

this mark will produce confusion. *Rock and Roll*, 934 F. Supp. at 872 (quoting *Little Caesar Enters., Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 571 (6th Cir. 1987)); see *supra* notes 44-58 (discussing trademark protection for buildings).

214. *Id.*

215. *Id.* (citing *Frisch's Restaurants, Inc. v. Elby's Big Boy, Inc.*, 670 F.2d 642, 651 (6th Cir.), *cert. denied*, 459 U.S. 916 (1982)).

216. *Id.* at 873.

217. *Id.* Specifically, the court noted:

[D]efendants will be harmed by the fact that the sales of the infringing posters will be terminated. Contrary to defendant's contentions, however, a preliminary injunction will not deprive defendants of a First Amendment right to free speech. The First Amendment does not accord protection to an 'unauthorized reproduction of a trade name or mark.' Moreover, as noted by the Supreme Court, for commercial speech to fall within the protection afforded by the First Amendment, it 'must concern lawful activity and not be misleading.' As defendants' poster is misleading as to its source of sponsorship it is not entitled to First Amendment protection.

Rock and Roll, 934 F. Supp. at 872-73 (citations omitted).

218. *Id.* at 873.

219. *Id.*

trademark would irreparably damage the Museum's licensing program and revenues.²²⁰ This possible financial harm could eventually impact the public interest because taxpayer dollars may be required to repay the bonds.²²¹ Thus, the court felt the public interest would best be served though a preliminary injunction.²²²

III. *ROCK AND ROLL WAS INCORRECTLY DECIDED BECAUSE WORKS OF ART THAT CONTAIN TRADEMARKS OR BRAND-NAMES DESERVE PROTECTION AS ARTISTIC EXPRESSION AND FREE SPEECH UNDER THE FIRST AMENDMENT*

A. *Artistic Works that Contain Trademarked Names or Images Should be Afforded the Fair Use Defense*

A trademark should not confer a monopoly that prevents others from copying something²²³—such protection from duplication is the function of copyright law.²²⁴ Rather, trademark law protects against the use by others of a word, name, symbol, or device in connection with the sale of goods or services that might mislead consumers as to the source of those goods or services.²²⁵ Consequently, a trademark

220. *Id.* at 872.

221. *Id.* at 873.

222. *Rock and Roll*, 934 F. Supp. at 873.

223. *Rohm & Haas Co. v. C.P. Hall Co.*, 105 U.S.P.Q. (BNA) 155, 158 (1955) (noting that trademarks are the essence of competition and thus “rights in them may not be asserted broadly to stifle competition”). Rather than granting a monopoly, trademark law recognizes “a fundamental right to compete through imitation of a competitor’s product, which right can only be *temporarily* denied by the patent or copyright laws.” *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1530 (D.C. Cir. 1994), *cert. denied*, 115 S. Ct. 1426 (1995) (citing *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1336 (C.C.P.A. 1982)). The sole exception is that deliberate copying of a trademark constitutes unfair competition under the Lanham Act. *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compro Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964).

224. *Brunswick*, 35 F.3d at 1350; *see supra* notes 25-29 (distinguishing patents, trademarks, and copyrights).

225. *See supra* notes 39-43 and accompanying text (defining trademark law and infringement).

owner may not prohibit all conceivable uses of its mark.²²⁶ While the trademark owner does have an important property interest in its marks, for a finding of infringement a defendant must have utilized the mark as a trademark.²²⁷ Thus, the use of a mark in its primary descriptive sense—not as an indicator of source—is not a trademark use of the mark and therefore, does not constitute an infringement of any of the trademark owner's rights.²²⁸

In the *Rock and Roll* decision, the district court's decision to grant a preliminary injunction ignores the intent underlying the Lanham Act.²²⁹ Charles Gentile is not a competitor of the Museum attempting to benefit from the Museum's reputation and goodwill. He did not erect a copy of the building to deceive customers and thereby entice them to patronize his own museum.²³⁰ Gentile simply photographed a downtown museum against a Lake Erie sunset and affixed a title to his photograph which described the photograph's subject—the Rock and Roll Hall of Fame in Cleveland.²³¹ Trademark law does not contemplate Gentile's activity as infringement, and a proper application would render his photograph fair use of the Museum's trademarks.²³²

Trademarks, slogans, and logos are particularly apt to fill in gaps in our language because they often describe products and services that are totally new and which are now commonly used, such as Xerox, Sanka, Kleenex, Band-Aid,

226. See *supra* notes 35-38 and accompanying text.

227. See *supra* notes 39-43 and accompanying text.

228. *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 911 F.2d 363, 366 (9th Cir. 1990) (citing *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 791 (5th Cir. 1983)); *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 584 (2d Cir. 1990); see *supra* notes 80-97 and accompanying text (discussing the fair use doctrine).

229. See *supra* notes 209-22 (discussing the district court's decision).

230. Had this been the case, *White Tower* and its progeny would justify a holding against Gentile. See *supra* notes 44-48 and accompanying text.

231. *Rock & Roll Hall of Fame and Museum, Inc. v. Gentile Prods.*, 934 F. Supp. 868, 870 (N.D. Ohio 1996); see *supra* notes 190-93 and accompanying text.

232. See *supra* notes 80-97 and accompanying text (explaining the concept of fair use).

and Escalator.²³³ What originates as a trademark or slogan quickly transforms into a political campaign, a Saturday Night Live skit, a metaphor, a cultural phenomenon, an everyday expression, and occasionally even a fixed part of language.²³⁴ Consequently, the originator of a trademark or logo cannot simply assert, "It's mine, I own it, and you have to pay for it any time you use it."²³⁵ Words and images do not enter discourse accidentally; they are generally placed there by well thought out campaigns intended to instill them into our consciousness.²³⁶ The originator of the symbol must give up some measure of control;²³⁷ he must understand that the symbol also belongs to the other minds who have received and integrated it.²³⁸ As the Ninth Circuit Court of Appeals explained in *New Kids on the Block v. News America Publishing, Inc.*:²³⁹

With many well-known trademarks, such as Jell-O, Scotch tape and Kleenex, there are equally informative non-trademark words describing the products (gelatin, cellophane tape and facial tissue). But sometimes there is no descriptive substitute, and a problem closely related to generity and descriptiveness is presented when many goods and services are effectively identifiable only by their trademarks. For example, one might refer to the two-time world champions or the professional basketball team from Chicago, but it's far simpler (and more likely to be understood) to refer to the Chicago Bulls. In such cases, use of the trademark does not imply sponsorship or endorse-

233. Rochelle C. Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 417 (1990).

234. Kozinski, *supra* note 81, at 974 ("Looking back in recent history, for example, 'Where's the Beef' and Joe Isuzu are perhaps the only memorable aspects of the 1984 and 1988 presidential campaigns.").

