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Four Free Speech Goals for Trademark Law

William McGeeveran
University of Minnesota Law School

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Cover Page Footnote

I have received helpful comments about this project from many people, especially Barton Beebe, Dan Burk, Tom Cotter, Stacey Dogan, Eric Goldman, Laura Heymann, Mark McKenna, and participants in the Fifth Annual Works in Progress in Intellectual Property Colloquium at Washington College of Law, American University. I also benefited from the questions and insights of participants at this symposium, particularly my fellow panelists Sonia Katyal, Brett Frischmann, and Robert Weisbein. I am grateful for research assistance from L. Ashley Aull and David Biggs. Some early research on these issues was conducted as part of a fellowship at the Berkman Center for Internet and Society at Harvard Law School.

Four Free Speech Goals for Trademark Law

William McGeveran*

Trademarks constrain the use of language. Some disputes about trademarks thus involve serious arguments about the defendant's right to engage in free speech. The case that serves as the impetus for this panel, *Freecycle Network, Inc. v. Oey*,¹ is an especially shocking example of a district court enjoining substantive noncommercial speech in the name of preserving the value of a trademark. It was so shocking that protests and amicus briefs poured in from bloggers, law professors, and advocacy groups of every stripe, including Eugene Volokh, Mark Lemley, Larry Lessig, David Post, the Electronic Frontier Foundation, and many others.² It was so shocking that the appeals court promptly

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* Associate Professor, University of Minnesota Law School. I have received helpful comments about this project from many people, especially Barton Beebe, Dan Burk, Tom Cotter, Stacey Dogan, Eric Goldman, Laura Heymann, Mark McKenna, and participants in the Fifth Annual Works in Progress in Intellectual Property Colloquium at Washington College of Law, American University. I also benefited from the questions and insights of participants at this symposium, particularly my fellow panelists Sonia Katyal, Brett Frischmann, and Robert Weisbein. I am grateful for research assistance from L. Ashley Aull and David Biggs. Some early research on these issues was conducted as part of a fellowship at the Berkman Center for Internet and Society at Harvard Law School.

¹ *Freecycle Network, Inc. v. Oey*, 505 F.3d 898 (9th Cir. 2007), *rev'g* *Freecycle Network, Inc. v. Oey*, No. CV 06-173, Preliminary Injunction Order (D. Ariz. May 11, 2006).

² See Brief for 38 Intell. Prop. Professors and the Elec. Frontier Found. as Amici Curiae Supporting Petitioners, *Freecycle*, 505 F.3d 898 (No. 06-16219), available at <http://www.volokh.com/files/freecyclelemleybrief.pdf>; Brief of James Boyle et al. as Amici Curiae Supporting Petitioners, *Freecycle*, 505 F.3d 898 (No. 06-16219), available at <http://www.volokh.com/files/freecyclepostbrief.pdf>; Posting of Eugene Volokh to The Volokh Conspiracy, http://www.volokh.com/posts/chain_1190828574.shtml (July 14, 2006, 18:03 EST).

reversed the injunction and concluded that the plaintiff had completely failed to show the required likelihood of success on the merits.³ It was shocking, and so the *Freecycle* case became a cause célèbre—not because it was typical, but because it was unusual.

There is no shortage of law review articles and books warning that overly broad interpretations of trademark rights imperil free speech values.⁴ I share their sense of concern, yet the eventual decisions in almost all recent controversial cases protected speech,⁵ just as the Ninth Circuit did in *Freecycle*. When courts finally reach the merits, these cases suggest, the defendant's free speech arguments ultimately carry the day.⁶ This does not mean that all is well. It does mean, however, that we need to focus on the true free speech problem in trademark law.

That problem arises because only a tiny fraction of disputes actually reach litigation and become eligible for a happy ending like the one we saw in the *Freecycle* case. Moreover, their holdings tend to be tied closely to their facts and so offer limited value as precedent. Considerable anecdotal evidence suggests that the real action occurs outside the courthouse: markholders send cease-and-desist letters and threaten legal action against those using trademarks to facilitate speech, and the recipients frequently

³ *Freecycle*, 505 F.3d at 906 & n.15.

⁴ See, e.g., DAVID BOLLIER, BRAND NAME BULLIES: THE QUEST TO OWN AND CONTROL CULTURE (2005); KEMBREW MCLEOD, FREEDOM OF EXPRESSION®: OVERZEALOUS COPYRIGHT BOZOS AND OTHER ENEMIES OF CREATIVITY (2005); Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397 (1990); Alex Kozinski, Essay, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960 (1993); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687 (1999); Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 YALE L.J. 1717 (1999).

⁵ See, e.g., *Mattel, Inc. v. Walking Mountain Prods. (Mattel-Walking Mountain)*, 353 F.3d 792 (9th Cir. 2003).

⁶ See, e.g., *id.*; *BidZirk, L.L.C. v. Smith*, No. 6:06-109-HMH, 2007 WL 3119445 (D.S.C. Oct. 22, 2007); see also Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 COLUM. J.L. & ARTS 187 (2004); Sarah Mazzie-Briscoe, *Free Speech v. Trademark Rights: Has the Weather Changed?* (March 19, 2006), <http://www.chillingeffects.org/weather.cgi?WeatherID=540> (noting a possible trend of improvement in courts' deference to free speech concerns in cybersquatting cases).

capitulate.⁷ We need not devote too much energy to improving the courts' ability to reach the correct substantive outcomes in the final judgment at the end of a lawsuit. They already do. Rather, the priority should be restructuring the relevant doctrines to reduce the pre-litigation chilling effect. My objective here is to discuss four normative goals to guide those doctrinal improvements (Part I), and to make some extremely preliminary suggestions about what the relevant parts of trademark law might look like as a result (Part II).

I.

A. *Balance Between Economic and Expressive Values*

The first normative objective, when stated simply, encapsulates the whole problem of using trademarks to engage in speech: the doctrine must balance interests in source identification and in unfettered expression. This search for equilibrium has been part of trademark jurisprudence since its earliest days.⁸ Despite other shortcomings, existing doctrine eventually strikes this balance most of the time.

