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## NOTES

# Cocaine-Cola, the Velvet Elvis, and Anti-Barbie: Defending the Trademark and Publicity Rights to Cultural Icons

Steven M. Cordero\*

### INTRODUCTION

Imagine yourself in Houston—at home or on a trip—with nothing to do on a Saturday night. So you jump into the car to seek excitement in a world permeated with cultural symbolism, and you find that symbolism dominated this night by Cocaine-Cola, the Velvet Elvis, and Anti-Barbie.

You first encounter an assortment of posters, plastered on the wall next to your parking space, containing the phrase “Enjoy Cocaine” printed in classic Coca-Cola styling.<sup>1</sup> On the car radio, a painfully annoying helium voiced soprano sings, “I’m a Barbie Girl . . . life in plastic . . . it’s fantastic . . . you can brush my hair . . . undress me everywhere . . . I’m a blonde bimbo girl . . . in a fantasy world . . .”<sup>2</sup> Afterward, a commercial advertises the “Third Anniversary Blue Hawaiian Luau,” held by Houston’s well-known Velvet Elvis nightclub to commemorate the twentieth anni-

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1. *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1186 (E.D.N.Y. 1972) (enjoining manufacturer from producing a poster that read “Enjoy Cocaine” in Coca-Cola’s characteristic styling).

2. AQUA, *BARBIE GIRL* (MCA Records 1997); *Barbie Song as Popular as the Doll*, *HARRISBURG PATRIOT*, Sept. 19, 1997, at D2.

versary of Elvis Presley's "disappearance."<sup>3</sup>

The Velvet Elvis sounds like the antidote to your Saturday night blues. So you race to the admittedly tacky nightspot<sup>4</sup> and discover on stage San Francisco female Elvis impersonator Elvis Herselvis and Mojo Nixon, the post punk-rock performance artist best known for the song *Elvis is Everywhere*.<sup>5</sup> In the lounge area, a giddy couple admires a Trailer Trash Barbie doll,<sup>6</sup> part of the Anti-Barbie series that includes Exorcist Barbie, Hooker Barbie, and Big Dyke Barbie.<sup>7</sup>

Your night on the town in Houston demonstrates the pervasiveness of "popular culture" and its icons in American society.<sup>8</sup>

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3. Rick Mitchell, *Elvis' 'Disappearance' to be Celebrated; Luau, Bands, Impersonator to Mark Event*, HOUS. CHRON., Aug. 14, 1997, at 3. Elvis Aaron Presley "disappeared" on April 16, 1977. *In Memory of 'King' Elvis*, HOUS. CHRON., Aug. 15, 1997, at 3. The "Third Anniversary Blue Hawaiian Luau," which offered roast pig, Blue Hawaiian drinks, and a candlelight vigil with a moment of silence for the "King's disappearance," was held on August 16, 1997. Mitchell, *supra*, at 3.

4. The Velvet Elvis comes complete with lava lamps, cheap ceramic sculptures, beaded curtains, and vinyl furniture. *See* *Elvis Presley Enter., Inc. v. Capece*, 950 F. Supp. 783, 783 (S.D. Tex. 1996) (describing the Velvet Elvis nightclub).

5. *See* Mitchell, *supra* note 3, at 3.

6. Vicki Haddock, *Messin' with Barbie; Creator of Now-Famous Trailer Trash Version Says He's "Got a Hobby Gone Mad"*, S.F. EXAMINER, Jan. 12, 1997, at C1 [hereinafter Haddock I]. Trailer Trash Barbie comes complete with a cigarette dangling from her lip, a baby swinging from her hip, black roots beneath her platinum blonde hair, and a quote bubble that reads "My Daddy Swears I'm the Best Kisser in the County!" *See id.*

7. *Id.* The works are the creations of amateur artist Paul Hansen, and were displayed in art galleries and sold at "In-Jean-Ious," an apparel store on Castro Street, a center of the gay community in San Francisco. *Id.*; *see* David Armstrong, *The Castro; KQED's Latest Look at the City's Neighborhoods is the Best One Yet*, S.F. EXAMINER, Mar. 12, 1997, at B1.

8. According to one commentator, "popular culture" can be defined as:

[T]he culture of the subordinated and disempowered and thus always bears within it signs of power relations, traces of the forces of domination and subordination that are central to our social system and therefore to our social experience. . . . Popular culture . . . is culture—the active process of generating and circulating meanings and pleasures within a social system. . . . Popular culture is made by the people, not produced by the culture industry. All the culture industries can do is produce a repertoire of texts or culture resources for the various formations of the people to use or reject in the ongoing process of producing their popular culture.

JOHN FISKE, UNDERSTANDING POPULAR CULTURE 4-5, 23-24 (1989) [hereinafter POP CULTURE].

Yet each of those symbols you encountered during the night was used without authorization, thus creating potential infringements of the creators' trademark and publicity rights. The question, however, is whether the creators alone should have the rights to profit from the exploitation of those symbols, or whether those rights should be shared by the public whose patronage gives value to cultural icons.<sup>9</sup> First Amendment principles of free expression suggest that a new standard be required to allow uninhibited public use, absent confusion as to source, sponsorship or affiliation.<sup>10</sup>

Because Coca-Cola, Elvis Presley, and Barbie are elements of American popular culture, they are part of our everyday language.<sup>11</sup> Coca-Cola represents not only a beverage, but also America itself.<sup>12</sup> Elvis Presley was a not only celebrated musical entertainer, but also the embodiment of "Rock-n-Roll" and the focus of a cultural obsession.<sup>13</sup> Barbie is not only a doll, manufactured by

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9. 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) (arguing that a celebrity loses the right to control his image when it achieves symbolic significance).

10. See Arlen W. Langvardt, *Trademark Rights and First Amendment Wrongs: Protecting the Former Without Committing the Latter*, 83 TRADEMARK REP. 633, 634-35 (1993) [hereinafter Langvardt I] (proposing a standard for balancing trademark rights and freedom of expression).

11. See Jollymore, *supra* note 9.

12. See MARK PENDERGRAST, *FOR GOD, COUNTRY AND COCA COLA: THE UNAUTHORIZED HISTORY OF THE GREAT AMERICAN SOFT DRINK AND THE COMPANY THAT MAKES IT* 370-71 (1993). One commentator states that:

The American public . . . revered a drink that symbolized America, that was associated with almost every aspect of their lives—first dates, moments of victory and defeat, joyous group celebrations, pensive solitude. As a poetic Texas consumer had written in his 1985 love letter to the drink, "Whenever things began to look too bleak, I'd come over and pick [Coca-Cola] up, we'd share a few minutes together, and I would be comforted."

*Id.*

13. See *Estate of Elvis Presley v. Russen*, 513 F. Supp. 1339, 1345 (D.N.J. 1981). See GRIEL MARCUS, *DEAD ELVIS: A CHRONICLE OF A CULTURAL OBSESSION* (1991), for a history detailing the creation of the Elvis myth after his death and his impact on American culture. In August 1997, fifty-thousand Elvis fans from around the world gathered in Memphis, Tennessee to commemorate the twentieth anniversary of Elvis's death. See Jim Yardley, *50, 000 Honor Elvis: King is Dead; Long Live the King*, ATLANTA J. & CONST., Aug. 16, 1997, at O1. Similar to previous celebrations, the week-long commemoration included an Elvis Riverboat Cruise and Dance Party, an Elvis International Gold and Platinum Record Award Ceremony, an Elvis Fan Club President's Gala, a new

Mattel, Inc. and venerated by millions of fans, but also is a symbol of American sexism.<sup>14</sup>

Coca-Cola and Barbie as objects and Elvis as a celebrity, have transcended their original meanings and ascended to the level of cultural icons.<sup>15</sup> A cultural icon is an image, picture, or representation that is an external expression of a society's internal convictions.<sup>16</sup> Icons objectify deep mythic structures of reality, expressing everyday things that make every day meaningful.<sup>17</sup>

In our society, icons are created through a partnership of purveyor<sup>18</sup> and populace, whereby the purveyor of a commodity<sup>19</sup> supplies the product, and the consumer—through an active creative practice—appropriates it by investing the product with new meaning.<sup>20</sup> Cultural icons span generations, from Matures through Gen-

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Elvis statue, candle light vigil, and an Elvis lecture and Conversation. *See id.*

14. *See* M.G. LORD, *BARBIE: THE UNAUTHORIZED BIOGRAPHY OF A REAL DOLL* 89-90 (1994). According to one commentator:

[The National Organization for Women]'s formal assault on Mattel began in August 1971, when its New York chapter issued a press release condemning ten companies for sexist advertising. . . . Feminists followed up in February 1972 by leafleting at a Toy Fair . . . [alleging] that . . . Barbie encouraged girls to see themselves solely as mannequins, sex objects or housekeepers.

*Id.*

15. *See* Jollymore, *supra* note 9, at 141 (offering that certain celebrities such as Elvis, as cultural icons, "become such a locus of reference in contemporary communication that the mere invocation of their name or image conveys meaning"). Mattel promoted an art exhibit in 1995 entitled, "Art, Design, and Barbie: The Evolution of a Cultural Icon." Barbara D. Phillips, *Beyond Her Ken: The Art of the Doll*, WALL ST. J., Dec. 13, 1995, at A12; *see also* FREDERICK ALLEN, *SECRET FORMULA: HOW BRILLIANT MARKETING AND RELENTLESS SALESMANSHIP MADE COCA-COLA THE BEST-KNOWN PRODUCT IN THE WORLD* 424-25 (1994) (discussing the global impact of Coca-Cola as an icon).

16. *See* MARSHALL W. FISHWICK, *SEVEN PILLARS OF POPULAR CULTURE* 131 (1985) (defining cultural icon).

17. *See id.*

18. This Note uses the term "purveyor" to refer to the supplier of a product (either tangible, such as a soft drink or doll, or intangible, such as one's persona) who may or may not have a title or interest in the intellectual property associated with the product.

19. This Note uses the term "commodities" to refer to products that are either cultural (movie, musical, or video performance) or industrial (tangible item). *See* Michael Madow, *Private Ownership of the Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 139 (1993) (analyzing the publicity rights and the popular culture debate).

20. *See id.* at 140.

eration X.<sup>21</sup> Each generation invests its own meaning in the icons, regardless of whether the icons were inherited from preceding generations or newly created.<sup>22</sup> Consumers “recode” commodities in ways that better serve their particular needs and interests, and “re-work” them to express meanings different from the ones intended or preferred by their producers.<sup>23</sup> The consumers neither uniformly receive nor uncritically accept the “preferred meanings” that are generated and circulated by the purveyors.<sup>24</sup> Commentators have argued that there is a “realm of living common culture” in which individuals and groups use commodities creatively to do “symbolic work” and thereby “establish their presence, identity,

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21. The term, Generation X, now widespread, was first popularized to describe the generation born between 1964 and 1979, in DOUGLAS COUPLAND, *GENERATION X: TALES FOR AN ACCELERATED CULTURE* (1991). Commentators offer that Generation X, like other generations, was forged through common experience:

The [generation] described as “matures,” born from 1909 to 1945, was shaped by the Depression and World War II. “Boomers,” born from 1946 to 1964, grew up in affluence: economic progress was assumed, freeing them to focus on idealism and personal growth. [Generation X] grew up . . . [in] divorce, [as] latchkey kids, [with] homelessness, [s]oaring national debt, [b]ankrupt Social Security, [h]oles in the ozone layer, [c]rack, [d]ownsizing and layoffs, [u]rban deterioration, [g]angs, and [j]unk bonds . . . .

Margot Hornblower, *Great Xpectations Slackers? Hardly. The So-Called Generation X Turns Out to be Full of Go-Getters Who Are Just Doing It—But Their Way*, *TIME*, June 9, 1997, at 58.

22. For example, Generation X invests new meaning in commodities based on its members’ common experiences as defined through exposure to television. See ROBERT OWEN, *GEN X TV: THE BRADY BUNCH TO MELROSE PLACE* (1997), for a discussion of how the identity and culture of this generation was defined by the media saturation from the 1970’s until the present. One commentator argues that:

[Generation] Xers are all members of one TV nation. Although not the first group of Americans to grow up on TV, Xers are the first group for whom TV served as a regularly scheduled baby-sitter. [Generation X] was the first to experience MTV and the Fox network, and they are an audience many advertisers are eager to reach. Xers are the most media-savvy generation ever.

*Id.* at 5.

23. See *id.* at 139. Proponents of this view, entitled “cultural populism,” are writers associated with or influenced by the British “cultural studies” movement. See, e.g., IAIN CHAMBERS, *POPULAR CULTURE: THE METROPOLITAN EXPERIENCE* (1986) (analyzing cultural populism); JOHN FISKE, *READING THE POPULAR* (1989) [hereinafter *READING THE POPULAR*] (same); JOHN FISKE, *TELEVISION CULTURE* (1987) [hereinafter *TV CULTURE*] (same); ANDREW ROSS, *NO RESPECT: INTELLECTUALS AND POPULAR CULTURE* (1989) (same); PAUL WILLIS ET AL., *COMMON CULTURE: SYMBOLIC WORK AT PLAY IN THE EVERYDAY CULTURES OF THE YOUNG* (1990)(same).

24. See Madow, *supra* note 19, at 139.

and meaning.”<sup>25</sup>

Rights holders<sup>26</sup> control the image or representation of commodities through the legal regime of trademark law and the right of publicity. The word “Coca-Cola” is a trademark, as is any word, name, symbol, or device employed by a manufacturer or a merchant to identify her goods and to distinguish them from those of another.<sup>27</sup> Elvis Presley’s right of publicity is the same as the inherent right of every human being to control the commercial use of his or her identity.<sup>28</sup> Although trademark law protects consumers from confusion due to false or misleading marks,<sup>29</sup> publicity rights

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25. WILLIS, *supra* note 23, at 1-2; *see also* CHAMBERS, *supra* note 23, at 53-54 (demonstrating how urban street “style” is achieved “through the creative bricolage of ordinary commodities”).

26. The term “rights holder,” as used in this Note, refers to any party, person, or corporation who has an interest or title in an object of intellectual property, such as a trademark or persona. For example, Coca-Cola Company is the rights holder of the trademark “Coca-Cola”; Mattel Incorporated is the rights holder of the trademark “Barbie”; and Elvis Presley Enterprises is the rights holders of not only the trademark “Elvis” but also his publicity rights. *See infra* Part II (detailing briefly, the origins and efforts of rights holders to defend the images of Coca-Cola, Elvis Presley, and Barbie).

27. *See* 15 U.S.C.A § 1127 (West Supp. 1996); *see also* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 (1995); *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.NY. 1988). The *Restatement* elaborates in the commentary:

The definition of “trademark” . . . does not incorporate any technical limitations on the nature of the subject matter that may qualify for protection. Words remain the most common type of trademark . . . . Numbers, letters, and slogans are also eligible for protection as trademarks, as are pictures, symbols, characters, sounds, graphic designs, product and packaging features, and other matter capable of identifying and distinguishing the goods or services of the user.

RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 cmt. g (1995).

28. *See* J. Thomas McCarthy, *Melville B. Nimmer and the Right of Publicity: A Tribute*, 34 U.C.L.A. L. REV. 1703, 1704 (1987) [hereinafter McCarthy I]. Professor McCarthy states that:

The modern view of the right of publicity is that it is an inherent right of identity possessed by everyone at birth. . . . [N]oncelebrities do indeed have a right of publicity. Noncelebrities should not be locked into the “mental distress” mold of privacy law—a constraint that forces them to limit their complaint to proof of hurt feelings and mental distress, buttressed by stories of sleepless nights and psychiatric care. If these plaintiffs only want the fair market value of their identity, then the right of publicity should be available.

*Id.* at 1710.

29. *See* S. REP. NO. 79-1333 (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274, 1274. Senate Report 1333 states 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

protect the person from the commercial appropriation of his or her persona.<sup>30</sup> A separate basis for trademark protection is the anti-dilution doctrine, whereby a trademark owner such as Mattel, Inc. is protected against the diminishment in value of a mark such as “Barbie.”<sup>31</sup>

The First Amendment<sup>32</sup> provides a limitation for imposing liability for trademark infringement, anti-dilution, and appropriation of publicity rights for some forms of expression.<sup>33</sup> Although the Supreme Court has acknowledged that the freedom of expression has relevance under trademark law,<sup>34</sup> the Court’s most significant contribution to resolving the issue of constitutional ramifications in private actions, was the defamation case *New York Times v. Sullivan*.<sup>35</sup> In *Sullivan*, the Court recognized that when a private liti-

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amended at 15 U.S.C.A. §§ 1051-1127 (West 1998 & Supp. 1998)), 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 asks for and wants to get.” S. REP. NO. 79-1333, reprinted in 1946 U.S.C.C.A.N. 1274, 1274; see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 44-49 (1995); *infra* Part I.C (discussing the right of publicity).

30. See 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28:1 (4th ed. 1997) [hereinafter MCCARTHY, TRADEMARKS]. Professor McCarthy argues that the right of publicity is “infringed by the unpermitted use which will likely damage the commercial value of this inherent right of human identity and which is not immunized by principles of free speech and free press.” *Id.*

31. See *id.* § 24:95. Professor McCarthy states that:

Dilution by tarnishment, along with “blurring,” comprises the two classic prongs of dilution. . . . After tarnishment, a famous mark still uniquely identifies a certain source, but the mark no longer uniquely identifies a certain degree or quality and favorable reputation. The positive associations the mark identifies are corroded and diluted by the tarnishing use.

