

THE DILUTION OF CULTURE AND THE LAW OF TRADEMARKS

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ABSTRACT

The cultural meaning of a trademark is built up by creating associative links between the mark and various positive cultural signs such as freedom, youth and happiness. This article argues that these links are reciprocal. That is, while the trademark begins to carry some of the meaning of the cultural signs it has been linked to, these cultural signs also absorb some of the meaning of the mark. This article develops a semiotic model, which helps to analyze the flow of meaning from non-commercial cultural signs into trademarks and from trademarks into other contexts. It argues that, by protecting the cultural meaning of trademarks, the legal system encourages the commercialization of culture and reinforces the dominance of consumer culture in our society.

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INTRODUCTION

This article deals with the cultural meaning of trademarks and the social significance of its legal protection. Trademarks are symbols designed to enable consumers to identify without confusion the source of goods and services. Today, however, trademarks are much more than source identifiers. They are culturally meaningful signs. Thus, for example, the trademark “Coca-Cola,” in addition to conveying information about the origin of soft drinks, is associated with freedom, youth, joy and globalization. The trademark “Chanel” stands not only for fragrances and apparel, but also for exclusivity, intelligence and European chic. The cultural meaning of the Olympic rings and Mickey Mouse, both registered trademarks, can hardly be described in a few words. Famous trademarks are embedded with the values, visions and ideals we believe in. As cultural signs, trademarks occupy a rather central place in our society.

The cultural meaning of a trademark is carefully built up by its owner through advertising and other marketing techniques. These techniques create associative links between the trademark and various positive cultural signs such as freedom, youth and intelligence. This article argues that these links are reciprocal. That is, while the trademark begins to carry some of the meaning of the cultural signs to which it has been linked, the cultural signs also absorb some of the meaning of the mark. This process adds some of the commercial flavor of

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the trademark to the cultural signs, which are utilized to build up the mark, thereby modifying and diluting the meaning of these signs. By observing the broader implications of this process, it is apparent that creating meaningful cultural signs out of commercial trademarks intensifies our culture's urge toward consumption and materialism.

Quite a lot has already been written concerning the commercialization of culture.¹ This article aims to explore the relationship between the phenomenon of commercializing culture and trademark law, a relationship which has not been studied. It focuses on the flow of meaning from cultural signs into commercial trademarks and from trademarks into other contexts. The article argues that the legal system offers no protection against the commercialization and dilution of cultural signs that occur when those signs are used to create commercial trademarks. On the other hand, trademark law does offer broad protection against the modification and dilution of commercial trademarks as cultural signs. Thus, the legal system actually favors trademarks over other cultural signs. This asymmetrical approach encourages trademark owners to misappropriate our culture's highest values by using cultural signs to saturate their trademarks, which simultaneously adds commercial significance to the signs employed in the process. In doing so, trademark law has become an accomplice to allowing commercial values to occupy a central place in our culture.

This article will show that speech employed to create meaningful trademarks has a dominant position in our society, whereas the First Amendment provides only limited protection for commercial speech.² This happens because the economic power of corporations allows them to spread their promotional messages over every imaginable communication medium. In addition, corporations may wield their role as commercial sponsors in order to suppress media content that is not in harmony with their corporate line.

This article suggests that promotional messages endorse a certain ideology. According to this ideology, consumption in general, and individual trademarks in particular, should play a central role in our society and culture; commercial activities, such as advertising, should be regarded as a natural part of our daily life; and the capitalist world order should be taken for granted and should never be questioned. Due to the power of corporations to place promo-

¹ See, e.g., THEODOR W. ADORNO & MAX HORKHEIMER, *DIALECTIC OF ENLIGHTENMENT* 120–67 (1972); MATTHEW P. MCALLISTER, *THE COMMERCIALIZATION OF THE AMERICAN CULTURE* 59 (1996); Sut Jhally, *Advertising at the Edge of Apocalypse*, in *CRITICAL STUDIES IN MEDIA COMMERCIALISM* 27–39 (Robin Anderson & Lance Strate eds., 2000).

² See, e.g., *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557 (1980).

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tional messages on various media and to suppress any antithetical media content, this ideology has a dominant position in our society.

Trademark law was originally enacted to prevent consumer confusion as to the source of goods and services.³ Today, however, the legal system grants extensive protection to the cultural meaning of trademarks. As this article will demonstrate, this extensive protection is primarily due to two factors: (1) a very broad interpretation of the term “consumer confusion” and (2) the dilution doctrine, which protects famous trademarks from non-confusing uses. The tendency of courts to regard trademarks as broad property rights also contributes to the protection of their cultural meaning.

Famous trademarks are the ultimate symbols of the ideology embedded in promotional messages. To use a famous trademark in a manner that challenges its cultural meaning is, to a certain extent, to question this ideology. By protecting the cultural meaning of trademarks, the legal system actually supports and reinforces the corporate world view.

There is a growing body of legal literature that recognizes subjects of intellectual property as meaningful signs that play an important role in contemporary culture.⁴ Many scholars, including Rosemary Coombe, Keith Aoki, Yochai Benkler and Sonia Katyal, have taken a deconstructionist view, arguing that the meaning of such signs should not originate exclusively with their legal owners.⁵ These scholars have emphasized the importance of letting cultural signs subject to intellectual property be freely “recoded”—that is, invested with new meanings.⁶ When the law allows owners of trademarks, copyright and publicity

³ See, e.g., *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 163–64 (1995).

⁴ See ROSEMARY J. COOMBE, *THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES: AUTHORSHIP, APPROPRIATION, AND THE LAW* 52–55 (1998); JOHN FISKE, *TELEVISION CULTURE* 236, 239 (1987); Keith Aoki, *How the World Dreams Itself To Be American: Reflections on the Relationship Between the Expanding Scope of Trademark Protection and Free Speech Norms*, 17 *LOY. L.A. ENT. L.J.* 523, 545 (1997); Jack M. Balkin, *Digital Speech and Democratic Culture: A Theory of Freedom of Expression for the Information Society*, 79 *N.Y.U. L. REV.* 1, 5–6 (2004); Yochai Benkler, *Through the Looking Glass: Alice and the Constitutional Foundations of the Public Domain*, 66 *LAW & CONTEMP. PROBS.* 173, 183–84 (2003); Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 *YALE L.J.* 1533, 1569 (1993); Sonia K. Katyal, *Semiotic Disobedience*, 84 *WASH. U. L. REV.* 489, 491 (2006); Michael Madow, *Private Ownership of the Public Image: Popular Culture and Publicity Rights*, 81 *CAL. L. REV.* 127, 145–46 (1993); Neil Weinstock Netanel, *Copyright and a Democratic Civil Society*, 106 *YALE L.J.* 283, 349 (1996); Madhavi Sunder, *IP³*, 59 *STAN. L. REV.* 257, 280–82 (2006).

⁵ See COOMBE, *supra* note 4, at 52–55; Aoki, *supra* note 4, at 545; Benkler, *supra* note 4, at 183–84; Katyal, *supra* note 4, at 491.

⁶ See COOMBE, *supra* note 4, at 52–55; Aoki, *supra* note 4, at 545; Benkler, *supra* note 4, at 183–84; Katyal, *supra* note 4, at 491.

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rights to “freeze” the meaning of the signs they own, it deprives other members of society the ability to take part in shaping their culture. Yet the opportunity to take part in shaping culture is fundamental to meaningful social dialogue, sometimes described as “semiotic democracy.”⁷

This article joins the voices calling to liberate cultural signs protected by intellectual property, specifically trademarks, so that alternative interpretations of our culture may flourish. Its contribution to the current discourse lies in the four following aspects. First, this article suggests an interconnection between cultural commercialization and the legal protection of trademarks. It explores the role trademark law plays in enhancing the importance of materialistic values in our culture. Second, on a methodological level, this article’s semiotic analysis is based on the cognitive model developed by Quillian.⁸ This approach is in contrast with Barton Beebe’s analysis based on the semiotic tools developed by Saussure and Peirce⁹ that help to understand the internal structure of a trademark, as well as the interaction between different trademarks,¹⁰ but not the relationship between trademarks and other, non-commercial, cultural signs. Third, this article suggests that trademark law promotes a certain cultural reality: a “licensed” reality. Several scholars have pointed out that trademark law acts to create consumer beliefs¹¹ and to promote a certain consumer worldview.¹² This article develops this concept further, exploring the traits of “licensed” reality, as well as the various aspects of trademark law that act to reinforce it. Fourth, this article concludes that private protection of the cultural meaning of trademarks helps corporate ideology to dominate our cultural discourse. This conclusion echoes the assertions made by Rosemary Coombe and Yochai Benkler that granting corporations control over cultural meaning “guarantees forms

⁷ See COOMBE, *supra* note 4, at 52–55; Aoki, *supra* note 4, at 545; Benkler, *supra* note 4, at 183–84; Katyal, *supra* note 4, at 491.

⁸ M. Ross Quillian, *Semantic Memory*, in SEMANTIC INFORMATION PROCESSING 227–70 (Marvin Minsky ed., 1927).

⁹ Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 627–28 (2004).

¹⁰ *Id.* at 645–46.

¹¹ See J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24.9 (4th ed. 2007); Robert C. Denicola, *Freedom to Copy*, 108 YALE L.J. 1661, 1668 (1999); James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 YALE L.J. 882, 919 (2007); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1708 (1999); Ross D. Petty, *Of Tartans and Trademarks*, 94 TRADEMARK REP. 859, 876 (2004).

¹² Graeme W. Austin, *Trademarks and the Burdened Imagination*, 69 BROOK. L. REV. 827, 829–31 (2004).

of corporate communicative hegemony.”¹³ These and other scholars have written on the effects of such hegemony on the ability of individuals and social groups, especially minorities, “to construct and to contest identities, communities, and authorities.”¹⁴ This article, in contrast, focuses on the consequences of corporate hegemony on society as a whole, including its beliefs and values. This article sees the main problem with corporate hegemony not in its effect to impoverish cultural resources for self-expression, but in the powerful ideological influence it foists on our society.

Part I of this article develops an analytical semiotic model that is used to analyze the interconnection between trademarks and other cultural signs in order to reach conclusions regarding the desirable scope of trademark protection. Part II shows how the process of shaping the cultural meaning behind commercial trademarks interferes with the meaning of the cultural signs utilized in the process. Part III explores the legal attitude toward the commercialization and dilution of cultural signs that occurs when cultural signs are employed to create meaningful trademarks. Part IV discusses how the legal system treats cultural signs registered as commercial trademarks and the extent to which the law protects their meaning. Part V concludes that the cultural meaning of trademarks should not be recognized as the private property of the trademark owner and, therefore, should not be protected.

I. AN ANALYTICAL SEMIOTIC MODEL

This part of the article develops a semiotic model that will be used to analyze the cultural meaning of trademarks. This model adopts the fundamental structure and terms of the semiotic model developed by M. Ross Quillian (hereinafter “the Q model”),¹⁵ but it alters one of its basic assumptions. First, let us clarify what the term “cultural sign” means and what role cultural signs play in society.

Semiotics, the study of signs, defines a sign as anything which implies something, stands for some idea, or symbolizes something in a given culture.¹⁶ A cultural sign can take many forms. For example, the word “love” stands for,

¹³ Rosemary J. Coombe & Jonathan Cohen, *The Law and Late Modern Culture: Reflections on Between Facts and Norms from the Perspective of Cultural Legal Studies*, 76 DENV. U. L. REV. 1029, 1052 (1999); see Benkler, *supra* note 4, at 183.

¹⁴ Rosemary J. Coombe, *Critical Cultural Legal Studies*, 10 YALE J.L. & HUMAN. 463, 484–85 (1998); see Aoki, *supra* note 4, at 529; Benkler, *supra* note 4, at 222; Gordon, *supra* note 4, at 1556.

¹⁵ See generally Quillian, *supra* note 8.

¹⁶ UMBERTO ECO, A THEORY OF SEMIOTICS 69 (1976).

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among other things, a romantic relationship. There are, however, other signs which denote the idea of love, such as flowery hearts, diamond rings or a romantic couple walking on a beach. Note that various signs convey the same idea differently. The notion of romantic love is a cultural sign in itself, a sign signifying one of the central ideals of modern Western society.

Cultural signs give meaning to the world around us; reality is meaningless until it is interpreted. Signs give significance to our experiences; they allow us to shape and share our opinions and observations. As Sapir and Whorf stated, “[h]uman beings do not live in an objective world . . . but are very much at the mercy of the particular language which ha[ve] become the medium of expression for their society.”¹⁷ Cultural signs represent the conventions of a given society. They determine whether certain things will be regarded as natural or anomalous, as important or negligible, as just or unjust.

There are several semiotic models to describe the structure of cultural signs.¹⁸ The Q model is employed here, since it best serves the purposes of the current analysis. The Q model likens a person’s mind to a mass of nodes, or signs, that are interconnected by different kinds of associative links.¹⁹ The meaning of every single node is determined by the configuration of linkages connecting that node to the other nodes.²⁰

Just as the links themselves are important, so too is their character.²¹ Thus, the node “love” has associative links to the node “flowery hearts,” as well as the nodes “a diamond ring” and “a romantic couple walking on a beach.” However, each of these associative links denotes the notion of love differently. Taken together, all the nodes and the links connecting them form the semantic network of our culture.

Umberto Eco used the Q model to argue that the structure of the semantic network is not fixed and unchangeable.²² On the contrary, social conventions can be challenged, existing links can be altered and new ones can be created.

¹⁷ David Glen Mick, *Consumer Research and Semiotics: Exploring the Morphology of Signs, Symbols, and Significance*, 13 J. CONSUMER RES. 196, 198 (1986) (quoting EDWARD SAPIR, *SELECTED WRITINGS IN LANGUAGE, CULTURE, AND PERSONALITY* 162 (David G. Mandelbaum, ed., Univ. of Berkeley Press 1949)).

¹⁸ See, e.g., ROLAND BARTHES, *ELEMENTS OF SEMIOLOGY* 6–9 (1968); Quillian, *supra* note 8, at 234–40; FERDINAND DE SAUSSURE, *COURSE IN GENERAL LINGUISTICS* 11, 13–17 (Charles Bally & Albert Reidlinger eds., 1959); *THE PHILOSOPHY OF PEIRCE: SELECTED WRITINGS passim* (Justus Buchler ed., 1956).

¹⁹ Quillian, *supra* note 8, at 234–40.

²⁰ *Id.* at 234–40.

²¹ *Id.* at 242–43.

²² ECO, *supra* note 16, at 124, 126–29.

Eco suggested that the role of “aesthetic text” is to challenge and modify the existing structure of the semantic network.²³ Unusual, unexpected or strange combinations make us reconsider the normative and widely accepted meaning of cultural signs.²⁴

The endless debate about the meaning of different signs is the cornerstone of democratic discourse. Links between nodes can be created and modified by political propaganda, by the protest of a minority group, and so on. Yet many of the messages that we are exposed to in our daily life merely use *established* associative links, thereby reinforcing those links. Thus, for example, an advertisement showing a young slim woman in a kitchen merely exploits the existing social templates as tools for selling the advertised product. In doing so, the advertisement strengthens the existing links in the semantic network of our society between woman and the kitchen, as well as links between the social desirability of a woman and her youth and slimness. A feminist movement, by contrast, strives to challenge and weaken these links.

The Q model assumes that the nodes are interconnected by one-way links.²⁵ In my opinion, however, the opposite assumption—that the links between nodes are always reciprocal—describes our perception more closely. Links between the nodes are best described by an analogy to the governing principle in the physical world that every action has an equal but opposite reaction.²⁶ According to that rule, whatever attracts or repels another is equally attracted or repelled by that other.²⁷ The force exerted by the sun on the Earth is equal to the force exerted by the Earth on the sun. Since the mass of the sun is much larger than that of the Earth, the force exerted by the Earth may not be apparent, but it exists nonetheless.

The same is true for the semantic network: the meaning of sign X is created or modified by establishing links between sign X and other signs. The significance of these other signs, however, will inevitably change by virtue of their connection to sign X. If sign X is strong enough, it may become what these other signs are most associated with. For instance, the Nazi movement has

²³ *Id.* at 124.

²⁴ *See id.* at 261–76.

²⁵ Quillian, *supra* note 8, at 239.

²⁶ Newton’s third law states that “[t]o every action there is always opposed an equal reaction: or the mutual actions of two bodies upon each other are always equal, and directed to contrary parts. Whatever draws or presses another is as much drawn or pressed by that other.” ISAAC NEWTON, *THE MATHEMATICAL PRINCIPLES OF NATURAL PHILOSOPHY* 12 (1729), *available at* <http://books.google.com/books?id=mLAG5EUZqQC&pg=PA12>.

²⁷ *Id.*

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become such a strong sign²⁸ that many of the cultural signs to which it linked itself were retooled to be entirely identified with that movement. This repurposing affected the swastika (a symbol originating in dharmic religions such as Hinduism and Buddhism),²⁹ the name Adolf and the word *Führer*. More commonly, however, a new link will only attach additional significance to the original sign without entirely dominating its meaning. Thus, Nazism has become associated with the sign “Germany.” Nazism is, however, only one association to become embedded in the sign “Germany.” Other signs, such as Goethe, the Rhine and beer, to name some of the more obvious, are also associated with “Germany.” Just as in the physical world when two signs become linked, the influence of this linkage will be more apparent in the weaker sign.³⁰ Thus, since “Germany” is a very strong cultural sign, “Nazism” is much more associated with “Germany,” than “Germany” with “Nazism.”

Legislatures have at times expressed concern about the existence of reciprocal forces in the semantic field. Thus, the German Criminal Code prohibits the use of the swastika for propaganda purposes.³¹ Another example is the British Trade Marks Act of 1994, which prohibits the use of royal images in commerce.³² Despite a very different attitude toward the two signs, both provisions have the effect of preserving the cultural meaning of the signs.

Consider the first example. In the United States, the use of the swastika is not prohibited and the sign is sometimes employed by political groups to express their critique of certain practices, such as the war in Iraq.³³ The swastika is

²⁸ The sign here is the notion of Nazism itself.

²⁹ See Colors of India, History of Swastik, <http://www.thecolorsofindia.com/swastik/history.html> (last visited Oct. 26, 2008).

³⁰ In physical terms, I am referring to the one having a smaller mass.

³¹ Strafgesetzbuch [StGB] (Criminal Code) Nov. 13, 1988, Bundesgesetzblatt [BGBl] §§ 86, 86a, translated at <http://www.iuscomp.org/gla/statutes/StGB.htm>. German leaders suggested banning the display of the swastika across the European Union; however, Hindu leaders strongly opposed the suggestion. *Hindus Opposing EU Swastika Ban*, BBC NEWS, Jan. 17, 2007, <http://news.bbc.co.uk/2/hi/europe/6269627.stm> (last visited Oct. 26, 2008). This is a good example of political discourse about the legitimate meaning of a cultural sign.