We all understand the economic function of trademarks as important shorthand to help consumers identify with accuracy the products they want to buy.⁹ So, for example, my young daughter

⁷ James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 *YALE L.J.* 882, 913 (2007); MARJORIE HEINS & TRICIA BECKLES, BRENNAN CTR. FOR JUSTICE, *WILL FAIR USE SURVIVE? FREE EXPRESSION IN THE AGE OF COPYRIGHT CONTROL* 35–36 (2005), available at <http://www.fepproject.org/policyreports/WillFairUseSurvive.pdf>; see Chilling Effects Clearinghouse: Search the Database, <http://www.chillingeffects.org/search.cgi> (last visited Feb. 26, 2008) (database with examples of legal threats against trademark holders); Citizen Media Law Project Legal Threats Database, <http://www.citmedialaw.org/database> (last visited Feb. 26, 2008) (same).

⁸ See, e.g., *Am. Waltham Watch Co. v. United States Watch Co.*, 53 N.E. 141, 142 (Mass. 1899) (Holmes, J.) (“The two desiderata cannot both be had to their full extent, and we have to fix the boundaries as best we can.”).

⁹ See generally *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 163–64 (1995); Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 *HOUS. L. REV.* 777, 786–88 (2005) [hereinafter Dogan & Lemley,

and I both prefer SKIPPY creamy peanut butter to others.¹⁰ As I hurry through the supermarket I know that, if I grab the jar of peanut butter with a turquoise cap and the SKIPPY brand name in a red paintbrush font, we will both be satisfied with our sandwiches. If an interloper could use a similar name and packaging to trick me into buying some competing inferior peanut butter, several undesirable results would occur. For one, my daughter might not eat her lunch.¹¹ As a result, my family might erroneously discard our preference for SKIPPY in the future (unless I later realized I'd been duped). The maker of SKIPPY¹² would lose my patronage through no fault of its own. The imposter would get my money unjustly through subterfuge. And finally, if this sort of misappropriation of customers happened routinely, a producer might find it no longer worthwhile even to attempt to preserve the consistent creamy goodness of the product. After all, customers who discover they like a product cannot reliably find it again without trademarks. These are all serious economic problems that must not be dismissed or trivialized.

The speech interest on the other pan of the scale is also familiar. Expansive trademark protection for common words and phrases can effectively remove them from our language, at least in certain contexts. This has significant anticompetitive effects.¹³

Search Costs]; William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 268–70 (1987).

¹⁰ Perhaps I am projecting; she is only four years old. But it seems that our peanut butter tastes coincide, at least for now.

¹¹ Or at least she may ask me repeatedly how many bites of the sandwich are necessary.

¹² The maker of SKIPPY, as it happens, is a corporation called CPC International that has attempted to use trademark law to silence critical commentary on a website. *See CPC Int'l, Inc. v. Skippy Inc.*, 214 F.3d 456, 458 (4th Cir. 2000). But I don't actually need to know anything about CPC International, even its name, provided I know that this jar of SKIPPY will resemble the others I have enjoyed in the past. *See Qualitex*, 514 U.S. at 164; 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3:9 (4th ed. 2007) (“‘source’ identified by a trademark need not be known by name to the buyer”) [hereinafter MCCARTHY ON TRADEMARKS]. Thus it is somewhat imprecise to say that trademarks are *source* identifiers, and it might be better to call them indicators of products' resemblance or consistency. The “source identification” terminology is well-established despite its imprecision, however, and I use it here.

¹³ *See Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1430 (7th Cir. 1985) (Easterbrook, J.) (“If descriptive words and pictures could be appropriated without evidence of a secondary meaning, sellers could snatch for themselves the riches of the

Beyond the economic impact, doctrines that permit monopolization of everyday language may also impoverish artistic, political, and social speech. “Much useful social and commercial discourse would be all but impossible if speakers were under threat of an infringement lawsuit every time they made reference to a person, company or product by using its trademark.”¹⁴ Trademarks constrain expression most seriously of all when they allow their holders to prevent or control discussion about themselves or their product.¹⁵

The key here is balance. Source identification is important, and an overly expansive doctrine that immunizes harmfully misleading speech might disserve the public. This can be true even in areas with great free speech sensitivity. I like to use the facts of a little-known Massachusetts case to make this point: one month after a Planned Parenthood abortion clinic opened, a local pro-life group called “Problem Pregnancy” rented an office that was down the hall and closer to the elevators, so women intending to go to the clinic had to pass by.¹⁶ The pro-life group then posted signs on the door reading “PP” and “Free pregnancy testing and counseling, walk in.”¹⁷ Several women did.¹⁸ Or, to take an example from the other end of the political spectrum, how about the case where the Democrats in a local election wanted to rename themselves the “Representation for Every Person Party” (or, by its initials, the “REP Party”)?¹⁹ These examples involve political speech—often

language and make it more difficult for new entrants to identify their own products; consumers would be worse off.”).

¹⁴ *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 307 (9th Cir. 1992).

¹⁵ *See L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 33 (1st Cir. 1987) (discussing the risk that “a corporation could shield itself from criticism by forbidding the use of its name in commentaries critical of its conduct”).

¹⁶ *Planned Parenthood Fed’n of Am., Inc. v. Problem Pregnancy of Worcester, Inc.*, 498 N.E.2d 1044, 1045 (Mass. 1986).

¹⁷ *Id.*

¹⁸ *Id.*

¹⁹ *Tomei v. Finley*, 512 F. Supp. 695, 696–97 (N.D. Ill. 1981); *see also United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 88 (2d Cir. 1997) (enjoining New York chapter of Ross Perot’s political organization, UNITED WE STAND AMERICA, which split off from the parent group, from operating and raising funds under the UNITED WE STAND name).

the sacrosanct category—but even here confusion might become too great to be tolerated.

On the other hand, as the Supreme Court recently ruled, sometimes we should tolerate a certain degree of potential confusion in order to accommodate concerns about expression.²⁰ The existence of confusion answers a factual question, but not the normative question of whether eliminating that confusion is more important than any other values.²¹ Indeed, no one seems troubled if the use of a functional source-indicator by two producers causes some confusion among consumers. We have already balanced competing values in those situations, and have structured doctrine such that neither producer may claim a trademark monopoly. The same type of balancing should occur when trademarks unduly impinge on free expression.