*Id.*

32. The First Amendment reads, in pertinent part, “Congress shall make no law . . . abridging the freedom of speech, or of the press . . . .” U.S. CONST. amend. I.

33. See 4 MCCARTHY, TRADEMARKS, *supra* note 30, § 28:40; Langvardt I, *supra* note 10 (proposing a standard for balancing trademark rights and freedom of expression); Siegrun D. Kane, *Trademark Infringement Litigation 1997: Sense & Sensibility*, 559 PLI/LIT. 361, 399 (1997).

34. See *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522, 527 (1987) (stating that the United States Olympic Committee’s property right in the word “Olympic” and associated symbols and slogans may be protected without violating the First Amendment); *Friedman v. Rogers*, 440 U.S. 1, 11 (1979) (holding that the regulation of trade names is to be judged under the standards governing commercial speech).

35. 376 U.S. 254, 265 (1964). One commentator asserts that:



gant invokes the courts to enforce rules of law, there is sufficient government action to elicit First Amendment scrutiny.<sup>36</sup> Those constitutional principles prevent rights holders from attempting to stifle speech under the guise of intellectual property rights.<sup>37</sup>

Rights holders have attempted to use the more expansive doctrines of anti-dilution and the right of publicity to inhibit the public, through artists and advertisers, from utilizing cultural icons.<sup>38</sup> The use of Coca-Cola, Elvis, and Barbie by artists, such as Andy Warhol, has been protected against the ownership interests of rights holders under First Amendment principles regarding artistic expressions, implicit in the fair use exception to trademark law and the parody defense.<sup>39</sup> Others, using such images in a commercial

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[S]tate recognition and enforcement of private rights touching forms of communication is itself sufficient to subject the resulting exercises of private power to constitutional scrutiny . . . . Perhaps the most familiar example is the line of United States Supreme Court decisions commencing with *New York Times Co. v. Sullivan*. . . . In that case . . . [d]espite the fact that the role of the state was limited to the enforcement of private rights, the Court showed no hesitation in subjecting the entire regime to constitutional inspection. . . . *New York Times* . . . concerned the limitations imposed by the First Amendment upon state doctrines restricting forms of expression that might intrude upon personal rights. Similar constitutional limitations operate with respect to state-ordained property rights.

Robert C. Denicola, *Trademark as Speech: Constitutional Implications of the Emerging Rationales for the Protection of the Trade Symbols*, 1982 WIS. L. REV. 158, 207 (1982).

36. *Sullivan*, 376 U.S. at 265. The Supreme Court reasoned that:

[T]he Alabama courts have applied a state rule of law which petitioners claim to impose invalid restrictions on their constitutional freedoms of speech and press. It matters not that that law has been applied in a civil action and that it is common law only. . . . The test is not the form in which state power has been applied but, whatever the form, whether such power in fact has been exercised.

*Id.*

37. See, e.g., *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 886 F.2d 490, 496 (2d Cir. 1989) (holding that the First Amendment interest in free expression outweighed the slight risk of consumer confusion under trademark law); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 28 (1st Cir. 1987) (holding that the application of Maine's anti-dilution statute to magazine's non-commercial parody of plaintiff's trademark violated the First Amendment); *Rogers v. Grimaldi*, 875 F.2d 994, 996 (2d Cir. 1985) (holding that the use of plaintiff's name in a movie title was protected under the First Amendment).

38. See Madow, *supra* note 19, at 142 (analyzing the publicity rights and the popular culture debate); Jollymore, *supra* note 9, at 130-35 (arguing that a celebrity loses the right to control his or her image when it achieves symbolic significance).

39. See George Vetter & Christopher C. Roche, *The First Amendment and the Art-*

context or in a gaudy manner, have not been afforded protection.<sup>40</sup> These unequal outcomes have resulted from courts' failures to recognize the First Amendment implications, misunderstanding of the cultural significance of icons, failures to acknowledge the consumer-public's substantial role in the ascendancy of the image, and reliance on a commercial/non-commercial speech distinction that one pioneering commentator labeled "irrational" and fundamentally flawed.<sup>41</sup>

This Note argues that in order to facilitate First Amendment principles of freedom of expression, a new standard should apply to cases dealing with the unauthorized use of cultural icons, permitting uninhibited use so long as there is no confusion as to source, sponsorship, or affiliation. Part I reviews trademark law, publicity rights, and First Amendment implications. Part II presents the history and efforts of rights holders who have attempted to protect the images of Coca-Cola, Elvis, and Barbie. Part III maintains that a likelihood of confusion standard is appropriate as a result of balancing the interests of rights-holders and the public. This Note concludes that courts should use the proposed new stan-

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*ist—Part I*, R.I. B.J., Mar. 1996, at 7. According to some commentators:

An artist's freedom to use the icons against such legal protections [as trademark, copyright, and the rights of privacy and publicity] ties into First Amendment concerns. . . . Andy Warhol's Cambell Soup Cans, "Double Elvis," and John Wayne portraits make powerful statements about art and our consumerist/fame based society. Other artists incorporate similar icons from culture-corporate logos, famous faces, and golden political calves.

*Id.*; see also *infra* Part III.A.3 (discussing the limitations of the fair use and parody defense to trademark infringement).

40. See, e.g., *Dallas Cowboys Cheerleaders v. Pussycat Cinema*, 604 F.2d 200, 205 (2d Cir.1979) (reasoning that it would be difficult for those who viewed defendant's "sexually depraved" film to disassociate it thereafter with the Dallas Cowboy Cheerleaders); *Mutual of Omaha Ins. v. Novak*, 775 F.2d 247, 250 (finding against the maker of "Mutant of Omaha" merchandise protesting the arms race).

41. Martin H. Redish, *First Amendment Theory and the Demise of the Commercial Speech Distinction: The Case of the Smoking Controversy*, 24 N. KY. L. REV. 553, 565 (1997); Robert J. Shaughnessy, *Trademark Parody: A Fair Use and First Amendment Analysis*, 77 TRADEMARK REP. 177, 204-206 (1987). One commentator argues that "commercial speech serves the values of free speech protection as much or more than does any category of fully protected expression. . . . Today, careful examination reveals that without question, none of the remaining arguments relied upon to justify commercial speech's second class status justifies the distinction's continued existence." Redish, *supra*, at 565.

standard to achieve equitable results when resolving conflicts over the unauthorized uses of images or representations of cultural icons.

### I. TRADEMARKS, PUBLICITY RIGHTS AND THE FIRST AMENDMENT

The use of identifying marks on goods dates to antiquity, with the original purpose being to indicate ownership.<sup>42</sup> In the United States, marks distinguishing merchandise have a long history of protection under the common law and state statutes.<sup>43</sup> Yet federal trademark law has only met success in the twentieth century.<sup>44</sup> In contrast, the right of publicity, despite allusion to in earlier cases,<sup>45</sup> was not recognized for the first time until 1953.<sup>46</sup>

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42. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 cmt. b. According to the American Law Institute, the use of trademarks date to ancient times:

The use of trademarks was well known in Roman times, although it was apparently left to the defrauded purchaser to bring an action against a trademark infringer. The guild system of medieval England produced the first widespread use of trademarks. Distinctive production marks were required on goods manufactured by the local guilds. Manufacturers began to adopt marks expressly for the purpose of identifying their goods to prospective customers. The medieval production mark thus evolved into the modern trademark used by manufacturers, distributors, and other sellers to identify their goods and services in the marketplace.

*Id.*

43. See *Trade-Mark Cases*, 100 U.S. 82, 92 (1879) (“The right to adopt and use a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has long been recognized by the common law . . .”); *Walton v. Crowley*, 29 F. Cas. 138 (C.C.S.D.N.Y. 1856) (No. 17,133) (preventing the sale of sewing needles packaged under counterfeit replicas of a competitor’s labels); *Coffen v. Brunton*, 5 F. Cas. 1184 (C.C.D. Ind. 1849) (No. 2,946) (holding that the law prevents the adoption of another’s mark or label when it prevents the public from distinguishing between competitors’ products); *Taylor v. Carpenter*, 23 F. Cas. 744 (C.C.D. Mass. 1846) (No. 13,785) (preventing the sale of thread bearing counterfeit replicas of a competitor’s trademarks).

44. See 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) (detailing the pre-history of the Lanham Act).

45. See, e.g., *Uproar Co. v. NBC*, 8 F. Supp. 358, 361 (D. Mass. 1934) (ruling that the commercial value of a celebrity’s name for advertising purposes can create rights of a pecuniary nature), *modified*, 81 F.2d 373 (1st Cir.), *cert. denied*, 298 U.S. 670 (1936); *Wood v. Lucy, Lady Duff-Gordon*, 118 N.E. 214 (N.Y. 1917) (enforcing an agency agreement for the marketing of a celebrity’s endorsements).

46. See *Haelan Lab., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953); see also *Madow*, *supra* note 19, 147-48 (arguing that the right of publicity is not a new right for a new wrong because the commercial exploita-

### A. Trademark Doctrine

Intellectual property law offers authors and inventors protection for their intellectual creations.<sup>47</sup> Intellectual property law's principle objective is to grant those originators of information a limited monopoly in the form of patents, copyrights, and trademarks.<sup>48</sup> These legal instruments are similar in that they safeguard innovation, but differ in their purpose for protection.<sup>49</sup> For example, although patent and copyright protection is afforded to encourage and reward creative expression and innovation, trademark protection's goal is to protect owners and the public from unfair competition and prevent consumer confusion.<sup>50</sup> This qualified protection of trademarks is viewed as "a general attempt to implement standards of commercial morality and fair dealing in the market."<sup>51</sup>

Traditionally, the law has afforded a trademark owner only a

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tion of celebrities has existed since the eighteenth century).

47. See *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); see also Tara J. Goldsmith, Note, *What's Wrong with this Picture? When the Lanham Act Clashes with Artistic Expression*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L. J. 821, 826 (1997).

48. 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); see also *Mazer v. Stein*, 347 U.S. 201 (1954) (“[Copyright, unlike a patent], gives no exclusive rights to the art disclosed; protection is given only to the expression of the idea—not to the idea itself.”); *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.”); 1 MCCARTHY, *supra* note 30, § 6:7 (stating that patent law deals with the concept of functional and design inventions, and grants monopolies in order to encourage investment in new technology and invention).

49. See Goldsmith, *supra* note 47, at 827.

50. See JANE C. GINSBURG ET AL., *TRADEMARK AND UNFAIR COMPETITION LAW* 53 (2d ed. 1996) (summarizing the distinction between trademarks, copyrights, and patents); see also *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 98 (1918) (“[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.”); *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 413 (1916).

51. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 cmt. c; see also Goldsmith, *supra* note 47, at 827.

limited right to prevent another's appropriation of his or her property.<sup>52</sup> Early trademark law focused on preventing deception in the market place.<sup>53</sup> Its origin can be traced to the common law action for deceit, whereby a member of the public would claim that she was deceived into buying a merchant's product through the latter's misleading adoption of a competitor's trademark.<sup>54</sup> The trademark owner itself was powerless to prevent unauthorized use of the mark.<sup>55</sup> Eventually, courts of equity began to allow the trademark owner to obtain injunctive relief against a competitor's use of the mark.<sup>56</sup>

Early in this century, a trademark owner's right to prevent another's use of the mark extended only to situations in which consumers were led to believe that the owner's product originated with the trademark owner.<sup>57</sup> Courts eventually disregarded the requirement of actual confusion<sup>58</sup> in favor of a likelihood of confusion model.<sup>59</sup> In the last twenty years, the doctrine has expanded still further, to forbid unauthorized uses that elicit a public percep-

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52. See, e.g., Trade-Mark Cases, 100 US 82, 92-94 (1879); see also Denicola, *supra* note 35, at 159 (noting the increased tendency of courts to treat trademarks as property); Shaughnessy, *supra* note 41, at 180 (discussing the confusion doctrine of trademark protection).

53. See Daniel M. McClure, *Trademarks and Unfair Competition: A Critical History of Legal Thought*, 69 TRADEMARK REP. 305, 310-26 (1979) (detailing the historical developments of the idea that trademarks are intangible property).

54. See *id.* at 311.

55. See *id.*

56. See *id.* at 313.

57. See, e.g., *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924) (Holmes, J.) ("A trademark only gives the right to prohibit the use of it so far as to protect the owner's good will against the sale of another's product as his."); see also Shaughnessy, *supra* note 41, at 180 (detailing the history of trademark protection).

58. See, e.g., *Standard Oil Co. of N.M., Inc. v. Standard Oil Co. of Cal.*, 56 F.2d 973, 980 (10th Cir. 1932) (holding that a senior corporation is protected against the use of a confusingly similar name by junior user, though businesses are dissimilar, where confusion as to identity is likely to injure business reputation).

59. See 3 MCCARTHY, TRADEMARKS, *supra* note 30, § 23:1 (discussing the likelihood of confusion model). In determining whether a likelihood of confusion exists, courts generally consider the factors enunciated in the influential case, *Polaroid Corp. v. Polaroid Electronics Corp.*, 287 F.2d 492, 495 (2d Cir. 1961), that is, (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. *Id.*

tion of the trademark owner's approval or sponsorship.<sup>60</sup> Despite those developments, consumer confusion remains the basis for legal protection afforded to trademark owners.<sup>61</sup>

Modern economic analysis emphasizes additional interests underlying the protection of trademarks.<sup>62</sup> The public-benefits afforded by competitive markets cannot be fully realized unless prospective consumers can differentiate the products of competing sellers.<sup>63</sup> In the absence of effective trademark protection, individual sellers gain little from improvements in product quality or service because they cannot benefit from a favorable consumer response.<sup>64</sup> The protection of trademarks, thus, encourages investment in quality and service by securing to the trademark owner the benefits of a favorable reputation.<sup>65</sup>

The economic analysis that has been invoked to support a vigorous system of trademark protection, as well as trademark law itself, has not gone unquestioned. Some argue that strong trademarks act as barriers to market-entry for new competitors and also enable trademark owners to escape the full rigors of competition through product differentiation and irrational brand loyalty sustained by advertising.<sup>66</sup> There is also a growing concern that trademark law is being expanded beyond the boundaries of its in-

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60. See, e.g., *Kentucky Fried Chicken Corp. v. Diversified Packaging Corp.*, 549 F.2d 368, 386-90, (5th Cir. 1977). This expansion reflects the relatively recent rise of trademark licensing, which allows a trademark owner to authorize another party to use the mark. See generally 2 MCCARTHY, TRADEMARKS, *supra* note 30, §§ 18.13-18.22 (discussing trademark licensing and franchising agreements).

61. See Shaughnessy, *supra* note 41, at 181 (examining consumer confusion and trademark infringement).

62. See William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 269-70 (1987). According to Landes and Posner:

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.' . . . The value of a trademark is the saving in [consumer] search costs made possible by the information or reputation that the trademark conveys . . . .

*Id.*; see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 cmt. c.

63. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9.

64. See *id.*

65. See *id.*

66. See *id.*

tended purpose.<sup>67</sup>

### B. *The Lanham Act*

Trademarks do not enjoy the same constitutional foundation<sup>68</sup> as patents and copyrights.<sup>69</sup> The Supreme Court has expressly held that the Patent and Copyright Clause of the Constitution does not encompass trademark protection.<sup>70</sup> Trademark protection, on the other hand, is grounded in the common law.<sup>71</sup> Following this common law underpinning, and basing its legislation on the Commerce Clause,<sup>72</sup> Congress enacted trademark statutes in the late nineteenth and early twentieth century that ultimately proved unsuccessful.<sup>73</sup> Finally, after years of delay, Congress passed the

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67. See Goldsmith, *supra* 47, at 827 (discussing the extension trademark protection); see also *Huber Baking Co. v. Stroehmann Bros.*, 252 F.2d 945, 955 (2d Cir. 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.”); *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).

68. See Kenneth L. Port, *Foreword to Symposium on Intellectual Property Law Theory*, 68 CHI.-KENT L. REV. 585, 594 (1993); Horwitz & Levi, *supra* note 44, at 61 (explaining that the Supreme Court, in *The Trade-Mark Cases*, struck down Congress’s first incursion into federal trademark law, due to the lack of an express Constitutional power).

69. See 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 Rights to their respective Writings and Discoveries.”).

70. 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). The Supreme Court’s justification was based on the rationale that trademark protection does not “depend upon novelty, invention, discovery, or any work of the brain.” *Id.* Such protection is based “simply . . . on priority of appropriation.” *Id.*; Goldsmith, *supra* note 47, at 829 (discussing the origins of the Lanham Act).

71. See *The Trade-Mark Cases*, 100 U.S. at 86.

72. See U.S. CONST. art. 1, § 8, cl. 3 (“Congress shall have the Power . . . [t]o regulate commerce with foreign nations, and among the several states, and with the Indian tribes.”). See generally Malla Pollack, *Unconstitutional Incontestability? The Intersection of the Intellectual Property and Commerce Clauses of the Constitution: Beyond a Critique of Shakespeare Co. v. Silstar Corp.*, 18 SEATTLE U. L. REV. 259, 260 (1995) (maintaining that the Constitution prevents Congress from providing authors or inventors exclusive rights unbounded by time limitations).