235. *Id.* at 975.

236. *Id.*

237. *Id.*

238. *Id.*

239. 971 F.2d 302 (9th Cir. 1991).

ment of the product because the mark is used only to describe the thing, rather than to identify its source.²⁴⁰

The Lanham Act, while designed to afford protection to the trademark owner in the commercial realm, was never intended to allow a trademark owner to travel beyond commercial boundaries and use his trademark ownership to control the free speech rights of others.²⁴¹ The Second Circuit Court of Appeals in *Car-Freshener Corp. v. S.C. Johnson & Son, Inc.*²⁴² explained, “[i]t is a fundamental principle [that] although trademark rights may be acquired in a word or image with descriptive qualities, the acquisition of such rights will not prevent others from using the word or image in good faith in its descriptive sense, and not as a trademark.”²⁴³

In determining that Gentile’s use of the marks was infringement,²⁴⁴ the district court overlooked trademark law’s key distinction between infringing uses and incidental, non-trademark uses of a mark.²⁴⁵ Gentile did not use his photograph of the Museum in the trademark sense to identify the source of the image, but rather in the descriptive sense, depicting in a striking and sophisticated manner what has become a national landmark of urban architecture. His poster simply employs the words “Rock and Roll Hall of Fame—Cleveland,” and the photograph of the building itself in its primary descriptive sense to depict the appearance of a particular building (the Rock and Roll Museum) located in a

240. *Id.* at 306.

241. See Wendy J. Gordon, *On Owning Information: Intellectual Property and the Restitutory Impulse*, 78 VA. L. REV. 149, 157 (1992) (observing that the recent judicial trend toward recognizing new intellectual property rights “sometimes may interfere impermissibly with the autonomy of others and with efforts by individuals to achieve cultural self-determination”).

242. 70 F.3d 267, 269 (2d Cir. 1995).

243. *Id.*; see also *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 12-13 (2d Cir. 1976); *United States Shoe Corp. v. Brown Group, Inc.*, 740 F. Supp. 196, 198-99 (S.D.N.Y.), *aff’d*, 923 F.2d 844 (1990).

244. See *supra* notes 209-22 and accompanying text.

245. See *supra* notes 80-97 and accompanying text.

particular place (Cleveland).²⁴⁶

Courts are quick to equate value with right—to leap from recognizing that consumers attach value to trademarks and to conclude that trademark holders ought to have the right to “capture that value for themselves.”²⁴⁷ The originator of a new image is often perceived as its creator and thus seen as a victim if and when the image is appropriated.²⁴⁸ However, once the notion that images become encrusted with meaning is illuminated, the creator is not conclusively the purveyor as well.²⁴⁹ The public domain has been divested of symbols that, by virtue of shared cultural understandings, serve valuable linguistic and symbolic functions.²⁵⁰ Once symbols are introduced into a culture, they tend to be receded by those who see and hear them.²⁵¹

When the appropriator of another’s image or mark is an artist, it is wrong to assume that a freeriding scavenger—a mere poacher against whom trademark law protects—has infringed upon the rights of a hard working image maker.²⁵²

246. See *supra* notes 190-93 and accompanying text.

247. Rochelle C. Dreyfuss, *We Are Symbols and Inhabit Symbols, So Should We Be Paying Rent? Deconstructing the Lanham Act and Rights of Publicity*, 20 COLUM.-VLA J.L. & ARTS 123, 124 (1996); see *San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522 (1987); *Electronic Lab. Supply Co. v. Cullen*, 977 F.2d 798, 803 (3d Cir. 1992); see also Gordon, *supra* note 241, at 166-80 (criticizing the tendency of some courts to assume that “reaping and sowing” and “unjust enrichment” automatically give rise to absolute claims, trumping all other considerations). *But see Door Sys. v. Pro-Line Door Sys.*, 83 F.3d 169, 173 (7th Cir. 1996) (“A trademark, even a registered one, is not a property right, like a copyright or a patent, but merely an identifier of source.”).

248. Dreyfuss, *supra* note 247, at 140; see also Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533 (1993).

249. Dreyfuss, *supra* note 247, at 140.

250. *Id.*

251. See, e.g., Keith Aoki, *Adrift in the Intertext: Authorship and Audience “Re-coding” Rights—Comment on Robert H. Rotstein, “Beyond Metaphor: Copyright Infringement and the Fiction of the Work”*, 68 CHI.-KENT L. REV. 805, 829 (1993); Rosemary J. Coombe, *Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue*, 69 TEX. L. REV. 1853, 1877 (1991) (discussing the concept of dialogism in society).

252. Dreyfuss, *supra* note 247, at 141.

While artists who use trademarks are in a sense freeriding by utilizing images they have not themselves vested with meaning, the use of the image is merely incidental to the amount of creativity and effort that goes into the entire work itself. In situations where an artist uses a pre-existing image or trademark in his art, this is hardly the case.²⁵³

The Museum's trademark infringement claim fails because Gentile's use complies with the fair use exception of using a name to designate a geographical location:²⁵⁴ the Museum's trademark is "ROCK AND ROLL HALL OF FAME," whereas Gentile's poster says "Rock N' Roll Hall of Fame—Cleveland."²⁵⁵ Gentile's reference to the Museum's name merely confirms that it is indeed the Rock and Roll Museum shown in the photograph. Gentile only refers to the words "Rock and Roll Hall of Fame" to the extent necessary to identify it as the subject of the poster. He does not use the Museum's logo, which the Museum prominently places on its poster, or anything else that is not necessary to make the poster intelligible to consumers.²⁵⁶ Nor do the words "Rock and Roll Hall of Fame" stand out from the word "Cleveland," as they might if Gentile were attempting

253. In fact, the Museum's argument that the money from licensing was necessary to pay back loans is weak: "The \$92 million Rock and Roll Hall on Cleveland's lakefront actually had a 'cost overrun,' if there is such a thing." Alan Johnson, *Rock and Roll Hall Puts 'Extra' Money on Debt*, COLUMBUS DISPATCH, May 15, 1996, at 4B. Museum administrators decided to use four million dollars in leftover construction money to begin paying off \$39 million in debt issued by the Cleveland-Cuyahoga County Port Authority. *Id.* In fact, "[o]fficials expect to hit 900,000 visitors for 1996—its first full calendar year of operation. A 1992 study by the Deloitte & Touche accounting firm projected that the Museum needed at least 695,000 the first year to break even." Bill Lubinger, *Rock Hall So Popular It Needs to Expand*, PLAIN DEALER, Apr. 19, 1996, at 1A.