The normal operation of trademark law typically conceals the balancing between these two vital interests. The issue just doesn't come up in the paradigmatic trademark dispute. Doctrines such as functionality, genericide, the lack of protection for merely descriptive marks, and others help ensure that source-identification and the public domain happily co-exist.²² In theory, when it comes time to decide whether there is a likelihood of consumer confusion and thus liability, these threshold requirements have already eliminated many of the purported marks that intrude too much on the public domain. In reality, the expansion of trademark rights in recent years undermined these initial screening mechanisms. But when cases do slip through those nets, courts ultimately conduct

²⁰ *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc. (KP Permanent I)*, 543 U.S. 111, 121–22 (2004) (noting “[t]he common law’s tolerance of a certain degree of confusion on the part of consumers” in light of the “undesirability of allowing anyone to obtain a complete monopoly on use of a descriptive term simply by grabbing it first”).

²¹ Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 481 (1999) (“[T]he issue of whether confusion should be actionable turns not merely on a factual analysis of whether confusion exists, but on a policy determination that the type of confusion present warrants legal intervention. Too often courts simply plug the facts of a case into their version of the *Polaroid* factor test and pretend that the result is necessarily a sensible one.”).

²² See Rebecca Tushnet, *Why the Customer Isn’t Always Right: Producer-Based Limits on Rights Accretion in Trademark*, 116 YALE L.J. POCKET PART 352 (2007), <http://yalelawjournal.org/2007/04/25/tushnet.html> (“Numerous trademark doctrines serve to cabin the ability of trademark owners to claim licensing rights.”).

the balancing later on by applying various doctrines, including the core likelihood of confusion test as well as special standards such as the nominative use analysis²³ or one of several types of defenses based on the First Amendment.²⁴ Occasionally, courts find a defendant's speech-related uses of a mark so confusing that trademark limitations ought to apply, although most final decisions favor the defendant. Whatever the outcome, the balancing does occur—eventually.

B. Integration of First Amendment Requirements

Traditionally, trademark infringement rulings did not violate the First Amendment because misleading or deceptive commercial speech receives no constitutional protection.²⁵ The courts currently define “commercial speech,” as speech that “does no more than propose a commercial transaction” in a manner “removed from any exposition of ideas.”²⁶ Many uses of trademarks in today's culture go far beyond the boundaries of such purely commercial speech.²⁷ They can involve political expression,²⁸ artistic works,²⁹ parodies,³⁰ or criticism³¹. These situations generate much more significant constitutional concerns.

²³ See, e.g., *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 228 (3d Cir. 2005); *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1150 (9th Cir. 2002); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

²⁴ See, e.g., *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 927 (6th Cir. 2003); *Mattel, Inc. v. MCA Records, Inc. (Mattel-MCA)*, 296 F.3d 894, 901–02 (9th Cir. 2002); *Hormel Foods Corp. v. Jim Henson Prod'ns, Inc.*, 73 F.3d 497 (2d Cir. 1996); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group*, 886 F.2d 490 (2d Cir. 1989); *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987).

²⁵ See *In re R.M.J.*, 455 U.S. 191, 203 (1982); *Friedman v. Rogers*, 440 U.S. 1, 15 (1979); Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 165–66 (1982).

²⁶ *Va. State Bd. of Pharm. v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976) (internal quotations and citations omitted).

²⁷ See, e.g., *Dreyfuss*, *supra* note 4, at 400.

²⁸ See, e.g., *MasterCard Int'l, Inc. v. Nader 2000 Primary Comm., Inc.*, 70 U.S.P.Q.2d 1046, 2004 WL 434404 (S.D.N.Y. Mar. 8, 2004); *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682 (N.D. Ohio 2002); *Brach Van Houten Holding, Inc. v. Save Brach's Coal. for Chicago*, 856 F. Supp. 472 (N.D. Ill. 1994); *Stop the Olympic Prison v. U.S. Olympic Comm.*, 489 F. Supp. 1112 (S.D.N.Y. 1980).

This does not mean, however, that we should invite First Amendment balancing into the workaday functioning of trademark cases. Judge Pierre Leval has argued forcefully and correctly for the “internalization” of First Amendment requirements within the structures of trademark law.³² The general precept that judges should avoid unnecessary constitutional decision-making has achieved nearly axiomatic status in our legal system.³³ The problems associated with unnecessary constitutional decisions are well-known. They freeze the development of law—particularly regrettable in the setting of the Lanham Act, which relies on incremental judicial interpretation of flexible common-law standards. They end the dialogue between the judiciary and the legislature because Congress cannot amend the statute in response to rulings it disfavors.³⁴ And there is no reason to believe that whatever precedents emerge from a constitutional analysis will function any better than those fashioned as common law in response to underlying policy concerns.³⁵

²⁹ See, e.g., *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 444 F. Supp. 2d 1012 (C.D. Cal. 2006), *appeal docketed*, No. 06-56237 (Sept. 8, 2006); *Charles Atlas, Ltd. v. DC Comics, Inc.*, 112 F. Supp. 2d 330 (S.D.N.Y. 2000); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727 (D. Minn. 1998).

³⁰ See, e.g., *Mattel, Inc. v. Walking Mountain Prods. (Mattel-Walking Mountain)*, 353 F.3d 792 (9th Cir. 2003); *Mattel, Inc. v. MCA Records, Inc. (Mattel-MCA)*, 296 F.3d 894 (9th Cir. 2002); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group*, 886 F.2d 490 (2d Cir. 1989); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987).

³¹ See, e.g., *Freecycle Network, Inc. v. Oey*, 505 F.3d 898 (9th Cir. 2007); *CPC Int’l, Inc. v. Skippy Inc.*, 214 F.3d 456 (4th Cir. 2000); *BidZirk, L.L.C. v. Smith*, No. 6:06-109-HMH, 2007 WL 3119445 (D.S.C. 2007).

³² Leval, *supra* note 6, at 188–89.

³³ See *Lowe v. Sec. & Exch. Comm’n*, 472 U.S. 181, 204–05 & n.50 (1985) (interpreting Investment Advisors Act to avoid conflict with First Amendment).

³⁴ Congress has shown no reluctance to do so in the sphere of trademark law. See, e.g., Trademark Dilution Revision Act, Pub. L. 109-312, 120 Stat. 1730 (2006) (reversing result in *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003) (holding that federal trademark law requires actual dilution, which *Victoria’s Secret* failed to prove)); Barton Beebe, *A Defense of the New Federal Trademark Antidilution Law*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1143, 1154–55 (2006) (describing Trademark Dilution Revision Act as response to *Moseley* and a product of cooperation among Congress, bar associations, academics, and civil society organizations).