³² See Trade Marks Act, 1994, c. 26 § 99 (Eng.), available at http://www.opsi.gov.uk/acts/acts1994/ukpga_19940026_en_7#pt4-pb1-11g99.

³³ See, e.g., Matthai Chakko Kuruvila, *Hundreds Around Bay Area Protest Iraq War Escalation*, S.F. CHRON., Jan. 11, 2007, <http://www.sfgate.com/cgi-bin/article.cgi?f=/c/a/2007/01/11/BAGNVNHDHF5.DTL> (last visited Oct. 26, 2008). Sometimes this occurs through “alternative political spelling”; for example, by replacing the letter “S” with a swastika in the words “Bush” or “U.S.A.” See e.g., Larry Rohrer & Elisabeth Bumiller, *Hemisphere Summit Marred by Violent Anti-Bush Pro-*

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used in order to strengthen the message of protest by investing it with some of the sign's power. Linking the thing being protested to one of the most terrifying symbols of our culture suggests that the thing being protested is an abomination. However, this very link may also affect the meaning of the swastika by diluting its strength. Using the swastika in this way implies that the sign symbolizes not only Nazi crimes but also, to some extent, other activities whose merits are much more open to debate. German courts have explicitly recognized that German law prohibits use of the swastika in order to prevent the effect of habituation.³⁴ If the swastika is regularly used as a means of expressing critique, its terrifying effect is likely to become diminished. Similarly, using images of the British monarchy in commercial advertising may create a royal aura around the advertised products. Such advertising, however, will inevitably have a cheapening effect on those images by impairing their uniqueness and solemnity.

II. THE DILUTION OF CULTURE

Hi. Remember me?
Probably not.
My name is Nike - No, not the shoes!
...
I'm Nike, the Goddess of Victory.
Ring a bell? Sound familiar?
Of course not. Didn't think so.

You know those shoes were named after *me*.
After. I was first. Were you aware of that?
Nike, the Goddess of Victory first. And then the shoes.
Much, much later.³⁵

This part of the article will show how the process of creating cultural meaning around commercial trademarks interferes with the meaning of the cultural signs utilized in the process.

tests, N.Y. TIMES, Nov. 5, 2005, <http://www.nytimes.com/2005/11/05/international/americas/05prexy.html?pagewanted=print> (last visited Oct. 26, 2008).

³⁴ Landgericht [LG] (trial court) Stuttgart, Sept. 29, 2006, 18 KLS 4 Js 6331/05 (F.R.G.). Though the German Federal Court of Justice overruled the decision, it affirmed that the purpose of the statute is, *inter alia*, to prevent society from becoming accustomed to Nazi symbols. Bundesgerichtshof [BGH] [Federal Court of Justice] Mar. 15, 2003, 3 StR 481/06 (F.R.G.); *see also* Bundesgerichtshof [BGH] [Federal Court of Justice] July 31, 2002, 3 StR 495/01 (F.R.G.).

³⁵ Jeff Goode, *Nike, Goddess of Victory*, <http://www.noshame.org/scripts/goode030117.htm> (last visited Oct. 26, 2008).

Constructing an effective trademark should, of course, start with selecting a sign. Sometimes a corporation creates a completely new sign, like “Kodak” or “Toshiba.” Far more often, however, the chosen sign consists of, or closely resembles, an existing cultural sign, which normally serves the purpose of creating positive associations with the trademark right from the start. After a corporation has chosen a certain sign to serve as its trademark, it faces two major tasks. The first basic task is to educate consumers to perceive the sign as a trademark, that is, to identify it with the corporation’s products or services. The second, and more crucial, task in the post-modern economy is to invest the trademarked sign with certain associations and values—that is, to create a meaningful cultural sign.³⁶

In terms of the Q model, the essence of the first task is to create a strong associative link between the trademark and the respective products or services in the consumer’s mind. If the trademark consists of an existing cultural sign, this process will inevitably interfere with its meaning. This interference happens due to the reciprocal forces existing in the semantic field; while some of the cultural sign’s initial meaning comes to be embedded in the trademark, the trademark also casts a shadow on the cultural sign. The strength of the influence exerted by the trademark on the cultural sign’s initial meaning depends on the relative strength of the two signs. The stronger the trademark and the weaker the cultural sign, the more the trademark’s meaning will dominate the sign.

Consider the trademark “Nike.” The initial significance of the cultural sign “Nike” was as the name of the Greek Goddess of Victory.³⁷ The sign was chosen to serve as a trademark for its ability to convey the message of success, overcoming adversity and victory, stated succinctly by the phrase “Just Do It.”³⁸ The trademark grew so strong that it turned into the sign’s primary meaning while its original significance grew weaker and became a kind of secondary meaning. The word “Cadillac” underwent a similar process. Cadillac’s initial cultural significance was as the name of an early 18th century French explorer

³⁶ DOUGLAS ATKIN, *THE CULTING OF BRANDS: WHEN CUSTOMERS BECOME TRUE BELIEVERS* 97 (2004); Joel H. Steckel & Shelley Schussheim, *Dilution through the Looking Glass: A Marketing Look at the Trademark Dilution Revision Act of 2005*, 96 TRADEMARK REP. 616, 620–23 (2006); see also ERICH FROMM, *THE SANE SOCIETY* 132 (1955).

³⁷ In Greek religion, Nike, the Goddess of Victory, the daughter of Pallas and Styx, is usually portrayed with wings. *Nike*, Encyclopædia Britannica Online, <http://www.britannica.com/EBchecked/topic/415189/Nike> (last visited Oct. 26, 2008).

³⁸ See Nike, http://www.nikebiz.com/company_overview/timeline (press ‘play’ and proceed to ‘1971’) (last visited Oct. 28, 2008) (describing origin of the Nike trademark); Logo Range Design Group, <http://www.logorange.com/logodesign-N.php> (last visited Oct. 28, 2008) (providing history of various logos, including Nike’s Swoosh and “Just Do It”).

who founded the city of Detroit.³⁹ The advent of the Cadillac automobile, however, imbued the name with a strong significance as a trademark, and the meaning connected to the explorer was relegated to an ancillary role. Another example is the word “Ajax,” which today primarily denotes both cleaning products of the Colgate-Palmolive Company and a computer program offered by Microsoft, but not the original meaning as a hero of Greek myth.⁴⁰ In each example, the transformation of meaning happened not only because of the strength of the trademarks, but also due to the fact that the original cultural meaning of the signs was not very strong. In other words, Nike, the Goddess of Victory, as well as Cadillac, the founder of Detroit, and Ajax, the Greek hero, did not play very important roles in American culture.

When the cultural sign is strong enough, its use as a trademark will usually not result in the trademark becoming the dominant meaning. Attaching a trademark connotation to a cultural sign, however, will always alter its significance to some extent. Consider, for example, two trademarks that consist of female names: “Mercedes” and “Tiffany.” Both trademarks have absorbed some of the feminine essence embodied in the names. Yet the names have gained an additional significance as well. Although the names have not come to signify trademarks primarily, the companies certainly come to mind when one hears the names. As a result, one may hesitate to choose one of the names for a girl, and the bearers of the names may be averse to the association. Another example is the Walt Disney Company’s Sleeping Beauty Castle trademark. This trademark was inspired by the German Neuschwanstein Castle, which was built in the 19th century.⁴¹ Undoubtedly, the Walt Disney Company gained some of the magic of this castle by adopting its image as a trademark. Today, however, the castle is strongly associated with Walt Disney as well. This association gives the Neuschwanstein Castle a connotation of popularity, triviality and kitsch.

³⁹ Antoine Laumet de La Mothe, sieur de Cadillac, founded Detroit in 1701. THE COLUMBIA ENCYCLOPEDIA, <http://www.encyclopedia.com/doc/1E1-Cadillac.html> (last visited Oct. 26, 2008).

⁴⁰ Ajax, in Greek legend, son of Telamon, king of Salamis, is described in Homer’s Iliad as being of great stature and colossal frame. HOMER, THE ILIAD, Book XVII, *available at* <http://classics.mit.edu/Homer/iliad.17.xvii.html>. During the Trojan War, he engaged Hector, the chief warrior, in combat. HOMER, THE ILIAD, Book VII, *available at* <http://classics.mit.edu/Homer/iliad.7.vii.html>. He later rescued the body of Achilles from the hands of the Trojans. BARRY STRAUSS, THE TROJAN WAR 164 (2006).

⁴¹ THE IMAGINEERS, WALT DISNEY IMAGINEERING: A BEHIND THE DREAMS LOOK AT MAKING THE MAGIC REAL (1998).

Corporations wishing to create a successful trademark must do more than establish an associative link between the trademarked sign and its goods or services. A second, and more important, task is to incorporate certain ideas and values within the trademark with which consumers wish to identify themselves. Trademarks in the modern economy are designed to function as signs of self-expression, self-identification and even self-actualization.⁴² Choosing an existing cultural sign with positive associations can help to achieve these ideals. Of course, these positive associations are not enough to create a strong and meaningful trademark. Also, although many trademarks either resemble or consist of existing cultural signs, a successful trademark may also be created out of a completely meaningless sign, as was the case with Kodak and Rolls-Royce.

The cultural meaning of trademarks is created using various marketing techniques. The central technique today is advertising. Modern advertising is predominantly designed to create a positive image for the promoted trademarks rather than to provide any information about the products or services.⁴³ Advertising rarely employs rational argumentation. More commonly, advertising involves images, colors, exclamations, music and rhyme to convey a message.⁴⁴ This should not be surprising. In terms of the Q model, the main purpose of advertising is to connect the advertised trademark and the products or services it represents with positive cultural values. Since no such connection exists, however, the associative link cannot be based on rational argumentation. The associative link can only be built with the help of rhetoric, a persuasive tactic not bound by the rules of logic.⁴⁵

In order to link a trademark to certain social values, advertising must exploit cultural signs that denote those values. For example, to invest a trademark with the spirit of romantic love, advertising can, among other things, dis-

⁴² See, e.g., McALLISTER, *supra* note 1, at 59; GRANT McCracken, CULTURE AND CONSUMPTION II – MARKETS, MEANING AND BRAND MANAGEMENT 100–03 (2005); ANDREW WERNICK, PROMOTIONAL CULTURE: ADVERTISING, IDEOLOGY, AND SYMBOLIC EXPRESSION 183–84 (1991); Martin Green, *Some Versions of the Pastoral: Myth in Advertising, Advertising as Myth*, in ADVERTISING AND CULTURE: THEORETICAL PERSPECTIVES 29, 44–46 (Mary Cross ed., 1996).

⁴³ See Mark Bartholomew, *Advertising and the Transformation of Trademark Law*, 38 N.M. L. REV. 1, 13–14 (2008); Yoav Hammer, *Expressions Which Preclude Rational Processing: The Case for Regulating Non-Informational Advertising*, 27 WHITTIER L. REV. 435, 437 (2005).

⁴⁴ The effectiveness of such tools is described in Edward F. McQuarrie & David Glen Mick, *Visual and Verbal Rhetorical Figures Under Directed Processing Versus Incidental Exposure to Advertising*, 29 J. CONSUMER RES. 579, 582–86 (2003).

⁴⁵ John F. Sherry, *Advertising as a Cultural System*, in MARKETING AND SEMIOTICS 441, 452–53 (Jean Umiker-Sebeok ed., 1987).

play it together with the word “love,” flowery hearts, a diamond ring or a romantic couple walking on a beach. One may wonder how advertising that employs no rational argumentation and merely suggests a totally unconvincing association between a commercial trademark and a genuine cultural value may succeed. This success is possible because of the special quality of human perception. We simply connect the things that appear together. Advertising creates associative links employing “classical conditioning”—a psychological technique based on repeated pairing of two previously unconnected stimuli.⁴⁶ The influence of this technique can be immense. Thus, for example, one experiment showed that when neutrally predisposed individuals hear the words “Denmark” and “Danish” in one headphone along with words “ugly,” “dreadful,” and “misfortune” in the other, they create a negative attitude towards Denmark and the Danish people.⁴⁷

Classical conditioning is the most widely used advertising technique.⁴⁸ It is the technique behind advertising campaigns that tell us that Disneyland is “the happiest place on Earth,”⁴⁹ that Bounty chocolate has “the taste of paradise,”⁵⁰ that the Southwest Airlines Company is the “symbol of freedom”⁵¹ or that Fiat is “driven by passion.”⁵² If repeated enough times, such slogans are able to create associative links in the consumer’s mind between the trademarks and the corporation’s desired values.⁵³ All of our society’s ideals—such as happiness, freedom, love and professional success—are eventually exploited by advertising, which attempts to link these ideals to commercial trademarks. This process strengthens the cultural significance of the advertised trademarks, specifically, and of consumption in general. The significance of the social ideals exploited by advertising, however, is affected as well.

⁴⁶ Hammer, *supra* note 43, at 444; Reginald Leamon Robinson, *White Cultural Matrix and the Language of Nonverbal Advertising in Housing Segregation: Toward an Aggregate Theory of Liability*, 25 *CAP. U. L. REV.* 101, 147–48 (1996).

⁴⁷ WERNER KROEBER-RIEL & PETER WEINBERG, *KONSUMENTENVERHALTEN* 132 (7th ed. 1999).

⁴⁸ *Id.*; Hammer, *supra* note 43, at 444; Robinson, *supra* note 46, at 147–48. For a brief overview of this advertising technique, see ROBERT B. SETTLE & PAMELA L. ALRECK, *WHY THEY BUY: AMERICAN CONSUMERS INSIDE AND OUT* 107 (1986).

⁴⁹ The Walt Disney Company, http://disneyland.disney.go.com/disneyland/en_US/parks/overview?name=DisneylandResortParksOverviewPage (last visited Oct. 26, 2008).

⁵⁰ The History of Branding, <http://www.historyofbranding.com/slogans.html> (last visited Oct. 26, 2008) (Bounty).

⁵¹ Southwest Airlines, http://www.southwest.com/rapid_rewards (last visited Oct. 26, 2008).

⁵² Database of Slogans, <http://www.textart.ru/database/english-advertising-slogans/car-brand-advertising-slogans.html> (last visited Oct. 26, 2008) (Fiat).

⁵³ Hammer, *supra* note 43, at 444; Robinson, *supra* note 46, at 147–48.

In terms of the Q model, since the mind's associative links are always reciprocal, the act of linking commercial trademarks and products of consumption with the cultural signs representing social ideals also influences the meaning of those signs. Since each advertisement pulls a given sign towards another product or service, it might be argued that the forces would eventually balance, leaving the meaning of the sign unchanged. This argument, however, is flawed. Although the specific content of advertisements may vary, the vast majority of them share a common message: the way to happiness, freedom, love or professional success lies in the consumption of commercial goods and services.

Though not every advertisement succeeds in fastening the promoted trademark to the desired cultural ideal, their cumulative effect is to successfully link consumption to important social values, thereby giving it a central place in modern society. People attribute great importance to consumption and associate it with happiness, pleasure, freedom and self-reward.⁵⁴ Because of the existence of reciprocal forces in the semantic field, however, this process also has a flip side. Cultural ideals to which consumption has been linked start incorporating the materialistic values embedded in trademarks as well. In other words, if consumption denotes happiness then, necessarily, happiness also denotes consumption. If a luxury cruise, dinner in a fancy restaurant or an expensive piece of jewelry symbolizes true love, then the notion of true love also includes these consuming practices to some extent. Constantly linking cultural ideals to the banal context of consumption dilutes and eviscerates their distinct meaning. As Andrew Wernick noted, it is hard to hear the word "paradise," even in church, without thinking of the multitude of goods to which the idea has been promotionally linked.⁵⁵

As consumers confront an unrelenting torrent of marketing stimuli at every turn, they become increasingly desensitized and develop various defense mechanisms.⁵⁶ Consumers learn to ignore advertising and to escape the mental

⁵⁴ See BRUNO S. FREY & ALOIS STUTZER, *HAPPINESS AND WELL-BEING: HOW THE ECONOMY AND INSTITUTIONS AFFECT HAPPINESS* 29 (2002) ("The material standard of living is regularly mentioned by a majority of respondents as being one of the most important elements of well-being. Consumption has become one of the central activities of modern life."); see also FROMM, *supra* note 36, at 135 ("Modern man, if he dared to be articulate about his concept of heaven, would describe a vision which would look like the biggest department store in the world, showing new things and gadgets, and himself having plenty of money with which to buy them.").

⁵⁵ WERNICK, *supra* note 42, at 189.

⁵⁶ Edward F. McQuarrie & David Glen Mick, *A Laboratory Study of the Effects of Verbal Rhetoric Versus Repetition When Consumers Are Not Directed to Process Advertising*, *INT'L J. ADVERTISING* (forthcoming 2008) (manuscript at 3–4, on file with authors).

processing of its messages.⁵⁷ This phenomenon has challenged advertisers to develop strategies that can attract consumers to process advertising. A widespread strategy is the use of rhetorical figures (also called “figures of speech”), such as rhymes, wordplays, metaphors, puns and rhetorical questions.⁵⁸ Consider the following examples: “For All You Do, This Bud’s For You,”⁵⁹ “Digitally Yours,”⁶⁰ “Good. Better. Paulaner,”⁶¹ “Guinness is Good for You”⁶² and “Accelerate Your Soul.”⁶³ Rhetorical figures invite cognitive processing because their style is based on “artful deviation, that is, a swerve from expectations.”⁶⁴ Empirical studies confirm that consumers are likely to elaborate on an advertising message that utilizes rhetorical figures, even in situations where they are free to ignore the message.⁶⁵ This “elaboration on the meanings [of the advertisement] . . . foster[s] a pleasurable aesthetic experience, which then improves the attitude toward the ad[vertisement].”⁶⁶

Frequently, cultural icons—cultural signs with a strong and distinctive significance—are chosen to serve as rhetorical figures. Thus, General Motors used the slogan “Life, Liberty, and the Pursuit”⁶⁷ to promote its Cadillac automobiles and Purina employed the saying “All You Add Is Love” to promote its dog food.⁶⁸ In each example, the variation on a famous expression was likely designed to attract attention and invite mental processing of the advertising slogan. Cultural icons are often used as metaphors as well. For example, McDonald’s has used advertising depicting the Statue of Liberty with canola oil in her

⁵⁷ *Id.* at 4.

⁵⁸ Edward F. McQuarrie & David Glen Mick, *On Resonance: A Critical Pluralistic Inquiry Into Advertising Rhetoric*, 19 J. CONSUMER RES. 180, 180 (1992).

⁵⁹ Database of Slogans, Beer Advertising Slogans, <http://www.textart.ru/database/english-advertising-slogans/beer-advertising-slogans.html> (last visited Oct. 26, 2008) (Budweiser).

⁶⁰ Justin Doebele, *Ends and Means*, FORBES.COM, Feb. 3, 2003, <http://www.forbes.com/global/2003/0203/014.htm> (last visited Oct. 26, 2008) (noting Samsung’s “Digitally Your’s” slogan).