254. See, e.g., *Schafer Co. v. Innco Management Corp.*, 797 F. Supp. 477, 481-82 (E.D.N.C. 1992), *aff'd*, 995 F.2d 1064 (4th Cir. 1993) (finding that motel operator's advertising billboards associating motel with "Border Exit" made fair use of the phrase, and, thus, did not infringe upon "South of the Border" trademark for theme-park home); see *supra* notes 80-97 and accompanying text.

255. See *supra* notes 190-93 and accompanying text.

256. Appellant's Brief at 4, *Rock & Roll* (No. 96-3759); see *supra* notes 190-93 and accompanying text.

to use them as a trademark.²⁵⁷ Thus, the Museum's poster is clearly an official one, while Gentile's is not.

In a similar case, the First Circuit considered whether one could describe the "Boston Marathon" without using the words "Boston Marathon."²⁵⁸ The court permitted a competing television station to use the words "Boston Marathon" to describe coverage of the Boston Marathon,²⁵⁹ stating, "[i]n technical trademark jargon, the use of words for descriptive purposes is called a 'fair use,' and the law usually permits it even if the words themselves also constitute a trademark."²⁶⁰

B. *Artistic Works that Contain Trademarked Names or Images Should Be Afforded First Amendment Protection Because They Are not Commercial Speech*

In issuing a preliminary injunction against Gentile,²⁶¹ the district court also failed to pay due homage to the artist's First Amendment rights.²⁶² For more than one hundred years, courts have recognized photographs as original works of art.²⁶³ Thus, Gentile's work stands as pure artistic expression and should have been protected by the First Amendment.

A work of art that incorporates trademarks as part of its composition but that is made and sold for a profit may nonetheless be artistic expression and not commercial speech.²⁶⁴ Consequently it may receive the strongest First Amendment protection.²⁶⁵ In previous Supreme Court cases in which the speech at issue contained both commercial and noncommer-

257. See *supra* notes 190-93 and accompanying text.

258. *WCVB-TV v. Boston Athletic Ass'n*, 926 F.2d 42 (1st Cir. 1991).

259. *WCVB*, 926 F.2d at 47.

260. *Id.* at 46; see *supra* notes 80-97 and accompanying text.

261. See *supra* notes 209-22 and accompanying text.

262. See *supra* notes 99-139 and accompanying text.

263. See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884); see *supra* notes 102-05 and accompanying text.

264. See *supra* notes 99-139 and accompanying text.

265. See *supra* notes 99-139 and accompanying text.

cial elements, the speaker had a commercial message to which he added noncommercial elements.²⁶⁶ With artwork or a film, the process is reversed; the artist has a noncommercial message to which he adds commercial elements.²⁶⁷ Thus, under the tests formulated by the Supreme Court that focus on the speaker,²⁶⁸ art that utilizes trademarks in its message is noncommercial and should be granted full First Amendment protection.

The district court's opinion supplies little information concerning the court's determination that Gentile's photo of the Museum at sunset constituted commercial speech as opposed to artistic expression.²⁶⁹ Apparently, the court surmised that the photograph was considered commercial speech because Gentile took the photographs in the course of his livelihood as a photographer and ultimately offered the photograph for sale.²⁷⁰

A work of art, much like a movie, may be driven by an economic motive. However, the Supreme Court has recognized that books, movies, religious literature, and even political speech are dependent on generating money for their dissemination:²⁷¹ "[i]t is well settled that a speaker's rights are not lost merely because compensation is received; a speaker is no less a speaker because he or she is paid to speak."²⁷² Without the possibility of financial rewards, it is unlikely that Gentile would have transformed his photo-

266. See *supra* notes 113-34 and accompanying text.

267. Steven L. Snyder, *Movies and Product Placement: Is Hollywood Turning Films into Commercial Speech?*, 1992 U. ILL. L. REV. 301, 321-22 (1992) (citations omitted).

268. *Valentine v. Chrestensen*, 316 U.S. 52, 55 (1942).

269. See *supra* notes 209-22 and accompanying text.

270. *Rock & Roll*, 934 F. Supp. at 870.

271. See *Smith v. California*, 361 U.S. 147 (1959) (books); *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495 (1955) (movies).

272. *Riley v. National Fed'n of Blind*, 487 U.S. 781, 801 (1988). See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 584 (1994); *New York Times Co. v. Sullivan*, 376 U.S. 254, 265-66 (1964); *Burke v. City of Charleston*, 893 F. Supp. 589, 601 (D.S.C. 1995).

graph into posters. Furthermore, the type of art that Gentile creates is in fact a part of the message of his art.²⁷³ In selling his posters to local frame shops, he makes the art available to the public.²⁷⁴ The Second Circuit agreed with a similar argument made on behalf of visual artists who peddled their wares on the streets of New York City:²⁷⁵ “[a]rtists are part of the ‘real’ world; they struggle to make a living and interact with their environments. The sale of art in public places conveys these messages.”²⁷⁶

Under the Court’s test for commercial speech, which asks whether the speech “does no more than propose a commercial transaction,”²⁷⁷ using trademarks in art does not constitute commercial speech. Chuck Gentile is the speaker and the photograph is the dominant speech. He is not directly affected if the viewers of his artwork visit the Museum. Gentile’s poster in no way advocates attendance to the Museum and thus does not even meet the threshold requirement of proposing a commercial transaction.²⁷⁸ In addition, the speech found in a work of art, however inundated with registered trademarks, is not in the format of an advertisement.²⁷⁹ Furthermore, this type of speech does not refer to a single product.²⁸⁰ Any mention or showing of trademarks or products is secondary to the work of art or the mood depicted.