73. See Horwitz & Levi, *supra* note 44, at 61-62 (examining the history of trademark law). The first statute to follow *The Trade-Mark Cases* was an 1881 act that limited federal trademark registration to marks used in commerce with foreign nations or the

Lanham Act on July 5, 1946, repealing the prior statutes.<sup>74</sup>

The Lanham Act defines a trademark as “any word, name symbol, or device or any other combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.”<sup>75</sup> The Lanham Act is founded on the principal that it is not equitable for a party to use a unique symbol and to trade on another party’s goodwill and reputation to promote his or her own goods or services, when the other party has expended resources to develop an identification for his or her product.<sup>76</sup>

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Indian tribes. See Act of Mar. 3, 1881, ch. 138, 21 Stat. 502 (repealed 1946). That statute was followed by another trademark law in 1905 and a particularly broader statute in 1920. See Act of Feb. 20, 1905, ch. 592, 33 Stat. 724 (repealed 1946); Act of Mar. 19, 1920, ch. 104, 41 Stat. 533 (repealed 1946).

74. See Horwitz & Levi, *supra* note 44, at 63; see also discussion *supra* note 29 and accompanying text (referring to the legislative history of the Lanham Act).

75. 15 U.S.C.A. § 1127 (West 1998 & Supp. 1998); 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. See 1 MCCARTHY, *supra* note 30, §§ 5.3-5.4 (discussing the origins of the Lanham Act).

76. See, e.g., *Frisch’s Restaurant v. Shoney’s Inc.*, 759 F.2d 1261, 1264 (6th Cir. 1985) (“Congress enacted the Lanham Act to make ‘actionable the deceptive and misleading use of marks in . . . commerce . . . [and] to protect persons engaged in such commerce against unfair competition.’”); *Federal-Mogul Bower Bearings, Inc. v. Azoff*, 313 F.2d 405, 409 (6th Cir. 1963) (“[T]he primary purpose of the [Lanham] Act was to eliminate deceitful practices in interstate commerce involving the misuse of trademarks, . . . [and] to eliminate other forms of misrepresentations which are of the same general character even though they do not involve any use of what can technically be called a [trademark].”); *Eastern Wine Corp. v. Winslow-Warren, Ltd.*, 137 F.2d 955, 958 (2d Cir. 1943) (stating that the “public interest” behind trademark protection and unfair competition law is the “preservation of honesty and fair dealing in business”); *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412-413 (1916) (“The redress that is accorded in trademark cases is based upon the party’s right to be protected in the good will of a trade or business.”); 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. 1968); *Goldsmith*, *supra* note 47, at 829 (examining the rationale behind the Lanham Act).



## 1. Trademark Infringement

The Lanham Act's expansive reach is due in part to the growing prominence of section 43(a) ("section 43(a)").<sup>77</sup> Initially, section 43(a) was interpreted as forbidding only "passing-off,"<sup>78</sup> or the infringement or unauthorized use of a trademark.<sup>79</sup> Expansive judicial interpretation and Congressional amendments have enlarged section 43(a) into an instrument for prohibiting infringement of common law marks,<sup>80</sup> trade dress infringement,<sup>81</sup> false advertising,<sup>82</sup>

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77. 15 U.S.C.A. § 1125(a)(1). Section 43(a) states, in relevant part:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is likely to be damaged by such act.

*Id.*; see also Horwitz & Levi, *supra* note 44, at 59 (quoting section 43(a) as enacted).

78. The early common law of trademark prevented only "passing off," that is, palming off one producer's goods as those of another. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 cmt. d. The term "passing off" is now used more broadly to describe any situation in which the conduct of a seller creates a likelihood that prospective purchasers will be confused as to the source of the goods or services. See *id.* at § 4, cmt. b.

79. See Horwitz & Levi, *supra* note 44, at 64 (examining the early years of section 43(a)).

80. See *Idling v. Anaston*, 266 F. Supp. 1015, 1019 (N.D. Ill. 1967) (holding that "infringement of a common law service mark is cognizable under [section] 43(a) . . . where the mark or goods are in some way caused to enter into interstate commerce").

81. See *Two Pesos, Inc. v. Taco Cabana, Inc.* 505 U.S. 763, 769, 774 (1992) (finding that inherently distinctive trade dress is protectable under section 43(a) without proof of secondary meaning); *Eastman Kodak Co. v. Royal-Pioneer Paper Box Mfg. Co.*, 197 F. Supp. 132 (E.D. Pa. 1961) (granting injunctive relief under section 43(a) against the defendant's use of packaging which constituted an unfair use of plaintiff's trade dress).

82. See *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1109 (9th Cir. 1992) ("[S]imple claims of false representations in advertising are actionable under section 43(a) when brought by competitors of the wrongdoer, even though they do not involve misuse of a trademark.").

and other practices falling within the realm of “unfair competition.”<sup>83</sup>

Section 43(a) protects both registered<sup>84</sup> and unregistered trademarks,<sup>85</sup> where the use may constitute a false designation of origin, sponsorship, or approval.<sup>86</sup> Courts have applied section 43(a) to protect a variety of unregistered or common law marks or trade names,<sup>87</sup> abandoned marks that are reused,<sup>88</sup> and marks that have been denied registration.<sup>89</sup> Congress codified the judicial interpretations of section 43(a) with respect to false designation of origin, in the Trademark Law Revision Act of 1988.<sup>90</sup>

Section 43(a) not only prohibits trademark infringement, but also provides protection against the use of any false designations of origin or false descriptions.<sup>91</sup> It is generally accepted that, under

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83. See Horwitz & Levi, *supra* note 44, at 64 (discussing the role of section 43(a) in enforcing rights encompassed within the term “unfair competition”).

84. See, e.g., *Guess? v. Mai-Tai Boutique*, 7 U.S.P.Q. 2d (BNA) 1387 (S.D.N.Y. 1988) (protecting the plaintiff’s registered trademarks).

85. See *Two Pesos*, 505 U.S. at 768; see also *Boston Prof’l Hockey Ass’n v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1010 (5th Cir. 1975) (“Under [section 43(a)], the registration of a mark is not a prerequisite of recovery . . .”).

86. See 15 U.S.C.A. § 1125(a)(1) (West 1998 & Supp. 1998); see also *Meier Co. v. Albany Novelty Mfg., Co.*, 236 F.2d 144, 147 (2d Cir. 1956) (holding that unregistered or common law trademarks fall within the scope of section 43(a)).

87. See, e.g., *Scarves by Vera, Inc. v. United Merchants & Mfrs., Inc.*, 173 F. Supp. 625 (S.D.N.Y. 1959) (granting section 43(a) protection to “Jollitop” women’s blouses because that brand name had become widely known as the plaintiff’s exclusive trademark).

88. See, e.g., *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, 817 F. Supp. 1103, 1131-33 (S.D.N.Y. 1993) (holding that reuse does not cure abandonment of a trademark, but instead generates new, albeit limited, trademark rights from the date of reuse), *vacated pursuant to settlement*, 859 F. Supp. 80 (S.D.N.Y. 1994), *cited in* *L. & J.G. Stickley, Inc. v. Canal Dover Furniture Co.*, 79 F.3d 258 (2d Cir. 1996); *Sutton Cosmetics (P.R.), Inc. v. Lander Co.*, 455 F.2d 285, 288 (2d Cir. 1972) (stating that the first bona fide user of an abandoned mark acquires trademark rights in the areas in which he uses the mark).

89. See, e.g., *Sweetheart Plastics, Inc. v. Detroit Forming, Inc.*, 743 F.2d 1039 (4th Cir. 1984) (allowing a plastics manufacturer to claim trademark protection for its banana split and ice cream sundae dishes, even though trademark registration had been denied).

90. Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935 (effective Nov. 16, 1989); see also Horwitz & Levi, *supra* note 44, at 69 (detailing Congressional codification of the Trademark Revision Act of 1988).

91. Section 43(a) prohibits “false or misleading description of fact, or false or misleading representation of fact, which . . . in commercial advertising or promotion, misrep-

section 43(a), false or misleading descriptions or representations of fact cover statements that are literally false, as well as statements that, although literally true, create false impressions.<sup>92</sup>

## 2. Trademark Dilution

Dilution, in contrast to trademark infringement, is the diminishment over time of the capacity of a distinctive trademark to identify the source of goods bearing that mark.<sup>93</sup> Dilution may occur even in the absence of consumer confusion, with damage manifesting itself in the harm to the mark.<sup>94</sup> A weakening or reduction in the ability of a mark to effectively distinguish one source can arise either by “blurring” or “tarnishment.”<sup>95</sup> Blurring occurs when a distinctive mark is associated with a plethora of different goods and services, diminishing the uniqueness and distinctiveness of the mark.<sup>96</sup> Tarnishment occurs when the effect of the unau-

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resents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities.” 15 U.S.C. § 1125(a)(1).

92. *Id.*; see also *S.C. Johnson & Son, Inc. v. Clorox Co.*, 930 F. Supp. 753, 779 (E.D.N.Y. 1996) (stating that section 43(a) covers either advertisements that are literally false, or though literally true, are likely to mislead and confuse); *Mutation Mink Breeders Ass'n v. LOU Nierenberg Corp.*, 23 F.R.D. 155, 162 (1959) (stating that the likelihood of public deception is an issue of fact to be resolved by considering all relevant circumstances).

93. See 3 MCCARTHY, TRADEMARKS, *supra* note 30, § 24:70 (analyzing trademark dilution); 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) (detailing the pre-history of the Federal Trademark Dilution Act).

94. 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”).

95. 3 MCCARTHY, TRADEMARKS, *supra* note 30, § 24:67 (discussing blurring and tarnishment under trademark dilution).

96. See *id.* at §24:68; see also *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1031 (2d Cir. 1989) (blurring involved the “whittling away of an established trademark's selling power and value through its unauthorized use by others upon dissimilar products”). The Second Circuit has articulated six factors in considering the likelihood of dilution caused by blurring “(1) similarity of the marks; (2) similarity of the products covered by the marks; (3) sophistication of consumers; (4) predatory intent;

thorized use is to tarnish or degrade positive associations of the mark, thereby diluting its distinctive quality.<sup>97</sup>

Dilution was not actionable under federal law prior to the Federal Trademark Dilution Act of 1995 (“Dilution Act”).<sup>98</sup> Dilution was actionable, however, under state law in approximately half of the states.<sup>99</sup> Under state statutes, a plaintiff can establish dilution by demonstrating that its trademark is distinctive and that the defendant’s mark was likely to dilute the plaintiff’s mark.<sup>100</sup> The Dilution Act, on the other hand, applies protection only to “famous” marks.<sup>101</sup> The rationale for granting protection only to “famous”

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(5) renown of the senior mark; and (6) renown of the junior mark.” *Mead Data*, 875 F.2d at 1035 (Sweet, J., concurring).

97. See *Hormel Foods Corp v. Jim Henson Prods.*, 73 F.3d 497, 504 (2d Cir. 1996) (“The sine qua non of tarnishment is a finding that plaintiff’s mark will suffer negative associations through defendant’s use); 3 MCCARTHY, *supra* note 30, § 24:95 (analyzing tarnishment).

98. Pub. L. No. 104-98, 109 Stat. 985 (1996) (codified at 15 U.S.C.A. §§ 1125(c), 1127 (West 1998 & Supp. 1998)).

99. See ALA. CODE § 8-12-17 (1984); ARK. CODE ANN. § 70-550 (Michie 1987); CAL. BUS. & PROF. CODE § 14330 (West 1986); CONN. GEN. STAT. ANN. § 35-11i(c) (West 1981); DEL. CODE ANN. tit. 6, § 3313 (1984); FLA. STAT. ANN. § 495.151 (West 1985); GA. CODE ANN. § 10-1-451(b) (1986); IDAHO CODE § 48-512 (1977); 765 ILL. COMP. STAT. 1036/65 (West 1997); IOWA CODE ANN. § 548.111(2) (West 1986); LA. REV. STAT. ANN. § 51-223.1 (West 1986); ME. REV. STAT. ANN. tit. 10, § 1530 (West 1980); MASS. GEN. LAWS ANN. ch. 110B, § 12 (West 1986); MO. ANN. STAT. § 417.061(1) (West 1979); MONT. CODE ANN. § 30-13-334 (1985); NEB. REV. STAT. § 87-122 (1981); N.H. REV. STAT. ANN. § 350-A:12 (1984); N.M. STAT. ANN. § 57-3-10 (Michie 1978); N.Y. GEN. BUS. LAW § 368-d (McKinney 1984); OR. REV. STAT. § 647.107 (1983); 54 PA. CONS. STAT. ANN. § 1124 (West 1986); R.I. GEN. LAWS § 6-2-12 (1985); TENN. CODE ANN. § 47-25-512 (1984).

100. See Prager, *supra* note 93, at 123 (detailing the pre-history of the Federal Trademark Dilution Act); see, e.g., *Mead Data*, 875 F.2d at 1029-30 (holding that, under New York law, the automobile manufacturer’s use of the mark “Lexus” for its new luxury automobile, did not dilute the defendant’s mark “Lexis” used to symbolize computerized legal research services, because the marks were not substantially similar, the products did not compete with each other, and the “Lexis” mark was not strong outside of the defendant’s market).

101. 15 U.S.C.A. § 1125(c). 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.” *Id.*; see, e.g., *Dr. Seuss Enter. v.*

marks is that those marks are most likely to be adversely affected by dilution.<sup>102</sup> The Dilution Act provides courts with a non-exclusive list of factors to consider when determining whether a mark is “famous.”<sup>103</sup>

### C. *The Right of Publicity*

The right of publicity protects the individual, primarily a celebrity,<sup>104</sup> against the commercial misappropriation of his or her name or likeness without consent.<sup>105</sup> Generally, the principle interest

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Penguin Books U.S.A., 109 F.3d 1394 (9th Cir. 1997) (asserting a cause of action under the Dilution Act); *Intermatic Inc. v. Toeppen*, 947 F. Supp. 1227 (N.D. Ill. 1996) (same); *WAWA Inc. v. Haaf*, 40 U.S.P.Q. 2d (BNA) 1629 (E.D. Pa. 1996) (same); *Ringling Bros.-Barnum & Bailey Combined Shows v. B.E. Windows Corp.*, 937 F. Supp. 204 (S.D.N.Y. 1996) (same).

102. 3 MCCARTHY, *supra* note 30, § 24:95 (discussing famous marks under dilution law).

103. 15 U.S.C.A. 1125(c)(1). The eight listed factors are:

(1) the degree of inherent or acquired distinctiveness of the mark; (2) the duration and extent of use of the mark in connection with the goods or services with which the mark is used; (3) the duration and extent of advertising and publicity of the mark; (4) the geographical extent of the trading area in which the mark is used; (5) the channels of trade for the goods or services with which the mark is used; (6) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought; (7) the nature and extent of use of the same or similar marks by third parties; and (8) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principle register.

*Id.* Senate Report 515, on the original version of the anti-dilution bill, stated that “[e]ach of the factors set forth in the provision should be weighed independently and it is the cumulative effect of these considerations which will determine whether a mark qualifies for federal protection from dilution.” S. REP. NO. 100-515, at 42 (1988).

104. *See, e.g.*, *Shamsky v. Garan, Inc.*, 632 N.Y.S.2d 930 (Sup. Ct. 1995) (former professional baseball players); *Titan Sports, Inc. v. Comics World Corp.*, 870 F.2d 85 (2d Cir. 1989) (professional wrestlers); *Eastwood v. Superior Court*, 198 Cal. Rptr. 342 (Ct. App. 1983) (actor); *Cher v. Forum Int'l, Ltd.*, 692 F.2d 634 (9th Cir. 1982) (actress and entertainer); *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977) (“human cannonball”); *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953) (professional baseball players); *see also* Darren F. Farrington, *Should the First Amendment Protect Against Right of Publicity Infringement Actions Where the Media is a Merchandiser? Say It Ain't So, Joe*, Note, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 779, 784 (1996) (stating that the right generally benefits entertainers, athletes, and other celebrities who have well known images).

105. *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (“One who appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade is subject to liability.”).

furthered by this right is allowing a celebrity to protect his or her livelihood by controlling the use of his or her image.<sup>106</sup> The unauthorized use must be a commercial one, which includes advertising, promotions, and implied endorsements.<sup>107</sup> Protectable aspects of a celebrity's identity could include his or her name,<sup>108</sup> likeness,<sup>109</sup> portrait,<sup>110</sup> signature,<sup>111</sup> voice,<sup>112</sup> or other characteristics of his or her persona.<sup>113</sup> In many states, the right of publicity is viewed as a property right that is freely transferable<sup>114</sup> and descendable.<sup>115</sup>

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106. See, e.g., *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 564, 573 (1977) (protecting the image of a "human cannonball" because his image constituted his act which was a means of earning a livelihood); see also 4 MCCARTHY, TRADEMARKS, *supra* note 30, § 28.1 ("The right of publicity is the inherent right of every human being to control the commercial use of his or her identity.").

107. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46-49; J. Thomas McCarthy, *Public Personas and Private Property: The Commercialization of Human Identity*, 79 TRADEMARK REP. 681, 697 (1989) [hereinafter McCarthy II]; see also *Madow*, *supra* note 19, at 127-29 (discussing the significance of commercial use with trademark dilution).

108. See *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 845 (6th Cir. 1983) (holding that the phrase "Here's Johnny" used for portable toilets violated Johnny Carson's right of publicity).