⁶¹ Database of Slogans, Beer Advertising Slogans, *supra* note 59 (Paulaner).

⁶² *Id.* (Guinness).

⁶³ Dunlop, <http://www.dunlopatv.com> (last visited Oct. 26, 2008).

⁶⁴ McQuarrie & Mick, *supra* note 44, at 579.

⁶⁵ McQuarrie & Mick, *supra* note 56, at 21.

⁶⁶ McQuarrie & Mick, *supra* note 44, at 579.

⁶⁷ Webwire, *Cadillac Introduces New “Life. Liberty. And The Pursuit.” Marketing Campaign*, July 26, 2006, <http://www.webwire.com/ViewPressRel.asp?ald=17489> (last visited Oct. 26, 2008).

⁶⁸ Purina, *History of Pet Expertise*, <http://www.purina.ca/about/timeline.aspx> (last visited Nov. 8, 2008).

hand to convey the idea that its products are now free of trans-fat oil.⁶⁹ Similarly, Mercedes-Benz has used a Stradivarius violin as a metaphor for high quality and uniqueness,⁷⁰ and communications company Nokia has used advertisements resembling the portion of Michelangelo's Sistine Chapel ceiling depicting the hand of God giving life to Adam as a visual metaphor for "connecting people."⁷¹ Because of their symbolic power, cultural icons are especially susceptible to use in advertising. Here, like the examples of the swastika and images of the British monarchy discussed above, the very act that strengthens the advertising message weakens the power of the employed cultural sign.

Advertising is only one of the marketing techniques designed to invest trademarks with cultural meaning. Yet all such techniques interfere with the meaning of the cultural signs they use. For example, sponsorship of cultural events by commercial corporations invests the corporation's trademarks with some of the elevated spirit of the events. At the same time, however, the sponsorship invests the cultural events with commercial spirit and the flavor of glossy marketing, evoking a somewhat more suspicious and less serious attitude towards them. The commercialization of the Olympic Games between the years 1984 and 2000 is a good example of this phenomenon. During that time, trademarks appeared on every object related to the Games, including the athletes themselves, marking the Games with the spirit of a large-scale marketing event.⁷²

Recently, a marketing technique called product placement has become increasingly widespread.⁷³ Product placement is the practice of integrating commercial trademarks into the narratives of entertainment, mainly films and television series, in exchange for money.⁷⁴ Trademarked goods are inserted into the plot in a manner that makes them appear a natural part of the story.⁷⁵ Product placement allows corporations to continue to reach consumers in a world where technological developments, such as the video-cassette recorder (VCR),

⁶⁹ A recent advertising campaign recollected by the author.

⁷⁰ A recent advertising campaign recollected by the author.

⁷¹ See Nokia, <http://www.nokiausa.com/A4409001> (last visited Oct. 26, 2008), for various products that display a picture resembling the portion of the Sistine Chapel depicting the hand of God giving life to Adam.

⁷² Matthew McAllister, *Sponsorship, Globalization and the Summer Olympics*, in *UNDRESSING THE AD: READING CULTURE IN ADVERTISING* 35, 41–43 (Katherine Toland Frith ed., 1997).

⁷³ See Ellen P. Goodman, *Stealth Marketing and Editorial Integrity*, 85 *TEX. L. REV.* 83, 93 (2006); Steven L. Snyder, *Movies and Product Placement: Is Hollywood Turning Films Into Commercial Speech?*, 1992 *U. ILL. L. REV.* 301, 304 (1992).

⁷⁴ Snyder, *supra* note 73, at 303–04.

⁷⁵ Goodman, *supra* note 73, at 93–94.

the remote control and the digital-video recorder (DVR), help consumers escape television commercials. In addition, while people tend to perceive advertising skeptically and develop a certain immunity against its influence, they usually do not resist messages embedded in non-commercial entertainment. In other words, by detaching the trademark from the context of marketing and making it look like a natural part of a creative work, the desirability of the product seems more credible. Thus, an Omega watch on James Bond's wrist conveys, more convincingly than any commercial could, that the Omega trademark represents charm, courage, success, intelligence and a suave sense of humor. At the same time, the medium that carries the marketing message becomes less credible, since it ceases to be pure art. As James Bond checks his Omega watch, he bestows some of his qualities upon the trademark. Yet, by this very action, James Bond himself absorbs some of the lifeless metal glow and some of the unsavory association with marketing, thereby becoming somewhat less authentic, consistent and credible.

As in the physical world, the reciprocal forces in the semantic field always act in opposite directions. Thus, while naming a brand of shoes "Nike" invests it with some of the glamour of the Greek Goddess of Victory, the glamour of the Goddess herself fades. When an advertisement suggests that Mercedes cars are as unique as Stradivarius violins, it simultaneously implies that Stradivarius violins are as common as Mercedes cars. Since the goal of marketing is to enhance a trademark's value, cultural signs will always be used to enhance what the trademark stands for. Hence, cultural signs that are chosen to serve as trademarks or that are used in various marketing techniques represent higher cultural values than embodied in the sale of commercial products or services. Linking the trademark to these signs makes the trademark grander, more impressive and more unique. Since reciprocal forces, however, always act in opposite directions, the cultural signs exploited in this process will inevitably become somewhat less grand, less impressive and less unique. I refer to this phenomenon as "the dilution of culture."

III. THE LEGAL ATTITUDE TOWARD THE DILUTION OF CULTURE

This part of the article will examine current law relating to both the practice of turning cultural signs into commercial trademarks, and the practice of exploiting cultural signs while creating meaningful trademarks. Specifically, this part of the article will examine whether the legal system grants protection to cultural signs against the commercialization and dilution that occur when they are employed to create meaningful trademarks. Finally, it will discuss the more

general cultural consequences of the marketing techniques employed to build up trademarks.

A. Cultural Signs Registered as Trademarks

Consider the practice of making a commercial trademark out of an existing cultural sign, as in the examples of Nike, Cadillac, Mercedes and Tiffany discussed previously. This practice is generally not restricted by U.S. law or the laws of other Western countries.⁷⁶ Though some trademarks cannot be registered, these exceptions are aimed at protecting the interests of private parties and preventing consumer confusion.⁷⁷ Thus, trademarks may not be registered if they falsely suggest a connection with institutions or persons, living or dead.⁷⁸ Likewise, trademarks may not be registered if they consist of a name, portrait or signature identifying a particular living individual without his or her consent.⁷⁹ With the exception of the national flag and other official insignia of the United States and other countries, cultural signs are not protected from appropriation as trademarks if they do not consist of already existing trademarks or suggest a connection to an institution or to a living or a recently deceased individual.⁸⁰

Yet a great number of signs in our culture do suggest a connection to institutions or to living or recently deceased individuals. But does trademark law protect their cultural meaning against dilution? The provisions mentioned above are simply designed to protect the rights of celebrated individuals and various institutions from commercial appropriation. For example, a third party cannot register the words “Michael Jordan,” “Salvador Dali” or “NBA” as trademarks without the consent of Michael Jordan, Salvador Dali’s estate or the representatives of the National Basketball Association, respectively. This does not mean, however, that these cultural signs may never become trademarks for

⁷⁶ See, e.g., 15 U.S.C. § 1052 (2006).

⁷⁷ §§ 1052(c)–(d).

⁷⁸ § 1052(a).

⁷⁹ § 1052(c).

⁸⁰ § 1052(b). It is clear that use of a trademark consisting of a famous individual’s name may falsely suggest a connection to this individual if he or she is recently deceased. In contrast, when a trademark consists of a historical figure’s name, like Napoleon, no such connection could be reasonably assumed. The right of publicity—which protects famous individuals from misappropriation of the commercial value of their personalities—may protect them against registration of their insignia as trademarks. See Katya Zakharov, *The Right of Publicity: How Much of It Can Be Protected by Privacy and the Law of Trademarks?*, 2003 GRUR INT’L 118, 125–26 (2003).

commercial products or services; it only means that the decision of whether to turn them into trademarks lies with the right holders.

The right holders' consent, however, is irrelevant to the cultural meaning of the signs. The associative link between the cultural sign and its trademark significance is even strengthened by the willful consent of the cultural icon whom the sign initially represents. Imagine if the law did not restrict the use of famous names as trademarks and that Nike was able to call one of its shoes "Air Jordan" as a tribute to Michael Jordan without his consent. In this case, the name "Jordan" is less likely to be associated with a brand of shoes than it is where Michael Jordan personally endorses the Nike sneaker. In other words, the associative link between a cultural sign and a commercial product is stronger when the entity symbolized by the cultural sign has provided the endorsement.

In this context, it is interesting to note the relatively recent emergence of so-called "merchandising rights" in trademark law.⁸¹ Today a trademark may be registered not only as an indication of origin, but also for the purpose of licensing the mark for decorative use on such items as posters, t-shirts, cups and apparel.⁸² Thus, singers, bands, sports teams, colleges, universities, social and political organizations, museums, film producers and even famous police departments—in short, any entity that believes it can make a profit by merchandising its insignia—often register their names and logos as trademarks.

Initially, trademark law was not designed to protect such rights.⁸³ Only when the sign was used as an indication of origin, and not as a decoration, could it be protected as a trademark. Indeed, at one time, courts were divided on whether it is appropriate to register trademarks for the purpose of merchandising one's insignia.⁸⁴ Today, however, courts take the merchandising right for granted and regard cultural signs representing entities as the indisputable property of those entities.⁸⁵

Registering insignia as trademarks and profiting from such merchandising is, of course, not the same as creating a brand of products or services bearing

⁸¹ GREGORY J. BATTERSBY & CHARLES W. GRIMES, 1 *LAW OF MERCHANDISE AND CHARACTER LICENSING* § 8:1 (2008).

⁸² *Id.* § 8:7.

⁸³ See, e.g., Mark A. Kahn, *May the Best Merchandise Win: The Law of Non-Trademark Uses of Sports Logos*, 14 *MARQ. SPORTS L. REV.* 283, 304 (2004).

⁸⁴ See *infra* Part IV(A)(1).

⁸⁵ See, e.g., *Audi AG & Volkswagen of Am., Inc. v. Bob D'Amato*, 469 F.3d 534, 541, 543 (6th Cir. 2006); *Gen. Motors Corp. v. Lanard Toys, Inc.*, 468 F.3d 405, 413, 421 (6th Cir. 2006); *Bd. of Supervisors of the La. State Univ. v. Smack Apparel Co.*, 438 F. Supp. 2d 653, 660, 664 (E.D. La. 2006).

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the insignia of Michael Jordan, Salvador Dali and the NBA. However, this practice can nonetheless interfere with the cultural meaning of the signs being trademarked.

T-shirts bearing the emblem of a university, a photograph of a singer or the name of a sports team demonstrate that the university, singer or team is famous and adored, and that people wish to be identified with that entity. However, when the consumer knows that the t-shirts are licensed by the entity, an additional message is sent: the university, singer or team is selling its own popularity in the form of merchandise. Licensing a cultural sign to be sold on merchandise creates an additional meaning for the sign—namely, that the sign is a commercial commodity. This additional meaning dilutes the cultural sign, impairing its power, authority and authenticity. This additional meaning suggests that the university is not only an educational institution, that the singer is not simply an artist and that the team is not just an organization that works towards athletic triumphs. The licensed merchandise implies that these entities are business units with a commercial interest in their popularity. Such merchandise suggests that the university, the artist and the team all belong to the world of commerce where the pursuit of profit is the main ideal.

B. Marketing Techniques Exploiting Cultural Signs

Advertising and other marketing techniques are used to imbue trademarks with cultural meaning. These techniques are generally categorized as commercial speech, though practices like product placement increasingly blur the distinction between commercial speech and creative content.⁸⁶

Commercial speech does not enjoy the full protection of the First Amendment.⁸⁷ Unlike political speech, commercial speech can be restricted if it includes false or misleading statements.⁸⁸ Further, commercial speech can be more easily restricted than other types of speech when it conflicts with a substantial public interest⁸⁹ or with private property rights such as intellectual prop-

⁸⁶ Goodman, *supra* note 73, at 144; Amit M. Schejter, *Art Thou for Us, or for Our Adversaries? Communicative Action and the Regulation of Product Placement: A Comparative Study and a Tool for Analysis*, 15 TUL. J. INT'L & COMP. L. 89, 114 (2006).

⁸⁷ *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447, 455–56 (1978).

⁸⁸ *See, e.g., Kasky v. Nike*, 27 Cal. 4th 939, 952 (2002).

⁸⁹ Several courts have recognized that state legislators have the authority to regulate outdoor advertising of tobacco products, *see, e.g., Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 571 (2001), and alcoholic beverages, *see, e.g., Penn Adver. of Balt., Inc. v. Mayor & City Council of Balt.*, 63 F.3d 1318, 1326 (4th Cir. 1995), *vacated and remanded on other grounds*, 518 U.S. 1030 (1996), *readopted as modified on remand*, 101 F.3d 332 (4th Cir. 1996). Ad-

erty rights.⁹⁰ Since commercial speech is considered to have little expressive value, free speech exceptions to intellectual property laws, such as the copyright fair use doctrine, are usually designated primarily for non-commercial speech.⁹¹

Marketing techniques that aim to imbue trademarks with cultural meaning, however, are not seriously limited by the restriction that the message cannot be false or misleading. All of these techniques attempt to convey the message that trademarks embody certain cultural values, and that products or services sold under the marks will help the consumer identify herself with those values. For example, Southwest Airlines's claim to be the "symbol of freedom"⁹² suggests that flying with the airline expresses one's belief in the ideal of freedom, or perhaps makes one feel free. Similarly, Coca-Cola Company's sponsorship of the Olympic Games suggests that the trademark "Coca-Cola" embodies such values as global awareness, competitiveness and striving for perfection. Coca-Cola's sponsorship also suggests that these values can be identified with, or even realized to some extent, by consumption of Coca-Cola products.

These messages are so incredible and absurd that no logical or factual statements can be utilized to convey them. Therefore, marketing must employ psychological techniques and rhetoric to influence consumers on an emotional rather than a rational level. Interestingly, this is the very reason that such messages are able to entirely avoid the scrutiny of the legal system. Such messages are not regarded as misleading because no reasonable consumer is expected to take seriously the marketing messages that promise, explicitly or implicitly, the realization of various cultural ideals through the consumption of goods.⁹³ Psychological influence achieved by marketing techniques itself is regarded as a wholly legitimate way of promoting one's commercial interests with the sole

ditionally, The Federal Cigarette Labeling and Advertising Act bans cigarette advertising completely on any medium of electronic communication falling under the jurisdiction of the Federal Communications Commission ("FCC"). 15 U.S.C. § 1335 (2006).

⁹⁰ See, e.g., *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992); *Am. Express Co. v. Vibra Approved Labs. Corp.*, 10 U.S.P.Q.2d (BNA) 2006 (S.D.N.Y. 1989); *Allen v. Men's World Outlet, Inc.*, 679 F. Supp. 360 (S.D.N.Y. 1988); *D.C. Comics v. Crazy Eddie, Inc.*, 205 U.S.P.Q. (BNA) 1177 (S.D.N.Y. 1979).

⁹¹ See, e.g., *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984) ("[A]lthough every commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright, noncommercial uses are a different matter.").

⁹² *Southwest Airlines*, *supra* note 51.

⁹³ More generally, promises of future performance in advertising are considered mere "puffing" and are not actionable as fraud. See, e.g., *Am. Computer Trust Leasing v. Jack Farrell Implement Co.*, 763 F. Supp. 1473, 1487 (D. Minn. 1991).

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exception of subliminal advertising, which is forbidden in the United States as well as in other Western countries.⁹⁴

Restrictions of commercial speech because of substantial public interests also do not have any significant impact on the various marketing techniques that exploit cultural signs. This is because the U.S. legal system does not recognize a substantial public interest in the protection of cultural signs against alterations of their meaning caused by marketing. This view is widely shared by other Western countries. While some countries, including Great Britain, have prohibited the use of royal images in commercial advertising,⁹⁵ these prohibitions are negligible limitations on the broad freedom to appropriate cultural signs in commercial contexts. This approach is emblematic of the general view that a democratic country's legal system should not protect cultural signs from changes in their meaning. United States law is, perhaps, one of the most liberal in this respect. The solid American tradition of protecting free speech results in allowing activities like burning the national flag and drawing a swastika, which is forbidden in some other Western countries.⁹⁶

This legal approach results in an almost unlimited ability to exploit cultural signs, important as they may be, while building up the meaning of commercial trademarks. Therefore, even though marketing techniques are categorized as commercial speech and can be more easily restricted in order to protect public interests, this categorization does not pose any serious restriction on the process of the commercialization of cultural signs and the resulting dilution of culture.

Intellectual property rights, however, do limit one's ability to employ cultural signs in marketing. Some cultural signs are protected by copyrights,

⁹⁴ In the United States, the FCC declared that attempts to convey information to viewers by transmitting messages below the threshold level of normal awareness are contrary to the public interest. FCC Public Notice, Broadcast of Information by Means of Subliminal Perception Techniques, 29 Rad. Reg. 2d (P & F) 395 (Jan. 24, 1974). In Europe, Article 10(3) of the Television Without Frontiers Directive forbids subliminal advertising. Council Directive 97/36/EC, art. 10(3), 1997 O.J. (L 202) 60.

⁹⁵ Trade Marks Act, 1994, c. 26, §§ 99(1)–(2) (Eng.), available at http://www.opsi.gov.uk/acts/acts1994/ukpga_19940026_en_7#pt4-pb1-11g99.

⁹⁶ For example, in Germany it is a crime to disseminate propaganda materials of certain political parties and to insult or maliciously express contempt for the government. Strafgesetzbuch [StGB] [Criminal Code] Nov. 13, 1988, Bundesgesetzblatt [BGBl] §§ 86, 86a, 90a, translated at <http://www.iuscomp.org/gla/statutes/StGB.htm>. In the United States, however, flag burning is regarded as a form of constitutionally-protected speech. See, e.g., *United States v. Eichman*, 496 U.S. 310, 318–19 (1990); *Texas v. Johnson*, 491 U.S. 397, 420 (1989). The same applies to displaying a swastika. *Vill. of Skokie v. Nat'l Socialist Party of Am.*, 373 N.E.2d 21, 25–26 (Ill. 1978).

trademark rights or the rights of publicity. For instance, Bart Simpson, Madonna, James Bond, Mikhail Gorbachev, the Rolling Stones' "Start Me Up"⁹⁷ and Queen's "Bohemian Rhapsody"⁹⁸ are all meaningful cultural signs that are protected as private property. Yet, as in the case with the registration of trademarks, this is not protection against commercialization. Protection as private property simply means that no commercial use of the cultural sign may be made without the right holder's consent. However, such consent is often given in exchange for a sufficient fee. Thus, all of the cultural signs mentioned here have been used to promote commercial products or services.⁹⁹ As is the case with turning cultural signs into trademarks, using these cultural signs in marketing techniques makes the associative link with commerce stronger when the right holder of the sign approves the use.