Courts have long recognized that noncommercial, artistic expression that utilizes a trademark or trade name constitutes protected speech.²⁸¹ By erroneously analyzing Gen-

273. See *supra* notes 106-12 and accompanying text.

274. See *supra* note 191 and accompanying text.

275. *Bery v. City of New York*, 97 F.3d 689, 696 (2d Cir. 1996).

276. *Id.*

277. *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 771 n.24 (1976) (quoting *Pittsburgh Press Co. v. Human Relations Comm’n*, 413 U.S. 376, 385 (1973)).

278. See *supra* notes 125-39 and accompanying text.

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

280. *Id.* at 66-67.

281. *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989); *Cliffs Notes, Inc. v.*

tile's photograph as "unprotected expression," the court failed "to realize that it was engaging in a practice that under all but the most exceptional circumstances violates the Constitution"—censoring the publication and distribution of constitutionally protected artistic expression.²⁸²

Photographers insist that a poster deserves the same First Amendment protection as a newspaper photograph.²⁸³ Indeed, the Museum acknowledges that pictures of the building published in newspapers are protected under the First Amendment.²⁸⁴ Because newspapers are published in order to make a profit, posters, another money making venture, should share the same protection.²⁸⁵ If a news photographer owns the right of self-expression in producing images, that same right should not be denied to a creator of images who employs paint and brush instead of a camera.²⁸⁶ Furthermore, assurances that the Museum does not intend to enforce its trademark against editorial photography is not a guarantee as to future policies, let alone those of the rest of the world's building owners, especially if the rules governing photographs are turned upside-down.²⁸⁷

Bantam Doubleday Dell Publishing Group, Inc., 886 F.2d 490, 494 (2d Cir. 1989); L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 33 (1st Cir. 1987).

282. Procter & Gamble Co. v. Bankers Trust Co., 78 F.3d 219, 225 (6th Cir. 1996).

283. Robyn Meredith, *Rock Hall of Fame Asserts Ownership of Image*, N.Y. TIMES, June 16, 1996, at 12A.

284. *Id.*

285. *Whose Rock Is It?*, CINCINNATI POST, June 24, 1996, at 6A. One critic made the same argument on behalf of Cortez: "If what Cortez does is thievery, then what are the photographs you see in the sports section of the newspaper? If Cortez is a thief, then what about the guy who does the sports on WNYT (Channel 13) and shows you moving pictures from the track?" Dan Lynch, *Artist a Loser at the Track*, TIMES UNION (Alb.), July 28, 1995, at B1.

286. Dan Lynch, *The Artless Dodgers of NYRA*, TIMES UNION (Alb.), July 7, 1996, at C1.

287. See Don Luce, *Counterpoint. . . Chuck Gentile and the Rock and Roll Hall of Fame*, ASMP BULL., Oct. 1996, at 9. Lynne Bryant, a member of the Executive of the British Association of Picture Libraries and Agencies and administrator of the Arcaid architectural picture library in London, England says, "Just imagine how many American-based corporations are here; if they adopt the practice of making a trademark in the shape of their buildings, all the rest will follow. Who

C. *The Rock and Roll Decision Fails to Balance the Lanham Act with First Amendment Concerns*

Courts have attempted to strike a balance between the freedom of artistic expression and the public's right not to be misled.²⁸⁸ The Second Circuit defined the balancing process in *Rogers v. Grimaldi*:²⁸⁹ "We believe that in general 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."²⁹⁰ The court scrutinized the trademark's effect on protected speech and determined whether an important, overriding interest was served by allowing regulation of speech via enforcement of a trademark owner's rights.²⁹¹

1. The Likelihood of Confusion is Minimal

The district court in *Rock and Roll* improperly presumed that a likelihood of confusion existed between Gentile's poster and the Museum's officially licensed products.²⁹² In a recent Second Circuit case, Judge Leval found that "even if there was some confusion as to source or origin, it was relatively minor and was far outweighed by First Amendment

knows how far this might go once it has started?" *Id.*

288. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490, 494 (2d Cir. 1989); *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989); see *supra* notes 140-59 and accompanying text.

289. 875 F.2d 994 (2d Cir. 1989).

290. *Id.* at 999; see *supra* notes 140-59 and accompanying text.

291. *Id.*; see *Girl Scouts v. Bantam Doubleday Dell Publishing Group, Inc.*, 808 F. Supp. 1112, 1121 (S.D.N.Y. 1992), *aff'd*, 996 F.2d 1477 (2d Cir. 1995) ("[T]he central issue . . . is . . . whether the risk of confusion as to the source of Defendants' merchandise is greater than the public interest in artistic expression."); *International Ass'n of Machinists & Aerospace Workers v. Winship Green Nursing Ctr.*, 914 F. Supp. 651, 655 (D. Me.), *aff'd*, 103 F.3d 196 (1st Cir. 1996) ("When trademark laws are applied to noncommercial, communicative speech uses of a mark, a balancing test should be applied to determine whether or not they meet the requirements of the relatively strong First Amendment protection afforded such speech.").

292. *Rock & Roll*, 934 F. Supp. at 872; see *supra* notes 209-22 and accompanying text.

considerations protecting the right of commentary and artistic expression.”²⁹³ As courts have increasingly assumed that consumers are very unsophisticated when evaluating the consumer confusion requirement,²⁹⁴ confusion has come to serve as a rather minor impediment to according plenary control to purveyors of images.²⁹⁵

Common sense dictates that consumers purchase a work of art such as the Gentile poster because it appeals to their individual tastes, not because the work has obtained some special approval from its subject. There is nothing in the poster itself that would, in conjunction with the Museum's marks, suggest that the Museum sponsored or endorsed Gentile's poster. In fact, his use of the word “Cleveland” in addition to the name of the Museum shows that he was only attempting to identify subject matter and geographical location and that he did not use the name to indicate Museum endorsement or sponsorship of his poster.²⁹⁶ Perhaps trademark law itself should be amended to reflect the tentative draft of the Restatement (Third) of the Law of Unfair Competition, which recommends that in cases involving expressions of noncommercial speech courts should require substantially more evidence of confusion to preserve the communicative message before imposing liability for infringement.²⁹⁷

293. *Yankee Publishing Inc. v. News Am. Publishing Corp.*, 809 F. Supp. 267, 272 (S.D.N.Y. 1992); see *supra* notes 140-59 and accompanying text.

294. See *supra* note 63 and accompanying text (discussing the sophistication of consumers as an element of trademark infringement).

