

2010

## Cease-and-Desist: Tarnishment's Blunt Sword in Its Battle Against the Unseemly, the Unwholesome, and the Unsavory

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### Recommended Citation

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# Cease-and-Desist: Tarnishment's Blunt Sword in Its Battle Against the Unseemly, the Unwholesome, and the Unsavory

Regina Schaffer-Goldman\*

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\* J.D., Fordham University School of Law, 2010; B.A., Wesleyan University, 2002. Many thanks to the staff and editorial board of the IPLJ for their tireless and diligent hard work. I would especially like to thank Professor Sonia Katyal for her insight, support, and guidance, and Michele Gipp for her patience and editorial assistance. Lastly, much love to my friends, family, and, of course, Paul, for all their encouragement and support.

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## INTRODUCTION

Words and images do not worm their way into our discourse by accident; they're generally thrust there by well-orchestrated campaigns intended to burn them into our collective consciousness. Having embarked on that endeavor, the originator of the symbol necessarily—and justly—must give up some measure of control. The originator must understand that the mark or symbol or image is no longer entirely its own, and that in some sense it also belongs to all those other minds who have received and integrated it. This does not imply a total loss of control, however, only that the public's right to make use of the word or image must be considered in the balance as we decide what rights the owner is entitled to assert.<sup>1</sup>

In September of 2005, Justin Watt posted a digitally altered image of a billboard to his website.<sup>2</sup> The billboard queried: "Straight? *Unhappy?* www.gay.com."<sup>3</sup> Watt's image was his tongue-in-cheek response to real-life billboards that Exodus International, "a Christian organization whose objective is to make gay people heterosexual through religion and counseling," had placed throughout the U.S.<sup>4</sup> Exodus's original ad had read: "Gay? Unhappy? www.exodus.to."<sup>5</sup> Of course, no good deed goes unpunished, and sure enough, Exodus's attorney from the Liberty Counsel sent a cease-and-desist letter to Watt on March 2, 2006.<sup>6</sup> The letter claimed that Watt's image infringed Exodus's copyright in the billboard; it further proclaimed that the "altered image

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<sup>1</sup> Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 975 (1993).

<sup>2</sup> Lia Miller, *Both Sides in Parody Dispute Agree on a Term: Unhappy*, N.Y. TIMES, Mar. 27, 2006, at C7, available at <http://www.nytimes.com/2006/03/27/technology/27straight.html?scp=3&sq=Justin%20Watt&st=cse>.

<sup>3</sup> Justin Watt, *My First Cease-and-Desist Letter*, JUSTINSOMNIA (Mar. 2, 2006, 11:08 AM), <http://justinsomnia.org/2006/03/my-first-cease-and-desist-letter> (displaying Watt's parodic billboard); see also Miller, *supra* note 2.

<sup>4</sup> Miller, *supra* note 2.

<sup>5</sup> *Id.*

<sup>6</sup> See Watt, *supra* note 3 (displaying Letter from Mathew D. Staver, Founder and Chairman, Liberty Counsel to Justin Watt (no date available)).

substantially diminishes the potential value of the original image as utilized by Exodus on billboards across America and online.”<sup>7</sup> Moreover, Exodus alleged that Watt’s use allegedly created a sense of false sponsorship, as he had kept Exodus’s “E” logo in his send-up of the billboard.<sup>8</sup> Because Exodus claimed that Watt had misconstrued any fair use he might have made of the image, the organization instructed Watt to

immediately cease use of the image on your web site or in any other form. Please confirm your agreement to this request, and please note your confirmation that no other use is being or will be made of the images or logo, by signing and returning an original signature on a copy of this letter at the address shown above . . . .<sup>9</sup>

Although Exodus’s assertion of trademark rights ostensibly focused on the fact that Watt’s image conveyed a false impression of sponsorship, the subtext of Exodus’s trademark allegation was that Watt had tarnished its mark by using its imagery and subverting its message. In other words, Watt’s positive reference to homosexuality in his image prompted Exodus, the trademark and copyright owner, to cry foul. Faced with Exodus’s assertion of intellectual property rights, Justin Watt did not capitulate. Instead, the ACLU and a Bay Area law firm agreed to represent him, and they countered with a letter enumerating Watt’s fair use rights under copyright law and First Amendment rights under trademark law.<sup>10</sup> Shortly thereafter, Exodus dropped its case against Watt.<sup>11</sup>

Flash forward to 2010. A blog following the progress of *Perry v. Schwarzenegger*<sup>12</sup> adopted a logo for its website deliberately

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<sup>7</sup> *Id.*

<sup>8</sup> *Id.*

<sup>9</sup> *Id.*

<sup>10</sup> See Letter from Laurence F. Pulgram, Partner, Fenwick & West LLP, to Mathew D. Staver, Chairman and Founder, Liberty Counsel (no date available), *available at* <http://justinsomnia.org/2006/03/a-response-to-liberty>.

<sup>11</sup> See Miller, *supra* note 2.

<sup>12</sup> --- F. Supp. 2d ---, No. C 09-2292 VRW, 2010 WL 3025614 (N.D. Cal. Aug. 4, 2010).

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similar to that of an arch-nemesis, ProtectMarriage.com.<sup>13</sup> ProtectMarriage.com's logo had depicted a mother, father, and two children (which is reminiscent of the silhouettes used to demarcate men's and women's restrooms).<sup>14</sup> The mark embodied ProtectMarriage.com's ideal of the traditional family. Prop 8 Trial Tracker, however, reworked the logo to depict two mothers and two children, a self-admitted parody of ProtectMarriage.com's trademark.<sup>15</sup> And like Justin Watt, Courage Campaign promptly received a cease-and-desist letter from ProtectMarriage.com, which vigorously asserted its copyright and trademark rights in the image.<sup>16</sup> ProtectMarriage.com alleged, inter alia, that the reworking of its logo would lead to a likelihood of confusion.<sup>17</sup> In its response letter, Courage Campaign's counsel from Morrison & Foerster cited precedent asserting Courage Campaign's right to parody the ProtectMarriage.com mark under trademark and copyright law, and argued that under established trademark law, there would be no likelihood of confusion.<sup>18</sup> While the ProtectMarriage.com cease-and-desist letter did not explicitly mention tarnishment, the letter highlighted that "Courage Campaign holds views that are diametrically opposed to ProtectMarriage.com."<sup>19</sup> No doubt it took umbrage at Courage Campaign's parodic riffing on its trademark. Courage Campaign,

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<sup>13</sup> Julia Rosen, *ProtectMarriage.com Issues Cease and Desist for Prop 8 Trial Tracker Logo Depicting Family of Two Mothers with Two Kids*, PROP 8 TRIAL TRACKER (Jan. 15, 2010), <http://prop8trialtracker.com/2010/01/15/protectmarriage-com-issues-cease-and-desist-for-prop-8-trial-tracker-logo>. The Courage Campaign Institute created the Prop 8 Trial Tracker site. *About*, PROP 8 TRIAL TRACKER, <http://prop8trialtracker.com/about> (last visited Apr. 3, 2010).

<sup>14</sup> Rosen, *supra* note 13 (displaying Letter from John M. Skeriotis, Partner, Brouse McDowell LPA, to Richard D. Jacobs, Founder and Chair, Courage Campaign (Jan. 12, 2010)).

<sup>15</sup> *Id.*

<sup>16</sup> *See id.*

<sup>17</sup> *Id.*

<sup>18</sup> *See id.* (displaying Letter from Nathan B. Sabri, Associate, Morrison Foerster LLP, to John M. Skeriotis, Partner, Brouse McDowell LPA (Jan. 14, 2010)).

<sup>19</sup> *Id.* (displaying Letter from John M. Skeriotis, Partner, Brouse McDowell LPA, to Richard D. Jacobs, Founder and Chair, Courage Campaign (Jan. 12, 2010)).

on the other hand, recoded a mark it deemed offensive to provide commentary and empowerment in its fight for marriage equality.<sup>20</sup>

As Watt's and Courage Campaign's experiences demonstrate, brands of all shapes, sizes, and political persuasions are ubiquitous<sup>21</sup> and sometimes even insidious. Moreover, brands have become part of our daily fabric and lexicon.<sup>22</sup> As our brand-awareness has increased, so has our ability to imbue brands with meaning,<sup>23</sup> whether these meanings accord with the brand identity a company intends to convey or not. Individuals seek to comment on and fight brand hegemony by, for example, poking fun at a particularly cloying cultural symbol,<sup>24</sup> or by subverting and recoding a brand's intended message.<sup>25</sup>

Trademark owners, however, benefit from a variety of causes of action, such as trademark infringement and trademark dilution,

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<sup>20</sup> *How ProtectMarriage.com Can Get Back at Courage Campaign's Logo Lift: Gay-Up CC's Logo*, QUEERTY, <http://www.queerty.com/how-protectmarriage-com-can-get-back-at-courage-campaigns-logo-lift-gay-up-ccs-logo-20100116/#ixzz0k6CWWZxc> (last visited Apr. 4, 2010).

<sup>21</sup> See Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507, 511 (2008) ("Consumers are inundated with ads, not just in traditional media but in bathroom stalls, sidewalk decals, even ads covering the paint strips in parking lots.").

<sup>22</sup> See generally Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397 (1990) (arguing that expressive uses of marks should be allowed under the doctrine of "expressive genericity").

<sup>23</sup> See, e.g., ROSEMARY J. COOMBE, *THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES: AUTHORSHIP, APPROPRIATION, AND THE LAW* 57 (1998) ("The consumption of commodified representational forms is productive activity in which people engage in meaning-making to adapt signs, texts, and images to their own agendas. These practices of appropriation or 'recoding' cultural forms are the essence of popular culture, understood by theorists of postmodernism to be central to the political practice of those in subordinate social groups and marginal to the centers of cultural production.").

<sup>24</sup> See, e.g., *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902, 906-07 (9th Cir. 2002) (holding that the group Aqua's tongue-in-cheek song, "Barbie Girl," was not an actionable use under the Federal Trademark Dilution Act and that it was a successful parody).

<sup>25</sup> See, e.g., *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 802 (9th Cir. 2003) (maintaining that the artist provided social commentary on Barbie by placing "carefully positioned, nude, and sometimes frazzled looking Barbies in often ridiculous and apparently dangerous situations"); NAOMI KLEIN, *NO LOGO* 280 (2d ed. 2002) (describing "culture jamming, the practice of parodying advertisements and hijacking billboards in order to drastically alter their messages").

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which they often wield to silence commentary on their marks.<sup>26</sup> This clash of trademark law with freedom of expression is especially unsettling when a trademark owner uses trademark law to silence speech it finds offensive and unseemly, specifically when related to sex and sexuality. Mark owners do so in order to shield their carefully cultivated brand images from tarnishment; often, however, they do so bluntly without distinguishing between truly prurient associations and those that are merely linked with expressions of sexual orientation that deviate from the societal norm. Even more unsettling is that trademark owners can often silence speech that they deem distasteful without recourse to a formal adjudication—they may simply draft an artfully worded cease-and-desist letter asserting their intellectual property rights.

Justin Watt's predicament is not uncommon. Nor was Prop 8 Trial Tracker's skirmish with ProtectMarriage.com. A simple search on Google for cease-and-desist letters brings up thousands of hits. The Chilling Effects Clearinghouse catalogues and displays letters sent to companies and individuals.<sup>27</sup> These communiqués have become increasingly common, even as courts concomitantly seek to reign in trademark law's grasp, especially in the dilution context.<sup>28</sup> Thus, while courts have become increasingly more receptive to protecting speech that trademark

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<sup>26</sup> See COOMBE, *supra* note 23, at 72 (“Concepts as vague as loss of distinctiveness and tarnishment have the capacity to escalate into a general power to prohibit all reproductions of a mark and ‘grow into a powerful vehicle for the suppression of unwelcome speech.’” (quoting Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 190)).

<sup>27</sup> The Chilling Effects Clearinghouse is “[a] joint project of the Electronic Frontier Foundation and Harvard, Stanford, Berkeley, University of San Francisco, University of Maine, George Washington School of Law, and Santa Clara University School of Law clinics.” CHILLING EFFECTS CLEARINGHOUSE, <http://www.chillingeffects.org> (last visited Apr. 7, 2010).

<sup>28</sup> Clarisa Long, *Dilution*, 106 COLUM. L. REV. 1029, 1031 (2006) (“Judicial enforcement of dilution law is not robust today and has been eroding over time. . . . [R]elief rates have been on a downward trajectory since then. It could well be the case that dilution law is a powerful bargaining chip in cease-and-desist letters and in negotiations entirely outside the litigatory arena. In the federal courts, however, dilution cases are not exactly a juggernaut. That is not to say that dilution law lacks seductive appeal, but rather that it seems not to have worked its wiles on the judicial mind as many feared.”).



owners say is tarnishing (especially as applied to sexually connotative uses or uses that reference a mark in association with sexuality), cease-and-desist letters make an end-run around judicially and statutorily created protective doctrines by preempting this kind of speech before it can even get into court.

Current cease-and-desist practice raises many concerns, not the least of which is that cease-and-desist letters have become a form of private-action prior restraint arguably more potent than preliminary injunctions. Indeed, to the uninitiated lay person, a cease-and-desist letter is often the death-knell to his or her non-actionable use of a trademark. As Professor Ramsay aptly puts it, “Those who cannot afford to litigate will self-censor rather than fight for their right of free expression.”<sup>29</sup> Thus, the real struggle is to craft protection from the chilling power of cease-and-desist letters that assert rights beyond the permissible scope of trademark doctrine. Moreover, it is most often behemoth companies policing their brands who send these letters to defendants who cannot bear the costs of litigation.<sup>30</sup> While many scholars recommend honing trademark doctrine to avoid this chilling effect,<sup>31</sup> others focus on procedural protections that may curb overreaching by trademark owners. More well-reasoned doctrinal interpretations will arguably elucidate standards for those well-versed in trademark law, however, they may be inaccessible to the layperson. For this reason, procedural protections may have a more deterrent effect on mark holders. Ultimately, the law must craft an effective combination of doctrinal adjustments and procedural mechanisms while ensuring that the average layperson is aware of those rights.

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<sup>29</sup> Lisa P. Ramsay, *Increasing First Amendment Scrutiny of Trademark Law*, 61 SMU L. REV. 381, 381 (2008).

<sup>30</sup> See, e.g., Barton Beebe, *The Continuing Debacle of U.S. Antidilution Law: Evidence from the First Year of Trademark Dilution Revision Act Case Law*, 24 SANTA CLARA COMPUTER & HIGH TECH. L.J. 449, 458 n.36 (“It may well be that the primary success of antidilution law to date is that it empowers potential plaintiffs with a greater ability to threaten potential defendants, particularly those that are unsophisticated, with prohibitive litigation costs.”).

<sup>31</sup> See, e.g., William McGeeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49, 109–22 (2008) [hereinafter McGeeveran, *Rethinking*].

Part I of this Note will examine how tarnishment causes of action in the courts have become increasingly more favorable to defendants who use trademarks in reference to sexuality or in sexually connotative ways. Part II, on the other hand, will emphasize the distinction between recordings that are sexually explicit or overtly suggestive and those that express ideas about and attributes of sexual orientation. Arguably, uses in the latter category are generally more worthy of protection from a First Amendment standpoint. Further, it will illustrate how cease-and-desist letters have sought to silence these kinds of uses and why this is especially problematic for marginalized groups, such as the gay, lesbian, bisexual, and transgender community. Many mark owners thus make an end-run around built-in statutory and First Amendment speech protections that defendants may use in litigation. Indeed, this Part will underscore that several scholars see this free-wheeling use of cease-and-desist letters as an abusive litigation tactic. Part III will juxtapose doctrinal solutions to this problem, including clarification of the Trademark Dilution Revision Act's exemptions and a proper substantive definition of tarnishment, with procedural remedies, which include reviving the trademark misuse doctrine, utilizing anti-SLAPP statutes, and fee-shifting. Finally, this Note will suggest that any doctrinal changes must be accompanied by procedural remedies, which may be more effective in curbing abusive behavior. This Note will also propose further steps that the law should take to allow trademark recoders and parodists to act affirmatively when faced with a cease-and-desist letter, including the complete abolishment of tarnishment as an actionable offense under trademark law.

#### I. TARNISHMENT: A MORE PROLIFIC PAST AND DWINDLING PRESENT?

While tarnishment has had an influential (and some would say ignominious) influence on trademark law, its presence in litigated cases has increasingly dwindled.<sup>32</sup> Moreover, courts have arguably

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<sup>32</sup> See Beebe, *supra* note 30, at 450 ("Most significantly, the case law shows the remarkable extent to which courts continue to treat the dilution cause of action as redundant of—and, thus, made superfluous by—the infringement cause of action. For all

become more and more sympathetic to defendants who seek to use trademarks in ways that mark owners may deem offensive and inconsistent with their brand's image.<sup>33</sup> This Part will briefly examine the genesis of dilution and tarnishment and discuss the evolution of case law as it applies to uses of marks that are sexually explicit or that reference sexuality.<sup>34</sup>

A. *A Brief Primer on the Tarnishment Cause of Action*

Dilution law has its genesis in Frank I. Schechter's seminal article, *The Rational Basis for Trademark Protection*, published in 1927.<sup>35</sup> In his article, Schechter expressed concern about

the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon non-competing goods. The more distinctive or unique the mark, the deeper is its impress upon the public consciousness, and the greater its need for protection against vitiation or dissociation from the particular product in connection with which it has been used.<sup>36</sup>

Under existing trademark law at that time, "protection was unlikely from a mark's appropriation for goods of different descriptive properties."<sup>37</sup> Instead, trademark law was confined to its twin rationales: protecting consumers from confusion and deception and trademark owners from unfair competition.<sup>38</sup>

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of the legislative and academic attention paid to it, antidilution law continues to have no appreciable effect on the outcomes of federal trademark cases or the remedies issuing from those outcomes."); Long, *supra* note 28, at 1057 ("Tarnishment is generally not a popular theory of dilution among trademark plaintiffs. Courts have tended not to favor tarnishment theory of dilution either."); *infra* Part I.B.5.