C. Commercialization of Culture

"And I'm beefin' wit' Mickey D's man, y'all dead wrong, talkin' 'bout payin' rappers to mention Big Macs in their song. We do rap from the heart, y'all better have some respect. Alright, Big Mac! Big Mac! Big Mac! Now where's my check?"¹⁰⁰

The influence of marketing techniques on our culture is not limited to the messages they convey directly. Today, advertising and sponsorship are the central source of income for the main media channels—television, radio, and the printed press.¹⁰¹ Thereby, advertisers are able to exercise considerable control over the content of these media.¹⁰²

Furthermore, commercial interests have the tendency to gradually take over all types of media. Every medium that attracts an audience attracts advertisers as well, since almost any audience includes potential consumers and, thus,

⁹⁷ THE ROLLING STONES, *Start Me Up*, on TATTOO YOU (Rolling Stones / Virgin Records 1981).

⁹⁸ QUEEN, *Bohemian Rhapsody*, on A NIGHT AT THE OPERA (1975).

⁹⁹ Mikhail Gorbachev's famous forehead and nickname (Gorby) were used to sell vodka and pasta. Alex Nicholson, *Trademark: Gorby Brands Name, Face*, Oct. 24, 2003, ST. PETERSBURG TIMES, http://www.sptimes.ru/index.php?action_id=2&story_id=11330 (last visited Nov. 1, 2008).

¹⁰⁰ Audio recording: Mad Skillz, 2005 Rap Up (available at <http://www.youtube.com/watch?v=t9lvYxsOIDw>).

¹⁰¹ See BEN H. BAGDIKIAN, *THE MEDIA MONOPOLY* 116–49 (1983).

¹⁰² See, e.g., *id.* at 115–19; MCALLISTER, *supra* note 1, at 39–52; Edwin Baker, *Advertising and a Democratic Press*, 140 U. PA. L. REV. 2097, 2139–68 (1992).

desirable recipients of advertising. As time goes by, commercial conglomerates discover more ways to use the media to convey their promotional messages. A good example is the practice of product placement mentioned above. This practice was still rare in the mid-1990s, but today nearly every movie, reality show, game show and sitcom includes product placement.¹⁰³ Many big advertisers invest considerable amounts in this marketing technique.¹⁰⁴ Product placement has no limits; media previously thought to be inappropriate for commercial marketing, such as novels and songs, are now losing their immunity.¹⁰⁵ Product placement has gradually expanded into newer types of media as well; it already embraces video games and Internet magazines, and is now proceeding into blogs and viral videos shared on sites such as YouTube.¹⁰⁶

This trend illustrates a more general tendency of placing promotional messages in every form of media. As soon as corporations discover the potential of a certain medium to attract an audience, they attempt to place their marketing messages on it. If the medium is especially successful, it is often purchased altogether. For example, in 1982 the Coca-Cola Company purchased Columbia Pictures,¹⁰⁷ and in 2006 Google Inc. purchased YouTube.¹⁰⁸

No mass communication medium is immune to marketing. The willingness of corporations to pay to place their promotional messages in a communication medium or to purchase the medium outright creates a new reality. Even if the medium previously existed without extensive financial support, such as was the case with YouTube, it is rather improbable that its owner would forgo the offered possibility of economic profit. In the world of capitalism and free market competition, every product ultimately reaches the one who values it the most, that is, the one is willing to pay the highest price for it.¹⁰⁹ Audience is a very precious product for corporations, which are interested in exposing potential consumers to their marketing. Corporations will always be able to translate

¹⁰³ See Lorne Manley, *On Television, Brands Go From Props to Stars*, Oct. 2, 2005, N.Y. TIMES, <http://www.nytimes.com/2005/10/02/business/yourmoney/02place.html> (last visited Nov. 1, 2008).

¹⁰⁴ See *id.*

¹⁰⁵ Scott Shagin & Matthew Savare, *Lawyering at the Intersection of Madison and Vine: It's About Brand Integration*, 23 ENT. & SPORTS LAW. 1, 32–34 (2005).

¹⁰⁶ Goodman, *supra* note 73, at 95.

¹⁰⁷ Snyder, *supra* note 73, at 304.

¹⁰⁸ *Google Buys YouTube for \$1.65bn*, BBC NEWS, Oct. 10, 2006, <http://news.bbc.co.uk/2/hi/business/6034577.stm> (last visited Oct. 28, 2008).

¹⁰⁹ See ANTHONY T. KRONMAN & RICHARD A. POSNER, *THE ECONOMICS OF CONTRACT LAW* 1–3 (1979).

this interest into money. Therefore, every communication medium that attracts an audience is almost inevitably destined to convey marketing messages.

As soon as a communication medium becomes sponsored or owned by its advertisers, commercial interests gradually gain control over its content. Corporations are increasingly becoming a powerful source of censorship in every medium they manage to put their hands on. For example, the Coca-Cola Company banned the use of 7-Up and Pepsi products in movies produced by Columbia Pictures shortly after purchasing the company.¹¹⁰ There has been at least one instance when a movie director was compelled to change a final scene to suit the visions of Reebok, the commercial sponsor that placed its products in the movie.¹¹¹ At times, corporations wishing to promote their products even initiate the creation of artistic projects. For example, in 2005 McDonald's began offering rewards to hip-hop artists who mentioned the Big Mac in their songs.¹¹² Nike even produced a boxing film to market its shoes.¹¹³ Since advertisers are almost always willing to pay high prices for their advertising in a given medium, they eventually have decisive influence over that medium's content. Therefore, the desire to promote commercial goods and services is gradually dictating the content of communication media in our society. Although the public has an obvious interest in preventing commercial entities from gradually taking over all communication media, existing law does not restrict the process of the commercialization of culture.

Marketing messages usually seek to create strong and meaningful trademarks. Thus, the need to create desirable associations with trademarks may dictate the development of a movie plot or a television series. Sometimes it can even be the primary purpose of producing a film or writing a song. Today it is hard to imagine how the desire to promote commercial goods and services will invade other cultural fields in the future. In sum, the process of creating meaningful trademarks has a deep influence on our cultural environment.

But what is the nature of that influence? Commercial corporations promote a certain ideology. To illustrate the essence of this ideology, consider two examples. In 1971 Janis Joplin released a song entitled "Mercedes Benz."¹¹⁴ In the song she asks the Lord to buy her a Mercedes Benz, a color TV and a

¹¹⁰ Snyder, *supra* note 73, at 304.

¹¹¹ Shagin & Savare, *supra* note 105, at 35.

¹¹² Angela J. Campbell, *Restricting the Marketing of Junk Food to Children by Product Placement and Character Selling*, 39 LOY. L.A. L. REV. 447, 454 (2006).

¹¹³ Goodman, *supra* note 73, at 96.

¹¹⁴ JANIS JOPLIN, *Mercedes Benz*, on PEARL (Columbia Records 1971).

night on the town.¹¹⁵ The song was written as social commentary on the fact that people relate happiness to consumption and material possessions. Ironically, in 1995 Mercedes Benz received a license from Janis Joplin's step-sister, who owned the rights to the song, to use it in its own commercial.¹¹⁶ Another example is the vagrant fashion style created by hippies in the 1960s. The style was meant to convey the counterculture group's antiestablishment beliefs, yet clothing manufacturers immediately adopted the style and presented it in advertising as a novelty in fashion.¹¹⁷ Corporations engaged in war contracts even adopted, for use in advertising, various symbols expressing the protest against the Vietnam War.¹¹⁸ By the early 1970s, much of the hippie style had already been integrated into mainstream American culture.

These examples demonstrate how commercial use can entirely distort the meaning of a cultural sign when the meaning clashes with commercial corporations' ideological visions. The strongest message of corporate ideology is the general endorsement of capitalist values, in particular that of consumer culture. Several big media sponsors have even formulated explicit rules that the media content must not bear any kind of critique on advertising, any critique of the consumer culture and, more generally, any negative claims concerning the capitalist world order.¹¹⁹ This commercial corporate ideology has already acquired a dominant position in our society; it is usually taken for granted and very rarely questioned. As more types of media fall into the hands of advertisers, these values will be ingrained deeper into our culture, making our society increasingly materialistic and consumption-oriented.

Thus, although commercial speech is not regarded as a primary subject of the First Amendment,¹²⁰ it is the type of speech that dominates our social and cultural discourse. This process is made possible by the logic of capitalism and the free-market economy: the divine right of capital¹²¹ has no limits. Those with capital can control or purchase whatever they wish. And when they wish to use every possible medium to promote commercial trademarks and the accompany-

¹¹⁵ *Id.*; A-Z Lyrics Universe, <http://www.azlyrics.com/lyrics/janisjoplin/mercedesbenz.html> (last visited Oct. 26, 2008).

¹¹⁶ The Pop History Dig, <http://www.pophistorydig.com/?p=66> (last visited Oct. 26, 2008).

¹¹⁷ BAGDIKIAN, *supra* note 101, at 189.

¹¹⁸ *Id.* at 190.

¹¹⁹ Baker, *supra* note 102, at 2149–52.

¹²⁰ *E.g.*, *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447, 456 (1978).

¹²¹ See MARJORIE KELLY, *THE DIVINE RIGHT OF CAPITAL: DETHRONING THE CORPORATE ARISTOCRACY* 56–58 (2001).

ing consumption ideology, there is hardly anything that can hamper the dominance of that ideology.

As time goes by, marketing techniques capture more and more of the space around us. Sidewalks, buildings, beaches and every place our eye naturally falls on can bear messages designed to make us remember certain trademarks. Marketing messages saturate our public space and constantly invade the private sphere. Some scholars have aptly compared commercial overload to air pollution.¹²² Current law, however, does not provide us with protection against the downpour of commercial messages. In fact, it is quite the contrary. Since commercial messages are regarded as “neutral,” they can reach us in places where political messages cannot, such as in situations with a “captive audience.”¹²³

The very omnipresence of promotional messages further endorses the commercial ideology. The more we are used to these messages, the more they seem to be a natural and indispensable part of our lives. Our environment, saturated with marketing, tells us implicitly that commercial messages have the legitimacy to reach us everywhere and to appear in every possible medium. We are made to know that the right of commercial conglomerates to shape our social and cultural landscape should be taken for granted. We become conditioned to the idea that consumption and marketing have the right to occupy a central place in our life.

IV. THE LAW OF TRADEMARKS

Part III of this article has shown that the law does not protect cultural signs against the commercialization and dilution of their meaning that occurs while they are exploited to build up meaningful trademarks. Part II has further shown that the current legal situation allows the commercial corporate ideology to acquire a dominant position in our cultural discourse. This part of the article focuses on trademarks themselves and will demonstrate that when cultural signs constitute commercial trademarks, the legal system does protect them, thus securing the dominance of the ideology of consumption.

¹²² E.g., Dennis D. Hirsch, *Protecting the Inner Environment: What Privacy Regulation Can Learn from Environmental Law*, 41 GA. L. REV. 1, 25 (2006).

¹²³ See *Lehman v. City of Shaker Heights*, 418 U.S. 298, 304 (1978). The Court upheld the city’s policy of selling advertising space on buses only to “innocuous and less controversial” commercial advertising but not to political advertising, reasoning that users of buses should not be “subjected to the blare of political propaganda.” *Id.*

The traditional purpose of trademark law is to protect the trademark as a symbol that identifies a single source of goods or services.¹²⁴ This purpose simultaneously serves two different interests: (1) protecting consumers against confusion and (2) allowing producers of goods or services to profit from the goodwill of their business. Trademark law allows consumers to use trademarks as “information chunks,” thereby lowering search costs;¹²⁵ and it encourages trademark owners to create and maintain a good reputation by providing consumers with goods or services of high quality.¹²⁶ In terms of the Q model, the primary purpose of trademark law is to protect the mental link between the trademarked sign and the goods or services of the trademark owner—the link identifying the owner as the origin of the respective goods or services.

As discussed above, trademark owners invest copious effort into creating additional cultural significance for their trademarks. Trademark owners attempt to link their trademarks to cultural signs, rather than strengthening the link between the trademark and their goods or services. As time goes by, trademark owners put more effort into the creation of a cultural significance for their brands and, to a certain extent, neglect the primary purpose of trademark law. Instead of attempting to strengthen their trademarks by improving the quality of their products or services, big corporations often invest more in advertising and other marketing techniques.¹²⁷

Trademark law seems to approve and encourage these developments by granting broad protection to the cultural meaning of trademarks; in other words, trademark law preserves the meaning created by their owners against alteration. This protection occurs as a result of three underlying factors: (1) a very broad interpretation of the consumer confusion test; (2) the protection of trademarks against dilution; and (3) a general tendency to regard a trademark right as a broad property right. Each factor will be discussed below.

A. *The Likelihood of Confusion Test*

The likelihood of consumer confusion as to the source of products or services is the keystone of trademark infringement¹²⁸—as the language of

¹²⁴ *Universal Studios, Inc. v. Nintendo Co., Ltd.*, 578 F. Supp. 911, 925 (S.D.N.Y. 1983).

¹²⁵ MCCARTHY, *supra* note 11, at § 2:5; Jacob Jacoby, *The Psychological Foundations of Trademark Law: Secondary Meaning, Genericism, Fame, Confusion and Dilution*, 91 TRADEMARK REP. 1013, 1024–25 (2001).

¹²⁶ MCCARTHY, *supra* note 11, at §§ 2:3–2:4.

¹²⁷ See VALÉRIE MEUNIER, 2157 – THEORY OF INDUSTRIAL ORGANIZATION I (2006), http://www.econ.au.dk/fag/2157/e06/Notes/Intro_Chap1.pdf.

¹²⁸ MCCARTHY, *supra* note 11, at § 2:8.

§ 1125(a)(1) of the Lanham Trademark Act (“Lanham Act”) confirms.¹²⁹ When interpreted narrowly, the likelihood of confusion test merely enables the trademark to fulfill its primary purpose: a designation of origin. Therefore, a narrow interpretation of the test preserves the semantic link identifying the trademark with the goods and services of its owner. As the following discussion will show, however, broad interpretation of this test has resulted in the protection of the semantic links between trademarks and various cultural signs, thereby actually creating and reinforcing a certain cultural reality.

1. Confusion as to the Source of a License

In the 1970s and 1980s, the question of whether an unauthorized decorative use of a trademark on merchandise constituted infringement was highly disputed. Some courts held that consumers who buy merchandise with certain insignia only wish to express their identification with a certain entity.¹³⁰ These courts determined that consumers did not reasonably expect that all merchandise bearing the name or the logo of a certain institution has necessarily been licensed by it.¹³¹ Besides, the same courts reasoned that consumers are usually indifferent to the question of the source of products and thus cannot be confused.¹³² Other courts expressed the opposite view: that consumers who purchase merchandise with such insignias wish to convey their identification with their favorite sports group, university or any other entity, and reasonably expect that such merchandise is authorized by the respective entity.¹³³ In the famous case *Boston Professional Hockey Ass’n, Inc. v. Dallas Cap & Emblem Manufacturing, Inc.*,¹³⁴ the court went so far as to state that the confusion requirement was met by the mere fact that consumers identify the symbols appearing on the sold merchandise as symbols of the hockey team.¹³⁵ The argument that there

¹²⁹ 15 U.S.C. § 1125(a)(1) (2006).

¹³⁰ Supreme Assembly, Order of Rainbow for Girls v. J. H. Ray Jewelry Co., 676 F.2d 1079, 1083 (5th Cir. 1982); Int’l Order of Job’s Daughters v. Lindeburg & Co., 633 F.2d 912, 918, 920 (9th Cir. 1980); see Bd. of Governors of the Univ. of N.C. v. Helpingstine, 714 F. Supp. 167, 172–73 (M.D.N.C. 1989).

¹³¹ See cases cited *supra* note 130.

¹³² E.g., Bd. of Governors of the Univ. of N.C., 714 F. Supp. at 173.

¹³³ Boston Athletic Ass’n v. Sullivan, 867 F.2d 22, 34 (1st Cir. 1989); Univ. of Ga. Athletic Ass’n v. Laite, 756 F.2d 1535, 1546–47 (11th Cir. 1985); Warner Bros. Inc. v. Gay Toys, Inc., 724 F.2d 327, 334 (2d Cir. 1983); Tuxedo Monopoly, Inc. v. Gen. Mills Fun Group, Inc., 648 F.2d 1335, 1336 (C.C.P.A. 1981).

¹³⁴ 510 F.2d 1004 (5th Cir. 1975).

¹³⁵ *Id.* at 1012.

must be confusion as to who *manufactured* the goods was unpersuasive to the court where the team's logo itself was the triggering mechanism for the sale of the goods.¹³⁶ Although this decision was harshly criticized in other decisions¹³⁷ and in the legal literature,¹³⁸ courts have increasingly accepted its logic.¹³⁹ The question has yet to be decided by the Supreme Court, but the logic underlying the court's decision has recently come to dominate legal practice.¹⁴⁰

The topic was considered in the relatively recent decision of *Texas Tech University v. Spiegelberg*.¹⁴¹ Texas Tech is a public, state-funded university.¹⁴² Over the years, Texas Tech developed various insignia that had come to be associated with the university as a whole and especially with its athletic program.¹⁴³ Texas Tech had registered its insignias as trademarks and had licensed them to be printed on different kinds of merchandise, receiving \$8 million in royalties per year.¹⁴⁴ The defendant, John Spiegelberg, sold unlicensed merchandise bearing the university's insignia.¹⁴⁵ The court found a likelihood of consumer confusion based on the assumption that the university's trademarks on the goods automatically signaled to the purchasing public that those products were officially licensed by the university.¹⁴⁶

¹³⁶ *Id.*

¹³⁷ *Int'l Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 918 (9th Cir. 1980); *Gen. Mills, Inc. v. Henry Regnery Co.*, 421 F. Supp. 359, 362 (N.D. Ill. 1976).

¹³⁸ *See, e.g.*, Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of the Trade Symbols*, 1982 WIS. L. REV. 158, 168 (1982); W.J. Keating, *Patches on the Trademark Law*, 67 TRADEMARK REP. 315, 315-17 (1977); Charles A. Laff & Larry L. Saret, *Further Unraveling of Sears-Compc: Of Patches, Paladin and Laurel and Hardy*, 66 TRADEMARK REP. 427, 443-45 (1976).

¹³⁹ *E.g.*, *Boston Athletic Ass'n v. Sullivan*, 867 F.2d 22, 33-34 (1st Cir. 1989); *Univ. of Ga. Athletic Ass'n v. Laite*, 756 F.2d 1535, 1546 (11th Cir. 1985); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204 (2d Cir. 1979).