295. Rochelle C. Dreyfuss, *We Are Symbols and Inhabit Symbols, So Should We Be Paying Rent? Deconstructing the Lanham Act and Rights of Publicity*, 20 COLUM.-VLA J.L. & ARTS 123, 131; see, e.g., *Florence Mfg. Co. v. J.C. Dowd & Co.*, 178 F. 73, 75 (2d Cir. 1910) (“The law is not made for the protection of experts, but for the public—that vast multitude which includes the ignorant, the unthinking and the credulous, who, in making purchases, do not stop to analyze, but are governed by appearances and general impressions.”).

296. See *supra* notes 190-93 and accompanying text.

297. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 20 cmt. b, rep. n. b, at 180.

2. Opening the Floodgates

The trademark infringement suit against Gentile goes far beyond the Museum's money-raising challenges. If photographers must obtain the prior consent of the owners of every arguably distinctive building in the United States before photographing them for commercial purposes, architectural and location photography will effectively cease to exist.²⁹⁸ Few, if any, publication photographers have the time or budget to seek such prior consent.²⁹⁹ The transaction costs of this process alone would be prohibitive for the vast majority of photographers.³⁰⁰ In addition, because the population of "distinctive," and therefore arguably protectable, building designs is enormous and limited only by whether the owner of a particular building can prove that its design is, in fact, protectable as a trademark, a prudent photographer would simply have to assume that every privately-owned building having any aesthetic appeal is prohibited.³⁰¹ The result will be that most buildings of interest to the public will be largely excluded from commercial photography.³⁰²

Throughout the development of architectural and location photography, publication photographers have never been required to obtain the consent of the owners of trade-

298. See *Whose Rock Is It?*, CINCINNATI POST, June 24, 1996, at 6A.

299. Brief of Am. Soc'y of Media Photographers, Inc. as Amicus Curiae at 4, *Rock & Roll* (No. 96-3759). The American Society of Media Photographers ("ASMP") is the nation's largest organization of publication photographers. *Id.* at 1.

300. *Id.* at 4.

301. *Id.*

302. As one commentator notes:

If such a law stands, distinctive building owners might eventually charge photographers for shooting a city skyline, though the Cleveland Museum says it has no problem with being in a group shot. Other organizations might, though. To hobble the creativity of an artist out for a stroll is to rein in the spontaneity of street photography, already hampered by release forms that must be signed to use pictures of people and private property. Public spaces should remain free of such fine print.

The Picture of Free Expression, B. GLOBE, June 22, 1996, at 14.

marked building designs before incorporating them into photographic images.³⁰³ Additionally, such a requirement conflicts with Congressional policy, reflected in the recently enacted Architectural Works Copyright Protection Act of 1990.³⁰⁴ This affirmative right to photograph publicly accessible buildings and to distribute and display those photographs freely, expressed as a limitation on the rights of architectural work copyright owners, was acknowledged in the House Report of the Copyright Act, the principal source of its legislative history.³⁰⁵ Furthermore, this exemption was intended to apply to photographs of buildings taken for both personal and commercial purposes.³⁰⁶ While the policies of trademark law differ from those of copyright law, the specific language and legislative history of section 120(a) of the Copyright Act reveal a Congressional determination that photographs of publicly accessible buildings should be freely taken and distributed for both personal and commercial uses.³⁰⁷

303. Brief of Am. Soc'y of Media Photographers, Inc. at 4, *Rock & Roll* (No. 96-3759).

304. Pub. L. No. 101-650, tit. VII, 104 Stat. 5133, 8515-8516 (Dec. 1, 1990).

305. H.R. REP. NO. 101-735, 101st Cong., 2d Sess. 21 (1990). The House Report explained the rationale for this exemption as follows:

Architecture is a public art form and is enjoyed as such. Millions of people visit our cities every year and take back home photographs, posters, and other pictorial representations of prominent works of architecture as a memory of their trip. . . . These uses do not interfere with the normal exploitation of architectural works. Given the important public purpose served by these uses and the lack of harm to the copyright owner's market, the Committee chose to provide an exemption, rather than to rely on the doctrine of fair use, which requires ad hoc determinations.

Id. at 22.

306. *Id.* at 22 n.50 (deciding that an amendment prohibiting pictorial representations made for the purpose of furthering the unauthorized design and construction of a substantially similar architectural work might also interfere with scholarly and noncompetitive analysis of architectural work, and with the ability of photographers to pursue their livelihood." *Id.* (emphasis added).

307. See *supra* note 207 and accompanying text; Patty Gerstenblith, *Architect as Artist: Artists' Rights and Historic Preservation*, 12 CARDOZO ARTS & ENT. L.J. 431 (1994).

Many photographers regularly include buildings and other works of architecture as integral parts of scenes shot on location.³⁰⁸ In many instances, photographs shot on location for advertising or artistic purposes feature prominent landmarks such as the Empire State Building or Radio City Music Hall in New York, chosen as subjects both for their own aesthetic merit and their distinctive and recognizable character.³⁰⁹

Furthermore, were trademarked images excluded from the artist's potential use, artistic expression would suffer widespread stifling.³¹⁰ Timothy J. Moore, Director of Communications and Public Relations for the Museum, stated that his organization "has *not* and is *not* trying to prevent anyone from photographing the Museum building."³¹¹ Nonetheless, as one commentator retorts: "Tell that to [a] prominent photographer. . . [who] reports that . . . he was making art photographs of the Museum from a public sidewalk [and] was confronted by a person who identified herself as a member of the Museum marketing staff and told

308. For example, photographers such as Walker Evans, Lewis Hine, Berenice Abbott, and Margaret Bourke-White captured the creation of the Chrysler Building (1930), the Empire State Building (1930), and the Rockefeller Center, (1929-31). Lynn MacRitchie, *Arts: City that Reaches for the Stars: New York Has Always Been an Inspiration for Artists*, FIN. TIMES, July 30, 1996, at 11.