<sup>33</sup> See *infra* Part I.B.

<sup>34</sup> At the outset, it is important to underscore that these two kinds of trademark recordings are not equivalent, and that references to sexuality often do not have any sexually explicit content.

<sup>35</sup> Frank I. Schechter, *The Rational Basis for Trademark Protection*, 40 HARV. L. REV. 813 (1927).

<sup>36</sup> *Id.* at 825.

<sup>37</sup> Jerre B. Swann, *Dilution Redefined for the Year 2002*, 92 TRADEMARK REP. 585, 587 (2002).

<sup>38</sup> Mark McKenna contends, however, that trademark law traditionally was primarily premised on unfair competition and that benefits to consumers' interests, while "welcome

Indeed, it was not until twenty years later that Massachusetts became the first state to enact a dilution statute,<sup>39</sup> and states thereafter began to extend protection beyond the traditional likelihood of confusion context.<sup>40</sup> As Professor Long has noted, “[D]ilution law is producer-focused rather than consumer-focused . . . . [Its] underlying assumption is that the unauthorized use of a famous mark by third parties, even when consumers are not confused by the use of the mark, can diminish the mark’s selling power.”<sup>41</sup> Dilution remained a “creature of state law,”<sup>42</sup> however, until 1995, when Congress passed the Federal Trademark Dilution Act (the “FTDA”).<sup>43</sup> Prior to the enactment of the FTDA, however, federal courts often got into the fray and helped “defin[e] the doctrine’s parameters.”<sup>44</sup>

In crafting the scope of this doctrine, federal courts recognized that a mark could be diluted in two ways: first, by blurring, “where the defendant uses or modifies the plaintiff’s trademark to identify the defendant’s goods and services, raising the possibility the mark will lose its ability to serve as a unique identifier of the plaintiff’s product;”<sup>45</sup> and second, by tarnishment, whereby “the plaintiff’s

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byproducts,” were a secondary consideration. Mark McKenna, *Testing Modern Trademark Law’s Theory of Harm*, 95 IOWA L. REV. 63, 72 (2009); see also Mark McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1848 (2007) (“Trademark law, indeed all of unfair competition law, was designed to promote commercial morality and protect producers from illegitimate attempts to divert their trade. Consumer confusion was relevant to the traditional determination of infringement not for its own sake, but because deceiving consumers was a particularly effective way of stealing a competitor’s trade.”).

<sup>39</sup> *Moseley v. V Secret Catalogue*, 537 U.S. 418, 430 (2003).

<sup>40</sup> See Sarah L. Burstein, *Dilution by Tarnishment: The New Cause of Action*, 98 TRADEMARK REP. 1189, 1193 (2008).

<sup>41</sup> Long, *supra* note 28, at 1034.

<sup>42</sup> *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 903 (9th Cir. 2002).

<sup>43</sup> Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (1996), repealed by Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730.

<sup>44</sup> Burstein, *supra* note 40, at 1199 (quoting Elliot B. Staffin, *The Dilution Doctrine: Towards a Reconciliation with the Lanham Act*, 6 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 105, 108–09 (1995)). As Burstein notes, “in interpreting state dilution statutes, it was not uncommon for courts to cite general propositions about dilution law from non-binding decisions in other jurisdictions that were interpreting different, though similarly-worded, state statutes.” *Id.*

<sup>45</sup> *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 43 (2d Cir. 1994).

trademark is linked to products of shoddy quality or is portrayed in an unwholesome or unsavory context likely to evoke unflattering thoughts about the owner's product."<sup>46</sup> As Sarah Burstein notes, however, tarnishment case law was often "inconsistent" before the enactment of the FTDA, and further, "very few cases were decided on tarnishment alone."<sup>47</sup> Part of this inconsistency arose because courts sometimes conflated tarnishment with their likelihood of confusion analyses;<sup>48</sup> at other times, courts varied in their willingness to afford speech protection to defendants who had allegedly tarnished a plaintiff's mark.<sup>49</sup>

After the FTDA took effect in 1996, courts continued to rely on pre-FTDA case law for tarnishment standards.<sup>50</sup> At the same time, the FTDA sought to avoid some of the prior inconsistency in case law based on state statutes by providing that

the owner of a mark could obtain relief against a junior user if: (1) the senior mark was famous; (2) the junior user made "commercial use in commerce of a mark or trade name;" (3) which use started after the senior user's mark became famous; (4) and which "cause[d] dilution of the distinctive quality" of the senior user's mark.<sup>51</sup>

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<sup>46</sup> *Id.*

<sup>47</sup> Burstein, *supra* note 40, at 1200.

<sup>48</sup> *See, e.g.,* MGM-Pathe Commc'ns, Co. v. Pink Panther Patrol, 774 F. Supp. 869, 871-73 (S.D.N.Y. 1991) (granting a permanent injunction ostensibly on solely infringement grounds, but allowing considerations of tarnishment to enter the likelihood of confusion analysis); Burstein, *supra* note 40, at 1203.

<sup>49</sup> *Compare* L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 33 (1st Cir. 1987) ("The Constitution does not, however, permit the range of the anti-dilution statute to encompass the unauthorized use of a trademark in a noncommercial setting such as an editorial or artistic context."), *with* Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema Ltd., 604 F.2d 200, 206 (2d Cir. 1979) ("Plaintiff's trademark is in the nature of a property right, and as such it need not 'yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.'" (internal citations omitted) (quoting Lloyd Corp. v. Tanner, 407 U.S. 551, 567 (1972))).

<sup>50</sup> *See, e.g.,* Hormel Foods Corp. v. Jim Henson Prods., 73 F.3d 497, 507 (2d Cir. 1996) (citing pre-FTDA case law).

<sup>51</sup> Burstein, *supra* note 40, at 1196 (quoting Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, § 3, 109 Stat. 985, 985 (1996), *repealed by* Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730).

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The federal act thus required that the senior mark be famous, and, in recognition of the more expressive uses of trademarks, required that the junior make “commercial use in commerce of a mark.”<sup>52</sup> Although the “commercial use in commerce” requirement was awkwardly worded at best, it may have been merely “an attempt by Congress to make absolutely clear that *noncommercial uses were not actionable*.”<sup>53</sup> Moreover, seeking to avoid the inconsistency in exemptions courts had crafted when applying state dilution statutes, the FTDA provided three exemptions: “(A) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark[;] (B) Noncommercial use of a mark[; and] (C) All forms of news reporting and news commentary.”<sup>54</sup> Following the enactment of this law, however, courts were still not clear as to what kinds of uses would fall under the “noncommercial use” exemption, and some struggled to apply the statute to allegedly tarnishing uses of a trademark owner’s mark.<sup>55</sup>

When the federal dilution standards failed to provide adequate clarity for the courts as to what kind of evidentiary showing the federal dilution action required and what kind of uses it covered, Congress stepped in again. The Trademark Dilution Revision Act of 2006 (the “TDRA”) expanded upon the exceptions provided.<sup>56</sup>

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<sup>52</sup> *Id.*

<sup>53</sup> *Id.* at 1228 (emphasis added).

<sup>54</sup> *Id.* at 1197 (quoting Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, § 3, 109 Stat. 985, 986 (1996), *repealed by* Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730).

<sup>55</sup> *See, e.g.,* Am. Dairy Queen Corp. v. New Line Prods., Inc., 35 F. Supp. 2d 727, 732–35 (D. Minn. 1998) (rejecting the defendant’s argument that its film title was protected under the noncommercial use exemption of the FTDA and further contending that First Amendment concerns were unfounded because “alternative avenues for expressing the idea exist[ed]”).

<sup>56</sup> Section 1125(c)(3) reads, in relevant part:

The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person’s own goods or services, including use in connection with—

In addition, it expressly incorporated “tarnishment” into the Lanham Act and defined it as “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”<sup>57</sup>

Further exegesis on the statutory development of tarnishment is beyond the scope of this paper, but it is important to note that while tarnishment has become an express part of the TDRA, courts still rely on pre-TDRA and pre-FTDA cases to define what constitutes tarnishment of a mark and what tests should be applied to determine what uses are actionable.<sup>58</sup>

*B. Sex and Sexuality in the Tarnishment Case Law: A Mixed Bag?*

As the doctrine of dilution by tarnishment developed in the courts, one thing became clear: some courts had a “distaste” for content involving sex and sexuality.<sup>59</sup> On the other hand, other courts were less willing to enjoin speech that included sexual uses of a mark on First Amendment grounds.<sup>60</sup> To some extent, these approaches created inconsistency among the circuits regarding how to approach tarnishment and how much First Amendment protection a defendant should receive.

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- (i) advertising or promotion that permits consumers to compare goods or services; or
  - (ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any noncommercial use of a mark.

15 U.S.C. § 1125(c)(3) (2006).

<sup>57</sup> *Id.* § 1125(c)(2)(C).

<sup>58</sup> *See infra* Part I.B.1–4. Indeed, Barton Beebe emphasizes that courts have not faithfully applied the new TDRA provisions, applying FTDA exemptions, rationales, and case law instead; he aptly maintains that “[t]he dead hand of the FTDA still plagues the law.” *See* Beebe, *supra* note 30, at 455–58, 467.

<sup>59</sup> Michael K. Cantwell, *Confusion, Dilution, and Speech: First Amendment Limitations on the Trademark Estate: An Update*, 94 TRADEMARK REP. 547, 549–50 (2004).

<sup>60</sup> *See, e.g.,* L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 30 (1st Cir. 1987) (“The basis for the district court’s injunction was that Bean’s trademark had been tarnished by the parody in defendant’s magazine. We think this was a constitutionally impermissible application of the anti-dilution statute.”).

After the enactment of the FTDA in 1995 and the subsequent revision of dilution law in 2006, however, it seemed that courts were embracing an increasingly expansive notion of what speech would be exempted under federal law. Moreover, as Professor Long's research has demonstrated, dilution lawsuits are litigated less and less.<sup>61</sup> This amounts to a greater likelihood of success for defendants if tarnishment claims are actually litigated.<sup>62</sup>

This section will examine the contours of tarnishment law as it applies to sex and sexuality and will highlight some of the doctrinal difficulties that have arisen in these cases. It will also draw a distinction between tarnishment cases based on overt references to sex and those that involve references to sexuality and sexual orientation.

### 1. Pre-FTDA Tarnishment

Pre-FTDA tarnishment cases conflicted in their treatment of marks associated with sexuality. On the one hand, several courts evinced a strong concern for marks that were associated with pornographic movies or magazines. While the reputational concerns these courts expressed may have had validity, the courts did not explain why. In other words, they did not elucidate what particularly is "tarnishing" about the uses, other than to say that the contexts in which the defendants used the marks were "revolting"<sup>63</sup> or "depraved."<sup>64</sup> The courts did not circumscribe the scope of tarnishment, nor did they define it. These judicial tendencies inevitably raise First Amendment concerns because trademark owners may thus silence speech that may not be actionable.

The paradigmatic case in this area is *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*<sup>65</sup> This case involved the defendant's use of a cheerleading uniform that was similar to

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<sup>61</sup> See *infra* Part I.B.5.

<sup>62</sup> As the next part will demonstrate, this greater likelihood of success is a pyrrhic victory for would-be recoders and parodists of famous marks, as cease-and-desist letters often chill speech before it can formally receive judicial protection.

<sup>63</sup> *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema Ltd.*, 604 F.2d 200, 203 (2d Cir. 1979).

<sup>64</sup> *Id.* at 205.

<sup>65</sup> 604 F.2d 200 (2d Cir. 1979).



that of the actual Dallas Cowboys Cheerleaders' uniforms in *Debbie Does Dallas*, an adult film.<sup>66</sup> Specifically, the plaintiff was upset by the fact that many of the actresses in the film wore these uniforms while performing various sexual acts.<sup>67</sup> Moreover, the defendants' movie posters featured captions such as "Starring Ex Dallas Cowgirl Cheerleader Bambi Woods" and "You'll do more than cheer for this X Dallas Cheerleader."<sup>68</sup> The plaintiff owners of the mark sued the defendants for trademark infringement under the Lanham Act and for dilution under section 368-d of the New York General Business Law.<sup>69</sup> The District Court for the Southern District of New York issued a preliminary injunction prohibiting the distribution and exhibition of the film.<sup>70</sup> The Second Circuit later held that the plaintiff's trade dress had acquired secondary meaning and was thus protectable, and that the defendant had demonstrated there was a likelihood of both confusion and dilution.<sup>71</sup> It then affirmed the preliminary injunction issued by the district court on both the trademark infringement and state law dilution grounds.<sup>72</sup>

In its analysis, the court made no efforts to hide its disdain for the film—"Debbie Does Dallas," for example, was "a gross and revolting sex film."<sup>73</sup> Indeed, the court's moral opprobrium permeated the opinion. In holding that there was a likelihood of confusion as to the sponsorship of the film, the court proclaimed that "it is hard to believe that anyone who had seen defendants' sexually depraved film could ever thereafter disassociate it from plaintiff's cheerleaders" and that the plaintiff had a right to "control his product's reputation."<sup>74</sup> Strictly speaking, there was no likelihood of confusion here;<sup>75</sup> rather the court maintained that

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<sup>66</sup> *Id.* at 202–03.

<sup>67</sup> *See id.* at 203.

<sup>68</sup> *Id.*

<sup>69</sup> *Id.*

<sup>70</sup> *Id.* at 202.

<sup>71</sup> *Id.* at 205.

<sup>72</sup> *Id.* at 207.

<sup>73</sup> *Id.* at 202.

<sup>74</sup> *Id.* at 205 (quoting *James Burrough Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 274 (7th Cir. 1976)).

<sup>75</sup> A finding of likelihood of confusion was more appropriate, however, with respect to the defendants' poster, which claimed that one of the stars was an "X Dallas

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sponsorship could follow from mere association.<sup>76</sup> As one commentator has noted, “The finding of a likelihood of confusion in the *Dallas Cowboys* . . . decision[] is best understood as reflective of [the] court’s strongly negative reaction to the nature of the parody. Yet the fact that the court[] [was] not amused does not mean that consumers are confused.”<sup>77</sup> And yet, the court’s dilution analysis is all but absent—it seems to presume that dilution will occur without examining any of the requirements under New York State law for that cause of action.

Moreover, the court brushed aside any First Amendment concerns, brusquely opining:

That defendants’ movie may convey a barely discernible message does not entitle them to appropriate plaintiff’s trademark in the process of conveying that message. Plaintiff’s trademark is in the nature of a property right, and as such it need not “yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.”<sup>78</sup>

Nor was this preliminary injunction an “unconstitutional ‘prior restraint.’”<sup>79</sup> As the court noted, this case was a private plaintiff’s

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Cheerleader.” *Id.* at 203; see Robert N. Kravitz, *Trademarks, Speech, and the Gay Olympics Case*, 69 B.U. L. REV. 131, 149–50 (1989) (“The court could have plausibly limited its finding of confusion to the film’s advertisements, which falsely suggested that the film starred an ex-Dallas Cowboys Cheerleader. But if the likelihood of confusion was limited to the advertisements, the court should have enjoined only the advertisements and not blocked exhibition of the film itself.” (footnote omitted)); see also Denicola, *supra* note 26, at 206 (“Yet the sweeping rejection of the defendant’s [F]irst [A]mendment claim in *Dallas Cowboys Cheerleaders* is dangerously simplistic.”).

<sup>76</sup> *Dallas Cowboys Cheerleaders*, 604 F.2d at 204–05.

<sup>77</sup> Cantwell, *supra* note 59, at 556; see also Kravitz, *supra* note 75, at 149–50 (“[I]t seems highly unlikely that a reasonable viewer would believe that the Dallas Cowboys Cheerleaders in any way sponsored or approved the film, or the use of the uniform, simply because a character in the film wore the uniform . . . . Quite clearly, the court primarily based its decision to uphold the plaintiff’s prohibition on the tarnishment rationale—that the plaintiff’s reputation would be degraded through association with what the court saw as a ‘gross and revolting sex film.’” (quoting *Dallas Cowboys Cheerleaders*, 604 F.2d at 202)).

<sup>78</sup> *Dallas Cowboys Cheerleaders*, 604 F.2d at 206 (quoting *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567 (1972)).

<sup>79</sup> *Id.*

action to “protect its property rights,” and the “prohibition of the Lanham Act is content neutral,” therefore, there were no constitutional concerns.<sup>80</sup>

Thus the Second Circuit’s main concern was protecting the Dallas Cowboys Cheerleaders’ trade dress (their uniform) from any unseemly association. Yet the court did not illustrate the contours of properly tarnishing uses, relying instead on a “strained” notion of likelihood of confusion.<sup>81</sup> The court did not elaborate on where to draw the lines between unfavorable, though unactionable, uses of a mark and actionable uses, if any lines were to be drawn at all. The court seemed to indicate that a mark owner has unfettered rights to control its brand image.