¹⁴⁰ *Tex. Tech Univ. v. Spiegelberg*, 461 F. Supp. 2d 510, 520 (N.D. Tex. 2006); *see* *AUDI AG v. D'Amato*, 469 F.3d 534, 543 (6th Cir. 2006); *Gen. Motors Corp. v. Lanard Toys, Inc.*, 468 F.3d 405, 413-14 (6th Cir. 2006); *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1076-77 (9th Cir. 2006); *Bd. of Supervisors of the La. State Univ. v. Smack Apparel Co.*, 438 F. Supp. 2d 653, 658-61 (E.D. La. 2006).

¹⁴¹ 461 F. Supp. 2d 510 (N.D. Tex. 2006).

¹⁴² *Id.* at 515.

¹⁴³ *Id.*

¹⁴⁴ *Id.* at 516.

¹⁴⁵ *Id.*

¹⁴⁶ *Id.* at 520.

The court believed one factor weighed heavily in favor of the university: the strength of its trademarks.¹⁴⁷ Traditionally, a trademark is considered to be strong when it indicates, for a large number of consumers, that the goods or services originate with the trademark owner.¹⁴⁸ A strong trademark is entitled to a higher level of protection under trademark law, since its strength is a factor in determining the likelihood of consumer confusion.¹⁴⁹

In *Texas Tech University*, the court equated the fame of the university and its athletic program with the strength of its trademarks.¹⁵⁰ Since football fans all over the nation were familiar with the trademarks, their strength was undeniable.¹⁵¹ Yet these are two distinct issues. The fact that the university and its sports teams are famous may, at most, lead to the conclusion that it has established strong trademarks for educational services and athletic programs. The university's fame, however, does not lead to the conclusion that consumers recognize it as the source of the merchandise.

But above all, the fame of the university's trademarks indicates that they are strong cultural signs. In terms of the Q model, there are two distinct links connecting the university to its signs—one points at the university as the origin of the strong cultural meaning of the signs, while the other presents the university as the origin that licenses the goods bearing those signs. Equating these two meanings, the *Texas Tech University* decision actually stated that private owners of strong cultural signs are entitled to extensive protection under trademark law.¹⁵² In doing so, the court suggested a very broad interpretation of the following question: What kind of an associative link between the trademark and its owner is necessary in order to be protected by trademark law?

The view that consumers necessarily perceive famous institutions as the origin of merchandise bearing their insignia was expressed in numerous other decisions.¹⁵³ This view implicitly encourages owners of cultural signs to regard the signs as economic assets, designed to bring commercial profit. According to this logic, any meaningful cultural sign that can be attributed to a currently ex-

¹⁴⁷ *Id.* at 521.

¹⁴⁸ McCARTHY, *supra* note 11, at § 11:73.

¹⁴⁹ *Id.* § 11:78.

¹⁵⁰ *Tex. Tech Univ.*, 461 F. Supp. 2d at 521.

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ *E.g.*, *Boston Athletic Ass'n v. Sullivan*, 867 F.2d 22, 34 (1st Cir. 1989); *Univ. of Ga. Athletic Ass'n v. Laite*, 756 F.2d 1535, 1546–47 (11th Cir. 1985); *Bd. of Supervisors of the La. State Univ. v. Smack Apparel Co.*, 438 F. Supp. 2d 653, 658–61 (E.D. La. 2006); *R & R Partners, Inc. v. Tovar*, 447 F. Supp. 2d 1141, 1152 (D. Nev. 2006).

isting organization, living or recently deceased individual should be viewed as private property and a potential source of income. For instance, a wide variety of government entities have begun to believe just that. In one case, the Las Vegas Convention and Visitors Authority was found to have a strong trademark—the nationally recognized slogan “What Happens Here Stays Here,” used to promote Las Vegas as a tourist destination.¹⁵⁴ In another case, the court found a defendant who was using the trademarked image of the subway station “Smith Street” to be profiting unfairly from the goodwill of the Metropolitan Transportation Authority.¹⁵⁵ In many cases, courts have especially noted the advertising efforts of trademark owners, as well as the licensing revenues the owners received, to further support the conclusion that strong trademarks had been established which are entitled to extensive protection.¹⁵⁶ In contrast, one court refused to protect the names of two historic sites in California as trademarks because the State of California had not proven substantial commercial use.¹⁵⁷

This line of judicial reasoning not only approves of, but encourages, the practice of the commercialization of cultural signs. Moreover, it specifically encourages the legal owners of cultural signs to invest money and effort in establishing and strengthening the link between themselves and the signs that represent them—the link that identifies them as the origin of commercial merchandise. That is, the law explicitly encourages owners of cultural signs to make consumers regard them not only as universities, cultural authorities and so forth, but also as businesspeople capitalizing on the fame of their cultural signs. As explained above, such practices have a substantial dilutive effect on the meaning of these signs.

Another noteworthy practice is the merchandising of film and cartoon characters. Since merchandise has the potential to bring even higher profits than the artistic work itself,¹⁵⁸ films and cartoons are often made with the goal of

¹⁵⁴ *R & R Partners, Inc.*, 447 F. Supp. 2d at 1151–52.

¹⁵⁵ *Metro. Transp. Auth. v. 476 Smith St. Corp.*, No. 403518/05 (N.Y. Sup. Ct. 2006), available at http://decisions.courts.state.ny.us/fcas/FCAS_docs/2006MAY/30040351820053SCIV.PDF.

¹⁵⁶ *Bd. of Supervisors of the La. State Univ.*, 438 F. Supp. 2d at 658; *R & R Partners*, 447 F. Supp. 2d at 1151; *Tex. Tech. Univ.*, 461 F. Supp. 2d at 516.

¹⁵⁷ *Dep't of Parks & Recreation for Cal. v. Bazaar Del Mundo Inc.*, 448 F.3d 1118, 1125 (9th Cir. 2006).

¹⁵⁸ See, e.g., Benjamin A. Goldberger, *How the “Summer of the Spinoff” Came to Be: The Branding of Characters in American Mass Media*, 23 LOY. L.A. ENT. L. REV. 301, 345–47 (2003); Paul Goldstein, *Derivative Rights and Derivative Works in Copyright*, 30 J. COPYRIGHT SOC'Y U.S. 209, 209 (1983); Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199, 213 (2002).

creating a market for merchandise.¹⁵⁹ The need to consider this goal can significantly influence the content of the artistic work.¹⁶⁰ To make a good profit from the sale of merchandise, the projects must be extremely popular. Striving for popularity pressures the entertainment industry to appeal to the lowest common denominator among the various public tastes, resulting in shallow content.¹⁶¹ The desire to profit from merchandise, among other things, often demands a change in the plot of classic works in order to produce blockbusters. Often a tragic finale must be swapped for a happy ending.¹⁶² The commercial demand for maximum popularity gives every work an identical gloss, an impression of being like every other work in the genre. Consider, for example, the tragic story of the Little Mermaid by Hans Christian Andersen¹⁶³ and the morals taught in the folk tale of Snow White, both turned into essentially exchangeable products by the Walt Disney Company.¹⁶⁴ By recognizing trademark rights in the merchandise of films and cartoons, the law implicitly discourages creation of these types of projects as distinctive and meaningful cultural signs, further contributing to the dilution of culture.

In cases involving unlicensed merchandise, an additional factor that courts consider to establish a likelihood of consumer confusion is the degree of consumer care. A generally accepted rule in trademark law is that the more carelessly the consumer chooses the product, the greater the chance similar trademarks are likely to cause confusion.¹⁶⁵ In other words, when choosing a new car, a consumer will usually pay attention even to relatively small differences in trademarks—like the difference between “Honda” and “Hyundai.” However, since the same degree of consumer care cannot be expected in the field of everyday goods, confusion is more readily assumed in these areas.

¹⁵⁹ Naomi Abe Voegtli, *Rethinking Derivative Rights*, 63 BROOK. L. REV. 1213, 1241–44 (1997).

¹⁶⁰ *Id.* at 1242.

¹⁶¹ For a discussion of the impact of striving for popularity on artistic works, see ADORNO & HORKHEIMER, *supra* note 1, at 120–67; Thomas F. Cotter, *Memes and Copyright*, 80 TUL. L. REV. 331, 395–97 (2005); Mark S. Nadel, *How Current Copyright Law Discourages Creative Output: The Overlooked Impact of Marketing*, 19 BERKELEY TECH. L.J. 785, 797–803 (2004).

¹⁶² *E.g.*, THE LITTLE MERMAID (Disney 1989).

¹⁶³ In the end of the original version of the fairy tale, the Little Mermaid throws herself into the sea and turns into sea foam after the Prince marries another woman. HANS CHRISTIAN ANDERSEN, THE LITTLE MERMAID (1836), *reprinted in* 2 HANS ANDERSEN'S FAIRY TALES 177 (J.H. Stickney ed., 1915).

¹⁶⁴ THE LITTLE MERMAID (Disney 1989); SNOW WHITE AND THE SEVEN DWARFS (Disney 1937).

¹⁶⁵ *See, e.g.*, Playboy Enters., Inc. v. Netscape Commc'ns Corp., 354 F.3d 1020, 1028 (9th Cir. 2004); Rosenthal A.G. v. Ritelite, Ltd., 986 F. Supp. 133, 145 (E.D.N.Y. 1997); Great Basin Brewing Co. v. Healdsburg Brewing Co., 44 U.S.P.Q.2d (BNA) 1751, 1755 (D. Nev. 1997).

Courts often assume that consumers are not likely to be careful when purchasing merchandised goods and regard this factor as weighing in favor of establishing consumer confusion.¹⁶⁶ However, courts tend to disregard the fact that consumer carelessness in such cases is often the result of indifference. Even if we assume that some consumers wish to purchase authorized merchandise in order to financially support their favorite organizations, this is certainly not always the case. For instance, in *Texas Tech University* the court remarked that “[t]he licensed items and the unlicensed items have an identical commercial effect: to serve as outward signs of support for Texas Tech University.”¹⁶⁷ Furthermore, “shoppers who purchase both licensed and unlicensed products are cut from the same cloth.”¹⁶⁸ This did not lead the court, however, to question the importance consumers really place on the existence of a license. Instead, quite ironically, the low degree of consumer care in this case, and in many similar cases,¹⁶⁹ was eventually a factor that made protection against confusion especially extensive!

Even if we assume that consumers consider whether merchandise is officially licensed when making a purchase, the main problem is that the legal system is responsible for educating them on this issue. The more courts presume that consumers expect every use of a trademark to be licensed and condemn unlicensed uses, the more this presumption will become a reality.¹⁷⁰ Before assuming that disclaimers will have little effect on the careless consumer, the courts should ask themselves what kind of public perception they wish to promote—what they think the consumers *should* believe. The current line of jurisprudence educates the public to believe that any decorative use of a trademark—and a trademark may be any cultural sign attributable to an existing organization or individual—must be authorized. This jurisprudence promotes the view that the signs of modern culture are private possessions and sources of economic gain for their owners.

This judicial practice endorses the public’s perception that anyone who acquires merchandise bearing a certain entity’s insignia in order to express admiration for or self-identification with that entity, can do so only through offi-

¹⁶⁶ AUDI AG v. D’Amato, 469 F.3d 534, 544 (6th Cir. 2006); Gen. Motors Corp. v. Lanard Toys, Inc., 468 F.3d 405, 413 (6th Cir. 2006); Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc., 457 F.3d 1062, 1076 (9th Cir. 2006); Mutual of Omaha Ins. Co. v. Novak, 836 F.2d 397, 401 (8th Cir. 1987).

¹⁶⁷ Tex. Tech Univ. v. Spiegelberg, 461 F. Supp. 2d 510, 521 (N.D. Tex. 2006).

¹⁶⁸ *Id.*

¹⁶⁹ See cases cited *supra* note 166.

¹⁷⁰ See MCCARTHY, *supra* note 11, at § 24:9; Denicola, *supra* note 11, at 1668; Lemley, *supra* note 11, at 1708.

cial channels established by the entity and must pay the fee the entity charges its fans. Empirical evidence confirms that consumers actually believe that merchandise must always be licensed.¹⁷¹ With the passage of time, society finds it more natural and unquestionable that a vast number of cultural signs may be privately possessed and that their creators or owners may exclusively control their distribution. As some early cases demonstrate, however, the current line of jurisprudence is not the only possible way to interpret existing trademark law.¹⁷² The public's perception that private entities can possess cultural signs would probably vanish if courts stop considering confusion relating to the existence of license for trademark merchandise as a substantial basis for establishing infringement.

2. Post-Sale Confusion

Post-sale confusion occurs when the consumer knowingly acquires an imitation of a trademarked product.¹⁷³ The initial consumer, however, is not the one confused; when she uses the imitation, other people are confused in that they are likely to believe that she has the genuine product. This confusion is not the traditional subject matter of trademark protection—the trademark is primarily designed to prevent the confusion of the buying consumer. However, post-sale confusion is increasingly regarded as sufficient to raise liability for trademark infringement.¹⁷⁴ In other words, today a consumer cannot buy a fake Rolex watch,¹⁷⁵ a fake pair of Reebok shoes¹⁷⁶ or a fake pair of Levi jeans,¹⁷⁷ even if she intentionally wishes to purchase the counterfeit. The restriction of post-sale confusion is generally justified by the injury caused to the trademark owner's goodwill when a prospective purchaser mistakenly takes the counterfeit for the genuine product and attributes its inferior quality to the trademark owner.¹⁷⁸ In 1962, Congress amended the Lanham Act, eliminating “purchasers” from the

¹⁷¹ In 1983, a survey showed that 91.2% of the people interviewed thought that an owner of a name or character had to give permission before a product could bear his name. MCCARTHY, *supra* note 11, at § 10:43.

¹⁷² See cases cited *supra* note 130.

¹⁷³ MCCARTHY, *supra* note 11, at § 23:7.

¹⁷⁴ *Id.*

¹⁷⁵ *United States v. Torkington*, 812 F.2d 1347, 1349, 1353 (11th Cir. 1987); *Rolex Watch U.S.A., Inc. v. Canner*, 645 F. Supp. 484, 488 (S.D. Fla. 1986).

¹⁷⁶ *Payless Shoesource, Inc. v. Reebok Int'l, Ltd.*, 998 F.2d 985, 989 (Fed. Cir. 1993).

¹⁷⁷ *Levi Strauss & Co. v. Blue Bell, Inc.*, 632 F.2d 817, 821–22 (9th Cir. 1980).

¹⁷⁸ *E.g.*, *Gen. Motors Corp. v. Keystone Auto. Indus., Inc.*, 453 F.3d 351, 358 (6th Cir. 2006); *Payless Shoesource*, 998 F.2d at 989; *Rolex Watch U.S.A.*, 645 F. Supp. at 495.

language dealing with consumer confusion, which was found in its original version.¹⁷⁹ Courts have regarded this amendment as an expansion of the scope of trademark infringement to include confusion of non-purchasers and as an explicit codification of the post-sale confusion doctrine.¹⁸⁰

Courts often note that the widespread existence of knock-offs may diminish the high value of the original, which comes in part from the original's rarity.¹⁸¹ This is true. The existence of knock-offs can undoubtedly lessen the cultural meaning of a prestigious trademark. The question is, however, why the legal system should cooperate with trademark owners in their effort to create ideal cultural symbols out of their trademarks. More importantly, the courts should ask themselves whether "licensed" reality is the type of reality they wish to create. Wearing a fake Rolex watch may suggest a certain meaning. It may be a way to express protest against the prestigious image of the original, to mock it, to question its authority or to blur its distinctiveness. It is hard to express in words the cultural message that knock-offs express, but they are certainly a type of cultural expression.¹⁸² This expression alters the cultural meaning of the trademark and thus constitutes "aesthetic text"; in other words, the expression constitutes an act of communication that questions social conventions concerning the widely accepted meaning of cultural signs.¹⁸³ When all is said and done, even those who buy knock-offs with the intent to make others believe that they have the original are shaking up the authoritarian status of trademarks in our society. By forbidding the sale of non-confusing counterfeit merchandise, the legal system is actually protecting the cultural meaning of trademarks. The legal system acts to preserve the notions of prestige, rarity, solemnity and authority incorporated in the original goods due to the marketing efforts of their owners. This legal practice is undesirable. However, given the amended lan-

¹⁷⁹ 15 U.S.C. § 1114(1)(a) (2006); see S. REP. NO. 87-2107, at 4 (1962), as reprinted in 1962 U.S.C.C.A.N. 2844, 2847.

¹⁸⁰ See, e.g., *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1077 (9th Cir. 2006); *Insty*Bit, Inc. v. Poly-Tech Indus., Inc.*, 95 F.3d 663, 671–72 (8th Cir. 1996); *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 716 (Fed. Cir. 1992); *Esercizio v. Roberts*, 944 F.2d 1235, 1244–45 (6th Cir. 1991).

¹⁸¹ See, e.g., *Gen. Motors Corp.*, 453 F.3d at 358; *Hermès Int'l v. Lederer de Paris Fifth Ave., Inc.*, 219 F.3d 104, 108 (2d Cir. 2000); *Acad. of Motion Picture Arts & Scis. v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1457 (9th Cir. 1991); *Esercizio*, 944 F.2d at 1245.

¹⁸² The fact that producers of counterfeit goods usually have a purely commercial motivation should not make any difference, since they provide the consumers with the means of expression.

¹⁸³ See *ECO*, *supra* note 16, at 261–76.

guage of the Lanham Act, this practice might be difficult to substantially change without changing the legislation.

3. Initial Interest Confusion in the Context of the Internet

Another trend in trademark law that helps trademark owners to pin cultural meaning to their trademarks is the doctrine of initial interest confusion as applied to domain names on the Internet. This doctrine is complimented by the Anticybersquatting Consumer Protection Act (“ACPA”), which is specifically designed to prevent trademark piracy on the Internet.¹⁸⁴ The Internet is a relatively uncontrolled medium of communication that is more likely to carry messages opposing corporate ideology than are television, radio, press and other sponsored media. Indeed, a number of sites contain negative commentary on various trademarks.¹⁸⁵ The courts, naturally, do not regard such commentary as trademark infringement or as a violation of the ACPA.¹⁸⁶

A more interesting issue arises when a site containing information antithetical to the values embedded in a certain trademark uses a domain name that consists of the trademark, sometimes including additional words, in a manner that does not immediately explain the site’s content.¹⁸⁷ Although the jurisprudence concerning such cases is somewhat contradictory,¹⁸⁸ the dominant view is that such use constitutes trademark infringement.¹⁸⁹ For example, the domain

¹⁸⁴ S. REP. NO. 106-140, at 4 (1999).

¹⁸⁵ See, e.g., McSucks.com Homepage, <http://www.mcsucks.com> (last visited Sept. 15, 2008); Boycott Nike Home Page, <http://www.saigon.com/~nike> (last visited Sept. 15, 2008); I Hate Microsoft.com The Official Place to Hate Microsoft, <http://www.ihatemicrosoft.com> (last visited Sept. 15, 2008).