309. Ironically, Cleveland, home to the Rock and Roll Hall of Fame and Museum, has been turned into a movie set for the upcoming film, "Telling Lies in America." Clint O'Connor, *Telling Lies' In Cleveland Filming of Eszterhas Opus Gives City a 24-Day Taste of Hollywood*, PLAIN DEALER, Sept. 1, 1996, at 1J. Such Cleveland spots as the West Side Market, Grays Armory, the Cuyahoga County Courthouse and Ruthie and Moe's Diner, were used to make the film. *Id.* Producer Ben Myron reasoned that "[i]f we had tried to build a church set in Los Angeles, it would have cost \$100,000." *Id.* Instead, they had the opportunity to use St. Stephen. *Id.*

310. According to one commentator:

Perhaps an advertiser should be charged for filming a commercial at the Museum—using the place to sell a soft drink, for instance. But a photo of a building is an image of a landmark, the product of free expression, not an assembly line.

The Picture of Free Expression, B. GLOBE, June 22, 1996, at 14.

311. Timothy J. Moore, *Point . . . Chuck Gentile and the Rock and Roll Hall of Fame*, ASMP BULL., Oct. 1996, at 8.

him that he was not allowed to photograph the building.”³¹²

On a video wall at the Museum, performances by artists including Bob Marley, Arrested Development, and Public Enemy are juxtaposed with footage depicting Jamaica, the Bronx, and South Central Los Angeles.³¹³ The irony would be overwhelming were the same Museum that would not allow its trademarked image to be photographed for commercial purposes similarly denied the right to utilize footage from these locations due to the implications from its own case.

In addition, breakthroughs in digital technology are revolutionizing the way filmmakers think about where to film movies. With digital wizardry, filmmakers can make the action appear in whatever location they desire without ever going there.³¹⁴ If the *Rock and Roll* holding stands, it might cause more owners to register their buildings as trademarks, which would stifle the emerging use of computer-digital technologies and, in turn, the creativity of the motion picture industry.

As the famous landscape photographer Ansel Adams once wrote: “Photography is a way of telling what you feel about what you see.”³¹⁵ Photographs are wise statements about the imprint humankind has made on the world; as pieces of art, they exhibit a clarity and formality of vision that is impressive.³¹⁶ The role of the realist artist, including

312. Luce, *supra* note 30, at 9.

313. William Weathersby Jr., *Rock and Roll Hall of Fame: Construction and Design*, TCI, Feb. 1996, at 38.

314. Connie Benesch, *Company Town Guided Imaging Is It Digital or Is It on Location?*, L.A. TIMES, July 30, 1996, at D1. Recent examples in the movie industry of invented locations by computer include the spaceship shots over major cities in “Independence Day”, Cincinnati’s historic Art Deco Union Terminal train station in “Batman Forever,” and the Catholic church for scenes in “Primal Fear.” *Id.*

315. John Kemp, *Photos Use Scenes You’ve Seen*, TIMES-PICAYUNE, Oct. 7, 1993, at 4H1.

316. James Kaufmann, *Photos are Wise Statements About our Imprint on Earth*, STAR TRIB., June 7, 1992, at 14F.

realist photographers, is to pay attention, holding truth as a standard “amid the swirling confusions of life.”³¹⁷

The artist Robert Forbes commented that “[s]omeone once called my paintings ‘entertaining architecture,’ because I pick out many of the attractions across the country that have been designed by architects. I accept that description, too, and find the search for such structures fascinating.”³¹⁸ In his quest to celebrate humanity, however, he too could face a trademark infringement suit similar to the one encountered by Chuck Gentile.³¹⁹

Artists and photographers who use familiar images such as buildings and brand-names reveal the manner in which they interpret the world.³²⁰ According to Richard Estes, one of the most renowned realist painters of the century, an image that dominates the piece is “purely a visual experience,” while allowing figures or personalities to intrude “[allows people to] start relating to the figures, and it’s an emotional relationship.”³²¹ Buildings and landmarks have always been the subject of artistic works. For instance, the city of New York has been a place where the artist “comes, looks and depicts.”³²² “Each artist views the metropolis with different

317. Chris Waddington, *Taking Realism to the Edge*, TIMES-PICAYUNE, Sept. 3, 1993, at L22.

318. Betsy S. Goldman, *Photo-Impressionism; Artist Robert Forbes Focuses on Light*, AM. ARTIST, Aug. 1994, at 44.

319. For example, Robert Forbes finds the Gateway Arch in St. Louis fascinating and often includes it in his works as a prime example of a mechanical marvel of our time. *Id.*

320. *Art; Seeing the City as Artists Do*, N.Y. TIMES, Oct. 25, 1987, at 26.

321. Cathy Curtis, *Candid Camera of Photorealist Painter Estes*, L.A. TIMES, Apr. 25, 1991, at 33. For additional articles discussing Richard Estes and the realism movement, see Kevin Lynch, *This Art’s For Real, and Easy for the Eye*, CAP. TIMES, Apr. 28, 1994, at 1E; Paul Richard, *The Hand that Plays Tricks on the Camera; Richard Estes’ Paintings Change the Way We Look at Real Life*, WASH. POST, Jan. 24, 1979, at B1; Chuck Twardy, *Realistic vs. Abstract: Debate at the Heart of Art*, ORLANDO SENTINEL TRIB., Jan. 28, 1990, at G1; John Kemp, *Amateur a Pro at Photo-Realism*, NEW ORLEANS TIMES-PICAYUNE, June 3, 1993, at 4H1.

322. Richard F. Shepard, *Seeing the Evolution of New York City Through Artists’ Eyes*, N.Y. TIMES, Mar. 20, 1987, at 1. Albert K. Baragwanath, senior curator emeritus of the Museum of the City of New York, observes that New York has

eyes, and lucky New Yorkers have abundant opportunities to see these perceptions and match them with their own in the city's Museums and galleries."³²³

Who could forget Andy Warhol's simple image of the Campbell soup can?³²⁴ Artists are often fascinated by the over-abundance of, and the role society places on, brands in modern society. In the grand tradition of movements like dadaism, realism, and post-impressionism, the use of images is a comment on society and on the role that we place on art.³²⁵ For example, Ken Keeley depicts New York City newsstands and scenes of Manhattan. His canvasses place the viewer in Times Square, in front of various landmark stores and well-known restaurants, or on the streets of the

been an object for the artist since its inception. *Id.*

323. *Id.* In fact, Manhattan's Whitney Museum of American Art recently produced an exhibition entitled "NYNY: City of Ambition," which included a range of artists' interpretations in a variety of media, including paintings, prints, photographs, films, architecture, and fashions. Joy Hakanson Colby, *Exhibits: Take a Look at New York City Life Through the Eyes of Various Artists*, DET. NEWS, July 3, 1996, at F10. Examples of the exhibits include Robert Moskowitz's "Skyscraper," Edward Hopper's "Early Sunday Morning," Samuel Halpert's "Flatiron Building," Red Grooms' "Washington Square Park," Lewis Hine's "Empire State Building: Construction," and Mondrian's "Broadway Boogie Woogie."