Even more concerning in *Dallas Cowboys Cheerleaders* was the court’s flippant treatment of the First Amendment. As one commentator underscored, “This decision to enjoin showings of the film to protect the plaintiff’s reputational interest in its trademark cannot be reconciled with [F]irst [A]mendment principles. There was no finding that the defendant’s film was obscene under [F]irst [A]mendment standards.”<sup>82</sup> The court thus enjoined this speech because it simply found the film disgusting; it never allowed a jury to determine whether this speech was obscenity under *Miller v. California*’s<sup>83</sup> standards, nor did it attempt to define the contours of tarnishing uses, other than by visceral, subjective reactions.

Similarly, in *Pillsbury Co. v. Milky Way Productions, Inc.*,<sup>84</sup> the district court failed to define the scope of tarnishment, while providing injunctive relief on dilution grounds.<sup>85</sup> In *Milky Way Productions*, the defendant, who owned the adult magazine, *Screw*,

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<sup>80</sup> *Id.*

<sup>81</sup> See Denicola, *supra* note 26, at 206 (“Although decided by an obviously strained reference to the confusion rationale, the court undoubtedly came closer to the true basis of its decision when it stated: ‘Indeed, it is hard to believe that anyone who had seen defendant’s sexually depraved film could ever thereafter disassociate it from plaintiff’s cheerleaders.’” (quoting *Dallas Cowboys Cheerleaders*, 604 F.2d at 205)).

<sup>82</sup> Kravitz, *supra* note 75, at 150–51.

<sup>83</sup> 413 U.S. 15 (1973). For an enumeration of the three-pronged *Miller* test, see *infra* note 303.

<sup>84</sup> No. C78-679A, 1981 WL 1402 (N.D. Ga. Dec. 24, 1981).

<sup>85</sup> *Id.* at \*14.

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published photos of clay “figures resembling [Pillsbury’s] trade characters ‘Poppin’ Fresh’ and ‘Poppie Fresh’” engaged in various sexual acts, including fellatio.<sup>86</sup> The pictures also contained Pillsbury’s trademark and parts of its advertising jingle.<sup>87</sup> Pillsbury sued Milky Way Productions, alleging, inter alia, copyright infringement, federal and state trademark infringement, and dilution under Georgia law.<sup>88</sup> The district court held that there was no likelihood of confusion arising from the defendant’s use of Pillsbury’s marks, primarily because the “parties’ products and retail outlets . . . [were] substantially dissimilar” and there was a lack of actual confusion.<sup>89</sup>

On the dilution claim, however, the court found that there was “a likelihood that the defendants’ presentation could injure the business reputation of the plaintiff or dilute the distinctive quality of its trademarks.”<sup>90</sup> Yet the court did not give a fulsome explanation of its reasoning in this part of the decision. Rather, it seemed to agree with the plaintiff that “Milky Way has tarnished the reputation, and thereby impaired the effectiveness, of its advertising agents by placing them in a ‘depraved context.’”<sup>91</sup> But what exactly is depravity? The court does not tell us.<sup>92</sup>

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<sup>86</sup> *Id.* at \*1.

<sup>87</sup> *Id.*

<sup>88</sup> *Id.*

<sup>89</sup> *Id.* at \*13.

<sup>90</sup> *Id.* at \*14.

<sup>91</sup> *Id.*

<sup>92</sup> Similarly, the court in *Edgar Rice Burroughs, Inc. v. High Society Magazine, Inc.*, 7 Media L. Rep. 1862 (BNA) (S.D.N.Y. 1981), did not elaborate on what exactly tarnishment is. The case involved a thirteen page spread in *High Society* magazine of the characters Tarzan and Jane engaged in sexual situations. *Id.* at 1863. These uses of the characters were unauthorized. *Id.* In granting a preliminary injunction for the trademark owner, the court merely noted that

[t]he reputation and good will with the public and among publishers, motion picture and TV producers, and in the publishing and entertainment fields which used the literary works authored by the late Edgar Rice Burroughs, the creator of the Tarzan and Jane characters and characterizations, have undoubtedly been besmirched, tarnished, and debased by the defendants and their magazine.

*Id.* at 1864.

Despite the lack of clarity concerning tarnishment and sexuality in these cases,<sup>93</sup> other courts began to rely on them to craft a rule in which tarnishment would “generally arise[] when the plaintiff’s trademark is linked to products of shoddy quality, or is portrayed in *an unwholesome or unsavory context likely to evoke unflattering thoughts about the owner’s product.*”<sup>94</sup> None of these courts, however, endeavored to define what constituted “unwholesome” or “unsavory.” Tarnishment, then, became a highly subjective, case-specific (and judge-specific) inquiry.<sup>95</sup>

On the other hand, as Sarah Burstein notes, other courts tried to eschew dependence on qualitative assessments of tarnishment in favor of a commercial/noncommercial distinction.<sup>96</sup> In *L.L. Bean, Inc. v. Drake Publishers, Inc.*,<sup>97</sup> the First Circuit turned a First Amendment lens on the Maine anti-dilution statute. The case involved a parodic two-page article in the adult magazine *High Society*.<sup>98</sup> The spoof article was entitled “L.L. Bean’s Back-to-School Sex Catalogue,” and it featured “a facsimile of Bean’s trademark . . . and pictures of nude models in sexually explicit positions using ‘products’ that were described in a crudely

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<sup>93</sup> One commentator even suggests that some “courts believed sexualization to be a per se harm leading to dilution by tarnishment.” Leigh A. Hansmann, Comment, *Sex, Selling Power, and Salacious Commentary: Applying the Copyright Fair Use Doctrine in the Trademark Context*, 2008 MICH. ST. L. REV. 843, 864.

<sup>94</sup> *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 43 (2d Cir. 1994) (emphasis added); see also *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 777 (8th Cir. 1994) (“Courts have frequently enjoined the ‘tarnishment’ of a mark through association with unsavory goods, persons or services.”); *Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*, 642 F. Supp. 1031, 1039 (N.D. Ga. 1986) (“[T]arnishment . . . occurs when a defendant uses the same or similar marks in a way that creates an undesirable, unwholesome, or unsavory mental association with the plaintiff’s mark.”).

<sup>95</sup> See, e.g., Pratheepan Gulasekaram, *Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works*, 80 WASH. L. REV. 887, 913 (2005) (“[B]y allowing judges to determine the social value to be accorded to expressive works, courts conduct a standardless exercise in imagination and creativity. When a court determines liability in cases involving sexuality, obscenity, drug use, or other ‘unwholesome’ associations, it runs the risk of transforming itself from a guardian of constitutional mandates into a literary and social critic—a demotion the judiciary is ill-equipped to handle.”).

<sup>96</sup> See Burstein, *supra* note 40, at 1212.

<sup>97</sup> 811 F.2d 26 (1st Cir. 1987).

<sup>98</sup> *Id.* at 27.

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humorous fashion.”<sup>99</sup> L.L. Bean brought suit for trademark infringement and dilution, inter alia, and the district court granted summary judgment on the dilution claim, finding that the defendant’s article “had tarnished Bean’s trademark by undermining the goodwill and reputation associated with the mark.”<sup>100</sup> At the outset, the First Circuit rejected the district court’s reliance on the real property analogy that the *Dallas Cowboys Cheerleaders* court had espoused.<sup>101</sup> Moreover, the court distinguished *Dallas Cowboys Cheerleaders* by maintaining that this case involved an “editorial or artistic” parody, which it characterized as noncommercial.<sup>102</sup> While acknowledging that “the Constitution tolerates an incidental impact on rights of expression of commercial actors in order to prevent a defendant from unauthorizedly merchandising his products with another’s trademark[,]”<sup>103</sup> it emphasized that

If the anti-dilution statute were construed as permitting a trademark owner to enjoin the use of his mark in a noncommercial context found to be negative or offensive, then a corporation could shield itself from criticism by forbidding the use of its name in commentaries critical of its conduct . . . . The Constitution does not . . . permit the range of the anti-dilution statute to encompass the unauthorized use of a trademark in a noncommercial setting such as an editorial or artistic context.<sup>104</sup>

Moreover, it viewed the district court’s evaluation of the speech at issue in the case as “an untoward judicial evaluation of the offensiveness or unwholesomeness of the appellant’s materials.”<sup>105</sup> It further maintained that “[t]he central role which trademarks occupy in public discourse (a role eagerly encouraged

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<sup>99</sup> *Id.*

<sup>100</sup> *Id.*

<sup>101</sup> *Id.* at 29.

<sup>102</sup> *Id.* at 32.

<sup>103</sup> *Id.*

<sup>104</sup> *Id.* at 33.

<sup>105</sup> *Id.* at 33–34.

by trademark owners), makes them a natural target of parodists. Trademark parodies, even when offensive, do convey a message.”<sup>106</sup> Thus, the parody was valuable speech and social commentary, however offensive.

In sum, the First Circuit seemed to find a subjective assessment of the parameters of tarnishment itself untenable when it could instead rely on a commercial/noncommercial distinction. To the First Circuit, it did not seem to matter if the use of the trademark was distasteful—everything turned on whether its use was *commercial*. Thus, *L.L. Bean* was much less concerned with the image that a trademark owner wanted to convey than with speech protection.

While well-intentioned, the First Circuit’s analysis seemed to gloss over the fact that Drake’s parody was no less injurious to a brand image than the uses in *Dallas Cowboys Cheerleaders* or *Milky Way Productions* were, and it was somewhat at pains to distinguish those cases, which it believed were commercial uses, from *L.L. Bean*’s noncommercial editorial.<sup>107</sup> The court thus did not clearly define what uses of a trademark would fall under the rubric of “noncommercial use” and left the determination up to subjective judicial assessments.

## 2. Tarnishment Rationales Underlying *San Francisco Arts & Athletics v. United States Olympic Committee* and *MGM-Pathe Communications Co. v. Pink Panther Patrol*

Around roughly the same time as the *L.L. Bean* case, two cases involving the use of trademarks and sexuality were working their way through the courts.<sup>108</sup> Although neither of these cases dealt explicitly with tarnishment or dilution, a tarnishment rationale underlies these cases—specifically, the tarnishment of marks by

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<sup>106</sup> *Id.* at 34.

<sup>107</sup> *Id.* at 32–33.

<sup>108</sup> See *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522 (1987); *MGM-Pathe Commc’ns, Co. v. Pink Panther Patrol*, 774 F. Supp. 869 (S.D.N.Y. 1991); see also *Int’l Olympic Comm. v. S.F. Arts & Athletics, Inc.*, 789 F.2d 1319 (9th Cir. 1986) (denial from rehearing en banc).

association with homosexuality.<sup>109</sup> While *International Olympic Committee v. San Francisco Arts & Athletics* (the “Gay Olympics case”) relied on the Amateur Sports Act to avoid a trademark’s association with a group of gay athletes,<sup>110</sup> the court in *MGM-Pathé Communications, Co. v. Pink Panther Patrol*<sup>111</sup> allowed concerns about tarnishment to inform its likelihood of confusion analysis, thus enjoining a group committed to the prevention of violence against gay men and women from using the mark of their choice.<sup>112</sup>

In 1986, the Ninth Circuit denied a rehearing en banc for the *Gay Olympics* case.<sup>113</sup> The case involved a San Francisco non-profit corporation that sought to use the name “Gay Olympics Games” for an event it wanted to sponsor that was “designed to combat homophobia and to work for the health and tolerance of gay and lesbian persons.”<sup>114</sup> The United States Olympic Committee (the “USOC”) sued San Francisco Arts & Athletics (the “SFAA”) under a federal statute that gave the USOC “the exclusive right to use the word Olympic ‘for the purpose of trade, to induce the sale of any goods or service, or to promote any theatrical exhibition, athletic performance, or competition.’”<sup>115</sup> The Ninth Circuit held for the USOC and upheld an injunction against the SFAA’s use of “Gay Olympic Games.”<sup>116</sup> Dissenting from the rehearing en banc, Judge Kozinski cautioned that the result reached by the court “threaten[ed] a potentially serious and widespread infringement of personal liberties.”<sup>117</sup> The SFAA sought to use the term “Olympic” to evoke a positive and healthy

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<sup>109</sup> See Sonia Katyal, *Performance, Property, and the Slashing of Gender in Fan Fiction*, 14 AM. U. J. GENDER SOC. POL’Y & L. 461, 462–63 (2006) (citing the *Gay Olympics* case as an example of how “courts have routinely protected the rights of intellectual property owners to enjoin expressive uses of their works under the argument that sexualized depictions ‘tarnish’ the wholesomeness of the original”).

<sup>110</sup> See Kravitz, *supra* note 75, at 180 (suggesting that the *Gay Olympics* case turned on dilution more than any likelihood of confusion).

<sup>111</sup> 774 F. Supp. 869 (S.D.N.Y. 1991).

<sup>112</sup> See *id.* at 876.

<sup>113</sup> 789 F.2d 1319, 1320 (9th Cir. 1986) (denial from rehearing en banc).

<sup>114</sup> *Id.* (Kozinski, J., dissenting).

<sup>115</sup> *Id.* (quoting 36 U.S.C. § 380 (1982)).

<sup>116</sup> *Id.*

<sup>117</sup> *Id.*



image of gay men and women.<sup>118</sup> According to Judge Kozinski, denying the SFAA the right to use the word “Olympic” deprived them of an essential “nuance of meaning.”<sup>119</sup>

The word Olympic was no doubt chosen to foster a wholesome, normal image of homosexuals. Denying SFAA use of the word thwarts that purpose. To say that the SFAA could have named its event “The Best and Most Accomplished Amateur Gay Athletes Competition” no more answers the [F]irst [A]mendment concerns here than to suggest that Paul Robert Cohen could have worn a jacket saying “I Strongly Resent the Draft.”<sup>120</sup>

Criticizing the majority for treating “the word ‘Olympic’ and its associated symbols and slogans [as] essentially property,”<sup>121</sup> Judge Kozinski expressed concern for the strengthening of intellectual property rights at the expense of the public domain.<sup>122</sup> And then Judge Kozinski hit on the heart of the matter—the majority supported “an exclusion that is invoked pursuant to a subjective assessment of the wholesomeness of the proposed speaker or propriety of the proposed message.”<sup>123</sup> Kozinski’s analysis thus indicates that the Ninth Circuit majority’s concerns were not grounded in any likelihood of confusion, but rather in the tarnishment of the Olympic name. As Kozinski noted acerbically, the “handicapped, juniors, police, Explorers, even dogs are allowed to carry the Olympic torch, but homosexuals are not.”<sup>124</sup>

The Supreme Court affirmed the Ninth Circuit’s opinion in 1987.<sup>125</sup> Relying on a Lockean conception of the USOC’s property right,<sup>126</sup> the Court determined that the SFAA’s use of the term was commercial and could thus be reached by section 110 of

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<sup>118</sup> *Id.* at 1321.

<sup>119</sup> *Id.*

<sup>120</sup> *Id.*

<sup>121</sup> *Id.*

<sup>122</sup> *Id.* at 1323.

<sup>123</sup> *Id.*

<sup>124</sup> *Id.*

<sup>125</sup> *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 528 (1987).

<sup>126</sup> *See id.* at 532.

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the Amateur Sports Act.<sup>127</sup> Justice Powell's majority opinion relied not on a likelihood of confusion analysis, but rather, on a dilution rationale.<sup>128</sup> Congress "could determine that unauthorized uses [of the Olympic words and symbols], even if not confusing, nevertheless may harm the USOC by lessening the distinctiveness and thus the commercial value of the marks."<sup>129</sup>

In his dissent, Justice Brennan took the majority to task for upholding a statute that he maintained was unconstitutionally overbroad—it prohibited noncommercial uses that would have benefited from First Amendment protection had the Act incorporated any of the traditional trademark defenses codified in the Lanham Act.<sup>130</sup> Indeed, the Act benefited from "additional authority to regulate a substantial amount of noncommercial speech that serves to promote social and political ideas."<sup>131</sup> According to Justice Brennan, "this broad discretion creat[ed] the potential for significant suppression of protected speech."<sup>132</sup> Furthermore, the Act was not viewpoint neutral—the "Amateur Sports Act singles out certain . . . groups for favorable treatment" but not others, including the SFAA.<sup>133</sup> Similar to Judge Kozinski's view, Justice Brennan's dissent implied that the injunction on this use was predicated upon a homophobic tarnishment rationale.

Thus, as Judge Kozinski and Justice Brennan indicated, the *Gay Olympics* cases, although not decided under the Lanham Act, had disturbing consequences for the association of sexual orientation and trademarks. As Rosemary Coombe asserts, "Trademark legislation thus enabled a public authority to exercise

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<sup>127</sup> *Id.* at 539–41. It is important to underscore that the statute at issue here was not the Lanham Act, but rather, the Amateur Sports Act, which granted greater rights to the use of the word "Olympic" than the Lanham Act would have. Nonetheless, the court relied on trademark principles in its analysis, and the decision has had wide-reaching influence in trademark law.

<sup>128</sup> Indeed, the Court emphasized that "the USOC need not prove that a contested use is likely to cause confusion, and an unauthorized user of the word does not have available the normal statutory defenses." *Id.* at 531.

<sup>129</sup> *Id.* at 539.

<sup>130</sup> *Id.* at 562 (Brennan, J., dissenting). Statutory trademark defenses are codified at 15 U.S.C. § 1115 (2006).

<sup>131</sup> *S.F. Arts & Athletics*, 483 U.S. at 567 (Brennan, J., dissenting).

<sup>132</sup> *Id.* at 568.