³⁵ See Leval, *supra* note 6, at 209.

Like other statutes, trademark laws should be interpreted to avoid any collisions with constitutional doctrine.³⁶ This internalization has happened in other doctrines like genericism and functionality, as discussed earlier.³⁷ A trademark fair use doctrine that similarly internalizes the requirements of the First Amendment can protect speech without the negative effects of excessive constitutionalization.³⁸ Courts that followed such a rule would have no legitimate need to look beyond it for a constitutionally acceptable outcome. This is one of the successes of the copyright fair use defense.³⁹ The First Amendment only appears in those cases as a rhetorical flourish, because the balance between the copyright monopoly and free speech is woven into the fabric of the Copyright Act already through, among other things, its fair use doctrine.⁴⁰

As Judge Leval laments, in the absence of such internalized free speech principles, many cases involving trademarks and free expression turn instead to free-form quasi-constitutional balancing, without much guidance from either trademark law or First Amendment precedents.⁴¹ These cases generally end with well-balanced results, but only on the basis of poorly-articulated constitutional justifications.⁴² Trademark doctrine, like copyright

³⁶ See, e.g., *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003) (avoiding interpretation of Lanham Act that would suggest Congress had unconstitutionally “created a species of perpetual patent and copyright”); *Universal Commc’ns Sys., Inc. v. Lycos, Inc.*, 478 F.3d 413, 425 (1st Cir. 2007) (“anti-dilution laws should be interpreted to provide breathing room for First Amendment concerns”); Leval, *supra* note 6, at 202–08 (reviewing trademark cases based on how well they avoid needless constitutional rulings).

³⁷ See *supra* notes 20–22 and accompanying text.

³⁸ *Contra* Pratheepan Gulasekaram, *Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works*, 80 WASH. L. REV. 887, 919–20 (2005) (criticizing courts that “have resorted to the fair use doctrine to protect First Amendment interests” rather than applying a direct constitutional analysis).

³⁹ 17 U.S.C. § 107 (2006).

⁴⁰ See *Eldred v. Ashcroft*, 537 U.S. 186, 219–21 (2003) (“[C]opyright law contains built-in First Amendment accommodations.”).

⁴¹ Leval, *supra* note 6, at 202–04, 210.

⁴² See, e.g., *Hormel Foods Corp. v. Jim Henson Prod’ns, Inc.*, 73 F.3d 497 (2d Cir. 1996); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group*, 886 F.2d 490 (2d Cir. 1989); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987); *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 444 F. Supp. 2d 1012 (C.D. Cal. 2006),

doctrine, should function in harmony with First Amendment requirements and avoid ad hoc constitutional determinations.

C. Predictability and Clarity

From the perspective of an accused infringer who has used a trademark merely for purposes of aiding expression, these first two goals are high-minded principles of little direct salience. The would-be defendant's immediate concern is finding out how to avoid liability cleanly and efficiently. A doctrine that is malleable and unclear, or that requires lengthy litigation for resolution, will exacerbate rather than ameliorate the chilling effect; it either discourages legitimate expression with trademarks to begin with, or it compels the defendant to withdraw speech when threatened with suit. The next two free speech goals address these more concrete problems. They are both areas where existing doctrine fails miserably.

If you have ever tried to counsel a client who wishes to use a trademark for expression then you have confronted the deeply muddled state of the law governing such uses. There are many routes to a final adjudication, but none is clear and it is difficult to know in advance which ones a court might employ. I'd even speculate that the tangled nature of the doctrine may discourage attorneys from offering pro bono help that might otherwise be available to some of the artists and parodists who most need advice.

Most obviously, the defendant may try to defeat the prima facie case of likelihood of confusion. Judge Leval, for one, suggests that the likelihood of confusion test offers as much protection as necessary for free speech.⁴³ There are several problems with reliance on likelihood of confusion alone. First, this analysis is notoriously murky and pliable even in typical trademark cases;⁴⁴ it may be impossible to anticipate in advance how confusing a judge

appeal docketed, No. 06-56237 (Sept. 8, 2006); *Charles Atlas, Ltd. v. DC Comics, Inc.*, 112 F. Supp. 2d 330 (S.D.N.Y. 2000).

⁴³ Leval, *supra* note 6, at 188–89, 202–04.

⁴⁴ See Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721, 761–64 (2004); Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CAL. L. REV. 1581, 1583–84 (2006).

will find your client's parody of, or allusion to, a trademark. Also, the test was designed for other situations entirely and a number of key factors have little bearing on the comparison between a commercially valuable trademark and a speech-focused use of that mark.⁴⁵ Finally, as I state above, we sometimes need to tolerate some confusion for the sake of speech.⁴⁶

A defendant who has used a trademark for speech purposes may try instead to invoke a number of defenses on that basis. Those I have in mind are distinct from threshold definitional hurdles like genericism and functionality, or from arguments that the allegedly infringing use did not satisfy a requirement limiting liability to using the mark "as a mark."⁴⁷ My list would include:

- The "descriptive use" defense under § 33(b)(4) of the Lanham Act;⁴⁸
- The "nominative use" doctrine originated by Judge Alex Kozinski in *New Kids on the Block v. News America Publishing, Inc.*;⁴⁹
- A defense for truthful comparative advertising;⁵⁰ and

⁴⁵ See *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 224–25 (3d Cir. 2005); *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 801 (9th Cir. 2002).

⁴⁶ See *supra* notes 13–19 and accompanying text. The relatively few final judicial decisions in the last 15 years or so that clearly overprotected trademarks at the expense of speech often did so because of excessive deference to the confusion-prevention purposes of trademarks. See, e.g., *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 773 (8th Cir. 1994) (finding infringement because the parody of a MICHELOB beer advertisement might have confused the "superficial observer").

⁴⁷ There is now an ongoing argument among trademark scholars concerning the existence and importance of such a requirement in trademark law. Compare, e.g., Margreth Barrett, *Internet Trademark Suits and the Demise of 'Trademark Use,'* 39 U.C. DAVIS L. REV. 371 (2006); Dogan & Lemley, *Search Costs*, *supra* note 9; Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669 (2007) [hereinafter Dogan & Lemley, *Grounding Trademark Law*], with Graeme B. Dinwoodie & Mark D. Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597 (2007); Mark McKenna, *Trademark Use and the Problem of Source in Trademark Law* (Jan. 18, 2008) (unpublished draft, on file with author). I find persuasive McKenna's argument that any such requirement ultimately collapses into a different articulation of likelihood of confusion, but this complex issue is beyond the scope of my more modest discussion here.