Many other cities' sites in the United States have been the subject of paintings and photographs. See, e.g. Anne Behrens, *Scenes of New York, Washington*, WASH. POST, June 21, 1984, at 2 (store fronts and panoramic views of Washington, D.C.); Roger Hurlburt, *Inspiration Beach—The Allure of Art Deco Buildings on Miami Beach Inspired an Artist to Stretch the Limits of Photo-Realism in his Watercolors*, SUN-SENTINEL FT. LAUDERDALE, Mar. 20, 1994, at 3D (scenes of Miami Beach); Suzanna Phelps-Fredette, *City Buildings and Corners Turn Poetic in Young Artist's Hands*, COM. APPEAL, June 19, 1993, at C1 (details of architectural landscape of downtown Memphis).

324. John W. Smith, archivist of the Andy Warhol Museum in Pittsburgh, said Mr. Warhol "never got explicit permission for any of the commercial products that he painted," including his famous portraits of the Campbell's Soup cans. Robyn Meredith, *Rock Hall of Fame Asserts Ownership of Image*, N.Y. TIMES, June 16, 1996, at 12A. On the other hand, Campbell's saw Mr. Warhol's silk-screen paintings "as a wonderful free promotional device." *Id.*

325. For example, Ralph Goings painted a blue pickup truck parked behind a country pool hall with a Pepsi-Cola sign hanging above it. Karen Lipson, *It's Not Real, It's Super-Realism*, NEWSDAY, Apr. 26, 1991, at 85. When asked what it meant, Goings replied, "[i]t means that you are looking at a depiction of a not-so-pretty pickup truck behind a not-so-pretty store." *Id.*

Big Apple.³²⁶ Keeley perceives his pictures as bits of Americana, historical records that give viewers an accurate sense of a certain time and place.³²⁷

D. *An Analogy to the Right of Publicity Demonstrates the Proper Standard for Using Trademarks in Artistic Works*

The idea that the right of publicity is a limited one in the face of a possible monopoly provides an apt analogy for courts to review when a trademark is appropriated for artistic expression.³²⁸ As with a celebrity's name and image, the public should be granted the right to use a trademark as a symbol, which might include using it in a work of art. Just as the celebrity loses the right to control her name, there is no interest in giving a trademark owner the power to control the uses of its name and image when not used for the intent of trademarks itself—to identify the origin of goods or services.³²⁹

Celebrity names, like trademarks and tradenames, are symbols which are part of our scheme of contemporary communication.³³⁰ Their name or image, as with a trademark, has assumed the status of a symbol.³³¹ Like the owner of a trademark, the celebrities themselves have invested time and energy in creating a “public persona.”³³² While courts

326. *Ken Keeley* (visited Nov. 1, 1996) <http://www.vivart.com/biographies/ken_keeley/>. The final paintings are not just faithful translations of these images but reconstructions devised by the artist that always include some whimsical or private code. *Id.* In one of his newest paintings, “Truth, Justice, and the Comics,” the author counted over 50 brand name products used to portray the reality and life likeness of a city corner newsstand. *Id.*

327. Gary Schwan, *Making Art News*, PALM BEACH POST, Apr. 24, 1994, at 1J.

328. See *supra* notes 171-82 and accompanying text.

329. It is well established in the area of defamation that individuals lose substantial protection for their reputation as they become public figures. See *Hustler Magazine, Inc. v. Falwell*, 486 U.S. 46, 50-52 (1988).

330. See Nicholas J. Jollymore, *Expiration of the Right of Publicity—When Symbolic Names and Images Pass Into the Public Domain*, 84 TRADEMARK REP. 125, 130 (1994).

331. *Id.*

332. *Id.* at 126.

have recognized that this effort should be rewarded by allowing the celebrity to commercially exploit her name or image,³³³ some courts have questioned whether it makes sense to give the celebrity a monopoly for the commercial exploitation of her persona to the exclusion of the general public.³³⁴ The consumers who purchase the celebrity's product create significant value by collectively forming a market.³³⁵ The mass media also contribute value as they disseminate the celebrity's name and image, creating the recognition which makes the public persona a thing of commercial value.³³⁶ Courts have held that when public usage has actually given meaning to the name or image of a famous person, the right of publicity should give way to the public's right to use the name or image as a symbol.³³⁷

E. Proposed Standard

While the above analysis might seem to permit every taking of trademarked names and images to further artistic ex-

333. See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992), cert. denied, 508 U.S. 951 (1993); *Presley's Estate v. Russen*, 513 F. Supp. 1339, 1355 (D.N.J. 1981); *Lugosi v. Universal Pictures*, 205 U.S.P.Q. (BNA) 1090 (Cal. Sup. Ct. 1979) (Bird, C.J., dissenting).

334. See *Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956 (6th Cir.), cert. denied, 449 U.S. 953 (1980). According to the *Memphis Development* court: Fame often is fortuitous and fleeting. It always depends on the participation of the public in the creation of an image. It usually depends on the communication of information about the famous person by the media. The intangible and shifting nature of fame and celebrity status, the presence of widespread public and press participation and its creation, the unusual psychic rewards and income that often flow from it during life and the fact that it may be created by bad as well as good conduct combine to create serious reservations about making fame the permanent right of a few individuals to the exclusion of the general public. *Id.* at 959; see also *White*, 971 F.2d at 1517 (Kozinski, J., dissenting); *Bi-Rite Enters. v. Button Master*, 555 F. Supp. 1188, 1194-96 (S.D.N.Y. 1983).

335. Nicholas J. Jollymore, *Expiration of the Right of Publicity—When Symbolic Names and Images Pass Into the Public Domain*, 84 TRADEMARK REP. 125, 126 (1994).