<sup>133</sup> *Id.* at 570.

its power over a signifier in a discriminatory manner—to prevent subordination from becoming translated into hegemonic articulation.”<sup>134</sup> This result was inherently problematic because “SFAA’s speech was speech on behalf of an unpopular minority, thus more susceptible to being discouraged.”<sup>135</sup> Thus, the majority opinion in the *Gay Olympics* case prevented gay athletes from empowering themselves by using a word that evokes the “spirit of co-operation, mutual acceptance, and international friendship.”<sup>136</sup> Moreover, the Supreme Court had (inadvertently?) created precedent whereby a court could deem a trademark’s association with sexual orientation tarnishment, and it restricted the free speech rights of a marginalized group.

A tarnishment rationale similarly underlies the Second Circuit’s decision in *MGM-Pathé Communications, Co. v. Pink Panther Patrol*. The case involved a gay rights group’s use of the name “The Pink Panther Patrol.”<sup>137</sup> The group patrolled the streets of New York, “with the goals of protecting the gay community and educating the general public about violence against gays.”<sup>138</sup> The name it chose was a deliberate homage to “other activist organizations such as the Grey and Black Panthers, changed to pink because pink is a color associated with gay activism.”<sup>139</sup> MGM filed suit to protect its trademark in the movie and popular cartoon character of the same name,<sup>140</sup> alleging trademark infringement and dilution under New York State’s General Business Law.<sup>141</sup> Although Judge Leval<sup>142</sup> granted a preliminary

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<sup>134</sup> COOMBE, *supra* note 23, at 137; *see also* Katya Assaf, *The Dilution of Culture and the Law of Trademarks*, 49 IDEA 1, 60 (2008) (“The Olympic Committee should have no right to make decisions with respect to the cultural meaning of the Olympic Games and, particularly, on whether or not they should be associated with homosexuals. By allowing the Olympic Committee to decide this issue, a single private entity is allowed to determine whether our cultural perception of wholesome and prestigious athletic games should include the notion of homosexuality.”).

<sup>135</sup> Kravitz, *supra* note 75, at 177.

<sup>136</sup> Dreyfuss, *supra* note 22, at 413.

<sup>137</sup> *MGM-Pathé Commc’ns, Co. v. Pink Panther Patrol*, 774 F. Supp. 869, 871 (S.D.N.Y. 1991).

<sup>138</sup> *Id.*

<sup>139</sup> *Id.*

<sup>140</sup> *Id.* at 872.

<sup>141</sup> *Id.*

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injunction on the basis of likelihood of confusion, stating that he did not need to consider MGM's state dilution claim,<sup>143</sup> tarnishment concerns pervade his opinion.<sup>144</sup> Judge Leval underscored that "MGM uses its mark to promote an image of lighthearted, nonpolitical, asexual, amicable, comic entertainment" whereas "[t]he Patrol's use of the name is associated with political activism, violence, defiance, *homosexuality* and angry confrontation."<sup>145</sup> Moreover, in weighing the balance of hardships, Judge Leval was concerned about

the cheapening [of the Pink Panther mark] through repeated use by others and the likely alteration of the image associated with the mark that could result from publicity given to violent attacks and counterattacks involving the Pink Panther Patrol [that] could seriously impair the value and continued usefulness of [MGM's] mark.<sup>146</sup>

*Pink Panther Patrol* is thus another example of sexual orientation as a tarnishing agent. While Judge Leval's analysis ostensibly focuses on likelihood of confusion, it is far from clear that confusion could have resulted from the gay rights group's use of the mark. Indeed, while the marks were the same, the lack of proximity of the marks in the marketplace and similar marketing channels strongly indicated that confusion would not result; moreover, there was no evidence of actual confusion.<sup>147</sup> Rather, dilution by tarnishment seemed to be foremost on Judge Leval's mind.

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<sup>142</sup> The fact that Judge Leval, champion of free speech and fair use, decided this case is more than a little ironic. See generally Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105 (1990) (examining copyright fair use); Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 COLUM. J.L. & ARTS 187 (2004) [hereinafter Leval, *Trademark*].

<sup>143</sup> *Pink Panther Patrol*, 774 F. Supp. at 877.

<sup>144</sup> See Burstein, *supra* note 40, at 1203 ("One court hinted—although it did not consider or decide—that tarnishment might be found where a defendant's use of a famous mark links the senior user's mark to a contentious political issue where the senior user 'has developed [the] mark to suggest 'carefree, comedic, non-political fun.'") (alteration in original) (quoting *Pink Panther Patrol*, 774 F. Supp. at 871–73)).

<sup>145</sup> *Pink Panther Patrol*, 774 F. Supp. at 876 (emphasis added).

<sup>146</sup> *Id.* at 877.

<sup>147</sup> See *id.* at 874–76.

*Pink Panther Patrol*, like the *Gay Olympics* case, added more fuel to the fire of tarnishment by association with “gayness,” notwithstanding the fact that sexual orientation is not synonymous with “unwholesomeness.” While, as the succeeding sections demonstrate, courts became more solicitous of free speech concerns in tarnishment cases, this tarnishment-by-sexuality rationale eventually found a place in pre-litigation maneuvers by trademark holders, namely in cease-and-desist letters.

### 3. Tarnishment Cases Under the FTDA

Following the enactment of the FTDA in 1995, statutory exemptions and judicial interpretation arguably began to afford greater protection to sexually connotative uses of marks. In particular, because the FTDA granted an exemption for noncommercial uses,<sup>148</sup> tarnishment could not reach certain kinds of speech. While some courts continued to rely on pre-FTDA case law in attempting to define tarnishing uses,<sup>149</sup> the dividing line between actionable and non-actionable uses moved away from the content of the use to a consideration of whether it was commercial or noncommercial.

A series of cases in the Ninth Circuit and its district courts began to solidify this distinction in the context of sexually explicit or suggestive uses of marks. For example, in *Lucasfilm Ltd. v. Media Market Group, Ltd.*,<sup>150</sup> the Northern District of California relied on the district court’s opinion in *Mattel, Inc. v. MCA Records, Inc.*<sup>151</sup> in holding that a “pornographic animated film entitled ‘Starballz’” was not actionable tarnishment under the FTDA.<sup>152</sup> Lucasfilm had sought a preliminary injunction alleging

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<sup>148</sup> Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (1996), repealed by Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 730.

<sup>149</sup> See, e.g., *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 507 (2d Cir. 1996) (“Some cases have found that a mark is tarnished when its likeness is placed in the context of sexual activity, obscenity, or illegal activity.”); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 733 (D. Minn. 1998) (“[T]arnishment most frequently occurs when a mark is used in connection with sexually explicit materials . . .”).

<sup>150</sup> 182 F. Supp. 2d 897 (N.D. Cal. 2002).

<sup>151</sup> 28 F. Supp. 2d 1120 (C.D. Cal. 1998).

<sup>152</sup> *Media Mkt. Group*, 182 F. Supp. 2d at 899–901.

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that the film infringed and diluted its trademarks in “Star Wars.”<sup>153</sup> In rejecting Lucasfilm’s claims, the court emphasized that “[p]arody is a form of non-commercial, protected speech which is not affected by the [FTDA].”<sup>154</sup> While the court’s conclusory statement on parody lacked nuance somewhat,<sup>155</sup> the court seemed to be emphasizing that an expressive use, though pornographic, will not rise to the level of actionable tarnishment. The implication was that courts may enjoin pornographic uses *only when they deem the use commercial*. Indeed, the court did agree that “Starballz tarnishes the Star Wars family of marks by associating them with a pornographic film that is inconsistent with the image Star Wars has striven to maintain for itself” but held that this use was simply not actionable under the FTDA.<sup>156</sup>

Soon after *Media Market Group* was decided, the Ninth Circuit’s decision in *Mattel, Inc. v. MCA Records, Inc.*<sup>157</sup> came down. Writing for the majority, Judge Kozinski held that the band Aqua’s use of Mattel’s “Barbie” mark in Aqua’s song and song title “Barbie Girl” fell under the FTDA’s noncommercial use exemption.<sup>158</sup> Mattel had sued MCA records, Aqua’s label, for trademark infringement and dilution, alleging that the song harmed the “Barbie” mark.<sup>159</sup> As Judge Kozinski pointed out, “the song . . . lampoons the Barbie image and comments humorously on the cultural values Aqua claims she represents.”<sup>160</sup> While the song was not overtly explicit, sexual innuendos abounded. To wit, the song contained the following lyrics that are at odds with the squeaky-clean image Mattel strives to maintain for Barbie: “You can brush my hair, undress me everywhere” and “Kiss me here, touch me there, hanky-panky.”<sup>161</sup> Although the opinion did not

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<sup>153</sup> *Id.* at 899.

<sup>154</sup> *Id.* at 900.

<sup>155</sup> A full examination of the scope of parody is beyond this paper. For more on the contours of trademark parody, see generally Cantwell, *supra* note 59; Bruce P. Keller & Rebecca Tushnet, *Even More Parodic than the Real Thing: Parody Lawsuits Revisited*, 94 TRADEMARK REP. 979 (2004).

<sup>156</sup> See *Media Mkt. Group*, 182 F. Supp. 2d at 900–01.

<sup>157</sup> 296 F.3d 894 (9th Cir. 2002).

<sup>158</sup> *Id.* at 906–07; see *supra* note 56 and accompanying text.

<sup>159</sup> *Id.* at 899.

<sup>160</sup> *Id.* at 907.

<sup>161</sup> *Id.* at 909 (app.).

explicitly mention “tarnishment,” it was clear that Mattel found the song to be offensive. Judge Kozinski held, however, that because the song did not comprise fully commercial *speech*, it fell under the FTDA’s noncommercial use exemption.<sup>162</sup> Thus, Judge Kozinski underscored that the inquiry should not focus on the offensiveness of the speech itself—rather, he focused on the commercial/noncommercial fulcrum. Moreover, he arguably expanded the scope of this exemption. As one commentator notes,

*Mattel* thus modifies the dichotomy first proposed in *Bean* from commercial *use* versus expressive *use* to commercial *speech* versus noncommercial *speech*. Under this reading, “mixed” uses of a trademark (*i.e.*, uses that combine a commercial with an expressive purpose) would not be actionable under the FTDA because they will always do more than “propose a commercial transaction.”<sup>163</sup>

Thus, under *MCA*, it would seem that pornographic but expressive uses of a mark could arguably pass muster.

The Ninth Circuit relied on *MCA* a year later in *Mattel, Inc. v. Walking Mountain Productions*.<sup>164</sup> Mattel had brought suit against Thomas Forsythe, an artist who had created the “Food Chain Barbie” photo series, “in which he depicted Barbie in various absurd and often sexualized positions.”<sup>165</sup> Indeed, Forsythe

display[ed] carefully positioned, nude, and sometimes frazzled looking Barbies in often ridiculous and apparently dangerous situations. . . . In some of [his] photos Barbie is about to be destroyed or harmed by domestic life in the form of kitchen appliances, yet continues displaying her well-known smile, disturbingly oblivious to her predicament. . . . [He] convey[ed] a sexualized

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<sup>162</sup> *Id.* at 906 (“If speech is not ‘purely commercial’—that is, if it does more than propose a commercial transaction—then it is entitled to full First Amendment protection.”).

<sup>163</sup> Cantwell, *supra* note 59, at 577.

<sup>164</sup> 353 F.3d 792 (9th Cir. 2003).

<sup>165</sup> *Id.* at 796.

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perspective of Barbie by showing the nude doll in sexually suggestive contexts.<sup>166</sup>

The Ninth Circuit affirmed the district court's grant of summary judgment to the defendant on all claims, including copyright and trademark infringement and dilution.<sup>167</sup> In its brief analysis of dilution, the court relied on *MCA* for the proposition that "[p]arody is a form of noncommercial expression if it does more than propose a commercial transaction."<sup>168</sup> The court deemed Forsythe's works parodies, and thus the sexualized Barbies comprised noncommercial speech.<sup>169</sup> As in *MCA* and *Media Market Group*, the court was not swayed by the fact that the content of Forsythe's pieces was at odds with the image that Mattel sought to cultivate or that Mattel viewed the works as damaging to Barbie's brand image.

Thus, as *Media Market Group*, *MCA*, and *Walking Mountain Productions* all demonstrate, courts began to avoid a qualitative assessment of the speech in favor of a commercial/noncommercial distinction.<sup>170</sup> Thus, speech that associated trademarks with sexually explicit or suggestive material arguably began to have more protection than under state dilution statutes. At the same time, however, some courts continued to find tarnishment in perhaps nonexpressive uses of marks, particularly with respect to uses of trademarks in the domain names of pornographic websites.<sup>171</sup> These decisions are not necessarily at odds with *MCA*,

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<sup>166</sup> *Id.* at 802.

<sup>167</sup> *Id.* at 796.

<sup>168</sup> *Id.* at 812.

<sup>169</sup> *Id.*

<sup>170</sup> *But see* Kraft Food Holdings, Inc. v. Helm, 205 F. Supp. 942, 956 (E.D. Ill. 2002) (holding that the defendant artist's use of the nickname "King VelVeeda" on a website containing pornographic material and drug use would dilute the plaintiff's "Velveeta" mark). As Cantwell notes, the court there demonstrated "judicial priggishness" in refusing to consider application of the FTDA's noncommercial use exception to this less-than-tasteful use of the plaintiff's mark. Cantwell, *supra* note 59, at 568-69.

<sup>171</sup> *See, e.g.,* Mattel, Inc. v. Internet Dimensions, Inc., 55 U.S.P.Q.2d 1620, 1627 (S.D.N.Y. 2000) (holding that the use of "Barbie" mark in "barbiesplaypen.com" site tarnished Mattel's mark); Polo Ralph Lauren L.P. v. Schuman, No. Civ.A. H97-1855, 1998 WL 110059, at \*2-3 (S.D. Tex. Feb. 9, 1998) (granting permanent injunction against use of the mark "Polo" in the name of defendant's "adult entertainment establishment"); Hasbro, Inc. v. Internet Entm't Group Ltd., 40 U.S.P.Q.2d 1479, 1480 (W.D. Wash. 1996) (holding that defendant's use of the "Candy Land" mark in its



however, as they arguably involve purely commercial uses of the plaintiff's trademarks.

It is important to underscore that beyond the noncommercial exemption provided in the FTDA, other courts sought to tighten the evidentiary requirements for showing dilution. Most prominently, in *Moseley v. V. Secret Catalogue*,<sup>172</sup> the Supreme Court held that the FTDA required “a showing of actual dilution, rather than a likelihood of dilution.”<sup>173</sup> The Supreme Court refused to presume that the “Victoria’s Secret” mark would be diluted by a small store in Fort Knox, Kentucky named “Victor’s Little Secret” that sold sex toys and lingerie.<sup>174</sup> It seems that the Supreme Court did not want to automatically equate what Victoria’s Secret described as “unwholesome, tawdry merchandise”<sup>175</sup> with actionable dilution under the FTDA. For that reason, it held that “actual dilution” was required under federal law.<sup>176</sup> Although Congress overruled the decision in *Moseley* by enacting the Trademark Dilution Revision Act in 2006,<sup>177</sup> the case still evinces an effort to reign in the potentially broad-reaching scope of tarnishment and dilution.<sup>178</sup>

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“sexually explicit Internet site, and [use of] the name string ‘www.candyland.com’ as an Internet domain name” diluted the plaintiff’s mark and granting a preliminary injunction).<sup>172</sup> 537 U.S. 418 (2003), *remanded to* 558 F. Supp. 2d 734 (W.D. Ky. 2008), *aff’d* 605 F.3d 382 (6th Cir. 2010).

<sup>173</sup> *Id.* at 433.

<sup>174</sup> *Id.* at 423.

<sup>175</sup> *Id.*

<sup>176</sup> *Id.* at 433.

<sup>177</sup> Trademark Dilution Revision Act of 2006, 109 Pub. L. No. 109-312, 120 Stat. 1730 (codified as amended at 15 U.S.C. §§ 1052, 1063–64, 1092, 1125, 1127 (2006)).

<sup>178</sup> On remand, however, the *Moseley* case took a decidedly different turn, seemingly reviving tarnishment in the courts by holding that the TDRA “creates a kind of rebuttable presumption, or at least a very strong inference, that a new mark used to sell sex related products is likely to tarnish a famous mark if there is a clear semantic association between the two.” *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 385 (6th Cir. 2010); *see also* Matthew D. Marcotte, *Dilution Back from the Dead? V Secret v. Moseley*, *Visa International v. JSL Corp.*, and *National Pork Board v. Supreme Lobster and Seafood Co.*, 80 PAT. TRADEMARK & COPYRIGHT J. (BNA) 402 (2010) (arguing that there may be “a new glimmer of hope for dilution plaintiffs” in the wake of three recent decisions upholding a likelihood of dilution).

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Thus, as this section has demonstrated, case law under the FTDA began treating tarnishment claims with greater solicitude for speech.<sup>179</sup>

#### 4. Post-TDRA Tarnishment and Sexually Suggestive Associations

Since the enactment of the TDRA in 2006, very few cases involving tarnishment and sexuality have been adjudicated. In *Burnett v. Twentieth Century Fox Film Corp.*,<sup>180</sup> Carol Burnett sued Fox for copyright and trademark infringement, dilution, statutory right of publicity, and common law misappropriation over a *Family Guy* episode she deemed offensive.<sup>181</sup> In the episode, “an animated figure resembling the ‘Charwoman’ from the Carol Burnett Show” was mopping the floor in a porn shop while a variation of Carol’s Theme from the Carol Burnett show played in the background.<sup>182</sup> The brief Carol Burnett reference also featured a puerile sexual innuendo involving Carol Burnett’s father.<sup>183</sup> The district court granted the motion to dismiss on all claims.<sup>184</sup> In dismissing the dilution claim, the court held that the *Family Guy* episode was “artistic” and “parodic” noncommercial speech and thus it could not be the subject of a trademark dilution claim.<sup>185</sup> The court did state that it “fully appreciate[d] how distasteful and offensive the segment [was] to Ms. Burnett,”<sup>186</sup> but it ultimately maintained that “the law, as it must in an open society, provides broad protection for the defendant’s segment.”<sup>187</sup> Thus, even though the court found *Family Guy*’s uses of Burnett’s

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<sup>179</sup> *But see* Cantwell, *supra* note 59, at 579 (“Yet it seems likely that post-*Mattel* case law will present no less of patchwork than the pre-*Mattel* case law.”).