109. See *Onassis v. Christian Dior-New York, Inc.*, 472 N.Y.S.2d 254, 261-62 (Sup. Ct. 1984) (imposing liability for the use of a look-alike of Jackie Onassis side-by-side with real celebrities in a clothing advertisement), *aff'd*, 488 N.Y.S.2d 843 (1985) (mem.).

110. See *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 726-27 (S.D.N.Y. 1978) (holding that a caricature of Muhammad Ali fell under the "portrait, photograph" category of the New York statute protecting publicity rights).

111. See *United States Life Ins., Co. v. Hamilton*, 238 S.W.2d 289, 292 (Tex. Ct. App. 1951) (holding that the unauthorized use of an employee's signature on advertising materials for a medical plan infringed on his property rights).

112. See *Middler v. Ford Motor Co.*, 849 F.2d 460, 462-64 (9th Cir. 1988) (imposing liability under the common law for unauthorized imitation of Bette Middler's voice in a Ford Motor Company television advertisement).

113. See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1398 (9th Cir. 1992) (finding that Vanna White had a cause of action under the common law against the use of a robot which had a blonde wig, wore a gown, and posed next to the "Wheel of Fortune" game board), *reh'g denied*, 989 F.2d 1512 (9th Cir. 1993).

114. See, e.g., IND. CODE ANN. § 32-13-1-16 (West 1997) (recognizing the right of publicity as freely transferable in whole or in part, by contract, license, gift or trust); TEX. PROP. CODE ANN. § 26.004 (West 1997).

115. See, e.g., CAL. CIV. CODE § 990(g) (West 1996) (providing a post-mortem right of publicity for a term of 50 years); TENN. CODE ANN. § 47-25-1104 (1997). *But see* *Stephano v. News Group Publications, Inc.*, 474 N.E.2d 580, 584 n.2 (N.Y. 1984) ("[W]e need not consider whether the statute would also control assignment, transfer or descent

## 1. Development of the Right of Publicity

The right of publicity has its foundation in the right of privacy.<sup>116</sup> The tort law concept of a right of privacy originated in a famous law review article written in 1890 by Samuel Warren and Louis Brandeis.<sup>117</sup> They argued that the common law should protect “the private life, habits, acts and relations” of individuals from public exposure.<sup>118</sup> Warren and Brandeis emphasized the need to protect those who were harmed when private facts about them were publicly disclosed.<sup>119</sup>

In a 1902 case, *Roberson v. Rochester Folding Box, Co.*,<sup>120</sup> the New York Court of Appeals refused to adopt a common law right of privacy.<sup>121</sup> The New York legislature, in response to this decision, became the first to codify a right to privacy.<sup>122</sup> And in *Pavesich v. New England Life Insurance Co.*,<sup>123</sup> the Georgia Supreme Court recognized that an insurance company’s unauthorized use of the plaintiff’s photograph in an advertisement, unreasonably infringed on his right to be left alone, the essence of the Warren-Brandeis privacy notion.<sup>124</sup> Though state courts began to accept

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of the publicity rights.”).

116. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. b (“The principal historical antecedent of the right of publicity is the right of privacy.”); McCarthy I, *supra* note 28, at 1704.

117. Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

118. See *id.* at 193.

119. See *id.* at 196, 215-16.

120. 64 N.E. 442 (N.Y. 1902) (refusing to grant relief to a plaintiff whose picture had been used without consent on flour boxes).

121. See *id.*

122. See N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1996). Section 50 of New York’s privacy statute makes it a misdemeanor for a “person, firm or corporation [to use] for advertising purposes, or for the purposes of trade, the name, portrait or picture of any living person without having first obtained the written consent of such person.” *Id.* § 50. Section 51 establishes a civil cause of action, for equitable relief and damages, in favor of “[a]ny person whose name, portrait or picture is used within this state for advertising purposes or for the purposes of trade” without the written consent contemplated by section 50. *Id.* § 51.

123. 50 S.E. 68 (Ga. 1905).

124. See *id.* at 78; see also Warren & Brandeis, *supra* note 117, at 193, 196, 215-16 (arguing for the right to privacy). See Arlen W. Langvardt, *The Troubling Implications of a Right of Publicity “Wheel” Spun Out of Control*, 45 U. KAN. L. REV. 329, 332 (1993) [hereinafter Langvardt II], for a discussion about the origins and rationales for the right of

the right of privacy, the evolving privacy law appeared incapable of dealing with commercial appropriation beyond the concept of a right to be left alone.<sup>125</sup>

The term “right of publicity” was first coined in 1953 by Judge Jerome Frank in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*<sup>126</sup> to denote a person’s commercial interest in the value of his or her identity apart from purely privacy rights.<sup>127</sup> The following year, Professor Melville B. Nimmer laid the foundation for the right of publicity.<sup>128</sup> Professor Nimmer defined it as the right to reap the commercial value of one’s identity when it is used for advertising or some other commercial purpose.<sup>129</sup> Professor Nimmer emphasized that what a celebrity wants is not protection against unreasonable intrusion into privacy, but a right to control the commercial value of his or her identity.<sup>130</sup>

Professor William Prosser, in an influential article written in 1960, categorized four distinct torts as being encompassed by the developing right of privacy law including appropriation of the plaintiff’s name or likeness for commercial benefit.<sup>131</sup> This approach was incorporated into the *Restatement (Second) on Torts* in

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publicity.

125. See 4 MCCARTHY, TRADEMARKS, *supra* note 30, § 28:3 (discussing the origins of the right to privacy).

126. 202 F.2d 866 (2d Cir. 1953).

127. See *id.* at 867-69. Thirty years after *Haelan Labs.*, the New York Court of Appeals expressed a contrary view, holding that a common law right of publicity does not exist in New York. See *Stephano v. News Group Publications, Inc.*, 474 N.E.2d 580 (N.Y. 1984). Instead, according to the court, the state’s privacy statutes provide the exclusive cause of action with regard to commercial uses of names and likeness. See *id.* at 584 (citing N.Y. CIV. RIGHTS LAW §§ 50, 51). *Stephano*, a decision of New York’s highest court, controls *Haelan Labs.*, a decisions of the federal court of appeals, over whether New York recognizes a common law right of publicity. *Haelan Labs.*, however, has had an impact on the development and recognition of the right of publicity in states other than New York. See J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 1.7 (1994) [hereinafter MCCARTHY, PUBLICITY RIGHTS].

128. See Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 215-18 (1954).

129. See *id.*

130. See *id.* at 203-04.

131. See William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 389 (1960). The three other categories are (1) intrusion upon one’s physical solitude or seclusion, (2) publicity which involves public disclosure of private facts, and (3) publicity which places a person in a false light in the public eye. See *id.*



1977.<sup>132</sup> That same year, the Supreme Court recognized the right of publicity for the first time in *Zacchini v. Scripps-Howard Broadcasting Co.*<sup>133</sup> The Court reasoned that the goal of the right of publicity was to prevent unjust enrichment and that it was an enforceable right separate from claims made for invasion of privacy or defamation.<sup>134</sup>

## 2. State Statutory Law and Common Law Rights

In 1903, New York became the first state to enact statutory protection for the right to privacy encompassing the right of publicity.<sup>135</sup> The statute prohibited the use of a person's name, portrait, or picture for advertising purposes or purposes of trade without the person's written consent.<sup>136</sup> New York courts have consistently stated that the rights of privacy and publicity are recognized purely as a statutory right.<sup>137</sup> Fifteen states protect publicity rights statutorily,<sup>138</sup> some through privacy statutes<sup>139</sup> and others

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132. RESTATEMENT (SECOND) OF TORTS §§ 652A-652I (1977). Under the title "Invasion of Privacy," sections 652A through 652I address the general principles of privacy rights, the intrusion upon seclusion, the appropriation of one's name or likeness, the publicity given to a person's private life, the publicity placing person in false light, absolute privileges, conditional privileges, damages, and the personal character of the right of privacy. *Id.*

133. 433 U.S. 562 (1977). *Zacchini* is the sole United States Supreme Court case to address the right of publicity.

134. *See id.* at 576; *see also* Langvardt II, *supra* note 10, at 356-62 (analyzing the *Zacchini* decision).

135. *See* N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1997).

136. *See id.*

137. *See, e.g.,* *Stephano v. News Group Publications, Inc.*, 474 N.E.2d 580 (N.Y. 1984) (noting that the rights of privacy and publicity are derived from statutory law); *Finger v. Omni Publication Int'l, Ltd.*, 566 N.E.2d 141 (N.Y. 1990) (same); *Shamsky v. Garan, Inc.*, 632 N.Y.S.2d 930 (Sup. Ct. 1995) (same).

138. *See* 4 MCCARTHY, TRADEMARKS, *supra* note 30, §§ 28:17-28:39 (compiling state statutory law); *see also* FLA. STAT. ANN. § 540.08 (West 1997); IND. CODE ANN. §§ 32-13-1-1 to 32-13-1-20 (West 1997); NEV. REV. STAT. ANN. §§ 597.770-597.810 (Michie 1994); R.I. GEN. LAWS §§ 9-1-28.1 (1997); TENN. CODE ANN. §§ 47-25-1101 to 47-25-1108 (1997); TEX. PROP. CODE ANN. §§ 26.001-26.015 (West 1997); UTAH CODE ANN. §§ 45-3-1 to 45-3-6 (1993); WISC. STAT. ANN. § 895.50 (West 1997). *See* Donna L. Candido, *The Right of Publicity: An Overview*, 476 PLL/PAT. 181, 201-04 (1997), for an overview of the right of publicity.

139. *See* MASS. GEN. LAWS ch. 214, § 3A (1997); NEB. REV. STAT. §§ 20-201 to 20-211, 25-840.01 (1997); VA. CODE ANN. §§ 8.01-40, 18.2-216.1 (Michie 1997).

through legislation specifically aimed at protecting publicity rights.<sup>140</sup>

The right of publicity has been recognized as existing under the common law of sixteen states.<sup>141</sup> Of those sixteen states, six also have statutory provisions broad enough to encompass the right of publicity.<sup>142</sup> Those sixteen states include those whose own courts have recognized the right,<sup>143</sup> and those in which federal courts, that are applying state law, have held that a state right exists.<sup>144</sup> The scope of protection under the common law has often been much broader to protect aspects of a person's persona not specifically covered by state statutory law.<sup>145</sup>

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140. See CAL. CIV. CODE § 3344 (West 1996); KY. REV. STAT. ANN. § 391.170 (Banks-Baldwin 1997); OKLA. STAT. ANN. tit. 12, §§ 1448-1449 (West 1997).

141. See, e.g., *Eastwood v. Superior Court*, 198 Cal. Rptr. 342 (Ct. App. 1983) (recognizing California common law right); *Jim Henson Prods. v. John T. Brady & Assocs.*, 867 F. Supp. 175 (S.D.N.Y. 1994) (deciding Connecticut common law); *Genesis Publications, Inc. v. Goss*, 437 So. 2d 169 (Fla. Dist. Ct. App. 1983) (Florida common law); *Martin Luther King, Jr. Ctr. v. American Heritage Prods.*, 296 S.E.2d 697 (Ga. 1982) (Georgia common law); *Fergerstrom v. Hawaiian Ocean View Estates*, 441 P.2d 141 (Haw. 1968) (Hawaii common law privacy right); *Douglass v. Hustler Magazine, Inc.*, 769 F.2d 1128 (7th Cir. 1985) (Illinois common law); *Cheatham v. Paisano Publications, Inc.*, 891 F. Supp. 381 (W.D. Ky. 1995) (Kentucky common law); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) (Michigan common law); *Uhlender v. Henricksen*, 316 F. Supp. 1277 (D. Minn. 1970) (Minnesota common law); *Haith v. Model Cities Health Corp.*, 704 S.W.2d 684 (Mo. Ct. App. 1986) (Missouri common law); *Estate of Elvis Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981) (New Jersey common law); *Reeves v. United Artists Corp.*, 765 F.2d 79 (6th Cir. 1985) (Ohio common law); *Gee v. CBS, Inc.*, 471 F. Supp. 600 (E.D. Pa. 1979) (Pennsylvania common law); *Kimbrough v. Coca-Cola/USA*, 521 S.W.2d 719 (Tex. Civ. App. 1975) (Texas common law privacy right); *Nature's Way Prods., Inc. v. Nature-Pharma, Inc.*, 736 F. Supp. 245 (D. Utah 1990) (Utah common law); *Hirsch v. S.C. Johnson & Sons*, 280 N.W.2d 129 (Wis. 1979) (Wisconsin common law right).

142. See *supra* notes 138, 141 (noting that the "common law" and "statutory" states are California, Florida, Kentucky, Texas, Utah, and Wisconsin).

143. See *Martin Luther King, Jr. Ctr. v. American Heritage Prods.*, 296 S.E.2d 697 (Ga. 1982).

144. See *Jim Henson Prods. v. John T. Brady & Assocs.*, 897 F. Supp. 175, 189 (S.D.N.Y. 1994) ("I hold that Connecticut's high court would recognize the right of publicity.").

145. See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir. 1993).

### 3. Protection of Publicity Rights Under Section 43(a)

Section 43(a) of the Lanham Act has been used to protect publicity rights against commercial use of a person's persona that constitutes false endorsement.<sup>146</sup> Celebrities, such as Woody Allen, have used section 43(a) to prevent the unauthorized use of their images or likenesses in advertising that constituted false endorsement, where state statutory or common law rights of publicity were not available.<sup>147</sup> Section 43(a), on the other hand, does not prevent advertisement that contains unauthorized use of a person's image or likeness absent false endorsement or generally a likelihood of confusion.<sup>148</sup> Falsity or a likelihood of confusion are not necessary elements to prove infringement of the right of publicity.<sup>149</sup>

#### D. *The First Amendment and the Freedom of Speech Defense*

The freedom of speech, as embodied in the First Amendment, provides a limitation for imposing liability for trademark infringement, anti-dilution, and appropriation of publicity rights.<sup>150</sup> The First Amendment confers a measure of protection for the unauthorized use of trademarks where the use is an expression of a communicative message.<sup>151</sup> Generally, defendants have successfully invoked First Amendment protection of unauthorized trademark use in parodies or other forms of artistic expression in the absence of consumer confusion.<sup>152</sup> As well, the right of publicity also must

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146. 15 U.S.C.A. § 1125(a).

147. *See Allen v. National Video, Inc.*, 610 F. Supp. 612, 628-29 (S.D.N.Y. 1985) (stating that the case would be better addressed under section 43(a) false endorsement rather than the New York statute).

148. 15 U.S.C.A. § 1125(a); *see also* 4 MCCARTHY *supra* note 30, § 28:14 (discussing section 43(a)).

149. *See, e.g., Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 348 (Ct. App. 1983) (“[T]he appearance of an endorsement is not the *sine qua non* of a claim of commercial appropriation [of the right of publicity].”).

150. *See* discussion *supra* note 37 and accompanying text (citing decisions protecting First Amendment interests in trademark, dilution, and publicity rights cases).

151. *See Yankee Publishing Inc. v. News Am. Publ'g Corp.*, 809 F. Sup. 267, 276 (S.D.N.Y. 1992).

152. *See, e.g., Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g. Group, Inc.*, 886 F.2d 490, 495 (2d Cir. 1989) (holding that “Spy Notes” was a permissible, parody of “Cliffs Notes”).

bow to the First Amendment where a person's name, image, or persona is used in a communicative capacity, such as a news report or documentary film.<sup>153</sup>

The level of protection afforded by the First Amendment in trademark and publicity rights cases ultimately depends upon the type of speech involved.<sup>154</sup> Historically, expressions about political, philosophical, social, artistic, economic, literary, scientific, or ethical matters were entitled to full First Amendment protection.<sup>155</sup> On the other hand, speech that proposes a commercial transaction, principally advertising, was not recognized as being afforded First Amendment protection until the Supreme Court's decision in *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.*<sup>156</sup> In *Virginia Pharmacy*, the Court held that commercial speech may be "more durable" than other types of speech and, as a result, "there is little likelihood of its being chilled by proper regulation."<sup>157</sup> Therefore, commercial speech receives an intermediate level of First Amendment protection only if it pertains to a lawful activity and is not misleading.<sup>158</sup>

In *Central Hudson Gas & Electric Corp. v. Public Service Commission*,<sup>159</sup> the Supreme Court embellished the rationale of *Virginia Pharmacy* by observing that two features of commercial speech permit regulation of its content.<sup>160</sup> First, commercial speakers are well situated to evaluate the accuracy of their messages; and second, commercial speech is not "particularly suscep-

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153. See, e.g., *Rogers v. Grimaldi*, 875 F.2d 994, 996 (2d Cir. 1985) (holding that the use of a celebrity's name in a movie title was permissible).

154. See 4 MCCARTHY, TRADEMARKS, *supra* note 30, §§ 28:41, 31:141 (analyzing the commercial/artistic speech distinction); Langvardt I, *supra* note 10, at 643 (discussing the different levels of protection afforded speech).

155. See, e.g., *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).

156. 425 U.S. 748 (1976).

157. *Id.* at 772 n.24.

158. See *Board of Trustees v. Fox*, 492 U.S. 469, 477-80 (1989); *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 762-63, 770-72 (1976).

159. 447 U.S. 557 (1980).