336. *Id.*

337. See *Friends of Phil Gramm v. Americans for Phil Gramm in '84*, 587 F. Supp. 769, 774 (E.D. Va. 1984); *Hicks v. Casablanca Records*, 464 F. Supp. 426 (S.D.N.Y. 1978).

pression, its application should be limited to photographs that are, in fact, artistically-oriented. While a legal standard for what constitutes “art” is inherently unworkable as in the mind of the beholder, an acceptable standard may be derived from another intellectual property regime—copyright law. The threshold requirements for copyrightability appear in Section 102(a) of the Copyright Act.³³⁸ Under the Copyright Clause of the United States Constitution, Congress may make laws to protect the “writings” of authors, and this requirement has been construed by the Supreme Court to mean any “physical rendering” of the fruits of the author’s creativity.³³⁹ However, because generally artistic works are usually fixed in a tangible meaning of expression, this prerequisite is not likely to present any difficulties.

Originality is the second prerequisite for federal or statutory copyright protection based upon the Copyright Clause’s provision for protection of authors’ writings.³⁴⁰ To qualify for copyright protection, a work must be original to the author.³⁴¹ Original, as the term is used in the statute, means only that the work was independently created by the author, as opposed to copied from other works, and that it possesses at least some minimal degree of creativity.³⁴² All that is needed to satisfy both the Constitution and the statute is that the author contributed something more than a “merely trivial” variation, something recognizably “his own.”³⁴³ In evaluating those works that might meet this standard, Justice Holmes warned that “[i]t would be a dangerous under-

338. 17 U.S.C.A. § 102(a) (West Supp. 1996). Specifically, the Copyright Act provides: “Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.” *Id.*

339. *Goldstein v. California*, 412 U.S. 546 (1973).

340. CRAIG JOYCE ET AL., COPYRIGHT LAW § 2.02 (3d ed. 1994).

341. *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 547-49 (1985).

342. *Feist Publications, Inc. v. Rural Tele. Serv. Co.*, 499 U.S. 340 (1991).

343. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951).

taking for persons trained only to the law to constitute themselves final judges of the worth or pictorial illustrations, outside of the narrowest and most obvious limits.”³⁴⁴

In *Burrow-Giles Lithographic Co. v. Sarony*,³⁴⁵ the Supreme Court held for the first time that photographs could be considered original works of art.³⁴⁶ The Court found that:

[The painting] is a useful, new, harmonious, characteristic, and graceful picture, and that plaintiff made the same . . . entirely from his own original mental conception, to which he gave visible form by posing the said Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other various accessories in said photograph, arranging the subject so as present graceful outlines, arranging and disposing the light and shade, suggesting and evoking the desired expression, and from such disposition, arrangement or representation, made entirely by plaintiff, he produced the picture in suit.³⁴⁷

Chuck Gentile made similar decisions when producing his original work. He visited the Museum several times before selecting the perfect shot, which, he decided, was just as the sun set on Lake Erie.³⁴⁸ In fact, the U.S. Copyright Office granted a copyright registration to Gentile for the photograph.³⁴⁹ Thus, because the photograph was independently created by the author, Gentile, and there was at the very least a modest quantum of creativity, the artistic expression meets the standard of originality.

Therefore, artistic works that contain previously trademarked names or images should be protected if they meet the prerequisites for copyright protection. While copyright

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

345. 111 U.S. 53 (1884).

346. *Id.* at 57.

347. *Id.* at 60.

348. Appellant's Brief at 3, *Rock & Roll* (No. 96-3759).

349. *Id.* at 5.

laws exist to encourage creative persons to produce new matter, this requirement presents a narrow area in which admittedly independent efforts by an author are deemed too trivial or insignificant to warrant copyright protection and the rights that flow from it. This modest standard will prevent freeriding on the goodwill of the trademark owner. Works that cannot meet the originality standard should not be entitled to the fair use or First Amendment defenses, as these protections should only be afforded to further artistic expression at the expense of the trademark owner. In addition, artistic expression will not be stifled by this standard because if the work cannot even meet the requirements of copyrightability, it does not meet the intent of the founding fathers for Congress “[t]o Promote the Progress of Science . . . by securing for limited Times to Authors . . . the exclusive Right to their . . . Writings”³⁵⁰

CONCLUSION

Intellectual property rights are not free; they are imposed at the expense of future creators and the public at large.³⁵¹ The rights given to a trademark owner should be limited in order to create richer public domain by allowing artists to build freely on the intellectual property of others. If successful, the legal action against Chuck Gentile could ultimately harm society in several ways. By ignoring the basic purpose of trademark law, the *Rock and Roll* decision threatens to in-

350. U.S. CONST. art. I, § 8.

351. *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1516 (9th Cir.), *cert denied*, 508 U.S. 951 (1993) (Kozinski, J., dissenting). According to Judge Kozinski:

Where would we be if Charles Lindbergh had an exclusive right in the concept of a heroic solo aviator? If Arthur Conan Doyle had gotten a copyright in the idea of the detective story, or Albert Einstein had patented the theory of relativity? If every author and celebrity had been given the right to keep people from mocking them or their work? Surely this would have made the world poorer, not richer, culturally as well as economically.

Id.

terfere with artistic expression and legitimate artistic commerce; it could make it impossible to depict a city skyline without obtaining entangling permissions and paying monetary tribute to building owners. With its potential to restrict the free flow of factual, educative, historical and artistic information to the public, the district court's decision also threatens to create case law that could eventually harm the way we communicate through visual imagery.

The current law ties the hands of commercial artists and designers, who cannot freely use images of buildings, brand names, or celebrities in their creative works offered for sale. Artists will be prevented from using some of the most powerful and evocative symbols of our time, either because consent will not be given or because it will be too difficult, financially or logistically, to obtain it. The idea that value should be wholly captured by purveyors or that anyone has the right to a marketplace purged of all sources of confusion, cannot be squared with intellectual property principles or with First Amendment values. As one commentator postulates:

If an artist paints a street scene with a Pontiac in the corner, should General Motors be entitled to 15 percent? If Norman Rockwell were still alive and painting his images of the America that never was, could a newspaper depicted as a bit of backdrop in its image as the Bennington Banner was in one of his paintings demand its piece of the action?³⁵²

Answers to the above should be a resounding "no," as such uses are a fair use of trademarks and should be fully protected by the First Amendment. Allowing Gentile to peddle his wares would be better for business and much more in tune with the freedom that underlies rock music. Indeed, "[i]f art is to nourish the roots of our culture, society must set the artist free to follow his vision wherever it takes

352. Lynch, *supra* note 1, at B1.

him.”³⁵³

353. John F. Kennedy, In Praise of Robert Frost, Address at Amherst College (Oct. 27, 1963).