<sup>180</sup> 491 F. Supp. 2d 962 (C.D. Cal. 2007).

<sup>181</sup> *Id.* at 966.

<sup>182</sup> *Id.*

<sup>183</sup> *See id.* (“The scene switches back to Peter and his friends. One of the friends remarks: ‘You know, when she tugged her ear at the end of that show, she was really saying goodnight to her mom.’ Another friend responds, ‘I wonder what she tugged to say goodnight to her dad,’ finishing with a comic’s explanation, ‘Oh!’” (internal citations omitted)).

<sup>184</sup> *Id.* at 975.

<sup>185</sup> *Id.* at 974.

<sup>186</sup> *Id.*

<sup>187</sup> *Id.* at 975.

trademarks to be distasteful, it maintained that it could not enjoin the use on those grounds alone. Although the *Burnett* case does not involve overt references to sex and sexuality, it suggests that post-TDRA courts may continue the trend of broadly interpreting exemptions from the tarnishment cause of action in the Lanham Act.<sup>188</sup>

##### 5. Tarnishment in the Courts Redux: Where Do We Go from Here?

As the foregoing sections demonstrate, the case law on tarnishment is a mixed bag, but it does indicate a growing

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<sup>188</sup> It is worth noting, however, that the recent Sixth Circuit *Moseley* decision has created some cause for concern regarding the automatic linkage between tarnishment and sex/sexuality. See *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 387–88 (6th Cir. 2010) (“There appears to be a clearly emerging consensus in the case law . . . that the creation of an ‘association’ between a famous mark and lewd or bawdy sexual activity disparages and defiles the famous mark and reduces the commercial value of its selling power. This consensus stems from an economic prediction about consumer taste and how the predicted reaction of conventional consumers in our culture will affect the economic value of the famous mark.”); *id.* at 389 (“Thus, any new mark with a lewd or offensive-to-some sexual association raises a strong inference of tarnishment. The inference must be overcome by evidence that rebuts the probability that some consumers will find the new mark both offensive and harmful to the reputation and the favorable symbolism of the famous mark.”); Paul Alan Levy, *What Dilution by Tarnishment Is Really About*, PUB. CITIZEN CONSUMER L. & POL’Y BLOG (May 20, 2010, 3:02 PM), <http://pubcit.typepad.com/clpblog/2010/05/what-dilution-by-tarnishment-is-really-about.html> (criticizing the outcome of the case and the disingenuity of its reasoning by noting that Victoria’s Secret’s “products are sexy lingerie and the like; and its real product is sexual connotation”—in sum, it is difficult to “tarnish” already sexed up goods); J. Thomas McCarthy, *A First Look by Tom McCarthy at the Sixth Circuit’s 2010 Victoria’s Secret Tarnishment Decision*, ERIC GOLDMAN—TECH. & MARKETING L. BLOG (May 24, 2010, 9:07 PM), [http://blog.ericgoldman.org/archives/2010/05/a\\_first\\_look\\_by.htm](http://blog.ericgoldman.org/archives/2010/05/a_first_look_by.htm) (“The decision also raises troubling issues of commercial speech. The majority creates a presumption of dilution by tarnishment if the junior mark appears on ‘sex-related products,’ invoking the tort doctrine of *res ipsa loquitur*. This sounds like the court is making value judgments about what is ‘sexy.’ As dissenting [J]udge Moore points out, it’s ironic that the ‘tarnished’ plaintiff’s VICTORIA’S SECRET mark itself is widely promoted as a source for ‘sexy little things’ intimate lingerie.”). Further exegesis on the *Moseley* decision is beyond the scope of this Note; it is important, though, to underscore its possible implications for tarnishment law, even though it is arguably premised on a misunderstanding of tarnishment and the recent trends in case law. At the same time, *Moseley* may be distinguished from noncommercial speech cases because of the defendants’ use of their mark as a source signifier and the commercial nature of their use (for an adult-themed store offering sex toys and other sexually-themed objects). *Moseley*, 605 F.3d at 384.

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solicitude for broadly interpreting the federal statute to exempt many, if not all, types of expressive speech. As Professor McGeeveran notes, “the results of reported cases involving expressive uses . . . have stabilized in the last decade and now favor the expressive uses most of the time.”<sup>189</sup>

At the same time, dilution law in general seems to be becoming less successful in the courts and “[j]udicial enthusiasm for dilution as a theory of infringement has diminished.”<sup>190</sup> As Professor Long notes,

Judicial enforcement of dilution law is not robust today and has been eroding over time. . . . [R]elief rates have been on a downward trajectory since then. It could well be the case that dilution law is a powerful bargaining chip in cease-and-desist letters and in negotiations entirely outside the litigatory arena. In the federal courts, however, dilution cases are not exactly a juggernaut. That is not to say that dilution law lacks seductive appeal, but rather that it seems not to have worked its wiles on the judicial mind as many feared.<sup>191</sup>

Long’s research demonstrates that, under FTDA reported cases, “the rate at which trademark holders have been able to get injunctive relief on their dilution claims in district court has been dropping over time from an initial success rate of 54.17% in 1996 to 12.00% for the first half of 2005.”<sup>192</sup> Similarly, in unreported filings, relief rates dropped from 45.45% in 1999 to 14.81% in the first half of 2005.<sup>193</sup> Professor Barton Beebe further argues that there is “strong and disturbing evidence of the continuing debacle of U.S. antidilution law and of the failure of the TDRA so far to effect any substantial change in course.”<sup>194</sup> Moreover, “the case

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<sup>189</sup> McGeeveran, *Rethinking*, *supra* note 31, at 59. Professor McGeeveran defines “expressive uses” as those “uses of trademarks [that] convey an articulable message rather than, or in addition to, the traditional function of source identification.” *Id.* at 54.

<sup>190</sup> Long, *supra* note 28, at 1054.

<sup>191</sup> *Id.* at 1031.

<sup>192</sup> *Id.* at 1042 (including domain name cases).

<sup>193</sup> *Id.* at 1050 (including domain name cases).

<sup>194</sup> Beebe, *supra* note 30, at 450.

law shows the remarkable extent to which courts continue to treat the dilution cause of action as redundant of—and, thus, made superfluous by—the infringement cause of action.”<sup>195</sup>

At first blush, it would seem that dilution in general, and tarnishment in particular, is losing its salience in trademark law. However, as Part II will demonstrate, it is likely that dilution by tarnishment plays an increasing role in pre-litigation correspondence, namely cease-and-desist letters. Moreover, the early attitudes towards uses of trademarks in either sexually explicit contexts or with reference to sexual orientation still seem to inform trademark owners’ actions in the cease-and-desist context.

## II. BRANDS AS VEHICLES OF SPEECH: HOW CEASE-AND-DESIST LETTERS MAY CHILL DEPICTIONS AND SUGGESTIONS OF SEXUALITY

As Part I discussed, tarnishment’s scope in adjudications has largely been cabined by statutory provisions and judicial fiat. As this Part will suggest, tarnishment allegations still can thrive in the plethora of cease-and-desist letters that mark owners send on a routine basis. This Part will begin by emphasizing the distinction between sex and sexuality in trademark recordings. It will also briefly survey the examples of cease-and-desist letters that potential trademark recoders<sup>196</sup> and parodists have received. It will then examine how cease-and-desist letters chill speech and examine why this silencing is troublesome. This Part will further examine how, notwithstanding, First Amendment,<sup>197</sup> statutory (the

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<sup>195</sup> *Id.* In Beebe’s survey of cases decided since the effective date of the TDRA on October 6, 2006, he found “that of the twenty-six opinions that found no infringement, none found dilution. Of the fifteen opinions that found infringement, fourteen also found dilution, yet none of these fourteen findings of dilution resulted in remedies not already triggered by the court’s finding of infringement.” *Id.* at 450–51.

<sup>196</sup> According to Rosemary Coombe, recoding is “productive activity in which people engage in meaning-making to adapt signs, texts, and images to their own agendas.” COOMBE, *supra* note 23, at 57.

<sup>197</sup> While I use the First Amendment here as shorthand for speech considerations, it is important to underscore that the doctrine of constitutional avoidance is well-embedded in trademark law. As Professor McGeeveran notes, it would be undesirable to “invite First Amendment balancing into the workaday functioning of trademark cases” because “judges should avoid unnecessary constitutional decision-making.” William McGeeveran,

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TDRA exemptions), and case law (the commercial/noncommercial distinctions drawn by courts) protections, these doctrines do not provide adequate safeguards for recoders. In the context of speech referencing sexuality and sexual orientation, a main concern is the silencing of a minority group's views through the functional equivalent of a prior restraint on speech. For uses of a trademark in a sexually explicit setting, this is also a concern, as these uses are never formally deemed obscene under current legal standards. Moreover, this Part will also touch on the practical implications for the average individual receiving a cease-and-desist letter.

A. *Distinctions Between "Sex" and "Sexuality" in Disputed Trademark Uses*

Before this Note embarks on a more detailed examination of recent cease-and-desist recipients, it is important to underscore, in light of the decisions surveyed in Part I *supra*, that there is a distinction between sexually explicit depictions of trademarks and those that reference sexuality and sexual orientation. On the one hand, sexually explicit depictions include those that are obscene, pornographic, prurient, or sexually suggestive in nature, such as in *Dallas Cowboys Cheerleaders*, *L.L. Bean*, and *Milky Way Productions*.<sup>198</sup> These depictions, while tacky and distasteful (depending on whom you ask), should generally be protected under the TDRA and existing tarnishment precedent if they fall under MCA's rubric of "noncommercial."<sup>199</sup> At the same time, speech issues aside, one cannot entirely fault trademark owners for being concerned about associations with sexually explicit content,<sup>200</sup>

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*Four Free Speech Goals for Trademark Law*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1205, 1212 (2008) [hereinafter McGeeveran, *Four Free Speech Goals*].

<sup>198</sup> See *supra* Part I.B.1.

<sup>199</sup> See, e.g., *Burnett v. Twentieth Century Fox Film*, 491 F. Supp. 2d 962 (C.D. Cal. 2007) ("A dilution action only applies to purely commercial speech." (citing *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 904 (9th Cir. 2002))).

<sup>200</sup> See K.J. Greene, *Abusive Trademark Litigation and the Incredible Shrinking Confusion Doctrine—Trademark Abuse in the Context of Entertainment Media and Cyberspace*, 27 HARV. J.L. & PUB. POL'Y 609, 634 (2004) ("Although trademark law should generally not chill artistic expression, it should prevent free-riding and egregious tarnishment (such as pornographic use) when the trademark holder's reputation will suffer tangible harm. For example, in *Dallas Cowboys Cheerleader Inc. v. Pussy Cinema*

especially if the marks are child-oriented.<sup>201</sup> Indeed, in examining recoding in copyright and trademark law, Professor Justin Hughes sees a distinction between trademarks that are “adult” by nature as opposed to those that are child-oriented:

A further distinction might be drawn between, on the one hand, lewd recordings of Mickey Mouse and, on the other hand, the breast-exposed excheerleaders of the Dallas Cowboys Cheerleaders parody poster. After all, the Dallas Cowboys Cheerleaders have always traded on sex—that is what their appeal is supposed to be. Any Dallas Cowboys corporate-speak about the Cheerleaders maintaining an image of purity would surely be tongue-in-cheek capitalism. When some of the Cheerleader alumni are seen topless, it really does not seem to “contaminate” the existing cultural object much. Mickey Mouse shooting up heroin puts a lot more stress on our communal image of Mickey Mouse than seeing a Dallas Cowboys Cheerleader topless puts on our communal image of the Cheerleaders.<sup>202</sup>

Thus, it would seem that potential degradation of more “wholesome” marks is arguably more objectionable or offensive.

On the other hand, when groups like the Courage Campaign and SFAA seek to use marks in expressive ways, they are associating marks with sexual orientation, not sex per se.<sup>203</sup> These

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*Ltd.*, a pornographic filmmaker’s expressive right to use of Dallas Cowboy-style cheerleader outfits in a film was found to be outweighed by the trademark owner’s rights to the wholesome image of the cheerleaders.”).

<sup>201</sup> See *infra* Part II.B.3 (discussing sexually explicit Harry Potter fan fiction).

<sup>202</sup> Justin Hughes, “Recoding” *Intellectual Property and Overlooked Audience Interests*, 77 TEX. L. REV. 923, 985 (1999) (footnote omitted) (referencing *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978)); see also *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 394 n.4 (6th Cir. 2010) (Moore, J., dissenting) (“Nor can the court ignore the character of the senior mark when applying the majority’s ‘rule.’ Victoria’s Secret sells women’s lingerie, and, as Victoria’s Secret readily admits, its own mark is already associated with sex, albeit not with sex novelties.”); Levy, *supra* note 188 (discussing the irony of the *Moseley* majority opinion).

<sup>203</sup> See *supra* Part I.

uses are not prurient in nature—rather, they seek to express core identity.<sup>204</sup> Decisions like *Gay Olympics* and *Pink Panther Patrol*, however, have seemingly conflated “sexual orientation” with unwholesomeness or unseemliness.<sup>205</sup> This is inherently problematic, because, Part II.C demonstrates, there is a lot at stake in this arena.<sup>206</sup> When such recoders receive cease-and-desist letters, they may capitulate and self-censor their speech, even when it is legally unobjectionable.

### B. Colorful Illustrations of the Cease-and-Desist Conundrum

Justin Watt and the Courage Campaign, our protagonists from the introduction, are certainly not alone in their struggles with trademark owners less than amused by reinterpretations of their marks. The following are anecdotes of expressions of sexuality or sexually connotative uses that trademark owners have sought to silence.

#### 1. Archie Grows Up, Comes Out, and Archie Comics Doesn't Like It

In April 2003, an Atlanta-based theatre group, Dad's Garage Theatre, received a cease-and-desist letter claiming that the play it was about to open, “Archie's Weird Fantasy,” infringed on the copyrights and trademarks Archie Comics held in its characters.<sup>207</sup> The play portrayed Archie and his pals “growing up, coming out and facing censorship.”<sup>208</sup> According to the play's artistic director, Sean Daniels, “Archie Comics thought if Archie was portrayed as being gay, that would dilute and tarnish his image.”<sup>209</sup> The letter further pointed out seven alleged copyright infringements in the script that would each cost \$150,000 in damages.<sup>210</sup> Concerned that the play would not qualify under a parody exception to federal

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<sup>204</sup> See *infra* Part II.C.

<sup>205</sup> See *supra* Part I.B.2.

<sup>206</sup> See *infra* Part II.C.

<sup>207</sup> Curt Holman, *Fallen Archies: Dad's Garage Told to Cease and Desist Archie Satire*, CREATIVE LOAFING (Apr. 9, 2003), <http://atlanta.creativeloafing.com/gyrobase/Content?oid=oid:11826>.

<sup>208</sup> *Id.*

<sup>209</sup> *Id.*

<sup>210</sup> *Id.*



copyright and trademark law, Daniels decided to change the title of the play to “Weird Comic Book Fantasy.”<sup>211</sup> However, the play’s author, Roberto Aguirre-Sacasa, apparently did not cede further ground to Archie Comics, and his tenacity paid off—in 2005, the play, re-dubbed “The Golden Age” premiered on a New York stage and garnered a favorable *New York Times* review.<sup>212</sup>

As this example illustrates, this referencing of the Archie characters had no salacious content nor any malicious intent. Rather, it was one author’s recoding of cultural icons. Archie Comics took exception to this recoding not because of any confusion-based rationale, but rather on the grounds that a gay reinvention of Archie would ruin the comic book character’s cherished (heterosexual) image. Had Archie Comics succeeded in suppressing this speech, though, it would have done so on perhaps purely erroneous dilution grounds—the use clearly would have fallen under MCA’s rubric of noncommercial speech, as it does much more than propose a commercial transaction. It would thus qualify for a statutory exemption under dilution law.<sup>213</sup>

## 2. DC Comics Puts a Damper on Batman and Robin’s Relationship

DC Comics, owner of the trademark rights to Batman and Robin, was not amused when it discovered artist Mark Chamberlain’s conceptualization of Batman and Robin’s relationship in August of 2005.<sup>214</sup> Chamberlain’s paintings showed Batman and Robin in various stages of undress and in amorous embraces.<sup>215</sup> DC Comics sent a cease-and-desist letter to the owner of the gallery where the works were on display.<sup>216</sup> Not

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<sup>211</sup> *Comic Book Legends Revealed #192*, CBR, <http://goodcomics.comicbookresources.com/2009/01/29/comic-book-legends-revealed-192> (last visited Apr. 20, 2010).

<sup>212</sup> *Id.*; see also Neil Genzlinger, *A Family Just Like Archie, Jughead and Their Pals*, N.Y. TIMES, Apr. 9, 2005, at B15, available at [http://theater.nytimes.com/2005/04/09/theater/reviews/09krai.html?\\_r=2&scp=2&sq=archie%20jughead&st=cse](http://theater.nytimes.com/2005/04/09/theater/reviews/09krai.html?_r=2&scp=2&sq=archie%20jughead&st=cse).