160. *Id.* at 564 n.6.

tible to being crushed by overbroad regulation.”<sup>161</sup> Yet, where traditional advertising as commercial speech is “inextricably intertwined” with communicative speech, the totality is treated as non-commercial, fully protected speech.<sup>162</sup> Arguably, all advertising contains socially valuable information, and communicative speech has a commercial component, therefore, courts have problems distinguishing between the two.<sup>163</sup>

Ultimately, the distinction between commercial and non-commercial speech may wither away.<sup>164</sup> In *44 Liquormart, Inc. v. Rhode Island*,<sup>165</sup> four justices in a plurality, represented in two opinions, openly advocated for full First Amendment protection for commercial speech that is not deceptive.<sup>166</sup> Justice Stevens, who announced the judgment of the Court, spoke for three Justices when he noted that “[a]dvertising has been a part of our culture throughout our history. Even in colonial days, the public relied on ‘commercial speech’ for vital information about the market . . . .”<sup>167</sup>

Courts have provided defendants in trademark infringement cases and anti-dilution claims, greater liberty in using another’s mark in the context of parody or other forms of artistic expres-

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161. *Id.*

162. *Riley v. National Fed’n of Blind, Inc.*, 487 U.S. 781, 791 (1988); *see also* 4 MCCARTHY *supra* note 30, § 31:141 (analyzing the commercial/artistic speech distinction).

163. *See, e.g.*, *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 309 (C.D. Cal. 1990) (holding that the use of the musical group’s identity in a revenue generating phone number survey was not commercial). *But see* *Bolger v. Young Drug Prods. Corp.*, 463 U.S. 60, 67-68 (1983) (stating that an informational pamphlet discussing the social issues of human sexuality and venereal disease was commercial speech).

164. *See 44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 116 S. Ct. 1495, 1515-20 (1996).

165. 517 U.S. 484, 116 S. Ct. 1495 (1996).

166. *See id.* Justice Stevens announced the judgment of the Court and stated that the Court would provide full constitutional protection to commercial speech. *Id.* at 1507. Justice Thomas, concurring separately, noted that truthful commercial speech could not be regulated more than non-commercial speech. *Id.* at 1515 (Thomas, J., concurring).

167. *Id.* at 1504. According to Justice Stevens: “Indeed, commercial messages played such a central role in public life prior to the Founding that Benjamin Franklin authored his early defense of a free press in support of his decision to print, of all things, an advertisement for voyages to Barbados.” *Id.*

sion.<sup>168</sup> In *L.L. Bean, Inc. v. Drake Publishers, Inc.*,<sup>169</sup> the First Circuit Court of Appeals acknowledged that trademark rights against infringement and dilution do not entitle the owner to extinguish the unauthorized use of a mark by another in an editorial parody.<sup>170</sup> In *Girl Scouts of America v. Bantam Doubleday Bell Publishing Group, Inc.*,<sup>171</sup> the Southern District of New York held that the plaintiff's protected trademark and any evidence of a likelihood of confusion were "sufficient to overcome the First Amendment value of protecting creative works," such as the defendant's children's book.<sup>172</sup>

Despite the Supreme Court's holding in *Zacchini v. Scripps-Howard Broadcasting Co.*,<sup>173</sup> that the First Amendment did not insulate the television news media from liability in broadcasting the entire act of a "human cannonball," courts have extended freedom of speech protection to defendants in publicity rights cases.<sup>174</sup> In *Rogers v. Grimaldi*,<sup>175</sup> Ginger Rogers sued the producers of a feature film entitled "Ginger and Fred" for violating her right of publicity.<sup>176</sup> The film was a satire built around the bittersweet reunion of two retired dancers who were once known by the nicknames "Ginger and Fred" because they imitated Ginger Rogers and Fred Astaire—America's dancing legends and symbols of "style, ele-

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168. See, e.g., *Pillsbury Co. v. Milky Way Prods.*, 215 U.S.P.Q. (BNA) 124 (N.D. Ga. 1981) (finding that a parody-advertisement 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) (finding that a poster depicting pregnant woman in a Junior Girl Scout uniform would not confuse the public as to its source); see also Goldsmith, *supra* note 47, at 846 (discussing the parody defense to trademark infringement).

169. 811 F.2d 26 (1st Cir.), *cert. denied*, 483 U.S. 1013 (1987).

170. *Id.* at 29, 31.

171. 808 F. Supp. 1112 (S.D.N.Y. 1992).

172. *Id.* at 1130.

173. 433 U.S. 562, 576 (1977).

174. See, e.g., *Benavidez v. Anheuser Busch, Inc.*, 873 F.2d 102, 103 (5th Cir. 1989) (holding that defendant beer company, which underwrote a documentary film containing an 80 second segment of the plaintiff war hero, was protected under the First Amendment); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 309 (C.D. Cal. 1990) (allowing the use of the plaintiff's likeness in a non-commercial setting).

175. 875 F.2d 994 (2d Cir. 1989).

176. *Id.* at 997.

gance, and grace.”<sup>177</sup> The court 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.”<sup>178</sup> The court further held that there is no violation of the right of publicity where the name or image of a celebrity is used for its symbolic significance.<sup>179</sup>

## II. ICONS OF POPULAR CULTURE

All cultures invent icons, with early symbols appearing in ancient tombs demonstrating the isolation in time and space of painted animals.<sup>180</sup> Eventually, such symbolic imagery becomes “conventionalized, systematized and commercialized.”<sup>181</sup> For example, ancient Pompeians made their domestic house shrines gathering places for traditional memory, tutelary powers, and gods, using distinct colors, details, and craftsmanship to attain a vital and expanding group of icons.<sup>182</sup> The pop icons of today are constantly being evoked and evolved, redesigned and reshaped as our information-age society seeks to revitalize our images.<sup>183</sup> The symbols of our time, specifically, Coca-Cola, Elvis, and Barbie, are an integral part of the common culture, whose images have been protected in an attempt to diffuse their links to the masses.<sup>184</sup>

### A. *Coca-Cola*

John “Doc” Pemberton, a Confederate veteran who was obsessed with inventing the ultimate medicine to break his morphine addiction, created a sugary syrup containing sugar, water, coca

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177. *Id.* at 996.

178. *Id.* at 1004-05.

179. *Id.*

180. See FISHWICK, *supra* note 16, at 131 (discussing the ancient use of cultural icons).

181. HERBERT READ, *ICON AND IDEA* 17 (1955).

182. See FISHWICK, *supra* note 16, at 133 (citing GEORGE K. BOYCE, *CORPUS OF THE LARARIA OF POMPEII* (1968); DAVID PYE, *THE NATURE AND ART OF WORKMANSHIP* (1968)).

183. See *id.* (analyzing how icons are developed in modern society).

184. See Madow, *supra* note 19, at 142 (discussing cultural images importance in popular culture).

leaves, and kola nuts in the spring of 1886.<sup>185</sup> Coca-Cola was born in the era of patent medicine, where promoters were the first to recognize the power of the catch phrase, identifiable logos, and celebrity endorsements.<sup>186</sup>

The soft drink's trademark was originally registered in 1887 and, a year later, Georgia businessman Asa Chandler ("Chandler") gained all rights to the formula.<sup>187</sup> Chandler soon formed the Coca-Cola Company ("Company") and battled charges that the beverage led to cocaine addiction.<sup>188</sup> Under Chandler and his successors, the aid of an annual advertising budget of one million dollars, a Supreme Court decision, and essentially being the only drink in town during Prohibition, Coca-Cola permeated every aspect of American society.<sup>189</sup> The Company's advertising was specifically geared to represent the product in pleasant, poignant scenes of every day American life and successfully engendered itself into the national culture, eventually defining America.<sup>190</sup>

Coca-Cola's success bred competition and imitators, as hundreds of counterfeiters flooded the market with sound-alike soft drinks at the turn of the century.<sup>191</sup> Yet, the product's greatest

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185. See PENDERGRAST, *supra* note 12, at 19-27 (examining the origins of Coca-Cola).

186. See *id.* at 12-13.

187. See *id.* at 55-62. The word "Coca-Cola" was subsequently re-registered in 1893, 1905, and 1928. See *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1186 (E.D.N.Y. 1972).

188. See PENDERGRAST, *supra* note 12, at 55-62.

189. See *id.* at 91, 176-177.

190. See ALLEN, *supra* note 15, at 8-9 (discussing the affect of Coca-Cola's advertising on American culture). Colonel Robert L. Scott, Jr. wrote:

I don't know exactly what democracy is, or the real, common-sense meaning of a republic. But as we used to talk things over in China, we all used to agree that we were fighting for the American Girl. She to us was America, democracy, Coca-Colas, hamburgers, clean places to sleep, or the American Way of Life.

ROBERT L. SCOTT, JR., *GOD IS MY CO-PILOT* 166 (1943); see also ALLEN, *supra* note 15, at 122.

191. See ALLEN, *supra* note 15, at 73. Among the imitators were: "Afri-Cola, Ameri-Cola, Ala-Cola, Bolama-Cola, Café-de-Ola, Carbo-Cola, Candy-Kola, Capa-Cola, Chero-Cola, Christo-Cola, Coke-Ola, Coo-EE-Cola, Curo-Cola, Grap-O-Cola, Its-A-Cola, Kaffir-Kola, Kaw-Kola, Kiss-Kola, Ko-Ca-Ama, Koca-Nola, Ko-Co-Lem-A, Kokola, Klu Ko Kola, Loco Cola, Luna Cola, Mitch-O-Cola, Mo-Cola, My Cola, Roco-Cola, Toca-Cola, Taka-Cola, Qua-Kola, Uneeda-Cola, Zeto-Cola, and Zippi-Cola." *Id.*



threat came from Dr. Harvey Washington Wiley, chief chemist of the United States Department of Agriculture.<sup>192</sup> Dr. Wiley launched a crusade to ban the soft drink because he believed that it contained cocaine and other harmful ingredients.<sup>193</sup> Having failed in his attempt to find cocaine in Coca-Cola, Dr. Wiley brought suit against the Company.<sup>194</sup> He claimed that the product was misbranded and adulterated by the addition of caffeine, in violation of section 10 of the Federal Food and Drugs Act of 1906.<sup>195</sup> In *United States v. Forty Barrels and Twenty Kegs of Coca-Cola*,<sup>196</sup> the district court judge issued a directed verdict for the Coca-Cola Company, holding that the name of the soft drink was not misbranded because it did not contain coca, and was not adulterated by the content of caffeine.<sup>197</sup> The Supreme Court reversed the decision and the case was eventually settled, but what resulted was the question whether Coca-Cola was a valid trademark.<sup>198</sup>

In 1920, the Coca-Cola Company brought suit against J. C. Mayfield, the former partner of Doc Pemberton, and his Koke

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192. *See id.* at 48.

193. *See id.*

194. *See id.*

195. 21 U.S.C. § 10, *repealed by* Federal Food, Drug, and Cosmetic Act of 1938, ch. 675, §§ 1, 902(a), 52 Stat. 1040, 1059. According to section 10, drugs are deemed misbranded:

[W]hen there is an imitation or use of name of other article, when there is removal and substitution of contents of package or failure to state on label quantity or proportion of narcotics therein, and when there is a false statement of curative or therapeutic effect; and food, when there is an imitation or use of name of other article, when there is a false label or brand removal and substitution of contents of package, or failure to state or label quantity or proportion of narcotics therein, when the packages are not marked with weight, with certain variations and exemptions permitted, when there are false or misleading statements on package or label as to ingredients or substances; and food, when mixtures or compounds under distinctive names, the articles are labeled, branded as compounds, imitations or blends; construed the term "blend" and related to disclosure of trade formulas of proprietary foods, and canned food.

*Id.*; *see also* ALLEN, *supra* note 15, at 58 (stating that Dr. Wiley had the "unshaken belief" that caffeine was injurious to human health and that he desired to punish the Coca-Cola Company).

196. 191 F. 431 (E.D. Tenn. 1911), *rev'd*, 241 U.S. 265 (1916).

197. *See id.* at 436-38.

198. *See United States v. Forty Barrels and Twenty Kegs of Coca-Cola*, 241 U.S. 265, 290 (1916).

Company of America, an obvious imitator, for trademark infringement.<sup>199</sup> A decree for the Company was reversed by the Ninth Circuit Court of Appeals, ruling that, in spite of Mayfield's blatant infringement, the Coca-Cola Company lost its trademark protection because it had made fraudulent representations as to the product's content.<sup>200</sup> The Supreme Court reversed the circuit court's ruling, in an opinion by Justice Oliver Wendell Holmes.<sup>201</sup> Justice Holmes dispelled the notion that the soft-drink was fraudulently represented, and stated that "[w]hatever may have been its original weakness, the [Coca-Cola] mark for years has acquired a secondary significance and has indicated the [Company's] product alone."<sup>202</sup> Justice Holmes further stated that Mayfield's use of the word "Koke" was chosen for the purposes of reaping the benefit of the product's goodwill and that it would be unsound to deny trademark protection against a "palpable fraud."<sup>203</sup> The decision saved Coca-Cola, frightened off most copycat manufactures, and was a sword in the Company's ongoing crusade to defend its trademark against flagrant infringers such as Co-Cola and Coke-Ola as well as claims of genericism.<sup>204</sup>

Coca Cola's crusade has reached beyond the realm of cola competitors, bringing suits for trademark infringement against such individuals as the owners of a Los Angeles restaurant named "Cocola," an Italian term of endearment.<sup>205</sup> The Company not only

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199. See ALLEN, *supra* note 15, at 121 (discussing the trademark infringement suit by the Coca-Cola Company).

200. See *Coca-Cola Co. v. Koke Co. of Am.*, 254 U.S. 143, 145 (1920), *superseded by statute as stated in* *Qualitex Co. v. Jacobson Products Co., Inc.* 514 U.S. 159 (1995); see also ALLEN, *supra* note 15, at 121 (commenting that Coca-Cola Company brought actions against Mayfield in Washington, D.C. and four other states for the sake of thoroughness and harassment).

201. See ALLEN, *supra* note 15, at 121.

202. *Id.*

203. *Id.* at 145-47.

204. See *id.* at 210 ("Harold Hirsch had assembled a team of lawyers. . .who scoured the land protecting Coca-Cola's trademark, hunting down violators, and filing hundreds of lawsuits that produced a blizzard of orders, injunctions, decrees, and judgments against defendant's big and small."). Six decades after *Coca-Cola v. Koke*, the Ninth Circuit Court of Appeals held that the word "Coke" was presumptively not generic to all cola beverages. See *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250, 1253-55 (9th Cir. 1982).

205. See PENDERGRAST, *supra* note 12, at 415. The puzzled owners quickly com-

wanted to prevent the use of the Coca-Cola mark or variations, but also desired to control its portrayal in advertising of non-competitors. In *Coca-Cola v. Gemini Rising Inc.*,<sup>206</sup> the Company was granted a preliminary injunction, enjoining the printing, distribution, and sale of the poster, “Enjoy Cocaine” in characteristic Coca-Cola stylized script, color, and design despite the defendant’s contention that the poster was a satire.<sup>207</sup> The district court agreed with the Company that “[to] associate such a noxious substance as cocaine with plaintiff’s wholesome beverage as symbolized by its ‘Coca-Cola’ trademark and format would clearly have a tendency to impugn that product and injure plaintiff’s business reputation.”<sup>208</sup> The district court, in an attempt to protect the image of a national symbol, utilized New York’s dilution doctrine confusingly intertwined with the Lanham Act, in order to punish the defendant’s bad taste, despite First Amendment implications.<sup>209</sup>

Two decades after *Gemini Rising*, the Coca-Cola Company once again attempted to protect its soft drink’s image.<sup>210</sup> This time dealing with comparative advertising, the Company sought a temporary restraining order against a carbonated soda manufacturer for the portrayal of Coca-Cola as un-pure in a television commercial.<sup>211</sup> Polar Corporation’s commercial featured a computer generated polar bear, similar to the one used in Coca-Cola’s “Always Coca-Cola” campaign,<sup>212</sup> that examines a Coke can, makes an un-

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plied, changing the restaurant’s name to “Boyd Street Grill,” even though the restaurant only sold R.C. Cola. *Id.*

206. 346 F. Supp. 1183 (E.D.N.Y. 1972).

207. *Id.* at 1187, 1192-93.

208. *Id.* at 1189.

209. *See id.* at 1188. Coca-Cola asserted the right to protect its mark by injunction on the grounds that defendant’s poster (1) unfairly disparaged Coca-Cola’s product, (2) created a likelihood of confusion under the section 43 of the Lanham Act, (3) created a likelihood of injury to reputation under New York law, and (4) libeled Coca Cola. *Id.* at 1190. The district court stated that Coca-Cola had sufficiently demonstrated right to injunctive relief under both federal and state law, holding that there was a likelihood of confusion and injury to reputation. *Id.* at 1191.

210. *See Polar Corp. v. Coca-Cola Co.*, 871 F. Supp. 1520 (D. Mass. 1994).