¹⁸⁶ See, e.g., TMI, Inc. v. Maxwell, 368 F.3d 433, 439–40 (5th Cir. 2004); Mayflower Transit, LLC v. Prince, 314 F. Supp. 2d 362, 369 (D. N.J. 2004); Ford Motor Co. v. 2600 Enters., 177 F. Supp. 2d 661, 665 (E.D. Mich. 2001); Bally Total Fitness Holding Corp. v. Faber, 29 F. Supp. 2d 1161, 1163–64 (C.D. Cal. 1998).

¹⁸⁷ Cases of pure “cybersquatting”—that is, registering a famous trademark as a domain name for the sole purpose of selling it to the trademark owner—will not be discussed here. In such cases, it is evident that there is no justification for protecting the cybersquatter, who has no expressive motivation and thus, is of no interest to the current discussion.

¹⁸⁸ *Lamparello v. Falwell*, 420 F.3d 309, 315 (4th Cir. 2005), *Lucas Nursery & Landscaping, Inc. v. Grosse*, 359 F.3d 806, 811 (6th Cir. 2004) and *CPC Int’l, Inc. v. Skippy Inc.*, 214 F.3d 456, 461–63 (4th Cir. 2000) are examples of cases that stray from the general line of jurisprudence.

¹⁸⁹ See, e.g., *Faegre & Benson, LLP v. Purdy*, 129 F. App’x 323, 324–25 (8th Cir. 2005); *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 364–66 (4th Cir. 2001); *Int’l Profit Assocs., Inc. v. Paisola*, 461 F. Supp. 2d 672, 676–77 (N.D. Ill. 2006); *E. & J. Gallo Winery v. Spider Webs Ltd.*, 129 F. Supp. 2d 1033, 1041–42 (S.D. Tex. 2001); OBH,

name thebuffalonews.com, used for a site that aimed to parody and criticize the newspaper “The Buffalo News,” was held to create a likelihood of confusion.¹⁹⁰ Similar conclusions were reached concerning the domain name plannedparenthood.com for a site expressing anti-abortion views that stood in sharp contrast to the views of Planned Parenthood¹⁹¹ and the domain name jewsforjesus.org for a site persuading Jews not to follow the “Jews for Jesus” organization and to stay Jewish rather than becoming Christian.¹⁹²

Cases of this nature followed the doctrine of initial interest confusion even though courts have not always explicitly mentioned the doctrine.¹⁹³ According to the initial interest confusion doctrine, trademark infringement occurs not only when the consumer is confused about a product’s source at the time of purchase, but also when a confusing use of the trademark causes the consumer to take an interest in a product that originates from a source other than the trademark owner.¹⁹⁴ In the context of the Internet, when users type in a trademark as a domain name, courts have assumed that the users expect to arrive at the trademark owner’s official site, because domain names generally signify the source of the website. Therefore, courts have concluded that the users who arrive at a different site are confused.¹⁹⁵ Although both the Lanham Act and the ACPA prevent only commercial use of a trademark,¹⁹⁶ this requirement is sometimes given such broad interpretation that virtually any site using someone’s trademark as its domain name can satisfy the requirements.¹⁹⁷ In such cases, the mere fact that the defendant’s Internet site was likely to cause commercial harm

Inc. v. Spotlight Magazine, Inc., 86 F. Supp. 2d 176, 190–91 (W.D.N.Y. 2000); Planned Parenthood Fed’n of Am. Inc. v. Bucci, 42 U.S.P.Q.2d (BNA) 1430, 1438 (S.D.N.Y. 1997).

¹⁹⁰ *OBH*, 86 F. Supp. 2d at 190–91.

¹⁹¹ *Planned Parenthood*, 42 U.S.P.Q.2d at 1432, 1441.

¹⁹² *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 301–05 (D.N.J. 1998); *see also E. & J. Gallo Winery*, 129 F. Supp. 2d at 1041–42 (domain name ernestandjulioallo.com was used for a site containing information about the risks of alcohol, which clearly contradicted the philosophy of the winery “Ernest and Julio Gallo”).

¹⁹³ *See, e.g., People for the Ethical Treatment of Animals*, 263 F.3d at 365–66; *Int’l Profit Assocs.*, 461 F. Supp. 2d at 677; *OBH*, 86 F. Supp. 2d at 190.

¹⁹⁴ McCARTHY, *supra* note 11, at § 23:6.

¹⁹⁵ *People for the Ethical Treatment of Animals*, 263 F.3d at 365; *Int’l Profit Assocs.*, 461 F. Supp. 2d at 677; *E. & J. Gallo Winery*, 129 F. Supp. 2d at 1043; *OBH*, 86 F. Supp. 2d at 190.

¹⁹⁶ 15 U.S.C. §§ 1125(a)(1), (c)(1), (d)(1)(A)(i) (2006).

¹⁹⁷ For a prominent example of this tendency, see *Coca-Cola Co. v. Purdy*, 382 F.3d 774, 784–87 (8th Cir. 2004). The court found that using famous trademarks as domain names in order to attract attention to the defendant’s anti-abortion sites was clearly made with a bad faith intent to profit, defining profit not just in its monetary sense. *Id.*

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to the plaintiff's business was enough to satisfy the commercial use requirement.¹⁹⁸

Of course, users who type in a trademark as a domain name are generally looking for the trademark owner's site. Those same people, however, are also the primary target audience of sites containing information antithetical to the values endorsed by the trademark owner. Allowing the trademark to be used as a domain name for such sites could increase public awareness about any criticism and controversy surrounding the values represented by the mark, which would allow discourse concerning the cultural meaning of trademarks to flow freely. Initial interest confusion in such cases does not have any serious consequences to the Internet user who is free to immediately leave the site. To draw a comparison, advertising usually reaches consumers when they are primarily interested in something else, yet the legitimacy of this practice is taken for granted. Unfortunately, courts do not see the potential usefulness of allowing a trademark to be used as the domain name for a site criticizing the trademark owner. On the contrary, courts often consider the offender's attempt to reach the trademark owner's audience as a factor weighing heavily in favor of establishing a likelihood of confusion and trademark infringement.¹⁹⁹

Courts primarily regard the Internet as a shopping mall and its users as consumers. This assumption helps secure the central position of consumption in our culture. In addition, this assumption contributes to the preservation of a reality where the cultural meaning of trademarks is under the strict control of their owners. Courts should narrowly interpret the "commercial use" requirement found in the Lanham Act and the ACPA and should not regard every expression connected to trademarks as pure "commerce." Courts should perceive the Internet as an area primarily designed for the exchange of ideas, not for shopping, and understand the importance of exposure to messages antithetical to the values embedded in the mark, even for loyal trademark consumers. If this exposure is allowed, another "unlicensed reality" can emerge within the context of the Internet—a reality where trademarks do not have fixed cultural meanings and where Internet users who type in a trademark as a domain name do not know for certain where they will land.

¹⁹⁸ *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 307–08 (D. N.J. 1998); *Planned Parenthood Fed'n of Am. Inc. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430, 1436 (S.D.N.Y. 1997).

¹⁹⁹ *Jews for Jesus*, 993 F. Supp. at 305; *Planned Parenthood*, 42 U.S.P.Q.2d (BNA) at 1438.

4. The Likelihood of Confusion Test & the “Licensed” Reality

The assumptions discussed above—that consumers expect all merchandised products to be licensed, that prospective purchasers presume the products used by other people are genuine and that trademarks as Internet domain names must be the official site of its owner—are only a few examples of the way the mechanism of consumer confusion can be used to construct a “licensed” reality.

What is curious about trademark law is that, while it is intended only to protect consumer beliefs, it actually acts to generate them.²⁰⁰ The generation of consumer beliefs occurs because a likelihood of confusion can be established by demonstrating that a relatively small portion of the consuming public—about ten to fifteen percent—is *actually* confused.²⁰¹ When courts enjoin the use of a trademark based on a view of the minority of the consuming public, the minority view becomes reality and, over time, the rest of the consuming public learns to accept it. Thus, trademark law has a built-in mechanism that turns it into an educational tool that constructs the reality according to the views of a minority group. And, of course, only one type of minority view becomes reality based on trademarks—the view that assumes the use of a trademark in a certain way requires the permission of its owner.

This structure provides a mechanism that has the potential to indefinitely expand the scope of trademark protection. Once a trademark use is enjoined due to the beliefs of a small group of consumers, the consuming public becomes aware of that view and gradually assimilates that view as its own. When the minority view becomes generally accepted, other minority groups can believe that an even more distant use of a trademark requires the owner’s authorization. When this occurs, this view will become a reality as well through the mechanism of consumer confusion.

The mechanism of consumer confusion actually turns trademark law into a mechanism for creating a “licensed” reality by educating the consuming public to accept that particular reality. In a “licensed” reality, people believe that communication through trademarks is always controlled by trademark owners and is never generated from other sources. In this reality, every product bearing a trademark originates with the trademark owner—there are no counter-

²⁰⁰ For literature discussing this phenomenon, see *supra* notes 11–12.

²⁰¹ See, e.g., *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 400–01 (8th Cir. 1987); *James Burrough Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 279 (7th Cir. 1976); *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 365 F. Supp. 707, 716 (S.D.N.Y. 1973); *Humble Oil & Ref. Co. v. Am. Oil Co.*, 259 F. Supp. 559, 564 (E.D. Mo. 1966).

feits. The major problem with the “licensed” reality currently endorsed by the law is that such a reality promotes a dictatorial status for trademarks.

The concept of consumer confusion, together with the tendency to register every possible sign as a trademark, allows currently existing entities to protect the cultural meaning of their signs. Such protection is not granted to non-trademarked cultural signs or to signs that cannot be attributed to any specific entity. For example, while the radical racist Ku Klux Klan group is allowed to use the symbol of a cross—a symbol generally associated with the church—another group with very similar views was enjoined from using the name “Church of the Creator,” which had already been registered to a religious organization.²⁰² While there are numerous cafés named after Mozart, the owner of a sixties-themed nightclub was enjoined from using the name “Velvet Elvis” without the permission of Elvis Presley’s heirs.²⁰³ While everybody is free to sell copies of the Statue of Liberty, selling replicas of the Oscar statuette was found to infringe on the rights of the Academy of Motion Picture Arts and Sciences.²⁰⁴ This legal situation creates a reality where many cultural signs are controlled by trademark owners and their meaning is not subject to free interpretation. This is a reality of a single, officially-licensed meaning of cultural signs deprived of any underground interpretation.

B. The Doctrine of Dilution

The above discussion showed how the concept of consumer confusion in trademark law actually functions as a mechanism for preserving the “licensed” meaning of trademarks. An even more troubling aspect of trademark law, however, is the doctrine of dilution, which protects trademarks when *no* likelihood of consumer confusion exists. Unlike traditional trademark protection, the dilution doctrine is not motivated by consumer interest but solely by the trademark owner’s interest in protecting the uniqueness and distinctiveness of their trademarks from gradually whittling away.²⁰⁵ In other words, this doctrine is explicitly designed to preserve the cultural value of trademarks.

²⁰² TE-TA-MA Truth Found.-Family of Uri v. World Church of the Creator, 297 F.3d 662, 663, 667 (7th Cir. 2002).

²⁰³ Elvis Presley Enters., Inc. v. Capece, 141 F.3d 188, 207 (5th Cir. 1998).

²⁰⁴ Acad. of Motion Picture Arts & Scis. v. Creative House Promotions, Inc., 944 F.2d 1446, 1457 (9th Cir. 1991).

²⁰⁵ MCCARTHY, *supra* note 11, at § 24:70; see Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 830–33 (1927).

The Dilution of Culture and the Law of Trademarks

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The doctrine of dilution was first introduced in the United States in the late 1920s.²⁰⁶ Since then the doctrine has gradually taken roots and increasingly expanded its scope in federal and state law.²⁰⁷ Although severely criticized,²⁰⁸ the doctrine has overcome any political and academic opposition and has eventually found its way into the hearts of judges and legislators.

The concept of dilution was codified in the federal law as late as 1996.²⁰⁹ Ten years later, Congress substantially reviewed the Federal Dilution Protection Act, enacting the Trademark Dilution Revision Act of 2006 (“TDRA”).²¹⁰ The main purpose of the revision was to overturn the Supreme Court’s decision in *Moseley v. V Secret Catalogue, Inc.*,²¹¹ which gave a rather narrow interpretation to the federal anti-dilution law.²¹² Specifically, the Court stated that a federal anti-dilution claim requires a showing of actual dilution.²¹³ The TDRA replaced this requirement with the less burdensome standard of “likelihood of dilution,”²¹⁴ which was explicitly rejected in *Moseley*. Although legal scholars have evaluated the overall effect of the TDRA differently, the majority of them seem to share the view that the TDRA has expanded, rather than narrowed, the scope of trademark protection.²¹⁵ This view is supported by

²⁰⁶ MCCARTHY, *supra* note 11, at § 24:67.

²⁰⁷ For the historical development of the doctrine, see Robert N. Klieger, *Trademark Dilution: The Whittling Away of the Rational Basis for Trademark Protection*, 58 U. PITT. L. REV. 789, 795–851 (1997).

²⁰⁸ See, e.g., Ralph S. Brown, Jr., *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 YALE L.J. 1165, 1191–94 (1948); Denicola, *supra* note 11, at 1664–67; Walter J. Derenberg, *The Problem of Trademark Dilution and the Antidilution Statutes*, 44 CAL. L. REV. 439, 448–81 (1956); Brian A. Jacobs, *Trademark Dilution on the Constitutional Edge*, 104 COLUM. L. REV. 161 (2004); Klieger, *supra* note 207, at 860–63. See generally Jonathan E. Moskin, *Dilution or Delusion: The Rational Limits of Trademark Protection*, 83 TRADEMARK REP. 122 (1993) (providing historical background criticism of the dilution doctrine).

²⁰⁹ MCCARTHY, *supra* note 11, at § 24:67.

²¹⁰ *Id.*

²¹¹ 537 U.S. 418 (2003).

²¹² See *id.* at 432–34.

²¹³ *Id.* at 434.

²¹⁴ 15 U.S.C. § 1125(c)(1) (2006). The Supreme Court had explicitly rejected this interpretation. *Moseley*, 537 U.S. at 434.

²¹⁵ E.g., Robert G. Bone, *A Skeptical View of the Trademark Dilution Revision Act*, 11 INTELL. PROP. L. BULL. 187, 187–88, 198 (2007); Jesse A. Hofrichter, *Tool of the Trademark: Brand Criticism and Free Speech Problems with the Trademark Dilution Revision Act of 2006*, 28 CARDOZO L. REV. 1923, 1939–40 (2007); see, e.g., ALEXANDER LINDEY & MICHAEL LANDAU, *LINDEY ON ENTERTAINMENT, PUBLISHING AND THE ARTS* § 2.52.50 (3d ed. 2008); MCCARTHY, *supra* note 11, at § 24:128; Brian W. Esler, *The Dilution Debate: A New Feder-*

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the legislative history of the TDRA.²¹⁶ Among other things, the TDRA codified the two branches of the dilution doctrine, “blurring” and “tarnishment,” which will be discussed below.²¹⁷

1. Dilution by Blurring

“Her mind is [T]iffany-twisted.”²¹⁸

Dilution by blurring occurs when a well-known trademark is used for goods substantially different from those for which it is known.²¹⁹ Hypothetical examples of blurring include Dupont shoes, Buick aspirin and Kodak pianos.²²⁰ Because of the substantial difference between the goods of the trademark owner and those of the unlicensed user, blurring does not cause consumer confusion. However, the mere fact that the trademark ceases to be associated exclusively with its owner dilutes its distinctiveness.

It is interesting to examine the already mentioned *Moseley* decision. The defendants used the name “Victor’s Little Secret” for a retail store selling adult videos and sex toys.²²¹ The plaintiff, the owner of the famous “Victoria’s Secret” trademark for women’s lingerie and apparel, claimed that the defendants diluted its mark by blurring.²²² The plaintiff brought evidence of an army officer who was offended by the advertisement of “Victor’s Little Secret.”²²³ The Court denied the dilution claim, holding that not every mental association with a famous trademark will necessarily blur it.²²⁴ The Court noted that the army officer did make the mental association between “Victor’s Little Secret” and “Victo-

al Law Gives Extra Protection to Famous Trademarks, 50 *ADVOCATE (IDAHO)* 18, 18–19 (2007).

²¹⁶ See *Trademark Dilution Revision Act of 2005: Hearing on H.R. 683 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the H. Comm. on the Judiciary*, 109th Cong. 23 (2005) (statement of Anne Gundelfinger, Associate General Counsel and Director for Trademarks and Brands, Intel Corporation) (“[D]ilution law in the United States is moving in every direction except the one that it needs to—forward.”).

²¹⁷ KENT D. STUCKEY ET AL., *INTERNET AND ONLINE LAW* § 7.03 (2008).

²¹⁸ THE EAGLES, *Hotel California*, on *HOTEL CALIFORNIA* (Asylum Records 1976).

²¹⁹ MCCARTHY, *supra* note 11, at § 24:68.

²²⁰ *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1031 (2d Cir. 1989).

²²¹ *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 423–24 (2003).

²²² *Id.* at 423–24.

²²³ *Id.* at 434.

²²⁴ *Id.* at 433–34.

ria's Secret."²²⁵ However, the officer understood that "Victoria's Secret" was not connected to the sex retail store; therefore, the existence of "Victor's Little Secret" did not change his conception of "Victoria's Secret" in any way.²²⁶

Although *Moseley* resulted in a desirable outcome, the Court's finding of fact was apparently wrong. As discussed above, any additional mental association changes the meaning of the cultural sign to a certain extent.²²⁷ Thus, although consumers familiar with "Victoria's Secret" were unlikely to believe the trademark was somehow connected to "Victor's Little Secret," the defendants' use undoubtedly created a mental association with "Victoria's Secret." Therefore, a likelihood existed that a person who had seen the defendants' store might have recalled "Victor's Little Secret" when she saw "Victoria's Secret."²²⁸ That is, while the army officer's opinion of "Victoria's Secret" had not changed, the defendants' use could have created negative mental associations with the prestigious "Victoria's Secret" trademark in his mind, which could even result in an unwillingness to go to "Victoria's Secret" stores.

The Court's ruling in *Moseley* could have been considered a turning point in a line of jurisprudence that had prohibited trademark uses of this kind. Lower courts were usually aware of the damaging effects that a non-confusing association may have on a trademark.²²⁹ However, the *Moseley* decision was followed by two years of lobbying and was finally overturned by the TDRA, which apparently restored, and perhaps even strengthened, the high standard of protection against trademark dilution by blurring.²³⁰

What is crucial about dilution by blurring is not the factual issue of whether the distinctive meaning of a trademark in a particular case has been altered. Instead, the primary issue is whether there should be a legal right to be protected against adverse mental associations. As shown above, cultural signs are generally not protected from alteration of their meaning due to their adaptation into trademarks. Thus, Nike, the Greek Goddess, was not protected from the additional meaning imposed on it through a brand of shoes. In contrast,

²²⁵ *Id.* at 434.