<sup>213</sup> See *supra* note 57 and accompanying text; Part I.B.3–4.

<sup>214</sup> See *Gallery Told to Drop “Gay” Batman*, BBC NEWS, Aug. 19, 2005, <http://news.bbc.co.uk/2/hi/entertainment/4167032.stm>.

<sup>215</sup> To access images of these paintings, see *Mark Chamberlain*, ARTNET, <http://www.artnet.com/artist/424157172/mark-chamberlain.html> (last visited Apr. 19, 2010).

<sup>216</sup> *Artnet News*, ARTNET (Aug. 18, 2005), <http://www.artnet.com/magazineus/news/artnetnews/artnetnews8-18-05.asp>.

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only did it seek to stop the exhibition, it also demanded that the owner of the gallery “hand over all unsold work.”<sup>217</sup> It is very likely that DC Comics was not just asserting its trademark and copyright rights in sending the letter; tarnishment of Batman’s virile heterosexual image was no doubt at issue here. As the images are still available on Artnet’s site,<sup>218</sup> it seems that Chamberlain did not fully accede to DC Comics’ demands. Nonetheless, this example is distressing because DC Comics not only sought to prevent public display of Chamberlain’s artistic speech, it also sought to confiscate the artist’s physical property. Most importantly, the trademark basis for those asserted rights was weak at best because Chamberlain had used the iconic characters in an expressive work that was not purely, if at all, commercial.

### 3. Honorable Mention: Other Cease-and-Desist Tarnishment Highlights

Another notable example of cease-and-desist “gorilla-chest thumping”<sup>219</sup> occurred in 2008 when counsel for the United States Olympic Committee sent a letter to a gay mens group, the “Northwest Bears,” who had used the name Kamp Kodiak 2008 “Olympic Village” for its annual summer campout.<sup>220</sup> As noted in USOC’s letter, the Amateur Sports Act allows the Olympic Committee to preempt any commercial uses of its mark that it has not licensed.<sup>221</sup> The Northwest Bears event, however, was a noncommercial, not-for-profit gathering,<sup>222</sup> which, even under the *Gay Olympics* case, might not have fallen under the Amateur

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<sup>217</sup> *Gallery Told to Drop “Gay” Batman*, *supra* note 214.

<sup>218</sup> *See Mark Chamberlain*, *supra* note 215.

<sup>219</sup> McGeeveran, *Rethinking*, *supra* note 31, at 64 (quoting *Frequently Asked Questions*, CHILLING EFFECTS CLEARINGHOUSE, <http://www.chillingeffects.org/question.cgi?QuestionID=250> (last visited Apr. 19, 2010)).

<sup>220</sup> Meegbear, *U.S. Olympic Committee Targets the Northwest’s Large, Hairy Gay Men*, DEMOCRATIC UNDERGROUND.COM (July 24, 2008, 8:20 AM), [http://www.democraticunderground.com/discuss/duboard.php?az=view\\_all&address=221x80234](http://www.democraticunderground.com/discuss/duboard.php?az=view_all&address=221x80234) (displaying correspondence with Carol Gross from the United States Olympic Committee).

<sup>221</sup> *Id.*; see 36 U.S.C. § 220506 (2006).

<sup>222</sup> Meegbear, *supra* note 220.

Sports Act's prohibitions.<sup>223</sup> Nonetheless, the Northwest Bears capitulated, though one member noted that he was from the *Olympic Peninsula* of Washington State and many organizations from his home region used the term "Olympic."<sup>224</sup> Thus, USOC succeeded in silencing speech that was noncommercial and referenced not only the Olympic Games, but also the Northwest Bears' geographic home.

Cease-and-desist letters are also common in the fan fiction arena.<sup>225</sup> Fan fiction involves the "widespread and active appropriation of given texts, plots, and characters" in which fans "recontextualize" and expand upon films, TV shows, and fiction.<sup>226</sup> Often these recontextualizations involve "graphic sexual activity."<sup>227</sup> Fan fiction works, while often posted on the Internet, are not written for profit,<sup>228</sup> but the fact that they have no pecuniary benefit has not stopped trademark and copyright holders from objecting, often on tarnishment grounds.<sup>229</sup> The Chilling Effects Clearinghouse features one such cease-and-desist letter sent to a Harry Potter fan fiction writer.<sup>230</sup> The letter, sent by J.K. Rowling's attorneys in London, expresses concern over the "integrity" of Rowling's intellectual property rights in Harry Potter and scolds the recipient for making such "sexually explicit"

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<sup>223</sup> See *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 537 n.15 (1987) ("[T]he extent to which the Act may be read to apply to noncommercial speech is limited.").

<sup>224</sup> Meegbear, *supra* note 220.

<sup>225</sup> A detailed analysis of the legal and sociological intricacies of fan fiction are beyond the scope of this paper. For a more detailed analysis, see generally COOMBE, *supra* note 23, at 117–29; Katyal, *supra* note 109; Rebecca Tushnet, *Copyright, Fan Fiction, and a New Common Law*, 17 *LOY. L.A. ENT. L.J.* 651 (1997).

<sup>226</sup> Katyal, *supra* note 109, at 483.

<sup>227</sup> See *id.* at 483–89 (describing "slash" fiction).

<sup>228</sup> See COOMBE, *supra* note 23, at 118.

<sup>229</sup> See Christopher Noxon, *When Harry Met Smutty*, *METRO* (June 26–July 2, 2003), <http://www.metroactive.com/papers/metro/06.26.03/potter-0326.html>. Furthermore, Professor Sonia Katyal highlights that in the slash fan fiction cease-and-desist arena, where content involves same-sex relationships, another difficulty that arises is that "it is hard to separate out whether the objectionable content is considered to be problematic because of its graphic sexual content or because of the same-sex narrative that it offers." Katyal, *supra* note 109, at 513.

<sup>230</sup> See *Harry Potter Adult Fan Fiction*, CHILLING EFFECTS CLEARINGHOUSE, <http://www.chillingeffects.org/fanfic/notice.cgi?NoticeID=534> (last visited Apr. 19, 2010).

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material available for all to see on his website. While Rowling's counsel deems the work "sexually explicit," it is important to note that there was no judicial determination that it was obscene, nor that it was done for a purely commercial purpose. Rather, Rowling seems to be the ultimate arbiter here in what is legally objectionable in the fan fiction work.

*C. Why the Stakes Are High in Cease-and-Desist Scenarios*

The stakes are high for people seeking to recode, parody, or simply reference parts of marks in noncommercial speech. If they do not cease their allegedly infringing/diluting behavior, they risk an extended court battle. And if they accede to the demands of the mark holder, they allow speech to be chilled, "even when the complained-of expressive uses are almost certainly legal under the substance of current legal doctrine."<sup>231</sup> As Professor McGeeveran emphasizes, "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 capitulate."<sup>232</sup> Admittedly, it is difficult to calculate the ratio of speech silenced to cease-and-desist letters sent each year.<sup>233</sup> Scholars, however, agree that fear of litigation is a formidable chilling agent against speech.<sup>234</sup> This is problematic in several major ways: one, speech is chilled for marginalized groups who seek to use trademarks in expressive ways; two, existing constitutional, statutory, and judge-made safeguards are too malleable and unpredictable to protect recoders *ex ante*; and three, cease-and-desist letters act as a form of prior restraint that restricts speech before it can even get to the courthouse.

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<sup>231</sup> McGeeveran, *Rethinking*, *supra* note 31, at 64.

<sup>232</sup> McGeeveran, *Four Free Speech Goals*, *supra* note 197, at 1206–07; *see also* Beebe, *supra* note 30, at 458 n.36.

<sup>233</sup> *See* William E. Ridgway, Note, *Revitalizing the Doctrine of Trademark Misuse*, 21 *BERKELEY TECH. L.J.* 1547, 1577 (2006) (noting that an accurate assessment of all cease-and-desist claims is difficult, as individuals "likely [to] know their legal rights better than the average internet user" are the ones posting cease-and-desist letters to the Chilling Effects Clearinghouse).

<sup>234</sup> *See, e.g.*, McGeeveran, *Rethinking*, *supra* note 31, at 52; Ramsay, *supra* note 29, at 405.

### 1. How Cease-and-Desist Letters Silence Marginalized Recoders

One concern regarding the increasing pervasiveness of cease-and-desist letters, especially in the context of marks referencing sexual orientation, is the ability to silence marginalized groups. As Rosemary Coombe expresses, individuals use trademark logos and other media imagery to “creat[e] new meanings for [the trademarks] by putting them in new contexts or juxtaposing them with other texts that convey[] hidden subtexts.”<sup>235</sup> This is important, sociologically speaking, because individuals in our society benefit from a dialogic relationship with culture.<sup>236</sup> Coombe emphasizes:

If what is quintessentially human is the capacity to make meaning, challenge meaning, and transform meaning, then we strip ourselves of our humanity through overzealous application and continuous expansion of intellectual property protections. Dialogue involves reciprocity in communication: the ability to respond to a sign with signs. What meaning does dialogue have when we are bombarded with messages to which we cannot respond, signs and images whose significations cannot be challenged, and connotations we cannot contest?<sup>237</sup>

Marginalized groups use trademarks expressively to engage in this dialogue and “in their struggles for recognition and voice.”<sup>238</sup> As the discussion *supra* Part I of the *Gay Olympics* case and *Pink Panther Patrol* indicates,<sup>239</sup> the defendants in those cases sought to use the trademarks at issue to empower gay men and women and to challenge their status as a marginalized group. SFAA and the Pink Panther Patrol both sought to use language to invoke positive images of themselves. Allowing tarnishment rationales to block such uses contravened basic First Amendment principles: “This

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<sup>235</sup> COOMBE, *supra* note 23, at 73.

<sup>236</sup> *See id.* at 82–87.

<sup>237</sup> *Id.* at 84–85.

<sup>238</sup> *Id.* at 130.

<sup>239</sup> *See supra* Part I.B.2.

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type of political advocacy on behalf of an unpopular minority has long been at the core of the [F]irst [A]mendment's protections."<sup>240</sup> Groups like SFAA and the Courage Campaign are asserting important political views implicating individual rights and liberties; as such, trademark law should not unduly censor such speech. Indeed, it seems perverse that a brand image would take priority over a group's desire and need to express itself and to engage in political speech.

Even worse, in the cease-and-desist context, such speech often never gets to the point of formal adjudication. Even though the examples illustrated above of Justin Watt, the Courage Campaign, and "Archie's Weird Fantasy" indicate that speakers sometimes do fight back against trademark owners, these examples are the outliers. This is because speakers lack the legal know-how and funds to pursue their claims more fully.<sup>241</sup> A more likely scenario is that of the Northwest Bears, who simply sought to use the word "Olympic" as the name for an annual not-for-profit social gathering; they were firmly rebuked for doing so and then capitulated to the USOC's demands.<sup>242</sup> Given the pervasiveness of cease-and-desist letters, it is likely that those who seek to imbue brands with their own interpretations in art, music, literature, and film may simply not do so for fear of an imminent cease-and-desist letter.

## 2. Malleable Doctrinal Safeguards Create Uncertainty

As this Note has examined *supra* Part I, case law has become increasingly more favorable to defendants in tarnishment causes of action.<sup>243</sup> At the same time, the doctrinal, statutory, and constitutional protections that defendants may rely on are,

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<sup>240</sup> Kravitz, *supra* note 75, at 179.

<sup>241</sup> See *infra* Part II.B.3.

<sup>242</sup> See *supra* Part II.A.3.

<sup>243</sup> See *supra* Part I.B. In 2010, however, it seems that dilution law, including tarnishment, may be enjoying a resurgence in the courts. See, e.g., *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382 (6th Cir. 2010); *supra* notes 178, 188.

nonetheless, often malleable and unpredictable.<sup>244</sup> As a result, would-be defendants may become risk-averse and self-censor.<sup>245</sup>

Take parody. Parody is ostensibly protected under the TRDA.<sup>246</sup> But ever since *Campbell v. Acuff-Rose Music, Inc.*'s<sup>247</sup> distinction between parody and satire,<sup>248</sup> what constitutes parody has been the subject of much debate.<sup>249</sup> As Bruce Keller and Rebecca Tushnet note, "'parody' is just as subject to manipulation by clever parties or courts in trademark as in copyright."<sup>250</sup> Indeed, often the successfulness of the parody turns on whether the judge and jury get the joke,<sup>251</sup> which can depend on certain socio-economic and/or cultural differences between judges and recoders.<sup>252</sup> Such contingencies do not offer strong assurances to the recipient of a cease-and-desist letter that her use is a protected one.

Furthermore, the language of the TDRA's exemptions itself does not provide protections on which would-be recoders can

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<sup>244</sup> This section briefly examines problems with the "protections" of the TDRA; it does not purport to exhaust the subject.

<sup>245</sup> See McGeeveran, *Rethinking*, *supra* note 31, at 111.

<sup>246</sup> See 15 U.S.C. § 1125(c)(3) (2006).

<sup>247</sup> 510 U.S. 569 (1994). Although *Campbell* is a copyright case, it has become common for courts to use its parody guidelines in trademark disputes. See, e.g., *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 901 (9th Cir. 2002).

<sup>248</sup> See *Campbell*, 510 U.S. at 580–81 ("Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim's (or collective victims') imagination, whereas satire can stand on its own two feet and so requires justification for the very act of borrowing.").

<sup>249</sup> See, e.g., Keller & Tushnet, *supra* note 155, at 979 ("[T]he distinction between parody and satire is too fine for courts (not generally recognized as great connoisseurs of humor) to make."); *id.* at 990 ("[T]he distinction between parody and satire is in the eye of the presiding judge.").

<sup>250</sup> *Id.* at 1002–03.

<sup>251</sup> See, e.g., Gulasekaram, *supra* note 95, at 911.

<sup>252</sup> See Assaf, *supra* note 134, at 70 ("As the cases above show, it is hard to predict which expressions will be protected as parodies and which will be regarded as a pointless tarnishment. Apart from legal uncertainty, this issue also has anti-democratic effects on cultural discourse. The reason why some expressions do not amuse certain judges—but seem vulgar, tasteless or depraved to them—is that the judges belong to a different social group than the target audience of such expressions. Courts exert what Pierre Bourdieu calls 'symbolic violence' by privileging the speech that appeals to them. Judges, belonging to the cultural elite, silence the voices of other classes by condemning their aesthetic judgments." (footnote omitted)).

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comfortably rely. The TDRA “needlessly muddies the law’s clarity”<sup>253</sup> by only exempting uses “‘other than as a designation of source.’”<sup>254</sup> Like parody, this standard is subject to manipulation by parties and judges. For example, in the parody at issue in the Courage Campaign’s dispute with ProtectMarriage.com, ProtectMarriage.com would argue that the Courage Campaign used the altered ProtectMarriage logo *as a trademark* to denote source, and thus its use could not be protected under the TDRA’s parody exemption. The Courage Campaign, in turn, would argue that the use at issue was not a designation of source; rather, it was a deliberate political message completely unrelated to commercial concerns. While the Courage Campaign could have a solid argument, once again, the interpretation of this provision is too unpredictable to afford much certainty, even for the most sophisticated of parties.

An overarching concern when considering the malleability of doctrinal protections is that the exemptions rely on judges’ and juries’ sensibilities and their notions of propriety. As Professor Ramsay underscores

If the plaintiff’s mark is a well-known brand and the defendant is sleazy or the message incorporating the mark is distasteful, the judge or jury may rule for the plaintiff despite its speech-harmful trademark claims. For example, courts punished and enjoined further use of the Dallas Cowboys Cheerleader’s trademarked outfits in a pornographic film and use of the Coca-Cola marks and logos in a poster with the phrase “Enjoy Cocaine.” A fact-finder may deem a certain trademark distinctive or a certain use of a trademark confusing, diluting, or commercial because he or she dislikes the defendant or its expression.<sup>255</sup>

Thus, inevitably, standards like these “invite judges and juries to evaluate the content of the speech, and . . . the vagueness of the

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<sup>253</sup> McGeeveran, *Rethinking*, *supra* note 31, at 107.

<sup>254</sup> *Id.* (quoting 15 U.S.C. § 1125(c)(3) (2006)).

<sup>255</sup> Ramsay, *supra* note 29, at 449.



rules may cause even well-intentioned factfinders to be subconsciously swayed by the viewpoint and subject matter of the speech.”<sup>256</sup> Moreover, the case law, while increasingly more favorable to expressive uses of all stripes, still evinces contradictions regarding what uses are legally objectionable and what are not.<sup>257</sup> Ultimately, one must ask what good constitutional, statutory, and case law protections are when they are dependent, above all, on subjective notions of propriety and personal taste.

### 3. Cease-and-Desists: A Private Action Prior Restraint?

It is clear, then, that the threat of a looming cease-and-desist letter often chills speech and that existing doctrinal protections do not lessen this chilling effect. From a legal perspective, this chilling effect is especially problematic because a cease-and-desist letter acts as the private action equivalent of a prior restraint. Under established First Amendment jurisprudence, prior restraints are disfavored by judges and are presumptively invalid.<sup>258</sup>

A comparison of cease-and-desist letters and preliminary injunctions is instructive in this context. In examining the problematic relationship between preliminary injunctions in intellectual property cases and prior restraints, Professors Mark Lemley and Eugene Volokh emphasize that “preliminary injunctions restraining speech are generally considered unconstitutional ‘prior restraints.’”<sup>259</sup> They further note that although libel and obscenity law are “constitutionally valid restrictions on speech . . . courts refuse to allow preliminary injunctions there.”<sup>260</sup> This is because courts must make a final determination as to whether allegedly libelous or obscene speech is

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<sup>256</sup> Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After Eldred, 44 Liquormart, and Bartnicki*, 40 HOUS. L. REV. 697, 710 (2003). Volokh argues that intellectual property rules are thus content-based, and should be treated as such. *Id.*

<sup>257</sup> See Gulasekaram, *supra* note 95, at 914 (comparing the outcomes in *L.L. Bean, Milky Way Productions*, and *Dallas Cowboys Cheerleaders*).