211. *See id.*

212. As part of Coca-Cola’s battle with its competitors, Coca-Cola’s advertising campaign utilized state of the art computer technology and the slogan “Always, Coca-Cola,” with a group of polar bears watching the Northern Lights together while sipping Cokes. ALLEN, *supra* note 15, at 424 (analyzing the “Always Coca-Cola” campaign).

happy sound, and then flips the can over its shoulder into a trash bin below a sign that reads “Keep the Arctic Pure.”<sup>213</sup> The polar bear then reaches down into the freezing, Arctic water and pulls out a can of Polar Seltzer and drinks contentedly.<sup>214</sup> The district court granted the Company’s motion because the commercial “implied that Coke [was] not pure,” misrepresented the nature and quality of Coke, thereby potentially harming the soft drink irreparably.<sup>215</sup> The district court went beyond the notions of tarnishment, utilizing the false advertising component of the Lanham Act in order to protect Coca-Cola’s image, not only from being associated with an illicit substance as in *Gemini Rising*, but also from the mere implication of impurity.<sup>216</sup>

### B. *Elvis Presley*

During his career, Elvis Aaron Presley (“Elvis”) established himself as one of the premier musical talents and entertainers in the United States, Europe, and other areas of the world.<sup>217</sup> He was the major force behind the American rock-and-roll movement, and his influence and popularity continues to this day.<sup>218</sup> On August 16, 1977, Elvis died, but his legend and worldwide popularity have flourished as well as his capacity for generating financial rewards.<sup>219</sup> After death, Elvis has elevated from idol to icon, being the center of a cultural obsession that ranges from impersonators and sightings, to candlelight vigils at his “shrine” in Graceland.<sup>220</sup>

The Estate of Elvis Presley (“Estate”), its licensees, and Elvis Presley Enterprises—the assignee and registrant of all trademarks,

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213. *Polar Corp.*, 871 F. Supp. at 1521.

214. *See id.*

215. *Id.* at 1521-22.

216. *See* 15 U.S.C. § 1125(a)(1) (West 1998 & Supp. 1998); *supra* note 77 and accompanying text; *see also infra* Part I.B.2 (discussing trademark dilution under state and federal law).

217. *See* Estate of Elvis Presley v. Russen, 513 F. Supp. 1339, 1345-47 (D.N.J. 1981).

218. *See id.*

219. *See id.*

220. Lou Carlozo, *Elvis, An Enduring Icon Twenty Years After His Death, He’s Still Bigger Than Life, and the Myths Often Overshadow His Real Cultural Impact*, ORLANDO SENTINEL, Aug. 10, 1997, at F1; *see also* MARCUS, *supra* note 13, at 202 (discussing Elvis Presley’s growth in popularity after his death).

copyrights, and publicity rights belonging to the Estate—have attempted to safe guard the image of Elvis as well as maximize their financial gain.<sup>221</sup> Soon after Elvis's death, the proprietors of his image brought suit against Pro Arts Incorporated ("Pro Arts"), the manufacturer of a poster that contained a copyrighted photograph owned by the defendants, carrying the words "In Memory . . . 1935-1977."<sup>222</sup> Factors Etc., Inc., and Boxcar Enterprises, Inc., were granted a permanent injunction enjoining the manufactures from marketing Elvis memorabilia.<sup>223</sup> The district court rejected the argument that the publication of the poster was protected by the First Amendment because it commemorated a newsworthy event.<sup>224</sup> Pro Arts was ultimately victorious, not because the Second Circuit agreed with its First Amendment assertions, but because of a technicality; Tennessee, whose law governs the suit, did not recognize a descendable right of publicity.<sup>225</sup>

In *Estate of Elvis Presley v. Russen*,<sup>226</sup> the Estate found some success in asserting its exclusive right to commercially exploit the image of Elvis, when they sought an injunction against the producers of a stage show in which a performer imitated Elvis and sold memorabilia based on the performance.<sup>227</sup> The show, entitled "The Big El Show," was promoted with slogans such as: "Reflections on a Legend . . . A Tribute to Elvis Presley" and "Looks and Sounds Like the King."<sup>228</sup> The district court in deciding whether to issue a preliminary injunction, determined that the show served primarily commercial goals and was afforded lesser protection un-

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221. See *Factors Etc., Inc. v. Pro Arts, Inc.*, 444 F. Supp. 288, 289-90 (S.D.N.Y. 1977); *Estate of Elvis Presley*, 513 F. Supp. at 1345-47; *Elvis Presley Enter., Inc. v. Capece*, 950 F. Supp. 783 (S.D. Tex. 1996).

222. See *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 217-18 (2d Cir. 1978). Boxcar Enterprise was a corporation owned by Elvis Presley and his manager, "Colonel" Tom Parker, which, after Elvis's death, granted Factors Etc., Inc. the exclusive right to exploit the name and likeness of Elvis. See *id.*

223. See *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090, 1103 (S.D.N.Y. 1980), *rev'd*, 652 F.2d 278 (2d Cir. 1981).

224. See *id.*

225. See *Factors Etc., Inc. v. Pro Arts, Inc.*, 652 F.2d 278, 283 (2d Cir. 1981).

226. 513 F. Supp. 1339 (D.N.J. 1981).

227. *Id.* at 1349.

228. *Id.* at 1349.

der the First Amendment.<sup>229</sup> Nevertheless, the court concluded that the Estate's ability to profit from exploiting Elvis's image was only diminished by the sale of memorabilia, not from the "Big El Show" production itself.<sup>230</sup> The defendants were enjoined from selling record albums, pendants, and other memorabilia based on the show that contained artistic representations of the Elvis impersonator because of a likelihood of confusion, but still were allowed to continue with the show.<sup>231</sup>

The Estate, in the guise of Elvis Presley Enterprises, achieved a hollow victory in *Elvis Presley Enterprises, Inc. v. Capece*.<sup>232</sup> Barry Capece opened a nightclub in Houston, Texas named under his registered trademark, "The Velvet Elvis."<sup>233</sup> The name, "The Velvet Elvis" referred to one of his more coveted velvet paintings.<sup>234</sup> Pictures and references to Elvis were also used in the nightclub's decorations, the menus, and advertisements promoting the establishment.<sup>235</sup> Elvis Presley Enterprises sued Capece for unfair competition, trademark infringement, dilution, as well as common law and statutory right of publicity, seeking injunctive relief and cancellation of "The Velvet Elvis" trademark.<sup>236</sup> The district court only enjoined the defendant from advertising the night-

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229. *See id.* at 1359.

230. *Id.* at 1380.

231. *See id.* at 1389.

232. 950 F. Supp. 783 (S.D. Tex. 1996).

233. *Id.* at 787. Registration for the service mark, which was uncontested during the requisite 30-day period, "The Velvet Elvis," was issued to Capece for use in the restaurant and tavern business. *Id.* at 788.

234. *Id.*

235. *See id.* at 789. A number of advertisements contained actual pictures of Elvis, while others made direct reference to the deceased singer or Graceland using phrases such as "The King Lives," "Viva la Elvis," or "Elvis has not left the building." *Id.* The bar's menu bears a caption, "The King of Dive Bars," containing drinks such as "Love Me Blenders," delicacies named "Your Football Hound Dog" and peanut butter banana sandwiches. *Id.*

236. *Id.* at 789. The plaintiff claimed that the inclusion of its "Elvis" trademark in the service mark "The Velvet Elvis" coupled with the defendant's use of the image and likeness of Elvis in promoting the bar created confusion as to whether the plaintiff, Elvis Presley Enterprises, licensed, approved, or sponsored the bar. *Id.* Also, according to the plaintiff, the use of the Elvis name in association with a "tacky bar that indiscriminately displays explicit and almost pornographic paintings of nude women has tainted the wholesome image of Elvis." *Id.* at 798; *see also supra* Parts I.B.1, I.B.2 (analyzing trademark infringement and trademark dilution).

club using Elvis's image, which was no longer used, but otherwise denied relief.<sup>237</sup> The court reasoned that the night club's name and decor were protected under the First Amendment as a parody intending to mock an era of lava lamps, velvet paintings, and bell bottoms, "remembered for its sensationalism and transient desire for flashiness" in which Elvis was a part of.<sup>238</sup>

### C. Barbie Doll

Barbie was created in 1957 by Ruth Handler, the later-expelled co-founder of Mattel Inc. ("Mattel").<sup>239</sup> It was inspired by a German doll named Lilli, a pornographic caricature that was a lascivious plaything for men.<sup>240</sup> The doll is sold in more than 140 countries at the rate of two dolls every second, netting Mattel \$2 billion in annual profits.<sup>241</sup> Artists and writers have exploited the "voluptuous clotheshorse" as muse and metaphor, developing a rich body of images and texts that use the doll to comment on class inequality, racial stereotypes, and the dark evanescence of childhood sexuality.<sup>242</sup> Since the height of the feminist movement, activist such as Gloria Steinem have criticized the figure as perpetuating "sexual stereotypes by encouraging little girls to see themselves solely as mannequins, sex objects or housekeepers."<sup>243</sup> Barbie is a

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237. See *id.* at 802-03. The advertising "lacked a recognizable connection to the Defendant's parodic purpose," and overemphasized the word "Elvis" than "Velvet." *Id.* at 796. By the time of trial, however, Capece no longer used that advertising. See *id.*

238. See *id.* at 792, 802.

239. Mrs. Handler was forced out of Mattel in 1975, and three years later was indicted with four other employees by a federal grand jury on charges of conspiring to violate federal securities, mail, and banking laws by preparing false financial statements. See Amy M. Spindler, *Bless Her Pointy Little Feet*, N.Y. TIMES, Feb. 5, 1995, § 7, at 22. She pleaded no contest and was required to perform 2,500 hours of community service and pay \$57,000 in fines. See *id.*

240. See LORD, *supra* note 14, at 26-29 (discussing the origins of Barbie).

241. See Spindler, *supra* note 239, § 7 at 22; see also Kevin M. Williams, *Mattel Sues Band Over 'Barbie Girl'*, CHI. SUN-TIMES, Sept. 14, 1997, at 24 (reporting on Mattel's suit against MCA records for copyright and trademark infringement).

242. M.G. Lord, *The Question Is: What Would Ken Think?*, N.Y. TIMES, Dec. 1, 1995, at C1.

243. *Feminists, Schoolchildren and Antiwar Demonstrators Picket Annual Wholesale Toy Fair*, N.Y. TIMES, Feb 29, 1972, at 20; see also LORD, *supra* note 14, at 89-90 (stating that the National Origin for Women began its formal assault on Mattel in August 1971).

pop icon that is vilified, lauded, deconstructed, avidly collected, and jealously protected by Mattel.<sup>244</sup>

Mattel's first attempt to protect Barbie, two years after the doll was first registered and marketed, proved unsuccessful in *Mattel, Inc. v. Goldberger Doll Manufacturing Co.*<sup>245</sup> Mattel brought an action for trademark infringement and unfair competition against Goldberger Doll Manufacturing Co. ("Goldberger").<sup>246</sup> Goldberger was the producers of "Miss Babette," a blonde doll the same height as Barbie, accompanied by similar attire and accessories.<sup>247</sup> Despite acknowledging Mattel's efforts to promote its commodity, the considerable public acceptance associated with the product and the fact that vendors who sold "Miss Babette" advertised it as "Barbie-Type," the district court held that the defendant did not infringe Mattel's trademark.<sup>248</sup> The court reasoned that the name "Miss Babette" was not confusingly similar to "Barbie" as to "deceive an ordinary prudent purchaser" and that the defendant had "no control over its [vendors] or the manner in which they advertise its products."<sup>249</sup> In recent years, with Barbie's ascendancy to cultural icon, Mattel has had more success in defending its product, even to the extent of receiving the aid of United States Customs to prevent the importation of dolls that only possibly infringed Mattel's intellectual property rights.<sup>250</sup>

Today, Mattel has attempted to prevent the use of Barbie's image and name by any unauthorized user including magazine publishers and advertisers.<sup>251</sup> For the last five years, Dan Miller has

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244. See Phillips, *supra* note 15, at A12 (analyzing the cultural impact of Barbie).

245. 200 F. Supp. 517 (E.D.N.Y. 1961).

246. *Id.* at 517.

247. *Id.* The original name of Goldberger's doll was "Babette," but they added "Miss" at the time of the lawsuit. *Id.* at 518.

248. *Id.* at 518-19.

249. *Id.*

250. See *Miss America Org. v. Mattel, Inc.*, 945 F.2d 536 (2d Cir. 1991). The Miss America Organization, who contracted with Kenner Products to design Miss America commemorative dolls, was unable to prevent United States Customs officers from detaining shipments of the dolls from China on "suspicion of infringement." *Id.* at 538.

251. Magazines are afforded the same First Amendment protection as Newspapers. See *Arkansas Writers' Project, Inc. v. Rangeland*, 481 U.S. 221, 233 (1987). But magazines may be entitled to less protection than advertising, if categorized as commercial speech. See *Cincinnati v. Discovery Network*, 507 U.S. 410, 427 (1993).



published *Miller's*, a quarterly magazine for Barbie lovers that reviews the quality and price of Barbie dolls.<sup>252</sup> The publication has been available at FAO Schwartz as well as the corporate store at Mattel's headquarters.<sup>253</sup> In April, 1997, after the magazine published photos of Barbie in tennis garb with a pack of Virginia Slims cigarettes, alcohol, and pills in its 1996 winter edition, Mattel brought suit for trademark and copyright infringement.<sup>254</sup> In the fall of the same year, Mattel filed suit against Japanese carmaker Nissan for trademark and copyright infringement.<sup>255</sup> The suit involves an innovative and critically acclaimed Nissan television ad.<sup>256</sup> The commercial features an animated commando doll named Nick who rescues the red-head Roxanne from the boredom of her doll-house, whisking her off in a red Nissan toy sports car under the Van Halen recording of the Kinks song "You Really Got Me."<sup>257</sup>

Mattel's protective reach has also extended to non-commercial entities such as artist Paul Hansen and the band, Aqua.<sup>258</sup> During Christmas 1996, the works of Paul Hansen were available in selected San Francisco shops on Castro Street and displayed in art galleries.<sup>259</sup> Those works included modified Barbie dolls named "Hooker Barbie," replete with a negligee, a condom, and a fifty dollar bill.<sup>260</sup> Other of Hansen's works include "Carrie Barbie," wearing a prom dress drenched in blood and "Big Dyke Barbie," featuring a pierced nose and quote bubble that asks, "Want to

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252. See Denise Gellene, *Mattel's Battle Over Barbie Isn't Child's Play Litigation: Toy Maker's Suit Accuses Magazine of Using Doll's Name and Image Without Permission*, L.A. TIMES, Apr. 30, 1997, at D2 [hereinafter Gellene I].

253. See *id.*

254. See *id.*; Denise Gellene, *Fits of Pink; Barbie Collectors Go Toe-to Toe with Mattel*, WASH. POST, May 16, 1997, at B02 [hereinafter Gellene II].

255. See *Advertising: Mattel Sues Nissan Over TV Ad*, L.A. TIMES, Sept. 20, 1997, at D2. Mattel asserts that the television commercial caused "irreparable injury to [its] name, business reputation and goodwill." *Id.*

256. See *id.*

257. *Id.*

258. See Kelly Flaherty, *Sue Me, Barbie*, RECORDER, Nov. 11, 1997, at 1 (detailing Mattel's efforts to protect the image of Barbie).

259. See Vicki Haddock, *Christmas Shoppers Seeking This Season's 'Hot' Barbie Items Have Alternatives to Real Thing*, J. REC., Dec. 19, 1996 [hereinafter Haddock II] (discussing Anti-Barbie).

260. Flaherty, *supra* note 258, at 1.

Shoot Some Pool?”<sup>261</sup> Mattel has taken issue with Hansen’s negative portrayal of Barbie and filed suit, in August 1997, for trademark and copyright infringement, seeking to enjoin Hansen from displaying or selling his art in galleries.<sup>262</sup>

Finally, Mattel has brought suit against MCA Records, the distributor of the Danish-band Aqua’s song, “Barbie Girl,” for copyright and trademark infringement.<sup>263</sup> The song, containing lyrics such as, “you can brush my hair, undress me everywhere . . . kiss me here, touch me there, hanky panky,” was released as part of Aqua’s album “Aquarium,” in Denmark and throughout Europe in March 1997.<sup>264</sup> The song was released in the United States in August of the same year, and peaked at number seven on the Billboard’s pop singles chart.<sup>265</sup> Aqua, who was not named in the lawsuit, has declared that “the song isn’t about the doll, it’s about the plastic world we live.”<sup>266</sup> Both the single and album have a disclaimer stating that the song is a “social comment that has not been created or approved by the makers of the doll.”<sup>267</sup> Mattel is seeking to enjoin the further sales of the album and single, the further broadcast of the music video, close down Aqua’s web site on the Internet, and compel the removal of all copies of the single and album from record store shelves.<sup>268</sup>

### III. FIRST AMENDMENT PROTECTION SHOULD BE AFFORDED TO INDIVIDUALS WHO USE THE IMAGE OR REPRESENTATION OF CULTURAL ICONS

One of the primary purposes of the First Amendment is to facilitate enlightenment and truth for the benefit of the public through the free exchange of ideas.<sup>269</sup> To serve this purpose,

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261. Haddock II, *supra* note 259.

262. See Flaherty, *supra* note 258, at 1.

263. *Don’t Toy With Our Doll, Mattel Warns Infringers*, NAT’L L.J., Oct. 6, 1997, at A31.

264. Lisa Bannon, *This Suit for Barbie is More Flattering than Song’s Lyrics*, WALL ST. J., Sept. 12, 1997, at B8 (discussing Aqua’s song, *Barbie Girl*).