⁴⁸ 15 U.S.C. § 1115(b)(4) (2000).

⁴⁹ 971 F.2d 302 (9th Cir. 1992).

- Several different flavors of “First Amendment” defenses, particularly those emerging from the Second Circuit’s decision in *Rogers v. Grimaldi*.⁵¹

This tangle of doctrines suffers from many problems of clarity. First, the boundaries between the various doctrines blur. Second, the requirements of each are vague and courts often apply them inconsistently, both within and between different jurisdictions (either different states or different circuits in the federal court system). Third, different jurisdictions adopt different combinations of doctrines.

The first of these problems, blur between the doctrines, is evident from terminology alone. All five doctrines are sometimes referred to as “fair use,” which is borrowed from the rather dissimilar fair use defense codified in copyright law.⁵² Yet none of them has the same scope or flexibility of the copyright fair use doctrine. Beyond the name they use, different courts and commentators mix and match these doctrines somewhat haphazardly. Professor McCarthy, in his influential treatise, presents comparative advertising as one form of nominative use and insists in turn that nominative use should not be an affirmative defense at all, but only a different heuristic for analyzing likelihood of confusion.⁵³ He discusses all those doctrines as part of likelihood of confusion, but takes up each of the others from my list in entirely different chapters, and even volumes, of his work.⁵⁴

⁵⁰ See, e.g., *Societe Comptoir de L’Industrie Cotonniere Etablissements Boussac v. Alexander’s Dep’t Stores, Inc.*, 299 F.2d 33 (2d Cir. 1962).

⁵¹ 875 F.2d 994 (2d Cir. 1989).

⁵² See 17 U.S.C. § 107 (2006).

⁵³ 4 MCCARTHY, *supra* note 12, §§ 23:62, 23:63, 23:69; see also Chad J. Doellinger, *Nominative Fair Use: Jardine and the Demise of a Doctrine*, 1 NW. J. TECH. & INTELL. PROP. 5, ¶ 9 (2003), available at <http://www.law.northwestern.edu/journals/njtip/v1/n1/5> (“[N]ominative fair use should be nothing more than a term used to describe a peculiar fact pattern that, given the specific facts of the case, does not lead to a likelihood of confusion.”). As McCarthy acknowledges, the circuits split on this point. *Compare* *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 228 (3d Cir. 2005) (adopting nominative use as an affirmative defense), *with* *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1150 (9th Cir. 2002) (holding that nominative use is a substitute test for likelihood of confusion).

⁵⁴ See 2 MCCARTHY, *supra* note 12, at §§ 11:45 et seq. (§ 33(b)(4) “fair use” defense); 4 *id.* at §§ 24:124 et seq. (“fair use” statutory defenses to trademark dilution); 6 *id.* at §§ 31:139 et seq. (“free speech defense”).

Another leading treatise sprinkles these defenses among others such as statutes of limitations, and while at one point it calls nominative fair use “a judge-made variation on the statutory fair use doctrine,” elsewhere it warns that the two are completely distinct.⁵⁵ In their casebook, Professors Dinwoodie and Janis group everything on my list (and others) in a chapter about “permissible uses of another’s trademarks.”⁵⁶ A well-known deskbook groups them in a similar way, but then, like McCarthy’s treatise, describes all of them as variants of likelihood of confusion analysis.⁵⁷ Courts are no more clear. Many bounce back and forth between the quite distinct precedents on § 33(b)(4) and nominative fair use, unaware of the resulting inconsistencies.⁵⁸ This may not be surprising, because even the most conscientious courts find the distinction between § 33(b)(4) and nominative use difficult to apply.⁵⁹ Meanwhile, other judges simply devise their own imprecise variations on “fair use.”⁶⁰

Because it is so difficult to predict in advance which doctrines may come into play and how they will work, those contemplating use of a trademark in speech (or lawyers advising them) must consider potential liability under all possible scenarios. Similarly, a party actually sued over an expressive trademark use must engage in defensive kitchen-sink pleading and briefing, relying on

⁵⁵ 3-11 ANNE GILSON LALONDE, *GILSON ON TRADEMARKS* §§ 11.08[3][d], 11.08[3][k] (2007).

⁵⁶ GRAEME B. DINWOODIE & MARK D. JANIS, *TRADEMARKS AND UNFAIR COMPETITION: LAW AND POLICY* 663–742 (2d ed. 2007).

⁵⁷ 1-8 BEVERLY W. PATTISHALL ET AL., *TRADEMARKS AND UNFAIR COMPETITION DESKBOOK* § 8.06 (2007); *see id.* at § 8.06[1] (“The salient principle governing the legal propriety of using another’s trademark is simply that of truthfulness and the absence of any likelihood of deception.”); *see also* BEVERLY W. PATTISHALL ET AL., *TRADEMARKS AND UNFAIR COMPETITION* 335, 335–57 (5th ed. 2002) (same).

⁵⁸ *See, e.g.*, *Ultimate Creations, Inc. v. THQ, Inc.*, No. CV-05-1134-PHX-SMM, 2008 WL 215827, at *4 (D. Ariz. Jan. 24, 2008).

⁵⁹ *See Brother Records, Inc. v. Jardine*, 318 F.3d 900, 905 (9th Cir. 2003) (lamenting that the “distinction often proves more frustrating than helpful”); *see also* *Mattel, Inc. v. Walking Mountain Prods. (Mattel-Walking Mountain)*, 353 F.3d 792, 809 (9th Cir. 2003) (finding “[t]hese two mutually exclusive forms of fair use are equally applicable” to the photographer’s use of the BARBIE doll trade dress in “Food Chain Barbie”).

⁶⁰ *See, e.g.*, *Audi AG v. D’Amato*, 469 F.3d 534, 547 (6th Cir. 2006) (defendant “asserts a defense of fair use, which means that he used the mark for a purpose other than that for which the mark is typically used”).

every theory that might succeed. When the same activity could be covered by a profusion of narrowly-drawn exceptions, harmonization merits serious consideration. Whatever the other shortcomings of copyright fair use, at least the single codified defense informs all parties (and judges) which doctrine controls.