<sup>258</sup> See *Near v. Minnesota*, 283 U.S. 697 (1931).

<sup>259</sup> Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 169 (1998).

<sup>260</sup> *Id.* at 150.

constitutionally protected.<sup>261</sup> Lemley and Volokh then question the propriety of allowing such restraints in intellectual property cases. For example, in the trademark context, plaintiffs may obtain preliminary injunctions before a “court can make a full determination on the merits that the speech is infringing.”<sup>262</sup> While Lemley and Volokh generally maintain that prior restraints against commercial speech that will likely lead to consumer confusion are appropriate, they caution that “a preliminary injunction against [noncommercial] speech seems to . . . be an unlawful prior restraint.”<sup>263</sup> They emphasize that “[o]ne certainly couldn’t get a preliminary injunction against the publication of a book on the grounds that the contents of the book might eventually be demonstrated at trial to be false or even libelous and therefore constitutionally unprotected.”<sup>264</sup> Similarly, trademark cases are “highly fact-specific [in] nature,” which highlights the importance of a full trial on the merits of the case.<sup>265</sup> Courts simply do not provide this level of inquiry at the preliminary injunction phase. Thus, Lemley and Volokh’s analysis underscores that allowing prior restraints in the form of preliminary injunctions in dilution cases is incongruous with the greater solicitude that courts give to speech in libel and obscenity cases.

By extension, the restraints that cease-and-desist letters place on speech are even more concerning especially when “the complained-of expressive uses are almost certainly legal under the substance of current legal doctrine.”<sup>266</sup> With cease-and-desist letters, there are no substantive or procedural protections at all whatsoever, unlike in a judicial determination for a preliminary injunction, where a court must generally determine “(1) a combination of probable success on the merits and the possibility of irreparable harm, or (2) that there exist serious questions regarding the merits and the balance of hardships that tip in

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<sup>261</sup> *See id.* at 180.

<sup>262</sup> *Id.* at 222.

<sup>263</sup> *Id.* at 224.

<sup>264</sup> *Id.* at 222.

<sup>265</sup> *Id.*

<sup>266</sup> McGeveran, *Rethinking*, *supra* note 31, at 64.

[plaintiff's] favor.”<sup>267</sup> Thus, even judicial determinations of preliminary injunctions, themselves inherently problematic as prior restraints, afford more speech protection than cease-and-desist letters do.

Because they act as private action prior restraints, cease-and-desist letters can even be problematic in the context of sexually explicit uses of a trademark (for example, when a trademark is used in a pornographic film, as in *Dallas Cowboys Cheerleaders*<sup>268</sup> and *Media Market Group*).<sup>269</sup> A comparison to obscenity law is instructive here. As Lemley and Volokh emphasize, the Supreme Court has held that prior restraints on films not “‘finally adjudicated to be obscene’” were unconstitutional.<sup>270</sup> It is troubling, therefore, that sexually explicit uses of a trademark are subject to much less protection in the pre-litigation and preliminary injunction context than allegedly obscene materials are.<sup>271</sup> In this way, cease-and-desist letters can circumvent not only dilution requirements under the TDRA, but also entrenched First Amendment principles.

#### 4. Other Impediments Associated with the Cease-and-Desist Letter

Not only do cease-and-desist letters often run contrary to established legal principles, they also rely on a likelihood that the recipient will be unsophisticated and lack the monetary resources necessary to mount a defense. For this reason, scholars liken such behavior to “trademark extortion.”<sup>272</sup> First, trademark owners rely

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<sup>267</sup> *Lucasfilm, Ltd. v. Media Mkt. Group, Ltd.*, 182 F. Supp. 2d 897, 899 (N.D. Cal. 2002). Of course, the various circuits vary in their requirements for a preliminary injunction, but *Media Market Group* is an illustrative example.

<sup>268</sup> See discussion *supra* Part I.B.1.

<sup>269</sup> See discussion *supra* Part I.B.3.

<sup>270</sup> Lemley & Volokh, *supra* note 259, at 173 (quoting *Vance v. Universal Amusement*, 445 U.S. 308 (1981)).

<sup>271</sup> See Kravitz, *supra* note 75, at 150–51 (“This decision to enjoin showings of [*Debbie Does Dallas*] to protect the plaintiff’s reputational interest in its trademark cannot be reconciled with [F]irst [A]mendment principles. There was no finding that the defendant’s film was obscene under [F]irst [A]mendment standards.”).

<sup>272</sup> See Kenneth L. Port, *Trademark Extortion: The End of Trademark Law*, 65 WASH. & LEE L. REV. 585, 589 (2008); see also McGeeveran, *Rethinking*, *supra* note 31, at 64 (quoting Port, *supra*, at 585).

on the fact that people making expressive uses of trademarks lack an understanding of the nuances of trademark law.<sup>273</sup> Thus, the mark owners likely presume, in the face of uncertain legal standards and doctrines, recipients will accede to a cease-and-desist letter rather than taking their chances in court.<sup>274</sup> Because markholders especially target uses that reference sexuality or are sexually explicit, they may believe that the lack of clarity in tarnishment law could be a sufficient deterrent in and of itself.

Second, it is likely that the cost of litigation will be daunting for the recipient of a cease-and-desist letter, and this will lead him or her to “settle the case and self-censor . . . speech rather than fight in court for the right to use particular language.”<sup>275</sup> Furthermore, those who do find representation are few and far between.<sup>276</sup> The defendant in *Walking Mountain Productions*, Thomas Forsythe, for example, spent “five months searching for legal representation,” and during that time, a “long list of attorneys suggested that [he] just give up, since [he] hadn’t made any money anyway.”<sup>277</sup> Eventually, the ACLU and a California firm agreed to represent him, but when all was said and done, his overall defense “topped two million dollars.”<sup>278</sup> Pro bono

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<sup>273</sup> See McGeveran, *Rethinking*, *supra* note 31, at 111 (“The more serious impact emerges earlier, before any suit is filed, when the chilling effects occur. Imagine an average person—not a lawyer—who is contemplating an unlicensed expressive use of a trademark and understandably worries about liability. The person asks an attorney for advice. The bottom line of the response should be that courts usually favor expressive uses. But, it will need to be accompanied by a lengthy memo, full of caveats, which cites in the alternative to a series of amorphous precedents, warns that those cases are all fact-specific, and predicts that litigation may be protracted. This response might not inspire great confidence.”); see also COOMBE, *supra* note 23, at 78 (“Faced with the threat of litigation, most local parodists, political activists, and satirical bootleggers will cease their activities.”).

<sup>274</sup> See COOMBE, *supra* note 23, at 78.

<sup>275</sup> Ramsay, *supra* note 29, at 405; see also McGeveran, *Four Free Speech Goals*, *supra* note 197, at 1220 (“Cost is especially important because many cease-and-desist letters from well-financed markholders target isolated individuals using trademarks expressively.”).

<sup>276</sup> See, e.g., McGeveran, *Four Free Speech Goals*, *supra* note 197, at 1221.

<sup>277</sup> *Id.*

<sup>278</sup> *Id.*

representation for people like Thomas Forsythe and Justin Watt is the exception, not the rule.<sup>279</sup>

*D. Are Cease-and-Desist Letters a Replacement for a Lawsuit?*

Perhaps the most disturbing trend regarding cease-and-desist letters is that they may prove more efficacious than lawsuits. As indicated above, the frequency of filed and litigated dilution lawsuits has dwindled since 1996.<sup>280</sup> Overall “[t]rademark litigation has seen a precipitous drop since 2001.”<sup>281</sup> At the same time, however, “the number of initial claims of trademark infringement filed per year is increasing.”<sup>282</sup> Moreover, “[a]s the number of cases initially filed continues to go up, the percentage of cases that reach a trial on the merits, the total number of cases reported, the total amount of damages, and the total number of cases where an injunction is demanded are all decreasing.”<sup>283</sup> According to Professor Port, one explanation for these figures is trademark extortion: “[Trademark owners] file suit with no intent to prosecute it to a conclusion on the merits. Therefore, the number of cases initially filed increases, but the number of cases that reach a trial on the merits remains constant and all other indicators decline.”<sup>284</sup>

These numbers may be instructive in the cease-and-desist context as applied to tarnishment and other forms of action. If trademark owners are increasingly filing weak lawsuits as a form

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<sup>279</sup> See also *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302 (2008) (defendant parodist of Wal-Mart’s mark was represented by Paul Alan Levy at Public Citizen, a nonprofit consumer advocacy group).

<sup>280</sup> See *supra* Part I.B.5; see also Port, *supra* note 272, at 626 (“It may have been pent up demand or the novelty of the dilution cause of action that caused the larger numbers of dilution claims in the late 1990s, but there has been a general downward trend in dilution cases for eight of the ten years for which there is data.”). *But see supra* notes 178, 188, 243.

<sup>281</sup> Port, *supra* note 272, at 622.

<sup>282</sup> *Id.*

<sup>283</sup> *Id.* at 633. For example, in 1995, 2595 infringement claims were filed, *id.* at 618 (graph L), and 60 claims reached a trial on the merits, for a total percentage of 2.3% of all claims. *Id.* at 619 (graph N). In 2005, however, 3636 claims were filed, *id.* at 618 (graph L), but only 51 claims reach a trial on the merits, for a total percentage of 1.43% of all claims. *Id.* at 619 (graph N).

<sup>284</sup> *Id.* at 633.

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of extortion to silence speech, they are probably also wielding a more potent and unregulated weapon in their arsenal even more frequently—the cease-and-desist letter.<sup>285</sup> Indeed, the cease-and-desist letter is quicker and cheaper than filing a trademark suit, and it is more efficacious.

Thus, as these figures suggest and the analyses above indicate, there is much to be concerned about in the realm of pre-litigation cease-and-desist letters. The following section will examine the routes courts and legislators should consider in curbing potentially abusive behavior.

### III. REMEDIES: DOCTRINAL AND PROCEDURAL

As the previous sections have demonstrated, tarnishment law has played an increasingly smaller role in the courts, but may still be thriving in pre-litigation maneuvers. At the same time, the recipients of cease-and-desist letters are at a disadvantage: they have less money to litigate than behemoth trademark owners do and are less knowledgeable about permissible uses of a trademark. On the one hand, honing tarnishment's substantive law may create greater certainty for those familiar with trademark law. A clarification in the law could delineate what kinds of sexually explicit material are tarnishing and what are not. There is no guarantee, however, that the average cease-and-desist recipient will understand or have access to these clarified standards,<sup>286</sup> nor that trademark owners will heed newly defined contours of tarnishment law.<sup>287</sup> Thus, while doctrinal adjustments are useful, procedural mechanisms that punish and deter overreaching by trademark holders are necessary ingredients to protect trademark recoders. This Part will examine some recent proposals to improve dilution law's substantive standards, as well as trademark law's

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<sup>285</sup> *See id.* at 589 (“[S]ome trademark holders send thousands of cease-and-desist letters to the point that there are now ‘sample’ cease-and-desist letters available on the internet. These cease-and-desist letters are followed by hundreds of trademark infringement filings. These cases are almost never prosecuted to a conclusion on the merits.” (footnotes omitted)).

<sup>286</sup> *See supra* notes 272–74 and accompanying text.

<sup>287</sup> *See infra* Part III.A–B.

procedural mechanisms.<sup>288</sup> Moreover, it will suggest that tarnishment may have outlived its usefulness and that other areas of the law could provide better protection for brands while being solicitous of speech concerns with respect to sex and sexuality.

#### A. *Doctrinal Adjustments*

##### 1. Clarify the Exemptions in the TDRA

Perhaps the best place to start in terms of doctrinal clarifications is with the language of the TDRA. As discussed *supra* in Part I, the TDRA exempts fair uses of a mark “other than as a designation of source for the person’s own goods or services” which includes parody, criticism of, or commentary on a mark.<sup>289</sup> It also exempts “any noncommercial use.”<sup>290</sup> This creates a redundancy in the statute, as Professor McGeeveran expresses: parody, comment, and critique all seem to fall under the rubric of “noncommercial use.”<sup>291</sup> McGeeveran’s solution to this issue is simple—he

propose[s] that Judge Kozinski’s broad interpretation of the noncommercial use exemption from dilution liability should remain in force, either as a matter of consistent interpretation and constitutional avoidance or, if necessary, through amendment of the statute. Any expressive use that does more than “propose a commercial transaction” should be immune from dilution liability, regardless of any other considerations. Because there is no reason to limit this rule to federal dilution claims, courts should apply it to state claims as well.<sup>292</sup>

At first blush, McGeeveran’s proposal is a clear, administrable one, and it could help protect the interests of people who seek to expressively recode trademarks by referencing sexuality or

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<sup>288</sup> Note that this is just a sampling of attractive options. A more fulsome examination of *all* options is beyond the scope of this paper.

<sup>289</sup> 15 U.S.C. § 1125(c)(3) (2006).

<sup>290</sup> *Id.*

<sup>291</sup> See McGeeveran, *Rethinking*, *supra* note 31, at 108–09.

<sup>292</sup> *Id.* at 116.

sexuality suggestive content. At the same time, though, perhaps McGeeveran's proposal could run into the same difficulties faced by courts currently deciding dilution actions—how exactly does one define speech that “does more than ‘propose a commercial transaction’”? Should this definition parallel analyses on broader First Amendment jurisprudence?<sup>293</sup> Is this proposed exemption so broad that it swallows the rule? Thus, though it seems to be a clear rule *ex ante*, its contours still contain ambiguity that either the courts or legislative action would need to dispel.

## 2. Align the Contours of Tarnishment with Obscenity Law?

In addition to a clarification of statutory exemptions, tarnishment law could benefit from a clearer definition of what uses are likely to tarnish a mark. As discussed in Part I.B.3 *supra*, after the enactment of the FTDA in 1995, courts continued to rely on pre-FTDA language defining tarnishing uses.<sup>294</sup> To wit: “a trademark may be tarnished when it is ‘. . . portrayed in an *unwholesome or unsavory* context,’ with the result that ‘the public will associate the lack of quality or lack of prestige in the defendant’s goods with the plaintiff’s unrelated goods.’”<sup>295</sup> To courts, “unwholesome or unsavory” was (and sometimes still is) synonymous with “sexual activity [or] obscenity.”<sup>296</sup> This language was too simplistic and helped lead some courts to make incorrect assessments of tarnishing uses. Indeed, as one commentator has noted, subject-matter based assessments of tarnishment are

untenable for two related reasons: (1) courts are not competent to make value judgments regarding the

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<sup>293</sup> See, e.g., *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983) (holding that unsolicited mailings are entitled to First Amendment protection as commercial speech).

<sup>294</sup> See *supra* Part I.B.3.

<sup>295</sup> *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 507 (2d Cir. 1996) (emphasis added) (quoting *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 43 (2d Cir. 1994)).

<sup>296</sup> See *id.* (citations omitted); see also *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 389 (6th Cir. 2010) (“Thus, any new mark with a lewd or offensive-to-some sexual association raises a strong inference of tarnishment. The inference must be overcome by evidence that rebuts the probability that some consumers will find the new mark both offensive and harmful to the reputation and the favorable symbolism of the famous mark.”).



worth of different types of speech; and (2) courts will encounter a line-drawing problem, already evident in the case law. The inherent problem with singling out cases for tarnishment liability based on the wholesomeness of their respective associations—for example, illegal drugs or pornography—is that courts are essentially permitted to make value judgments regarding the worthiness of specific types of speech. An artist’s or commentator’s legal rights should not depend on whether an individual judge “gets” the humorist’s joke or the critic’s jab.<sup>297</sup>

For example, in *American Dairy Queen Corp. v. New Line Productions, Inc.*,<sup>298</sup> the district court granted an injunction against the use of the title “Dairy Queens” for an off-color comedy about beauty pageants on both infringement and tarnishment grounds.<sup>299</sup> Invoking the *Dallas Cowboys Cheerleaders* “alternative avenues” test, the court ruled that the movie title was a commercial use, and that it could have sought other ways to convey its message.<sup>300</sup> It then proceeded to find a likelihood of dilution by tarnishment of the plaintiff’s “Dairy Queen” mark.<sup>301</sup> According to the court, the film’s objectionable material included “backbiting and jealousy,” “eating disorders,” and “off-color humor.”<sup>302</sup> Certainly this was a broad interpretation of what could “tarnish” a mark; it seems that any humor that was not squeaky-clean could have passed muster under the court’s assessment. The district court in *American Dairy Queen* thus broadened the scope of tarnishment to any unwanted connotations of a mark.

In the context of sexuality, *if* tarnishment has a substantive component, it should be no broader than truly obscene material under *Miller v. California*’s<sup>303</sup> standards, and it should accord with

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<sup>297</sup> Gulasekaram, *supra* note 95, at 911.

<sup>298</sup> 35 F. Supp. 2d 727 (D. Minn. 1998).

<sup>299</sup> *Id.* at 735.

<sup>300</sup> *Id.* at 732. This decision could also have benefited from a more liberal Kozinski-esque conceptualization of “noncommercial use.”

<sup>301</sup> *Id.* at 733.

<sup>302</sup> *Id.* at 729.