²²⁶ *Id.*

²²⁷ *See supra* Part II.

²²⁸ *See* Jacoby, *supra* note 125, at 1067–68.

²²⁹ *See, e.g.*, Acad. of Motion Picture Arts & Scis. v. Creative House Promotions, Inc., 944 F.2d 1446, 1456 (9th Cir. 1991); Ameritech, Inc. v. Am. Info. Tech. Corp., 811 F.2d 960, 965 (6th Cir. 1987); Toys "R" Us, Inc. v. Canarsie Kiddie Shop, Inc., 559 F. Supp. 1189, 1201 (E.D.N.Y. 1983).

²³⁰ *See* sources cited *supra* note 215.

“Bacardi” was protected from becoming a brand of jewelry,²³¹ the circus trademark “The Greatest Show on Earth” was protected from association with used cars,²³² the “Lexus” mark for cars was protected from becoming a brand of personal care products²³³ and even FASNY, the fireman’s association of the state of New York, was entitled to protection from being associated with private schools.²³⁴

This approach is unjustified. The law allows trademark owners to exploit cultural signs without limitation while creating a meaningful trademark. Trademarks are created entirely from the spirit and significance of the various signs of our culture. However, when others wish to use the meanings of these cultural signs, now incorporated in a commercial trademark, the law does not let it happen. This practice creates an asymmetrical relationship between the various signs, letting the cultural meaning flow only in one direction—from the cultural public domain into commercial trademarks, subjects of private property.

Trademark owners have a strong economic motivation to incorporate the notions of exclusivity, superiority and uniqueness into their trademarks. However, our society hardly has a great interest in these commercial cultural icons. One can hardly argue that the public interest in the distinctive meaning of “Bacardi” is greater than in the meaning of Nike, the Goddess. Recall Wernick’s remark that even in church it is hard to disassociate the notion of paradise from commercial products.²³⁵ Why should trademarks, as cultural signs—or, better said, idols—enjoy a better status? When the law protects trademarks from dilution caused by non-confusing association with commercial products, it practically encourages and supports the social cult of trademarks.

As described above, trademark owners use every possible communication medium to raise the cultural significance of consumption, in general, and trademarks, in particular. Allowing famous trademarks to be used for unrelated products, without creating confusion, would indeed dilute their distinctive cul-

²³¹ *Bacardi & Co. v. Bacardi Mfg. Jewelers Co.*, 174 U.S.P.Q. (BNA) 284, 286 (N.D. Ill. 1972), *aff’d*, 475 F.2d 1406 (7th Cir. 1973).

²³² *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Celozzi-Ettelson Chevrolet, Inc.*, 855 F.2d 480, 485 (7th Cir. 1988).

²³³ *Toyota Jidosha Kabushiki Kaisha v. Natural Health Trends Corp.*, No. CV 04-9028 DSF (Ex), 2005 WL 1041112, at *5 (C.D. Cal. Jan. 10, 2005).

²³⁴ *Fireman’s Ass’n of the State of N.Y. v. French Am. Sch. of N.Y.*, 839 N.Y.S.2d 238, 241 (N.Y. App. Div. 2007).

²³⁵ WERNICK, *supra* note 42, at 189.

tural meaning and, thus, somewhat weaken the commodity fetishism²³⁶ currently dominating our society. In other words, if consumers constantly come across “Rolls Royce” peanuts, “Chanel” floor wax and the like, perhaps the idolized status of famous trademarks in our culture would be somewhat shaken. There is no reason why the law should act to prevent this from happening and try to preserve the somewhat pagan consumer culture promoted by commercial corporations.

Quite a different issue is whether dilution by blurring impairs a trademark’s capacity to effectively serve as an indication of origin. The assertion that every additional association attached to a trademark alters its cultural meaning to a certain extent does not necessarily lead to the conclusion that the additional association will affect the specific semantic link that identifies the trademark owner as the origin of the respective goods. In other words, even if the army officer in *Moseley* recalls “Victor’s Little Secret” each time he comes across a “Victoria’s Secret,” that does not necessarily mean that he would have trouble identifying “Victoria’s Secret” as a trademark for women’s lingerie and apparel.

Some commentators have argued that protection against dilution by blurring serves the consumer interest, because when a trademark is diluted by non-confusing uses, the association in the consumer’s mind of the trademark with the trademark owner ceases to be straightforward and immediate.²³⁷ This process increases the consumer’s search costs and thus jeopardizes the primary purpose of trademark law.²³⁸ Empirical evidence, however, does not support this argument—research shows that dilutive uses increase the response time for a trademark by about 125 milliseconds, which can hardly be viewed as a serious increase in search costs.²³⁹ Furthermore, empirical studies have found that famous trademarks, which are the subject matter of protection against dilution, are immune from dilution by blurring, because their memory connections are so

²³⁶ “Commodity fetishism” is a term introduced by Karl Marx. 1 KARL MARX, CAPITAL 71 (Frederick Engels ed., Samuel Moore & Edward Aveling trans., 3d German ed., Int’l Publishers 1967) (1867).

²³⁷ See, e.g., *Ty Inc. v. Perryman*, 306 F.3d 509, 510 (7th Cir. 2002); Dan L. Burk, *Trademark Doctrines for Global Electronic Commerce*, 49 S.C. L. REV. 695, 719 (1998); Lemley, *supra* note 11, at 1704 & n.90; Richard A. Posner, *When Is Parody Fair Use?*, 21 J. LEGAL STUD. 67, 75 (1992).

²³⁸ See sources cited *supra* note 237.

²³⁹ Bone, *supra* note 215 at 193. See Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507, 527–46 (2008) for a comprehensive discussion of this topic.

strong.²⁴⁰ Thus, the additional associations imposed on a famous trademark by a blurring use may alter its distinctive cultural meaning without impairing its primary function.

The term “dilution” is defined as “lessening of the capacity of a famous mark to identify and distinguish goods or services.”²⁴¹ The *Moseley* Court denied the dilution claims because the plaintiff provided no evidence of any lessening of the trademark’s ability to identify goods sold in “Victoria’s Secret” stores.²⁴² The *Moseley* Court explicitly stated that mental association does not necessarily reduce the trademark’s ability to identify the goods of its owner.²⁴³ This holding conforms to the empirical research in the field of dilution mentioned above. If accepted as precedent, *Moseley* could have made blurring claims very difficult to prove as a factual matter. However, the TDRA seems to have overturned the decision by defining “dilution by blurring” as an “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.”²⁴⁴ If the term “distinctiveness” is interpreted as the distinct meaning of the famous trademark rather than as its ability to function as a source identifier, the new statute would restore, if not enhance, the broad protection provided to famous trademarks against adverse mental associations found in the jurisprudence prior to *Moseley*.

Protection against dilution by blurring becomes even more difficult to understand when the trademark is created out of an existing cultural sign. Thus, one court held that the use of the name “Tiffany’s” by a Boston restaurant diluted the famous jewelry trademark.²⁴⁵ Such use, the court remarked, had the potential to erode the public’s identification of this very strong trademark with the plaintiff alone, which would diminish its distinctiveness, uniqueness, effectiveness and prestigious connotations.²⁴⁶ Another case reached a similar conclusion when the name “Tiffany & Co.” was used by a movie producer.²⁴⁷

²⁴⁰ Barton Beebe, *A Defense of the New Federal Trademark Antidilution Law*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1143, 1162 (2006); Tushnet, *supra* note 239 at 541–42.

²⁴¹ 15 U.S.C. § 1127 (2006).

²⁴² *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 434 (2003).

²⁴³ *Id.* at 433.

²⁴⁴ 15 U.S.C. § 1125(c)(2)(B) (2006).

²⁴⁵ *Tiffany & Co. v. Boston Club, Inc.*, 231 F. Supp. 836, 843–44 (D. Mass. 1964).

²⁴⁶ *Id.* at 844.

²⁴⁷ *Tiffany & Co. v. Tiffany Prods.*, 264 N.Y.S. 459, 460, 462 (N.Y. Sup. Ct. 1932), *aff’d*, 260 N.Y.S. 821 (N.Y. App. Div. 1932), *aff’d*, 188 N.E. 30 (N.Y. 1933); *see also* *Tiffany & Co. v. Classic Motor Carriages, Inc.*, 10 U.S.P.Q.2d (BNA) 1835, 1842 (T.T.A.B. 1989).

Thus, the legal system holds the view that “Tiffany” should signify jewelry and only jewelry. But why? Tiffany is a female name that has been appropriated as a trademark. As discussed above, such appropriation added a commercial connotation to the name, thus somewhat altering its cultural meaning.²⁴⁸ That is, as a female name this cultural sign was not protected from a commercial “secondary meaning.” However, as soon as the name became a trademark, its legal status has risen, and now it is protected from further expansion of commercial meanings. Importantly, the uses of the name “Tiffany” that have been enjoined do not create any confusion; their only fault is that they attribute an additional connotation to the trademark. In other words, the legal system sees nothing wrong with the fact that when someone meets a person named Tiffany her mind might create an association with the jewelry store. However, should someone recall a restaurant or a movie producer when she comes across a Tiffany’s jewelry store, this would be the kind of evil the law seeks to prevent. The values that underlie this approach are inconceivable.

It is noteworthy in this context that the name “Tiffany” is currently used mainly for one type of business, which makes the effect of the commercial use of “Tiffany” on the cultural meaning of the sign particularly strong. The word “Tiffany” is strongly associated with jewelry precisely because that is its only extensive use other than as a female name; therefore its commercial “secondary meaning” is strong. Were the name to be used for numerous types of businesses, its cultural significance would be less affected, because the association of the name with a commercial context would be less straightforward, immediate and concrete. The TDRA approves the practice of protecting famous trademarks consisting of existing cultural signs against dilution. It explicitly states that protection against dilution is not limited to inherently distinctive trademarks, such as invented words.²⁴⁹

2. Dilution by Tarnishment

The most far-reaching protection of the cultural meaning of trademarks is granted by the second branch of the dilution doctrine: tarnishment.²⁵⁰ Tarnishment occurs when a famous trademark is used in a manner that clashes with its image—as created and maintained by its owner.²⁵¹ Classic examples of tar-

²⁴⁸ See *supra* Part I.

²⁴⁹ 15 U.S.C. § 1125(c)(1) (2006).

²⁵⁰ But see Bone, *supra* note 215, at 189–91 (“Dilution by tarnishment is the least problematic of the three types of dilution”).

²⁵¹ L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 31 (1st Cir. 1987).

nishment involve placing famous trademarks in the contexts of sexual activity,²⁵² illegal drugs²⁵³ and other contexts dissonant with their wholesome image.²⁵⁴

Protection against tarnishment has been sharply criticized by legal scholars.²⁵⁵ Some even doubted that the Federal Anti-Dilution Act embraced the notion of tarnishment.²⁵⁶ This doubt was shared by the Supreme Court in *Moseley*.²⁵⁷ One of the primary purposes of enacting the TDRA was to resolve this ambiguity by explicitly incorporating protection against tarnishment into the federal anti-dilution law.²⁵⁸

Tarnishment is the trademark law's most explicit assertion that trademarks should be protected as cultural signs. Protection against tarnishment specifically aims to preserve the integrity of the "licensed" meaning of famous trademarks, that is, their "official" meaning as created by their owner's efforts. The TDRA defines tarnishment broadly as an association "that harms the reputation of the famous mark."²⁵⁹

²⁵² Kraft Foods Holdings, Inc. v. Helm, 205 F. Supp. 2d 942, 944, 956 (N.D. Ill. 2002); Toys "R" Us, Inc. v. Akkaoui, No. C 96-3381 CW, 1996 WL 772709, at *3 (N.D. Cal. Oct. 29, 1996); Hasbro, Inc. v. Internet Entm't Group, Ltd., No. C96-130WD, 1996 WL 84853, at *1 (W.D. Wash. Feb. 9, 1996); Pillsbury Co. v. Milky Way Prods., Inc., No. C78-679A, 1981 WL 1402, at *14-15 (N.D. Ga. Dec. 24, 1981); Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 467 F. Supp. 366, 377 (S.D.N.Y. 1979), *aff'd*, 604 F.2d 200 (2d Cir. 1979); Edgar Rice Burroughs, Inc. v. Manns Theatres, 195 U.S.P.Q. (BNA) 159, 162 (C.D. Cal. 1976).

²⁵³ NBA Props. v. Entertainment Records LLC, No. 99 CIV. 2933(HB), 1999 WL 335147, at *9 (S.D.N.Y. May 26, 1999); Coca-Cola Co. v. Alma-Leo U.S.A., Inc., 719 F. Supp. 725, 728 – 29 (N.D. Ill. 1989); Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183, 1187, 1191–93 (E.D.N.Y. 1972).

²⁵⁴ Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc., 642 F. Supp. 1031, 1030–40 (N.D. Ga. 1986).

²⁵⁵ See, e.g., Klieger, *supra* note 207, at 865; Robert S. Nelson, *Unraveling the Trademark Rope: Tarnishment and Its Proper Place in the Laws of Unfair Competition*, 42 IDEA 133, 179 (2002); Natalie A. Dopson, Note, *The Federal Trademark Dilution Act and Its Effect on Parody: No Laughing Matter*, 5 J. INTELL. PROP. L. 539, 570 (1998); Julie Zando-Dennis, Note, *Not Playing Around: The Chilling Power of the Federal Trademark Dilution Act of 1995*, 11 CARDOZO WOMEN'S L.J. 599, 629 (2005).

²⁵⁶ See, e.g., Miles J. Alexander & Michael K. Heilbronner, *Dilution Under Section 43(C) of the Lanham Act*, 59 LAW & CONTEMP. PROBS. 93, 124–25 (1996); Robert C. Denicola, *Some Thoughts on the Dynamics of Federal Trademark Legislation and the Trademark Dilution Act of 1995*, 59 LAW & CONTEMP. PROBS. 75, 88–90 (1996).

²⁵⁷ *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 432 (2003).

²⁵⁸ See 15 U.S.C. § 1125(c) (2006).

²⁵⁹ § 1125(c)(2)(C).

This seemingly boundless protection is limited, however, by an explicit exclusion for “fair use,” which reflects the legislature’s concern about First Amendment rights.²⁶⁰ The TDRA elaborated on this exclusion, which was previously formulated rather laconically.²⁶¹ The TDRA clarified that “fair use” includes comparative advertising, parodies, criticism and commentary on the owner of a famous trademark or its goods or services, all forms of news reporting and commentary and any noncommercial use of a trademark.²⁶² Whether this elaboration broadens the scope of the “fair use” defense is, however, questionable.²⁶³

The body of case law dealing with tarnishment is quite substantial. For the purpose of the current analysis, the following discussion will consider the influence of the following four factors on the outcome of the decisions: (a) the distinction between commercial and non-commercial speech; (b) the role of the trademark in the conveyed message; (c) the nature of the conveyed message; and (d) the likelihood of consumer confusion.

a. The Distinction Between Commercial and Non-commercial Speech

Commercial speech enjoys only limited protection under the First Amendment.²⁶⁴ This fact, however, does not prevent either the omnipresence of promotional messages or the dominance of commercial corporation’s visions in our cultural discourse. Consumers are constantly exposed to attempts to create “licensed” meaning for trademarks, that is, the cultural meaning desired by their owners. In addition, commercial interests dictate, to a large extent, the content of media, sterilizing any expressions that clash with the “licensed” meaning of trademarks or the consumption ideology.

Yet the low level of protection granted to commercial speech can be a serious legal obstacle when it comes to uses of trademarks that are dissonant

²⁶⁰ See H.R. REP. NO. 109-23, at 25 (2005) (statement of Howard L. Berman, Ranking Member, Subcomm. On Courts, the Internet, and Intellectual Property).

²⁶¹ It specifically included only comparative advertising, non-commercial use and use in news reporting and commentary. 15 U.S.C. § 1125(c)(4) (1995).

²⁶² 15 U.S.C. § 1125(c)(3) (2006).

²⁶³ Some scholars argue that the revision expanded the scope of the “fair use” defense. See, e.g., MCCARTHY, *supra* note 11, § 24.123; STUCKEY ET AL., *supra* note 217, at § 7.03. Others believe that the scope of the defense has not changed. See, e.g., Marc L. Delflache et al., *Life After Moseley: The Trademark Dilution Revision Act*, 16 TEX. INTEL. PROP. L.J. 125, 142 (2007).

²⁶⁴ See, e.g., *Ohralik v. Ohio State Bar Ass’n*, 436 U.S. 447, 455–56 (1978).

with the “licensed” meaning of the marks. Since the “licensed” meaning of trademarks is regarded as part of the property right of their owners, one who wishes to injure this meaning has to show a genuine First Amendment interest.²⁶⁵ Only non-commercial speech is fully exempted.²⁶⁶ Thus, although commercial speech is not itself fully protected, the “licensed” meaning of trademarks, one of commercial speech’s major outcomes, is protected against dissonant commercial speech.

To illustrate this point, consider two cases concerning advertising. In the first case, the defendant aired a television commercial showing a version of its competitor’s John Deere deer logo being chased around a yard by its own tractor and a barking dog.²⁶⁷ In the second case, the defendant featured a commercial in which a polar bear examined a Coke can, made an unhappy sound, threw it into a trash bin bearing the inscription “Keep the Arctic Pure,” and then drank the defendant’s own “Polar Seltzer” contentedly.²⁶⁸ In both cases, the defendant’s use was enjoined because each commercial created an unfavorable association with the competitor’s trademark.²⁶⁹

Thus, commercial corporations are allowed to attach positive associations to their own trademarks, but are not allowed to attach negative associations to the trademarks of others. For example, while absolutely nothing prevents the Coca-Cola Company from suggesting that Coke is “the real thing,” the real joy of life, its competitor was not allowed to suggest that Coke was not “pure.”²⁷⁰ Both assertions have absolutely no factual basis; yet the former is allowed since it does not clash with any private interests, while the latter is forbidden because of the trademark owner’s interests. This legal outcome implicitly conveys a certain message—a message of private interests’ priority around the meanings of cultural signs. While nothing protects the meaning of the cultural sign “joy” from being diluted through commercialization, the legal system does protect the image of the “real thing” from dissonant associations. This protection happens because, while nobody owns “joy,” somebody does own the “real thing.”

As the John Deere and Polar Seltzer cases demonstrate, using a competitor’s trademark to symbolically convey a message of one’s own superiority is not considered legitimate comparative advertising that is exempted by the “fair

²⁶⁵ See, e.g., *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987); *Interbank Card Ass’n v. Simms*, 431 F. Supp. 131, 133–34 (M.D.N.C. 1977).

²⁶⁶ 15 U.S.C. § 1125 (c)(3) (2006).

²⁶⁷ *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 41 (2d Cir. 1994).

²⁶⁸ *Polar Corp. v. Coca-Cola Co.*, 871 F. Supp. 1520, 1521 (D. Mass. 1994).