Second, the various “fair use” doctrines themselves are, to put it simply, squishy. Even the doctrines that present multi-prong tests leave great latitude for interpretation: how is the court to determine the requirements of descriptiveness or good faith under § 33(b)(4)?⁶¹ Or whether the defendant meets the conditions under Judge Kozinski’s *New Kids* test for nominative use that “[f]irst, the product or service in question must be one not readily identifiable without use of the trademark [and] second, only so much of the mark or marks may be used as is reasonably necessary to identify the product or service?”⁶² Worst of all are the totally unstructured principles in the First Amendment balancing cases, as noted earlier.

Further squishiness arises because, on closer examination, many of the doctrines tend to collapse into likelihood of confusion inquiries with all the attendant vagueness. The terms of § 33(b)(4) require that the defendant’s use be “otherwise than as a mark.”⁶³ This sounds like a restatement of the likelihood of confusion question.⁶⁴ Likewise, nominative use cases often boil down to the requirement that the use involve “nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.”⁶⁵ This, too, can be viewed as a highly factual question about the subjective confusion of consumers. Defendants may find it even *more* difficult to prevail under these

⁶¹ 15 U.S.C. § 1115(b)(4) (2000).

⁶² *New Kids on the Block v. News Am. Publ’g, Inc*, 971 F.2d 302, 308 (9th Cir. 1992). For some reasonably thoughtful analysis of these two factors, but with some confusion about which factor applies to the facts at hand, see *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 804 (9th Cir. 2002).

⁶³ 15 U.S.C. § 1115(b)(4).

⁶⁴ *See, e.g., Whirlpool Props., Inc. v. LG Elecs. Inc.*, No. 1:03-cv-414, 2005 WL 3088339, *20–21 (W.D. Mich. Nov. 17, 2005) (“The first issue is whether defendant used the term descriptively and not as a trademark. These questions are really two sides of the same coin.”).

⁶⁵ *New Kids on the Block*, 971 F.2d at 308.

poorly theorized substitute standards than under the traditional test, especially because there are fewer precedents to guide interpretation than would be available for the established likelihood of confusion standards.⁶⁶ In both instances, the key factor in the test really does little but restate likelihood of confusion.

Third and finally, different jurisdictions recognize different combinations and variations of these doctrines. While at least three circuits have adopted a nominative use doctrine,⁶⁷ others have declined the opportunity to do so.⁶⁸ The Second Circuit now structures its First Amendment analysis as a balancing test between confusion and speech,⁶⁹ but other courts citing the Second Circuit's *Rogers v. Grimaldi* precedent deploy it as a complete defense rather than as a countervailing factor against confusion.⁷⁰ These variations are especially nettlesome because the different circuits all adhere to their own interpretations of federal trademark law and because it can sometimes be difficult to predict where trademark cases involving mass communication technology, including the internet, can be brought if there are the requisite contacts for jurisdiction in many states.⁷¹

To be sure, predictability and clarity are matters of degree. The goal must be improvement, not perfection. Nonetheless, trademark law should allow a reasonable advance judgment about the standards a court will apply to a particular case. At the moment this goal is nowhere close to satisfied.

⁶⁶ See Doellinger, *supra* note 53, at ¶ 1.

⁶⁷ See *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211 (3d Cir. 2005); *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 545–47 (5th Cir. 1998); *New Kids on the Block*, 971 F.2d at 308.

⁶⁸ See *Universal Commc'ns Sys., Inc. v. Lycos, Inc.*, 478 F.3d 413, 424 (1st Cir. 2007); *PACCAR Inc. v. Telescan Techs., L.L.C.*, 319 F.3d 243, 256 (6th Cir. 2003).

⁶⁹ *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379–80 (2d Cir. 1993).

⁷⁰ *E.g.*, *Mattel, Inc. v. MCA Records, Inc. (Mattel-MCA)*, 296 F.3d 894 (9th Cir. 2002); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 927–28 (6th Cir. 2003); *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 444 F. Supp. 2d 1012 (C.D. Cal. 2006), *appeal docketed*, No. 06-56237 (Sept. 8, 2006).

⁷¹ *Cf. Calder v. Jones*, 465 U.S. 783 (1984); *Keeton v. Hustler Magazine*, 465 U.S. 770 (1984); *Griffis v. Luban*, 646 N.W.2d 527 (Minn. 2002).

D. Faster and Less Expensive Adjudication

Returning to the vantage point of a speaker confronting the threat of a trademark lawsuit, the length and expense of litigation may well be the most important consideration. The prospect of a protracted court fight that drains resources and demands time and energy will dissuade many an author or critic from mounting a defense. According to a wide-ranging survey conducted by the American Intellectual Property Law Association, the estimated total median cost of the lowest-stakes category of trademark infringement litigation in 2006 was just over a quarter of a million dollars; in larger cases with more than a million dollars “at risk,” that figure rose to \$650,000.⁷² If we are to reduce the chilling effect, faster and cheaper litigation must be a goal.

Cost is especially important because many cease-and-desist letters from well-financed markholders target isolated individuals using trademarks expressively.⁷³ Even those with somewhat more resources than a pajama-clad blogger still may have higher priorities than preserving the supposedly infringing use of a trademark: authors want to write books, political candidates want to win elections, and movie moguls want to go to parties. Further increasing the asymmetry, the contested trademark may represent the lifeblood of a brand manager zealously guarding a trademark portfolio, but may constitute only a part of the overall message the defendant wished to convey.

⁷² AM. I.P. LAW ASS’N, REPORT OF THE ECONOMIC SURVEY 25 (2007).

⁷³ See, e.g., BOLLIER, *supra* note 4, at 100 (“Most small-time parodists immediately fold when a large company accuses them of a trademark violation. Who can afford the legal fees? . . . Typically, the inequality of economic power between corporation and parodist tends to determine who prevails in trademark infringement lawsuits.”); Lia Miller, *Cosby’s Lawyers See No Flattery in an Imitation*, N.Y. TIMES, Mar. 6, 2006, at C9 (quoting web satirist who received cease-and-desist letter as saying: “Well-funded media, offline media, they are able to do this. . . . [W]hen you are a small independent artist, even when you know you are legally right, someone with money can strong-arm you into bending.”); Sean Higgins, *Lake-O-Be-Gone*, National Review Online (Sept. 28, 2005), <http://www.nationalreview.com/comment/higgins200509280816.asp> (reporting that recipient of cease-and-desist letter is “not eager to test” potential fair use defense and instead complied with letter); see also MCLEOD, *supra* note 4, at 184–85, 212–14 (discussing responsiveness of intermediaries such as movie studios and internet service providers to litigation threats); Gibson, *supra* note 7, at 913 (same).