<sup>303</sup> 413 U.S. 15 (1973). The *Miller* obscenity test is as follows:

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the noncommercial use exemption in the TDRA. This approach could help assuage trademark holders' understandable fears about truly disgusting *commercial* uses of their mark, without reaching expression that is merely off-color or even slightly offensive. Thus, commercial pornographic uses with no possible redeeming artistic virtues could be reached under such a standard. One caveat to this approach is that the noncommercial use exemption could not be so broad so as to encompass all obscene uses. Noncommercial use and Judge Kozinki's "noncommercial speech" formulation would require some line-drawing in order to appease legitimate trademark-holder concerns about truly denigrating and obscene uses of their marks. This approach could further address concerns about the uses of child-oriented trademarks in truly explicit ways.

### *B. Procedural Mechanisms*

Procedural mechanisms turn the focus on the more sophisticated party in cease-and-desist battle: the trademark owner. It is these mechanisms, perhaps more than a clarification of substantive standards, that can deter trademark overreaching by overzealous mark owners. They thus can provide more clarity ex ante for trademark owners than doctrinal rules that may or not be malleable.

#### 1. Trademark Misuse

Trademark misuse is an equitable defense akin to the doctrine of unclean hands.<sup>304</sup> According to Professor McCarthy, it "does not form the basis for an affirmative claim for recovery."<sup>305</sup> While patent and copyright regimes have embraced some form of misuse,

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(a) whether "the average person, applying contemporary community standards" would find that the work, taken as a whole, appeals to the prurient interest, (b) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law; and (c) whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value.

*Id.* at 24 (internal citations omitted).

<sup>304</sup> See 6 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:44 (4th ed. 2009).

<sup>305</sup> *Id.*

“trademark misuse garners little acceptance from courts or commentators today.”<sup>306</sup> As William E. Ridgway has noted, however, instituting some form of trademark misuse in litigation could be a potential deterrent against abusive and unmeritorious cease-and-desist letters, particularly when sent to individuals who engage in criticism or parody.<sup>307</sup> Ridgway maintains that trademark misuse could protect speech interests in pre-litigation correspondence better than doctrinal protections in court can:

[C]ertain kinds of coercive conduct undermine free speech independent of formal First Amendment defenses—the paradigmatic example being pre-litigation threats sent to alleged infringers or internet intermediaries based on dubious claims. Misuse restores this constricted free speech space by providing a more aggressive weapon than a First Amendment shield.<sup>308</sup>

Ridgway’s test is two-fold; it would examine (1) whether the trademark holder incorrectly asserts its rights, and (2) whether the trademark owner had an improper purpose in doing so.<sup>309</sup> This doctrine could be subsumed under section 1115(b)(9) of the Lanham Act, as an equitable defense in litigation.<sup>310</sup>

But Ridgway poses a more stringent and effective mechanism for using the trademark misuse doctrine—as an affirmative cause of action akin to section 512(f) of the Digital Millennium Copyright Act (the “DMCA”).<sup>311</sup> Such a provision would punish unmeritorious cease-and-desist letters by awarding costs and attorney’s fees, and, in the case of willful or knowing behavior, treble damages.<sup>312</sup> One caveat to Ridgway’s affirmative cause of action, however, is the Noerr-Pennington doctrine, “which, on the basis of the First Amendment’s Petition Clause, immunizes from

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<sup>306</sup> Ridgway, *supra* note 233, at 1553.

<sup>307</sup> *See id.* at 1548–49.

<sup>308</sup> *Id.* at 1574.

<sup>309</sup> *Id.* at 1566–67.

<sup>310</sup> *Id.* at 1583–84; *see also* 15 U.S.C. § 1115(b)(9) (2006) (“That equitable principles, including laches, estoppels, and acquiescence are also applicable.”).

<sup>311</sup> *See* Ridgway, *supra* note 233, at 1586 (citing 17 U.S.C. § 512(f)).

<sup>312</sup> *Id.*

liability individuals who petition the judiciary by, for example, bringing a lawsuit.”<sup>313</sup> Immune petitioning will prevent liability from resulting, unless it is sham litigation.<sup>314</sup> As Ridgway notes, most circuit courts hold that cease-and-desist letters enjoy immunity under the doctrine.<sup>315</sup> The Tenth Circuit, however, has bucked this trend and held that the Noerr-Pennington Doctrine does not immunize private party pre-litigation correspondence.<sup>316</sup>

If Ridgway’s proposal were to avoid any Noerr-Pennington difficulties, it could prove to be a formidable weapon in a would-be trademark recoder’s arsenal. When faced with a meritless cease-and-desist letter, he or she could have some degree of certainty that fighting the letter would not prove unduly burdensome. The difficulty lies, as with doctrinal solutions, in the fact that recipients of cease-and-desist letters may not avail themselves of such a defense, and they may not understand which claims are truly abusive and meritless. Moreover, some trademark holders might forge ahead with weak cease-and-desist claims without heeding such retributive consequences. Nonetheless, the trademark misuse doctrine could prove a deterrent for many trademark holders who do not wish to risk paying costs, attorneys’ fees, or treble damages.

## 2. Anti-SLAPP Protection

Another prophylactic measure against unfounded cease-and-desist tarnishment letters is protection under anti-SLAPP statutes. “SLAPPS are by definition meritless suits. Plaintiffs intend not to win but to intimidate and harass political critics into silence.”<sup>317</sup> An anti-SLAPP statute protects against such meritless suits.<sup>318</sup> Such statutes generally include:

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<sup>313</sup> *Id.*

<sup>314</sup> *Id.*

<sup>315</sup> *Id.* at 1587.

<sup>316</sup> *Id.* (citing *Cardtoons, L.C. v. Major League Players Ass’n*, 208 F.3d 885, 889–90 (10th Cir. 2000)).

<sup>317</sup> John C. Barker, *Common-Law and Statutory Solutions to the Problems of SLAPPS*, 26 LOY. L.A. L. REV. 395, 399 (1993) (internal citations and quotations omitted).

<sup>318</sup> See Lauren McBrayer, Note, *The DirecTV Cases: Applying Anti-Slapp Laws to Copyright Protection Cease-and-Desist Letters*, 20 BERKELEY TECH. L.J. 603, 609–11 (2005).

the establishment of a process for motions to dismiss or strike claims targeting public participation; the expedited hearing of such motions and suspension or significant curtailment of discovery until the court rules on the motion; and a cost-shifting award of attorneys fees and costs payable by the filer to the target when the target prevails on its motion to dismiss.<sup>319</sup>

Under California's anti-SLAPP laws, protection extends to the right of petition or free speech "in connection with a public issue or an issue of public interest."<sup>320</sup> At least twenty-six states in addition to California have enacted anti-SLAPP statutes.<sup>321</sup>

The prospect of anti-SLAPP protection for would-be defendants in trademark litigation could be a strong deterrent against trademark overreaching through cease-and-desist letters. Much like the trademark misuse doctrine, such protection focuses on the wrong-doing of the trademark holder, who is the party in a better position to know about the intricacies of trademark law. As with trademark misuse, though, it is possible that an overzealous trademark holder may choose to ignore the possibility of anti-SLAPP reprisals, relying on a would-be defendant's lack of knowledge and sophistication in this area of the law.

It is worth mentioning, though, that such protection is not unknown in trademark dilution cases. In the *Burnett* case, for example, the defendant, Fox, filed a special motion to strike under California's anti-SLAPP provision.<sup>322</sup> Although the motion was mooted on jurisdictional grounds,<sup>323</sup> it does illustrate that trademark defendants may use this tool as a weapon in their defensive arsenal, especially in the tarnishment arena. Widespread availability of such a statute in trademark litigation may help curb pre-litigation abusive behavior, lest the overreaching plaintiff get

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<sup>319</sup> *Id.* at 610.

<sup>320</sup> *Id.* (quoting CAL. CIV. PROC. CODE § 425.16 (West 2004)).

<sup>321</sup> See CALIFORNIA ANTI-SLAPP PROJECT, <http://www.casp.net/statutes/menstate.html> (last visited Apr. 21, 2010).

<sup>322</sup> *Burnett v. Twentieth Century Fox Film Corp.*, 491 F. Supp. 2d 962, 966 (C.D. Cal. 2007).

<sup>323</sup> *Id.* at 974.

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hit with an anti-SLAPP motion to dismiss and face attorneys' fees and costs.

### 3. Fee-shifting

As mentioned in the previous sections, fee-shifting may also work as a deterrent to trademark holders. As Professor McGeveran suggests,

fee-shifting is another possible procedural tool to discourage nonmeritorious litigation against expressive uses and support impecunious defendants. There is already a provision of the Lanham Act allowing courts to impose defense costs on plaintiffs in "exceptional cases." The photographer in "Food Chain Barbie" secured this relief, but in general it is unusual. This presumption should shift. Courts should presume that unsuccessful lawsuits against expressive uses represent exceptional cases eligible for awards of attorneys' fees unless the plaintiff can show that they were particularly close cases.<sup>324</sup>

As McGeveran indicates, fee-shifting provisions may be a strong deterrent against the rampant practice of sending cease-and-desist letters. Such a provision could induce trademark holders to be more judicious with the claims that they file, and perhaps even in the claims they assert in pre-litigation correspondence. Trademark holders may find that it is not worth their while to risk losing costs and fees for claims that will, in the best possible outcome, get thrown out at the summary judgment phase.

### *C. The Remedial Recipe?*

The remedy to frequent and often meritless cease-and-desist letters in the tarnishment arena thus must address substantive concerns (What is noncommercial use? What are the contours of tarnishment itself?), as well as procedural remedies that serve as stringent deterrents to trademark holders. One drawback to these remedies, however, is that they involve doctrinal mechanisms

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<sup>324</sup> McGeveran, *Rethinking*, *supra* note 31, at 123 (footnotes omitted).

asserted once litigation *has begun*. As expressed above, recipients of cease-and-desist letters often capitulate to trademark holders' demands before ever reaching the formal litigation stage. Thus, such recipients may benefit from an affirmative cause of action at the pre-litigation stage based on the trademark misuse doctrine or anti-SLAPP statutes.

One option that Congress should explore, for example, is an inexpensive and quick process to obtain declaratory judgment of the recoder's expressive rights based upon a wrongful claim in a cease-and-desist letter. Such a cause of action could be subsumed within the TDRA.<sup>325</sup> Trademark holders, however, may try to invoke the Noerr-Pennington doctrine against such an affirmative cause of action, claiming that pre-litigation correspondence is proper petitioning to the government. However, it is worth exploring this option for the sake of those who use trademarks in purely expressive, non-actionable ways, and who do not have the resources to defend their expressive rights at trial.

#### *D. Has Tarnishment Overstayed Its Welcome?*

While doctrinal adjustments and procedural mechanisms may afford recoders increased protections when they encounter cease-and-desist letters that have no substantive bases in law, perhaps it is time to go further and reconsider tarnishment as a cause of action altogether. As noted by Professor Beebe, dilution law in general largely has become redundant of trademark infringement actions.<sup>326</sup> Tarnishment has lived on in cease-and-desist practice, however, and this is inherently problematic because, as noted in Part II.C, trademark holders may take advantage of unsophisticated recipients and malleable legal standards to silence speech in a private action form of restraint. If tarnishment has all but disappeared in the courts, and is subject to being abused outside the courtroom, does it still serve a purpose? Should we dispense with it altogether?

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<sup>325</sup> Cf. Jennifer M. Urban & Laura Quilter, *Efficient Process or "Chilling Effects?" Takedown Notices Under Section 512 of the Digital Millennium Copyright Act*, 22 SANTA CLARA COMPUTER & HIGH TECH. L.J. 621, 629–30 (2006) (detailing the remedies for bad faith DMCA takedowns codified in the Copyright Act at 17 U.S.C. § 512(f) (2006)).

<sup>326</sup> See Beebe, *supra* note 30, at 458–59.

As some scholars have suggested, product disparagement or trade libel law, which is a subset of defamation law, could address trademark owners' concerns about brand image.<sup>327</sup> Such a standard could hew closely to the general definition in section 623A of the Restatement (Second) of Torts for "Liability for Publication of Injurious Falsehood":

One who publishes a false statement harmful to the interests of another is subject to liability for pecuniary loss resulting to the other if

- (a) he intends for publication of the statement to result in harm to interests of the other having a pecuniary value, or either recognizes or should recognize that it is likely to do so, and
- (b) he knows that the statement is false or acts in reckless disregard of its truth or falsity.<sup>328</sup>

Further, trademarks could fall under the rubric of public "figures," who must meet an actual malice standard in order for their owners to collect damages under *New York Times Co. v. Sullivan*.<sup>329</sup> Additionally, trade libel could reach only statements of fact, not opinion or fictional representations;<sup>330</sup> such a standard would allow for recoders to enjoy greater leeway in using marks in expressive and artistic works regardless of the

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<sup>327</sup> See, e.g., Kravitz, *supra* note 75, at 152–53 ("Product disparagement laws, not tarnishment rationale, should set bounds on political and artistic commentary. A trademark owner damaged by false and injurious *statements of fact* retains a cause of action. But in fictional or satirical contexts where no statement of fact can reasonably be inferred, trademarks should not be protected against mere tarnishment by non-commercial expression. If Rev. Jerry Falwell cannot succeed on a cause of action against an advertising parody suggesting he had a sexual encounter with his mother while drunk in an outhouse, why should an inanimate trademark enjoy greater protection against similar slurs?" (footnotes omitted)); cf. Mary LaFrance, *No Reason to Live: Dilution Laws as Unconstitutional Restrictions on Commercial Speech*, 58 S.C. L. REV. 709, 721 (2007) ("Tarnishment is like trade libel without the falsehood; instead of disparaging the product or service in a way that can be proven true or false, tarnishment is a less direct swipe, one which merely tries to alter public opinion rather than disseminate false information.").

<sup>328</sup> RESTATEMENT (SECOND) OF TORTS § 623A (1977).

<sup>329</sup> 376 U.S. 254, 279–80, 283–84 (1964); see RESTATEMENT (SECOND) OF TORTS §§ 623A, 626; Kravitz, *supra* note 75, at 152–53 (using Jerry Falwell as an example of a public figure).

<sup>330</sup> See Kravitz, *supra* note 75, at 153.



commercial/noncommercial distinction. The strict parameters of libel law could thus prevent overreaching by trademark holders while addressing legitimate concerns about truly harmful product disparagement. While adopting this standard does not directly affect cease-and-desist practice *per se*, it would eliminate an amorphously powerful legal standard from a trademark holder's arsenal.

In addition, truly explicit uses of trademarks could fall directly under obscenity law. It is true that obscenity law necessarily relies on community standards to deem whether a use is truly offensive,<sup>331</sup> which may fall prey to the same concerns of subjective taste as an assessment of tarnishment would. And yet, "community standards" refer to the community as a whole, and not just one particular judge or jury. In addition, utilizing obscenity law to determine whether a use is legally "obscene" would allow for a more searching inquiry under the First Amendment than an assessment of tarnishment would afford.<sup>332</sup>

This section does not purport to exhaust all the possible substitutions for tarnishment as a cause of action, nor does it seek to address all the ramifications of eliminating tarnishment from trademark law. It merely suggests that perhaps we can better address expressive interests *and* legitimate trademark owners' concerns in a different legal arena. Perhaps, however, relying on trade disparagement and obscenity laws will merely shift cease-and-desist practice to focus on these doctrines instead. Perhaps trademark owners will fall back on an old friend—plain vanilla trademark infringement—to protect brand image. But it may just be that removing tarnishment from markholders' arsenals will begin to reign in the kind of overreaching that the TDRA exemptions and relevant case law have not prevented.

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<sup>331</sup> See *Miller v. California*, 413 U.S. 15, 24 (1974); *supra* note 303.

<sup>332</sup> See Ramsay, *supra* note 29, at 413 (noting that courts generally view trademarks as "speech that is protected by the First Amendment but subject to more regulation than other types of fully protected speech").

## CONCLUSION

Since the enactment of the FTDA and the TDRA, courts have largely fallen out of love with the tarnishment cause of action. Plaintiffs bring these claims less frequently and have less frequent success. While the substantive law of tarnishment has arguably become more favorable to expressive uses, even when those uses toe the line of propriety, trademark owners have turned to out-of-court measures to protect brand images. Cease-and-desist letters based on tarnishment have thus increased, and it is likely that the amount of speech chilled by these letters has increased as well. These propositions have become evident as websites like the Chilling Effects Clearinghouse document the scope and frequency of cease-and-desist letters. However, the lucky few who can afford to fight claims of tarnishment or who can obtain pro bono legal representation (Justin Watt, the Courage Campaign, Thomas Forsythe) are few and far between.

The stakes are high in this area of law. Would-be recoders and brand commentators need to know that their creative reimaginings will not land them in court. Thus, as this Note has tried to demonstrate, the law needs to change substantively, and it needs to afford clear procedural mechanisms for these individuals to assert their rights. As Judge Kozinski presciently observed, trademark owners “must give up some measure of control”<sup>333</sup> when their brands become part of pop culture. They must understand that not all interpretations of trademarks will be favorable or in line with the image they cultivate. Most importantly, though, they must understand that there are limits to the amount of trademark protection they receive,<sup>334</sup> and that overzealous assertions of their trademark rights through tarnishment claims is bad behavior, plain and simple.

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<sup>333</sup> Kozinski, *supra* note 1, at 975.

<sup>334</sup> See Leval, *Trademark*, *supra* note 142, at 205 (“The purpose of the trademark laws is not to prevent people from saying nasty things about others but to permit entities in commerce to identify their goods or services to the public.”).