265. See *id.*

266. Williams, *supra* note 241, at 24.

267. Bannon, *supra* note 264, at B8.

268. See *id.*

269. See generally *Red Lion Broad. Co. v. FCC*, 395 U.S. 367, 390 (1969) (“It is

where the intangible property such as a trademark or publicity rights are used for its symbolic significance, a balance must be struck in favor of freedom of expression over ownership rights.<sup>270</sup> Rights holders such as the Coca-Cola Company, Elvis Presley Enterprises, and Mattel have attempted to use trademark law, anti-dilution, and publicity rights to extract a monopoly that prevents others from using names or images that are significant in American culture.<sup>271</sup> This Part maintains that a new standard, more expansive than the fair use or parody defense, should apply to cases involving the use of cultural icons, in order to advance First Amendment principles. In addition, this Part suggests that an analysis distinguishing between commercial and non-commercial speech is untenable when dealing with cultural icons.

A. *The Use of Cultural Icons Should be Protected in the Absence of Likelihood of Consumer Confusion*

When dealing with the image or representation of cultural icons, such as Coca-Cola, Elvis, or Barbie, the unauthorized use should be permitted so long as it does not cause a likelihood of confusion as to source, sponsorship, or affiliation.<sup>272</sup> Although this proposed standard complies with traditional trademark principles, it may undermine publicity rights and anti-dilution doctrines in favor of the realization that cultural symbols progress to the level of ideas and discourse.<sup>273</sup> The district court in *Elvis Presley Enter-*

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the purpose of the First Amendment to preserve an uninhibited marketplace of ideas in which truth will ultimately prevail.”); *Abrahams v. United States*, 250 U.S. 616, 630 (1919) (Holmes, J., dissenting) (arguing that the truth of any idea can only be determined in the marketplace of competing ideas).

270. See *Rogers v. Grimaldi*, 875 F.2d 994, 1004-05 (2d Cir. 1989).

271. See *supra* Part II (discussing Coca-Cola, Elvis, and Barbie).

272. The notion of consumer confusion remains the foundation of the legal protection of trademarks and is incorporated in the Lanham Act. See 15 U.S.C.A. § 1125(a)(1) (West 1998 & Supp. 1998); Shaughnessy, *supra* note 41, at 181, 183-84 (examining the likelihood of confusion standard in trademark infringement). The standard here proposed would require rights holders to show a likelihood of confusion by a preponderance of evidence, not by clear and convincing evidence as some commentators have argued. See, e.g., Langvardt I, *supra* note 10, at 653 (advocating for a clear and convincing standard where the alleged infringement is in the form of a non-commercial expression).

273. See Rochelle C. Dreyfuss, *We Are Symbols and Inhabit Symbols, So Should We Be Paying Rent? Deconstructing the Lanham Act and Right of Publicity*, 20 COLUM.-VLA J.L. & ARTS 123, 142 (1996) (“[A rights holder’s] contribution may not be suffi-

*prises v. Capece*,<sup>274</sup> recognized this transformation from image to icon, stating that “the image of Elvis, conjured up by way of velvet paintings, has transcended into iconoclastic form of art that has a specific meaning in our culture, which surpasses the identity of the man represented in the painting.”<sup>275</sup>

Coca-Cola Company, Mattel, and to a lesser extent, Elvis Presley Enterprises have spent millions of dollars promoting their products, images, or personae; but ultimately it is the consumer who makes these images profitable and socially valuable.<sup>276</sup> In light of these economic realities, it is questionable whether to give rights holders monopolies over the commercial exploitation of their names, images, or personae to the exclusion of the general public.<sup>277</sup> A limited monopoly, governed under traditional trademark law rather than the more expansive anti-dilution doctrine and publicity rights, is more appropriate.<sup>278</sup>

The standard proposes that the members of the public, such as artists like Paul Hansen, or even “advertisers” like Nissan, be al-

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cient to create the vibrancy of an image and project it into public consciousness.”); *see also* Jollymore, *supra* note 9, at 130 (arguing that a celebrity loses the right to control his or her image when the image achieves symbolic significance).

274. 950 F. Supp. 783, (S.D. Tex. 1996).

275. *Id.* at 792.

276. *See* Jollymore, *supra* note 9, at 126.

277. *See* *Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956 (6th Cir. 1980).

The Sixth Circuit, in dealing with celebrity rights, offered that:

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 in 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 v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1517 (9th Cir.), *reh'g denied*, 971 F.2d 1395 (9th Cir.), *cert. denied*, 508 U.S. 951 (1993) (Kozinski, J., dissenting); *Bi-Rite Enter., Inc. v. Button Master*, 555 F. Supp. 1188, 1194-96 (S.D.N.Y. 1983).

278. Although a likelihood of confusion, as the touchstone of trademark infringement, protects the public, the anti-dilution doctrine protects the trademark holder in the absence of confusion, and the right of publicity protects a celebrity's persona from commercial misappropriation. *See* Prager, *supra* note 93, at 122 (analyzing trademark dilution); Goldsmith, *supra* note 47, at 850-51 (discussing the right of publicity).

lowed to use the images of cultural icons, such as Barbie, in any form of expression, so long as there is no implication that the rights holder, such as Mattel, owned or sponsored the expression.<sup>279</sup> This allows the public to share in an image it helped create and to comment on the image's meaning regardless of the medium.<sup>280</sup> The balance permits rights holders to profit from their marks or images without depriving the public, in the form of artists and advertisers, from engaging in cultural expression.<sup>281</sup>

### 1. Legally Defining "Cultural Icon"

Though scholars have defined the phrase "cultural icon" in ethereal terms,<sup>282</sup> a precise legal definition is necessary in order to facilitate a clear and reliable standard. A status-based standard distinguishing marks and celebrities from cultural icons is analogous to the Supreme Court's jurisprudence regarding defamation.<sup>283</sup> The Court has imposed a high tier "actual malice" standard on public figures, rather than private individuals, when balancing First Amendment principles and the individual's interest in freedom from harm to his or her reputation.<sup>284</sup> The rationale for this status-based standard is that an analysis concentrating solely on the sub-

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279. See *supra* Part II.C (detailing Mattel's efforts to protect the image of Barbie).

280. See Dreyfuss, *supra* note 273, at 124 (addressing who should reap the benefits of images, "those who introduce them into popular culture or those who imbue them with enduring meaning").

281. See Rosemary J. Coombe, *Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue*, 69 TEX. L. REV. 1853, 1855 (1991) (arguing that in the current climate, "intellectual property laws stifle dialogic practices—preventing us from using the most powerful, prevalent, and accessible cultural forms to express identity, community, and difference").

282. See FISHWICK, *supra* note 16, at 131 (defining the word "icon").

283. See Mark D. Walton, *The Public Figure Doctrine: A Reexamination of Gertz v. Robert Welch, Inc. in Light of Lower Federal Court Public Figure Formulations*, 16 N. ILL. U. L. REV. 141, 151 (1995) (examining the distinction between public and private figure defamation and the constitutional defamation standard).

284. *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 343 (1974). The plaintiff in *Gertz* was an attorney who represented the family of a youth who was shot and killed by a Chicago police officer. *Id.* at 325. The officer was subsequently convicted of second degree murder, and the plaintiff represented the victim's family in a civil suit against the officer. *See id.* The defendant published an article falsely accusing the plaintiff of being a Communist, Marxist, and Leninist. *See id.* at 326. The article also falsely accused the plaintiff of having a lengthy police record and falsely asserted that the plaintiff was responsible for framing the police officer. *See id.*

ject matter of the defamatory statement provides inadequate protection of First Amendment interests.<sup>285</sup>

The means of defining a public figure is helpful in determining what is a “cultural icon.” Circuit courts have defined a general-purpose public figure as a well-known celebrity whose name is a “household word.”<sup>286</sup> Considering that cultural icons are both persons and objects that are household words, a more definitive delineation appears appropriate. The Dilution Act<sup>287</sup> only entitles protection to marks that are “famous,” providing a non-exclusive list of eight factors that courts may consider in determining whether a mark is famous.<sup>288</sup> This is a significant departure from state statutes, which typically have required only “distinctiveness.”<sup>289</sup> Distinctiveness is the level of uniqueness required for protection against trademark infringement.<sup>290</sup> This higher level of requisite uniqueness is in tune with the Congressional intention of qualifying the dilution remedy as an “extraordinary” one that requires a significant showing of fame.<sup>291</sup>

Commentators have stated that the fame intended under the Dilution Act is a synonym for “super-distinctiveness.”<sup>292</sup> Using this

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285. *See id.* at 345-46.

286. *Waldbaum v. Fairchild Publication, Inc.*, 627 F. 2d 1287, 1294 (D.C. Cir.), *cert. denied*, 449 U.S. 898 (1980). The court listed several factors that could be considered in this determination, including statistical surveys regarding name recognition, previous media coverage of the plaintiff, the plaintiff’s influence on the actions of others, and whether the plaintiff has successfully shunned media attention. *See id.* at 1295. The court noted that the most important aspects of this determination are the “voluntariness” of the plaintiff’s notoriety and the plaintiff’s access to the media. *Id.*

287. *See supra* notes 93-103 and accompanying text (detailing the Federal Trademark Dilution Act).

288. 15 U.S.C.A. § 1125(c)(1)(A)-(H); *see also supra* note 103 (listing the factors).

289. *Merriam-Webster, Inc. v. Random House, Inc.*, 35 F. 3d 65, 73 (2d Cir. 1994) (“In order to prevail on a claim of dilution under [the New York State dilution statute], the plaintiff must prove. . .that its trade dress or trademark either is of truly distinctive quality or has acquired secondary meaning . . . .”); *see also* *Prager, supra* note 93, at 127 (detailing the eligibility standard for protection under the Federal Trademark Dilution Act).

290. *See Prager, supra* note 93, at 127.

291. *Report of the Trademark Review Commission*, 77 TRADEMARK REP. 375, 461 (1987) (“We believe that a higher standard [than fame among an “appreciable number” of persons] should be employed to gauge the fame of a trademark eligible for this extraordinary remedy.”).

292. *Prager, supra* note 93, at 130 (“It may be that fame is intended to be a syno-

concept, a cultural icon can be categorized as “ultra-distinctive.” In making this determination, courts should use the eight statutory factors associated with “famous” under the Dilution Act, plus an additional element.<sup>293</sup> This additional element can be defined as whether the mark or person has achieved “tertiary meaning.” Tertiary meaning is achieved when a mark or person has acquired symbolic significance, a meaning beyond that of its descriptive sense and secondary meaning.<sup>294</sup> Accordingly, both persons such as Elvis and objects such as Barbie, may achieve iconic status and thus would be covered under the proposed standard.

## 2. A Likelihood of Confusion Standard Serves the Interests of Rights Holders and the Public

A likelihood of confusion standard embraces the social significance associated with Coca-Cola, Elvis, and Barbie, balances society’s and rights holders’ interests, thus eliciting a just result where the use of cultural icons is challenged in non-competitive situations.<sup>295</sup> Consumer confusion remains the foundation of legal pro-

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nym for ‘super-distinctiveness,’ and this would be consistent with the caselaw under the state statutes and with Congress’ eight factors.”).

293. See *supra* note 103 and accompanying text (listing the factors).

294. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13. cmt. e. The Restatement defines “secondary meaning” as:

[Referring] to a subsequent significance added to the original meaning of the term. Secondary meaning exists only if a significant number of prospective purchasers understand the term, when used in connection with a particular kind of good, service, or business, not merely in its lexicographic sense, but also as an indication of association with a particular, even if anonymous, entity.

*Id.*

295. The *Polaroid* multifaceted analysis to determine likelihood of confusion is primarily used in non-competitive situations, however, the Second Circuit has been expanded it to reach competing goods. See *Physicians Formula Cosmetics, Inc. v. West Cabot Cosmetics, Inc.*, 857 F. 2d 80, 82 (2d Cir. 1988) (“Although the *Polaroid* test originally was applied to non-competing products, it has been expanded to apply where, as here, competing goods are involved.”). But generally, a likelihood of confusion will easily be found where the goods are competing and the marks are similar. See *Lindy Pen Co. v. Bic Pen Corp.*, 796 F.2d 254, 255 (9th Cir. 1986). Considering that in situations involving competitive goods, the injury results from a direct diversion of sales, a balance should be struck in favor of the rights holder. See 3 MCCARTHY, TRADEMARKS, *supra* note 30, § 24:22. Yet to be competitive, there is a question of “interchangeability” of products, where by a purchaser is willing or ready to substitute one product for another. *Id. supra* § 24:23. Where an advertiser or artist uses the image of a cultural icon, the

tection of trademarks and is the touchstone of trademark infringement.<sup>296</sup> On the other hand, the dilution doctrine is concerned with granting protection to trademarks beyond that provided by the “likelihood of confusion” test.<sup>297</sup> With publicity rights, consumer confusion is of no concern, the focus being on the “identifiability” of the plaintiff as a person.<sup>298</sup> Although consumer confusion protects the public, anti-dilution protects rights holders from the diminishment of their marks, and publicity rights protect a person from the commercial appropriation of his or her image.<sup>299</sup>

The prohibition against unauthorized uses of trademarks that are likely to cause consumer confusion serves three related societal interests.<sup>300</sup> First, it shields the public from misleading information in the market place.<sup>301</sup> Second, it prevents the unjust enrichment of the infringer, who would otherwise be able to gain by adopting the trademark owner’s identity and reputation as his own.<sup>302</sup> Finally, it insulates the trademark owner from the possibility that the infringer will pass off inferior products as those of the rights holder, harming the rights holder’s reputation among the

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question of “interchangeability” is mute because the purchaser desires to buy the artist or advertiser’s expression, not his or her product over the rights holder’s product. *Id.*

296. *See id.* § 23:1 (discussing the likelihood of confusion standard); Shaughnessy, *supra* note 41, at 181 (examining the preeminence of the likelihood of confusion standard).

297. *See* 3 MCCARTHY, TRADEMARKS, *supra* note 30, § 24:70.

298. *Id.* § 28:12; *see also* University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., 703 F.2d 1372, 1376 (Fed. Cir. 1983) (“There may be no likelihood of such confusion as to the source of goods even under a theory of ‘sponsorship’ or ‘endorsement,’ and, nevertheless, one’s right of privacy, or the related right of publicity, may be violated.”). “Identifiability” measures whether an insignificant number of people can identify the object person from the defendant’s unauthorized commercial use. 3 MCCARTHY, TRADEMARKS, *supra* note 30, § 28:12.

299. *See id.* §§ 24:70, 28:12 (analyzing trademark dilution and the right of publicity).

300. *See* Shaughnessy, *supra* note 41, at 181 (discussing the societal interests protected by the likelihood of confusion standard).

301. *See* Falcon Rice Mill, Inc. v. Community Rice Mill, Inc., 725 F.2d 336, 348 (5th Cir. 1984) (“By ensuring correct information in the marketplace, the [trademark] laws reduce losses caused by misunderstanding and deceit and thus permit consumers and merchants to maximize their own welfare confident that the information presented is truthful.”).

302. *See* Aetna Casualty & Surety Co. v. Aetna Auto Finance, Inc., 123 F.2d 582, 584 (5th Cir. 1941).



consuming public.<sup>303</sup> The first interest is unique to the likelihood of confusion doctrine, the second is akin to the rationale supporting anti-dilution, and the third is similar to the protection against the loss of commercial value of one's persona under the right of publicity.<sup>304</sup>

Where cultural icons are concerned, these societal interests are served by affording the individual the opportunity to use his or her image free from liability, so long as the work does not deceive the public.<sup>305</sup> In the absence of deceit, there is a significant distinction between the rights holder's mark or image and the defendant's use that does not result in unjust enrichment, because something of value is added to the cultural image.<sup>306</sup> A rights holder may claim that the use injures his or her reputation or diminishes the commercial value of his or her mark or image, but any negative association made to the cultural icon is a result of free expression in the realm of First Amendment protection.<sup>307</sup>

The proposed standard, as applied to the three icons that are the subject of this Note, would lead to an equitable result. In *Coca-Cola v. Gemini Rising*,<sup>308</sup> the use of the words "Enjoy Cocaine" would not be enjoined because there is no likelihood of confusion contrary to the district court's analysis, and that allusion to Coca-Cola was in the spirit of ridiculing a national symbol.<sup>309</sup> Applying

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303. See *Yale Electric Corp. v. Robertson*, 26 F. 2d 972, 974 (2d Cir. 1928). If the unauthorized user of the trademark is a direct competitor of the trademark owner, the owner faces the possibility of diversion of trade as well as harm to reputation. In this situation, the infringement creates the likelihood that some consumers will buy the infringer's product believing it to be that of the trademark owner. Here, there is both unjust enrichment of the infringer and unjust impoverishment of the trademark owner. See 1 MCCARTHY, TRADEMARKS, *supra* note 30, § 2:10.

304. See *id.* §§ 23:1, 24:70, 28:7.

305. Deceit, which was the common law foundation for trademark law, occurs when the public is confused. See *supra* notes 52-56 and accompanying text.

306. See *supra* notes 19-25 and accompanying text (detailing the views and works of authors who are proponents of "cultural populism.").

307. See *supra* Part I.D (analyzing First Amendment protection of expression).

308. 346 F. Supp. 1183 (E.D.N.Y. 1972).