Usually, then, recipients of cease-and-desist demands capitulate. The few stories of those who do not give up are instructive. Tom Forsythe, an art photographer, confronted Mattel's objection to his series of works entitled "Food Chain Barbie," which "portray a nude Barbie in danger of being attacked by vintage household appliances."⁷⁴ He spent five months searching for legal representation and reports that a "long list of attorneys suggested I just give up, since I hadn't made any money anyway."⁷⁵ The ACLU finally agreed to represent him and enlisted a large California law firm to handle the case pro bono.⁷⁶ The overall defense costs for the litigation, which included closely-integrated trademark and copyright claims, eventually topped two million dollars.⁷⁷

Litigating the likelihood of confusion question is a long, fact-intensive, and expensive process. It often involves the use of survey evidence, which runs up the bill quickly. Courts consider its highly-factual nature frequently inappropriate for summary judgment.⁷⁸ As noted above, numerous free speech cases turn on the analysis of this arduous test.

Worse, some judges combine the distinct doctrines aimed at protecting speech interests with the likelihood of confusion inquiry, resulting in an *even longer* analysis. Courts in the Second Circuit usually combine a full likelihood of confusion test with special *Rogers v. Grimaldi* considerations related to free

⁷⁴ *Mattel, Inc. v. Walking Mountain Prods. (Mattel-Walking Mountain)*, 353 F.3d 792, 796 (9th Cir. 2003).

⁷⁵ Tom Forsythe, *Artsurdism*, www.tomforsythe.com/bio_foodchain.cfm (last visited Feb. 29, 2008).

⁷⁶ *Id.*

⁷⁷ See Order Granting Defendant's Motion for Attorney's Fees and Expenses, *Mattel-Walking Mountain*, No. CV99-85432RSWL(RZX), 2004 WL 1454100 (C.D. Cal. June 21, 2004) (awarding defendant \$1,584,089 in legal fees and \$241,797.09 in costs); Forsythe, *supra* note 75 (stating that appeals fees and costs of approximately \$300,000 added to trial court figures for a total of \$2.1 million total in fees and costs). Fee-shifting such as occurred in the "Food Chain Barbie" case is relatively unusual in trademark law, where only "exceptional cases" justify such awards. 15 U.S.C. § 1117(a) (2000).

⁷⁸ See *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1265 (9th Cir. 2001); *Packman v. Chicago Tribune Co.*, 267 F.3d 628, 637 (7th Cir. 2001); 3 MCCARTHY ON TRADEMARKS, *supra* note 12, at § 32:120-21 (collecting cases showing presumption against summary judgment).

expression.⁷⁹ The Ninth Circuit, even after the Supreme Court held in *KP Permanent* that the presence of confusion did not foreclose the § 33(b)(4) defense for descriptive uses, nevertheless remanded that case to the district court to conduct the full likelihood of confusion review, just in case it might shed light on the § 33(b)(4) analysis.⁸⁰ The Third Circuit adopted the nominative fair use test, but mandated that a court must always first conduct a modified (but not really simplified) likelihood of confusion analysis.⁸¹

Even without combining the doctrines, routine judicial management decisions can have the same prolonging effect. If a court defers all summary judgment motions and hears them together at the end of a fixed discovery period, then both sides must marshal the evidence and arguments to support their view of likelihood of confusion, regardless of any affirmative defenses that might have disposed of the case more simply and with less discovery. Similar results follow if a court simultaneously considers all matters related to a motion for preliminary injunction, often decided after extensive discovery.

Finally, aside from the sequence in which courts consider issues, the unclear standards explored in Section C magnify the expense and length of court fights. Fighting on multiple doctrinal fronts requires more pricey lawyer time. Dealing with unclear and fact-intensive standards likewise presents more difficult, and therefore more expensive, legal tasks. (Similar delay arises where the inquiry collapses into likelihood of confusion, since the defendant must offer much of the same evidence for both likelihood of confusion and these other doctrines anyway and may

⁷⁹ See, e.g., *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379–80 (2d Cir. 1993); *Charles Atlas, Ltd. v. DC Comics, Inc.*, 112 F. Supp. 2d 330, 337 (S.D.N.Y. 2000).

⁸⁰ *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc. (KP Permanent II)*, 408 F.3d 596, 607–09 (9th Cir. 2005).

⁸¹ *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 222 (3d Cir. 2005). Ironically, the court said it adopted this structure to help defendants, because it kept the initial burden of proof on plaintiffs. *Id.* at 223, 232. This may be true in a formal sense, but most defendants in these cases would prefer to carry that burden on a quick and simple defense rather than endure a lengthy discovery process to adjudicate plaintiff's burden on likelihood of confusion first.

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end up arguing over fundamentally similar standards.) Addressing the interrelated problems of legal clarity and predictability should, in turn, help speed adjudication and keep down costs. Addressing one goal advances the other one too.

In practical terms, if the legal defenses available for speech require substantial investment by speakers, a chilling effect will result. Yet just a little more attention to the structural features of those defenses could bring us much closer to the goal of speedy adjudication. This change may do more than any other to empower speech that uses trademarks.

E. Summary of Free Speech Goals

Only one of the four goals I have discussed animates current law. That is the goal related to substantive legal issues: the balance between competing values of source identification and free expression. This goal should remain paramount, but not to the exclusion of the others. Constitutional avoidance has deteriorated in recent years as open-ended First Amendment reasoning became more common. The two more procedural goals have also been neglected. Procedural changes will do more to protect speech than would complete renovation of the substantive rules.

It may fairly be argued that confusing legal standards or inequality of power are endemic problems in many areas of the law and are no worse here. I would disagree with this comparative assessment. But more fundamentally, even if this characterization is right, it does not mean that we should settle for the current state of affairs and its speech-suppressing consequences. Rather, trademark doctrine should aim to satisfy all four of the free speech goals discussed here. If we started from scratch today to design the law of trademark fair use, we should begin with these four goals and pay special attention to doctrinal structure.

II.

Turning goals into doctrines is the tough part. Nevertheless, more attention to the full range of free speech goals—not merely trying to reach the correctly balanced result—should help us see

the big picture. And from that, we can learn some lessons that will be useful in the next stage of this project.⁸² This Essay is not the place to finish the job, but I can suggest some starting points.