309. See *id.* at 1191; see also *White v. Samsung Elecs. Am.*, 971 F.2d 1395, 1401 (9th Cir. 1992) (Kozinski, J., dissenting) (stating that "much of the vibrancy of our culture . . . depends on the existence of . . . intangible rights," such as the "right to draw ideas from a rich and varied public domain, and the right to mock, for profit as well as fun, the cultural icons of our time"), *reh'g denied*, 989 F.2d 1512 (9th Cir. 1993).

the proposed standard to *Polar Corp. v. Coca-Cola*,<sup>310</sup> would lead to a different result in granting Polar Corporation a declaratory judgment entitling them to broadcast the television commercial.<sup>311</sup> Here, unlike other cases, Coca-Cola employed the Lanham Act's prohibition against false representations in advertising to prevent the use of its image by a competitor.<sup>312</sup> Polar Corporation, as a competitor, may present a direct threat to Coca-Cola because Polar Corporation may divert revenue away from the rights holder through the use of a similar mark.<sup>313</sup> There was, however, no reasonable expectation of confusion from the use of Coca-Cola's image in Polar Corporation's commercial.<sup>314</sup> The throwing of a Coca-Cola can into the trash in an animated commercial, would only give a subtle implication of impurity, which alone, should not have been enough to inhibit Polar Corporation's expression.<sup>315</sup>

With Barbie, there is no likelihood of confusion as to the artwork of Paul Hansen's "Big Dyke Barbie" and the like, as well as Nissan's commercial because Mattel does not possess the rights to every female doll in the market, but with Miller's Publication, the result may be different.<sup>316</sup> Though Mr. Hansen's work may be distasteful, his work acts as a commentary on the image of Barbie in our society, and the creative endeavors of Nissan's advertisers are

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310. 871 F. Supp. 1520 (D. Mass. 1994).

311. Polar Corporation's use of the Coca-Cola trademark may be covered under fair use for comparative advertising. The Federal Trade Commission encourages the naming of competitors in comparative advertising. See FTC Procedures and Rules of Practice, 16 C.F.R. § 14.15(b)-(c) (1988) ("Commission policy in the area of comparative advertising encourages the naming of, or references to competitors . . ."). In general, it is neither trademark infringement nor unfair competition to truthfully compare products in advertising, and in doing so, to identify by trademark, the competitor's goods. See 3 MCCARTHY, TRADEMARKS, *supra* note 30, § 25:52.

312. *Polar Corp.*, 871 F. Supp. at 1521; see also *supra* note 77 and accompanying text (quoting section 43(a) as enacted).

313. See 3 MCCARTHY, TRADEMARKS, *supra* note 30, § 24:1 (discussing the effects of a competitor's use of another's mark).

314. See *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, (9th Cir. 1979) ("When the goods produced by the alleged infringer compete for sales with those of the trademark owner, infringement usually will be found if the marks are sufficiently similar that confusion can be expected.").

315. See 3 MCCARTHY, TRADEMARKS, *supra* note 30, § 23:9 (analyzing what constitutes consumer confusion).

316. See *supra* notes 252-254 and accompanying text (discussing Miller's Publication's use of the Barbie trademark).

protected because the television commercial only “calls to mind” which traditionally is not enough to establish trademark infringement.<sup>317</sup> With Miller’s Publication, there may be a likelihood of confusion, but the use of Barbie’s image would be protected under other defenses to trademark infringement and dilution.<sup>318</sup>

### 3. The Fair Use Doctrine and Parody Defense Does Not Adequately Serve First Amendment Principles and the Public’s Interest

The fair use doctrine and a parody defense may not be sufficient in safeguarding First Amendment principles in light of the dilution doctrine and the right of publicity.<sup>319</sup> 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.<sup>320</sup> This fair use defense “allows a competitor to use another’s registered trademark to describe aspects of one’s own goods.”<sup>321</sup>

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317. 3 MCCARTHY, TRADEMARKS, *supra* note 30, § 23:9 (“‘Confusion’ means more than that the junior user’s mark merely ‘calls to mind’ the senior user’s mark.”).

318. Miller’s Publication, which began publishing *Miller’s* in 1992 and circulated the magazine at Mattel headquarters, may successfully evoke the affirmative defenses of laches and acquiescence. See Gellene I, *supra* note 252, at D2; Cuban Cigar Brands, N.V. v. Upmann Int’l, Inc., 457 F. Supp. 1090, 1096 (S.D.N.Y. 1978) (laches defense), *aff’d*, 607 F.2d 995 (2d Cir. 1979); Carl Zeiss Stiftung v. V.E.B. Carl Zeiss, Jenna, 293 F. Supp. 892, 917 (S.D.N.Y. 1968) (acquiescence defense), *aff’d*, 433 F.2d 686 (2d Cir. 1970).

319. See *Coca-Cola v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972); *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1517 (9th Cir.), *reh’g denied*, 971 F.2d 1395, (9th Cir.), *cert. denied*, 508 U.S. 951 (1993).

320. The fair use defense is available when the allegedly infringed trademark has both a “primary” meaning, that is, an ordinary descriptive usage, and a “secondary” meaning, which identifies the product of a specific business. Shaughnessy, *supra* note 41, at 200 n.125; see also 15 U.S.C.A. § 1115(b)(4) (West 1998 & Supp. 1998). The Lanham Act states that:

[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.

15 U.S.C.A. § 1115(b)(4); see also *Car-Freshener Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 269 (2d Cir. 1995); 2 MCCARTHY, TRADEMARKS, *supra* note 30, § 11:45-11:49 (“No one competitor can use trademark law to exclude others from use of a word in its primary, descriptive and non-trademark sense.”).

321. 15 U.S.C.A. § 1115(b)(4); see also *New Kids on the Block v. News Am.*

The difficulty with the fair use defense as dealing with cultural icons is that it has little relevance where the dilution doctrine is evoked because it is simply a recognition of a specific application of the Lanham Act's test of infringement—there is no likelihood of confusion where a term is used in its descriptive sense.<sup>322</sup> Under federal law, the dilution doctrine protects “famous” marks from diminishing its uniqueness or portraying it in an “unwholesome or unsavory context,” without an inquiry as to confusion.<sup>323</sup> The dilution theory allows courts to prohibit the unauthorized use of cultural icons that are famous by their very nature, where there is no reasonable possibility of confusion and a minimal amount of tarnishment exists, if at all.<sup>324</sup>

Parody, which is an ancient form of social commentary and literary criticism, has been viewed as a form of artistic expression that is protected by the First Amendment.<sup>325</sup> Courts have often stated the general proposition that parodies and satires deserve substantial freedom as entertainment and as a form of social and literary criticism.<sup>326</sup> Although the dilution doctrine has been viewed as violating the First Amendment where a trademark owner attempted to inhibit trademark parodists,<sup>327</sup> courts have shown a propensity to find trademark infringement where the parody is distasteful.<sup>328</sup> For example, in *Coca-Cola v. Gemini Rising, Inc.*,<sup>329</sup>

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Publ'g, Inc., 971 F.2d 302, 306 (9th Cir. 1991).

322. See 15 U.S.C.A. § 1115(b)(4); see also Shaughnessy, *supra* note 41, at 200 (discussing the likelihood of confusion standard).

323. 15 U.S.C.A. § 1125 (c)(1); *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 43 (2d Cir. 1994); see also *supra* Part I.A.2 (analyzing trademark dilution).

324. See *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972). The *Gemini Rising* decision occurred before the passage of the Federal Trademark Dilution Act, but the court recognized that Coca-Cola “was so widely known” that there was little doubt that the mark was “famous.” *Id.* at 1187; see also 15 U.S.C.A. § 1125 (c)(1).

325. See *Cliffs Notes v. Bantam Doubleday Dell Publ'g Group*, 886 F.2d 490, 495 (2d Cir. 1989); *Groucho Marx Prod. v. Day & Night Co.*, 689 F.2d 317, 319 n.2 (2d Cir. 1982) (recognizing “the broad scope permitted parody in First Amendment law”).

326. See Gretchen A. Pemberton, *The Parodist's Claim to Fame: A Parody Exception to the Right of Publicity*, U.C. DAVIS L. REV. 97, 114 (1993) (advocating for a parody exception to the right of publicity).

327. See *L.L. Bean v. Drake Publishers*, 811 F.2d 26, 31 (1st Cir. 1987) (holding that anti-dilution statutes can violate the First Amendment rights of trademark parodists whose pornographic magazine's parodied L.L. Bean's trademark).

328. See *infra* note 40 and accompanying text (detailing decisions finding trade-

the district court's ruling that the "Enjoy Cocaine" poster impaired Coca-Cola's mark is essentially that the mere suggestion of the name in connection with an illegal substance tarnishes the mark.<sup>330</sup> In right of publicity cases, courts have refused to recognize a parody exception to the right of publicity where the use is for commercial purposes.<sup>331</sup>

An appropriate outcome, akin to the proposed standard, resulted in *Elvis Presley Enterprises v. Capece*,<sup>332</sup> where the district court acknowledged Elvis's cultural significance and refused to find trademark infringement, misappropriation of publicity rights, or dilution even though the Elvis name and image were associated with a "tasteless" bar that displayed explicit pictures of woman.<sup>333</sup> The *Capece* court only enjoined the defendant's use of Elvis's image in advertising because there was a likelihood of consumer confusion.<sup>334</sup>

#### B. *The Distinction Between Commercial Speech and Noncommercial Speech Is Untenable When Dealing With Cultural Icons*

Both artists and advertisers have used the image or representations of cultural icons to comment on society, criticize the symbol, or sell merchandise.<sup>335</sup> In our pop culture, "where salesmanship must be entertaining and entertainment must sell," the line between commercial and non-commercial speech has disappeared.<sup>336</sup> Af-

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mark infringement when marks are used in connection with pornographic or offensive material).

329. 346 F. Supp. 1183 (E.D.N.Y. 1972).

330. *Id.* at 1190.

331. *See White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1401 (9th Cir. 1992).

332. 950 F. Supp. 783 (S.D. Tex. 1996).

333. *Id.* at 798.

334. *Id.* at 792.

335. *See supra* note 15 and accompanying text (detailing the significance of cultural icons in contemporary society).

336. *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1519 (9th Cir.) (Kozinski, J., dissenting), *cert. denied*, 508 U.S. 951 (1993). Judge Kozinski questioned:

Is the Samsung parody [of Vanna White in a television commercial] any different from a parody on Saturday Night Live or in *Spy Magazine*? . . . Both use a celebrity's identity to sell things—one to sell VCRs, the other to sell advertising. Both mock their subjects. Both try to make people laugh. Both add some-

for different First Amendment protection on the basis of whether the use of a cultural icon is commercial speech or non-commercial speech fails to acknowledge its social significance and the role the public plays in its creation.<sup>337</sup> Elvis symbolizes “American Rock-n-Roll,” Barbie symbolizes “a beautiful but empty headed accessory” and American sexism, and to nations of the world, Coca-Cola symbolizes America itself.<sup>338</sup>

The level of First Amendment protection should not be determined upon whether Paul Hansen created “Trailer Trash Barbie” solely for a museum exhibit, rather than for sale.<sup>339</sup> If Aqua’s song “Barbie Girl” is protected as artistic speech, it should not matter that the single sold hundreds of thousands of copies.<sup>340</sup> Nissan’s television commercial is highly acclaimed for creativity, and arguably more brilliant than traditional artistic work, and the unauthorized use of Barbie’s image should not be penalized solely because the advertisement proposes a commercial transaction.<sup>341</sup>

Commentators have proposed that the medium for where the trademark is used, and not the message, should be dispositive in determining whether there is infringement.<sup>342</sup> This complies with traditional Supreme Court analysis, affording commercial speech a lower level of First Amendment protection.<sup>343</sup> Therefore, even though Aqua’s song is a social commentary and Paul Hansen’s

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thing, perhaps something worthwhile and memorable, perhaps not, to our culture.

*Id.*

337. See Madow, *supra* note 19, at 139 (analyzing society’s role in the creation of cultural symbols).

338. See *supra* notes 13-15 and accompanying text (detailing the symbolic significance of Elvis and Barbie).

339. See *supra* notes 259-262 and accompanying text (discussing Mattel’s suit against artist Paul Hansen).

340. See Bannon, *supra* note 264, at B8.

341. See *The Best Awards: Automotive Toyland Adventure Boosts Enjoyable Nissan: Ride Honda Seeks Sanity, While Fantasies Sell Jeeps, Electric Cars*, ADVERTISING AGE, May 26, 1997, at S2 (detailing the success of the Nissan commercial).

342. See 4 MCCARTHY, TRADEMARKS, *supra* note 30, § 31:152 (“In situations where the First Amendment is invoked in cases of the allegedly communicative use of a trademark . . . it is the medium, not the message, that will often make the difference in result.”).

343. See *supra* notes 154-167 and accompanying text (detailing the level of protection afforded commercial speech).

work merely mocks society, there is infringement if the use is commercial.<sup>344</sup> In order to prove a prima facie case for dilution under the Dilution Act, a plaintiff must prove that the “defendant is making commercial use” of his or her mark.<sup>345</sup> The right of publicity affords protection against the “commercial” use of a celebrity’s name, image, or persona, and some courts have reasoned that parodies and satires are not protected if the use is commercial in nature.<sup>346</sup>

Commercial speech is a significant, valuable part of our national discourse.<sup>347</sup> Commentators have challenged the Supreme Court’s rationale for distinguishing commercial and non-commercial speech on various grounds.<sup>348</sup> For example, *Virginia State Board of Pharmacy v. Virginia Citizens Council, Inc.*,<sup>349</sup> has been criticized as operating under a false presumption that personal or economic incentive prevents commercial expression from being “chilled” by regulation.<sup>350</sup> Political speech, which is afforded full constitutional protection, arguably is motivated by considerations of personal benefit.<sup>351</sup> Ironically, the Supreme Court’s landmark decision in protecting free expression from being “chilled” by a defamation action, involved a paid-for advertisement that appeared in the *New York Times*.<sup>352</sup>

One of the underlying rationales for affording commercial speech a lesser degree of First Amendment protection was to pro-

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344. See *supra* notes 154-167 and accompanying text (discussing the relationship between commercial speech and infringement).

345. 15 U.S.C.A. § 1125(c).

346. See, e.g., *L.L. Bean, Inc. v. Drake Publ’g*, 811 F.2d 26, 32-33 (1st Cir. 1987) (limiting First Amendment protection to non-commercial parodies).

347. See *White v. Samsung Elecs. Am., Inc.*, 989 F. 2d 1512, 1519 (9th Cir.) (Kozinski, J., dissenting), *cert. denied*, 508 U.S. 951 (1993).

348. See Redish, *supra* note 41, at 565-74. Professor Redish suggests that a commercial speech distinction is flawed because (1) the distinction is impermissible as content-based, (2) commercial speech and non-commercial speech are equally verifiable, (3) a speech-action dichotomy does not apply, (4) self-interest is immaterial, and (5) a corporate entity-person distinction is irrational. *Id.*

349. 425 U.S. 748 (1976).

350. Redish, *supra* note 41, 565-66 (questioning the Supreme Court’s distinction between commercial and non-commercial speech).

351. See *id.*

352. *Id.*; *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964).

tect consumers from undesirable persuasion to purchase products.<sup>353</sup> This reasoning, when applied to situations involving cultural icons, is unsound considering the profound nature of a widely known image. If the commercial speech distinction no longer exists, the proper analysis will be of the message, not the medium.<sup>354</sup> Justice Stevens in *44 Liquormart, Inc. v. Rhode Island*,<sup>355</sup> reasoned that deceptive commercial speech should be afforded minimal constitutional protection but concluded that restrictions on “truthful, nonmisleading messages” demand “rigorous” First Amendment review.<sup>356</sup> Using the image of cultural icons in posters, artwork, or television commercials should be protected regardless of the medium, as long as the use is a “truthful, nonmisleading message” as alluded to in *44 Liquormart*, that is, no confusion as to source, sponsorship, or affiliation.<sup>357</sup>

#### CONCLUSION

Intellectual property rights are essential to modern life. They provide incentive for investment and innovation and allow culture to flourish. The rights are imposed, however, at the expense of future creators and the general public. Yet, as the court noted in *White v. Samsung Electronics America, Inc.*, the vibrancy of culture depends upon the existence of a right to draw ideas from the public domain, and the right to mock cultural icons for both commercial and entertainment purposes. Although individuals create trademarks or personae, society elevates them to symbols, celebrities, and ultimately icons. To deny the public the use of icons, such as Coca-Cola, Elvis, and Barbie, would be to ignore the public’s role in the creation of these images.

Recognition of the partnership that exists between the public and rights holders would allow for equal use, so long as there is no likelihood of confusion as to source, sponsorship, or affiliation. Such qualified recognition would prevent public deception while

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353. See Redish, *supra* note 41, at 555.

354. See 4 MCCARTHY, TRADEMARKS, *supra* note 30, § 31:152 (arguing for a “medium” rather than a “message” approach).

355. 517 U.S. 484, 116 S. Ct. 1495 (1996).

356. *Id.* at 1506-07.

357. *Id.* at 1507.



protecting the interest of rights holders in controlling their ownership images. Overprotection of images deters creativity and ultimately hurts society. Coca-Cola Company, Elvis Presley Enterprises, and Mattel, Inc. earn enormous amounts of money through the exploitation of the images they own. Allowing the use of these images—for societal commentary, for product critiques, or for simple fun—would not injure the earning power of the cultural icons and will benefit everyone. The reverse would injure us all.