First of all, the above analysis leads to the conclusion that we should uncouple trademark fair use doctrines as much as possible from the canonical likelihood of confusion test. Let me be sure to emphasize that the balance between source identification and confusion remains crucial—goal number one, in fact. But striking that balance doctrinally through the likelihood of confusion standard (or other standards that reduce to much the same thing) often causes too much obscurity and delay. Likelihood of confusion reasoning satisfies the first goal but directly thwarts the third and fourth. If the structure of a doctrine systematically chills the very speech it aims to protect, then it must be reconsidered. While the hard cases may reach the likelihood of confusion stage, it should be a final hurdle for borderline fact patterns, not the first line of defense for free speech.

Some courts and commentators are moving toward a different doctrinal solution based on explicit First Amendment balancing. This approach has some potential advantages over likelihood of confusion reasoning (although as I've pointed out, it is often used in conjunction with that reasoning anyhow). But it also fails to satisfy the four goals outlined here. The *Rogers v. Grimaldi* test⁸³ and all its variants engage in problematic and unnecessary constitutional decision-making. Their reliance on ethereal standards make the predictability and clarity of the law even worse. So, on at least two of the four goals enunciated here, the newly popular First Amendment doctrine moves backwards.

So, what would be better? Ideally, we would structure our new doctrine so that the defendant could invoke it earlier in litigation with less need for factually-based determinations and the resulting discovery and experts. This ideal defense would function as a “gatekeeper” that could efficiently screen out legitimate expressive uses of trademarks whose communicative value likely outweighed

⁸² See William McGeeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. (forthcoming 2008).

⁸³ 875 F.2d 994, 997–1000 (2d Cir. 1989).

any source identification value at stake.⁸⁴ A clearly applicable affirmative defense would also serve as a powerful shield against cease-and-desist demands from markholders. A response that advances such a crisp doctrine, rather than citing in the alternative to a series of amorphous precedents, could end the dispute without litigation, but this time in the defendant's favor.

How should such defenses work? I think there is promise in the development of some categorical safe harbors. The best example of this approach in current trademark doctrine is the relatively new set of statutory carve-outs from liability under federal dilution law (which do not apply to infringement cases).⁸⁵ The original carve-outs, which were part of the federal dilution statute enacted in 1995, applied to noncommercial uses, comparative advertising, and news reporting or commentary.⁸⁶ We could select certain types of repeat situations in which trademark disputes with free speech implications arise, and simply remove them from consideration. As Robert Bone has documented, trademark law already relies on many such general rules to "simplify the inquiry" in response to high enforcement costs, including the administrative costs of adjudicating an issue.⁸⁷ A few marginal cases involving some confusion might escape liability this way, but perhaps we would decide, as we have in other aspects of trademark law, to tolerate a small amount of confusion in exchange for other values.

I am not yet prepared to support particular examples of such rules, but let me nominate a few possibilities to illustrate the point. Perhaps we should consider exemptions for:

⁸⁴ Cf. Dogan & Lemley, *Search Costs*, *supra* note 9, at 805 (arguing for same role for trademark use requirement).

⁸⁵ Trademark Dilution Revision Act, Pub. L. 109-312, 120 Stat. 1730 (2006).

⁸⁶ Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (1996). Unfortunately, in 2006 Congress amended the statute in a manner that severely reduced its clarity. See 15 U.S.C. § 1125(c)(3) (2000), *amended by* The Trademark Dilution Revision Act of 2006. The provision I am discussing in text is the old version; the new version may have some of these advantages but will lack others.

⁸⁷ Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2101-02 (2004).

- “[N]ews reporting and news commentary,” an exception already found in the federal dilution statute that could be extended to infringement cases;
- Uses within political campaigns, adapting a statutory exemption in California’s right of publicity statute;⁸⁸
- Incidental use of a trademark within a work of fiction;
- Evaluations of products such as reviews and rankings aimed at informing consumers; and
- Negative commentary, on the theory that the likelihood of confusion is inherently lower and the dangers of markholder control especially high.

While such blanket exemptions make the simplest rules, in trickier cases we could also develop rebuttable presumptions, burden-shifting, or, at least, affirmative defenses that a defendant could raise immediately upon assembling the necessary evidence. These might be necessary where it proves difficult to define a category, but nonetheless we can generate a list of characteristics that should lead to immunization. Existing defenses such as § 33(b)(4) presumably would continue to exist and might be invoked for cases that were not screened out by these other mechanisms. Finally, the most complicated cases would make it all the way through to the likelihood of confusion analysis. Their numbers would be fewer, however, and they would involve the sort of closer calls that justify the lengthier examination of all the circumstances.

The outlines of this structure already represent an improvement over current doctrine in meeting all four free speech goals for trademark law. (Clearly, the details need a good deal of thought.) As a matter of substance, these types of suggestions would balance the goals of source identification and protection for free expression. They also internalize First Amendment imperatives in a manner similar to copyright law, rather than indulging courts’ taste for ad hoc constitutional decision-making. At the same time,

⁸⁸ See CAL. CIV. CODE § 3344(d) (2006). Granted, the examples I cited above about “Problem Pregnancy” and the “REP Party” lead to challenges here, but they can be addressed through appropriate general limitations on the defense. See *supra* notes 16–19 and accompanying text.

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doctrines of this sort offer a lot more to our imagined speaker considering the unlicensed use of a trademark or facing a threat of infringement litigation over a use already made.

CONCLUSION

A browse through decided cases on Westlaw might suggest that all is well with free speech in trademark law. Such complacency would be wrong. Getting the correct substantive result may provide some tidy academic satisfaction, but it is only supposed to be the instrumental means to a larger end. Right now, that larger end is thwarted by the structure of trademark law, which pervasively chills expression without sufficient benefit in preventing confusion.

It is time to rethink the law of trademark fair use so that it achieves all four free speech goals outlined here. Those goals include balancing the policy objectives of trademark law with free speech and integrating the commands of the First Amendment into trademark doctrine. More fundamentally, clearer rules and faster adjudication will increase the chances that expression using trademarks becomes and remains available to our shared discourse. In the end, that is really the only free speech goal. Until such reform, for every happy ending in the law books like *Freecycle*, there will be uncounted other individual decisions to forego or withdraw speech, robbing us of its contributions.