²⁶⁹ *Deere*, 41 F.3d at 45–46; *Polar Corp.*, 871 F. Supp. at 1522.

²⁷⁰ *Polar Corp.*, 871 F. Supp. at 1521.

use” defense. Interestingly, when dealing with disparaging comments, courts allow competitors not only to assert factual statements but also to express their opinions, groundless as they may be. Stating that a competitor is “too small” to handle a certain business,²⁷¹ that a business service is a “scam”²⁷² or that a store is “trashy”²⁷³ are considered legitimate expressions of opinion, even if they are not based on factual data. However, the attractive force of a famous trademark lies mainly in its symbolic power and not in the factual information underlying the trademark. Trademark owners invest vast amounts of resources in creating this symbolic power.

When courts refuse to recognize attempts to attach negative associations to another’s trademark as a legitimate way of competing, they actually preclude discourse over the symbolic cultural meanings of trademarks from entering legitimate areas of competition. Thus, under current law, the only way to compete with the cultural meaning of another entity’s trademark is to create an alternative meaning to one’s own trademark. It is unclear why a competitor should not be allowed to participate in the discourse over the symbolic cultural meaning of another’s trademark. Of course, a competitor is not expressing her sincere beliefs and so, First Amendment concerns do not weigh strongly in her favor. What is expressed in such advertisements is solely a competitor’s commercial interest. But this is exactly the case with advertising that creates a positive “licensed” cultural meaning of trademarks as well. Both types of speech arise entirely from commercial interests and both are aimed entirely at the purely psychological influence of rhetoric and not at rational persuasion. So why prefer the one over the other? Our society has no particular interest in the “licensed” meaning of trademarks. However, letting only such meanings into the world of advertising provides substantial support for the “licensed” reality.

In our society, commercial interest is one of the strongest motives for action, in general, and speech, in particular. And the strongest commercial interest to challenge the “licensed” meaning of a trademark is, of course, the interest of a competitor. Therefore, the legal position that lets advertising only create positive trademark meanings and does not let advertising tarnish such meanings significantly contributes to securing the dominant position of the “licensed” meaning of trademarks in our culture. This attitude has interesting practical consequences on the ability of commercial speech to create culturally meaningful trademarks. Although, on the formal level, the legal system does not consider the commercial speech that created the image of the “real thing” highly valu-

²⁷¹ *Coastal Abstract Serv., Inc. v. First Am. Title Ins. Co.*, 173 F.3d 725, 731 (9th Cir. 1999).

²⁷² *NBC Subsidiary (KCNC-TV), Inc. v. Living Will Ctr.*, 879 P.2d 6, 11 (Colo. 1994).

²⁷³ *Levinsky’s, Inc. v. Wal-Mart Stores, Inc.*, 127 F.3d 122, 130 (1st Cir. 1997).

able, it does protect its outcome. By doing this, the legal system actually encourages this type of speech, making it highly beneficial. Moreover, the legal system gives this type of speech the highest imaginable protection, a kind of protection not granted to any other type of speech—protection against contradictory statements.

A further problem with the limited protection of commercial speech in the context of tarnishment lies in the broad scope of speech regarded as “commercial.” Courts consider the use of trademarks on merchandise such as posters, stickers and t-shirts as “commercial.”²⁷⁴ This means that such uses are not automatically exempted from tarnishment claims; each use is further examined to determine whether it constitutes protected social commentary or an inexcusable injury to another’s property.

Thus, in the most classic tarnishment case, a court enjoined the defendant from selling posters that displayed the famous “Enjoy Coca-Cola” logo that was altered to read “Enjoy Cocaine.”²⁷⁵ In another case, a court granted a preliminary injunction to protect the famous “Budweiser” trademark where the defendant sold t-shirts reading “Buttweiser.”²⁷⁶ Even when non-profit entities, such as a church²⁷⁷ or a nuclear protestor,²⁷⁸ sell merchandise bearing their own messages that use famous trademarks, such use is considered commercial. Recent case law demonstrates that the TDRA is not expected to change this line of jurisprudence.²⁷⁹ Moreover, the newly formulated “fair use” defense makes it clear that a parody is only protected when the trademark is not used as a designation of origin.²⁸⁰ Since trademarks displayed on various merchandise are normally considered to be designations of origin, the chance that a poster or a t-shirt bearing a distorted version of a famous trademark will be exempted as a parody seems to be even lower now than before the TDRA.²⁸¹

²⁷⁴ *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 399, 403 n.8 (8th Cir. 1987); *Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc.*, 600 F.2d 1184, 1186 (5th Cir. 1979); *Hard Rock Cafe Licensing Corp. v. Pac. Graphics, Inc.*, 776 F. Supp. 1454, 1461–62 (W.D. Wash. 1991); *Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*, 642 F. Supp. 1031, 1040 (N.D. Ga. 1986).

²⁷⁵ *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1187, 1193 (E.D.N.Y. 1972).

²⁷⁶ *Anheuser-Busch Inc. v. Andy’s Sportswear Inc.*, 40 U.S.P.Q.2d (BNA) 1542, 1543 (N.D. Cal. 1996).

²⁷⁷ *Interbank Card Ass’n v. Simms*, 431 F. Supp. 131, 133–34 (M.D.N.C. 1977).

²⁷⁸ *Mutual of Omaha Ins.*, 836 F.2d at 398.

²⁷⁹ *Harris Research, Inc. v. Lydon*, 505 F. Supp. 2d 1161, 1165 (D. Utah 2007).

²⁸⁰ 15 U.S.C. § 1125 (c)(3)(A) (2006).

²⁸¹ Hofrichter, *supra* note 215, at 1952.

One court noted that, while wearing a t-shirt with a message might be a unique means of communication—similar to displaying a message on one’s home—selling t-shirts with a message was not uniquely valuable, since there were other means available to disseminate the message.²⁸² This position is difficult to understand. How should those who wish to express their message by means of wearing a t-shirt achieve their goal? One can, of course, imagine that people would themselves emblazon their t-shirts with various slogans. In the modern world of consumer culture, however, it is much more natural for people to buy t-shirts with messages they wish to convey. Besides, the core of freedom of speech is to be able to shape one’s own opinion while being exposed to a wide range of messages. Most people choose the majority of their views from the existing options rather than basing their views on entirely independent observations. When consumers see an assortment of expression for sale, this brings the various messages to their mind, allowing them to decide whether they wish to identify themselves with any of those messages by purchasing the offered means of expression.

The TDRA’s new definition of the “fair use” defense explicitly exempts the facilitation of “fair use” from dilution liability.²⁸³ To reach a desirable outcome on this point without changing the legislation, the words “facilitation of fair use” might be interpreted to include providing consumers with various ways of expressing messages that relate to famous trademarks.

The fact that money is paid for merchandise displaying tarnishing messages does not lead to the conclusion that this type of speech is commercial. Just like a contribution made by an individual to a political party, the money paid by consumers reflects their views and, therefore, selling such merchandise should be protected by the First Amendment. Merchandise is an important medium of expression. Unlike many other forms of communication media, merchandise can provide messages on a small scale without the need of big sponsors. Therefore, merchandise has the ability to bear messages antithetical to large commercial corporation’s visions for their marks. There is no conceivable reason why the legal system should regulate this kind of speech, while leaving the main communication media in the hands of the market and thereby condemning them to bear marketing messages and be censored by their commercial sponsors.

Perhaps the most troubling aspect of commercial speech’s lower level of protection in the context of tarnishment is that courts do not clearly set boun-

²⁸² *One World One Family Now v. City & County of Honolulu*, 76 F.3d 1009, 1015 (9th Cir. 1996).

²⁸³ § 1125 (c)(3)(A).

daries on the scope of “commercial speech.” Thus, even types of speech traditionally considered non-commercial, such as magazines,²⁸⁴ books,²⁸⁵ movies²⁸⁶ and stand-up comedies,²⁸⁷ often become subject to scrutiny and restriction because of violation of trademark rights. The TDRA exempts non-commercial use from dilution liability, just like the Federal Trademark Dilution Act did before the revision.²⁸⁸ Nevertheless, there is some indication that the protection of non-commercial speech that conflicts with trademark rights might now even be narrower than before the revision.²⁸⁹

Speakers can only be sure that they do not infringe trademark rights when they gain absolutely no economic benefit from their tarnishing expression. This situation should be a subject of serious concern. It has the tendency to kill off all expressions dissonant with the “licensed” meaning of trademarks. This problem is especially strong in a world where economically-motivated speech dominates our cultural domain and has a much stronger potential for effective dissemination than entirely altruistic speech. The times when people gathered to listen to speakers on street corners are gone. Today society is made up mainly of consumers of commercially-motivated speech designed for consumption. This type of speech is shaping public opinion. In other words, the importance of allowing the public to be exposed to expressive speech disseminated for economic benefit may be even more acute than not interrupting the street corner speaker.

²⁸⁴ *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 774 (8th Cir. 1994); *Pillsbury Co. v. Milky Way Prods., Inc.*, 215 U.S.P.Q. (BNA) 124, 133–34 (N.D. Ga. 1981).

²⁸⁵ *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1406 (9th Cir. 1997).

²⁸⁶ *Films of Distinction, Inc. v. Allegro Film Prods., Inc.*, 12 F. Supp. 2d 1068, 1073 (C.D. Cal. 1998); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 467 F. Supp. 366, 369 (S.D.N.Y. 1979); *Edgar Rice Burroughs, Inc. v. Manns Theatres*, 195 U.S.P.Q. (BNA) 159, 161 (C.D. Cal. 1976).

²⁸⁷ *Eastman Kodak Co. v. Rakow*, 739 F. Supp. 116, 117 (W.D.N.Y. 1989).

²⁸⁸ 15 U.S.C. § 1125 (c)(3)(C) (2006); 15 U.S.C. § 1125 (c)(4)(B) (1995).

²⁸⁹ The TDRA restricted the non-commercial use defense to dilution claims, 15 U.S.C. § 1125 (c)(3)(C) (2006), whereas previously it was a general defense to all trademark infringement claims. 15 U.S.C. § 1125 (c)(4)(B) (1995). In addition, the previous language of the Act required “commercial use in commerce” to establish a *prima facie* dilution claim. 15 U.S.C. § 1125 (c)(1) (1995). The TDRA eliminated this requirement, making the argument of non-commercial speech merely a defense. 15 U.S.C. § 1125 (2006).

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b. The Role of the Trademark in the Conveyed Message

When a tarnishing expression is clearly critical of the trademark owner, courts usually do not regard the expression as infringing.²⁹⁰ Thus, in one case an environmental nonprofit organization used a mocking caricature of Reddy K-lowatt, a cartoon character the plaintiff used to promote its electric utilities.²⁹¹ The obvious purpose was to criticize the plaintiff's policy and the court denied the trademark infringement claim, finding no likelihood of confusion.²⁹² In a similar case, infringement claims were denied where an environmental group ran a political ad criticizing the U.S. Forest Service policies.²⁹³ The ad featured the well-known figure of Smokey Bear trying to hide a chain saw behind his back, with the slogan "Say it ain't so, Smokey."²⁹⁴

Courts have reached the same conclusion when the tarnishing use was intended to criticize the values the trademark generally represented or when the trademark was chosen to criticize a wider social phenomenon.²⁹⁵ In one case, the defendant produced photographs of Barbie dolls in various sexual poses, often juxtaposed with vintage household appliances.²⁹⁶ In doing so, the defendant attempted to criticize the objectification of women associated with Barbie.²⁹⁷ The court found the use non-infringing.²⁹⁸ The same result was reached in another Barbie case, where defendant's song "Barbie Girl" mocked the brand values symbolized by the "blond bimbo girl" whose "life is plastic."²⁹⁹ Similarly, trademark infringement was denied where a magazine used a deviated imitation of the Old Farmer's Almanac, which is associated with rusticity and thrift, as a comment on the slowing economy.³⁰⁰

²⁹⁰ See, e.g., *LightHawk, the Env'tl. Air Force v. Robertson*, 812 F. Supp. 1095, 1104 (W.D. Wash. 1993); *Reddy Commc'ns, Inc. v. Env'tl. Action Found., Inc.*, 199 U.S.P.Q. (BNA) 630, 635-36 (D.D.C. 1977).

²⁹¹ *Reddy Commc'ns*, 199 U.S.P.Q. at 632.

²⁹² *Id.* at 636.

²⁹³ *LightHawk*, 812 F. Supp. at 1104.

²⁹⁴ *Id.* at 1096.

²⁹⁵ See, e.g., *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 812 (9th Cir. 2003); *Mattel, Inc. v. MCA Records, Inc.*, 28 F. Supp. 2d 1120, 1143 & n.29 (C.D. Cal. 1998); *Yankee Publ'g Inc. v. News Am. Publ'g Inc.*, 809 F. Supp. 267, 279 (S.D.N.Y. 1992).

²⁹⁶ *Walking Mountain Prods.*, 353 F.3d at 796.

²⁹⁷ *Id.*

²⁹⁸ *Id.* at 812.

²⁹⁹ *MCA Records*, 28 F. Supp. 2d at 1156.

³⁰⁰ *Yankee Publ'g*, 809 F. Supp. at 271, 282.

The trouble begins where the message expresses something different than a critique on the trademark owner or the values represented by the mark. Thus, instead of criticizing a trademark, defendants sometimes exploit a trademark's positive cultural meaning as a tool to assist in conveying their message. Minority groups often use this strategy in an attempt to challenge or improve their social image. Examples of such attempts include the "Gay Olympic Games," an athletic competition for homosexuals;³⁰¹ "The Pink Panther Patrol," an organization that patrolled the streets to protect homosexuals against physical attacks;³⁰² and t-shirts imprinted with a black version of Mickey and Minnie Mouse.³⁰³ In each case, minority groups exploited the cultural meaning embedded in the trademarks to convey a message of social acceptability. To simplify their allegorical language, the messages seem to say "gays can also be outstanding athletes," "the Pink Panther is against violence toward gays" and "such widely accepted symbols of our culture as Mickey and Minnie Mouse may not necessarily be white."³⁰⁴ The courts considered each use infringing and enjoined each message.³⁰⁵ The courts reasoned that the First Amendment does not provide a right to misappropriate another's property.³⁰⁶

These decisions deprive minority groups of a powerful means of expression, since the trademarks used by the defendants have strong, distinctive cultural meanings. Many articles have already been written on this topic,³⁰⁷ however, so this discussion will consider a different point. These decisions also

³⁰¹ *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 525 (1987).

³⁰² *MGM-Pathe Commc'ns Co. v. Pink Panther Patrol*, 774 F. Supp. 869, 871 (S.D.N.Y. 1991).

³⁰³ *Walt Disney Co. v. Powell*, 698 F. Supp. 10, 12 n.2 (D.D.C. 1988), *aff'd in part & vacated in part*, 897 F.2d 565 (D.C. Cir. 1990).

³⁰⁴ *S.F. Arts & Athletics*, 483 U.S. at 535; *MGM-Pathe Commc'ns*, 774 F. Supp. at 873; *Walt Disney*, 698 F. Supp. at 12 n.2.

³⁰⁵ *S.F. Arts & Athletics*, 483 U.S. at 527–28; *MGM-Pathe Commc'ns*, 774 F. Supp. at 877; *Walt Disney*, 698 F. Supp. at 12.

³⁰⁶ *MGM-Pathe Commc'ns*, 774 F. Supp. at 877; *Walt Disney*, 698 F. Supp. at 12 n.2.

³⁰⁷ See, e.g., Aoki, *supra* note 4, at 526; Rosemary J. Coombe, *Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue*, 69 TEX. L. REV. 1853, 1866 (1991); Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 402–03, 423–24 (1990); Gordon, *supra* note 4, at 1585; Sonia K. Katyal, *Performance, Property, and the Slashing of Gender in Fan Fiction*, 14 AM. U. J. GENDER SOC. POL'Y & L. 461, 464 (2006); Robert N. Kravitz, *Trademarks, Speech, and the Gay Olympics Case*, 69 B.U. L. REV. 131, 132–33 (1989); Kellie L. Pendras, Comment, *Revisiting San Francisco Arts & Athletics v. United States Olympic Committee: Why It Is Time to Narrow Protection of the Word "Olympic"*, 24 U. HAW. L. REV. 729, 731 (2002); Diane Leenheer Zimmerman, *Is There a Right to Have Something to Say? One View of the Public Domain*, 73 FORDHAM L. REV. 297, 311 (2004).

demonstrate the strong legal protection of trademarks as cultural signs. They implicitly recognize trademark owners' right to control the social and political connotations of their trademarks. Thus, the Olympic symbol and the Pink Panther may not become associated with homosexuals' struggle for equality if the trademark owners do not wish them to. Mickey and Minnie Mouse are not allowed to engage in social discourse concerning racial discrimination without their owner's permission.

Let us examine the example of the "Gay Olympic Games" more closely. The Olympic Games are a very strong cultural sign in our society. Athletes' participation in the Games, public viewing and discussion of the Games, the press and literature all contribute to the meaning of the Olympic Games. And yet, a single entity owns all the symbols related to the Games—the Olympic Committee.³⁰⁸ Like a capitalist in Marxist theory, the Committee owns the means of production. This property right allows the Committee to control the "production" of the cultural meaning of these symbols and to benefit from commercial exploitation of that meaning. During the years 1984 to 2000, the Committee chose to commercialize the Olympic Games extensively, diluting the Games' cultural meaning.³⁰⁹ Thus, the Committee deprived the public of one of its strongest cultural signs for its own economic gain. However, when a homosexual rights group wishes to employ the Olympic symbols to convey a message of social acceptability, the Committee has the right to prevent it from doing so. This is especially peculiar, since the Olympic Games originated in ancient Greece, where they were part of its homosexual or, to be more exact, pederast culture.³¹⁰ In ancient Greece, participation in the Games was limited to young males who competed naked, since the festival was meant, in part, to celebrate the beauty of the male body.³¹¹

I believe that the whole concept that a cultural sign can have an owner is fundamentally flawed. Cultural signs, in general, and trademarks, in particular, shape our social and cultural heritage. The meaning embedded in cultural signs should always belong to the public—that is, owned by society in general—and should never be regarded as private property. Trademark owners are naturally involved in creating the cultural meaning of their marks. The role of the legal system, however, should be to minimize the owners' control. Like grown-up children, trademarks should be regarded as free to take part in discourse of any kind, without having to ask the permission of their creators and owners.

³⁰⁸ *S.F. Arts & Athletics*, 483 U.S. at 523.

³⁰⁹ See *supra* note 72 and associated text.

³¹⁰ See James A. Arieti, *Nudity in Greek Athletics*, 68 CLASSICAL WORLD 431, 434–35 (1975).

³¹¹ *Id.* at 434–35.

Cultural signs reflect the values and conventions of our society. These values and conventions should not evolve under the supervision of trademark owners. 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. This outcome is undesirable. Society should be able to establish the meaning of its cultural signs in a free and uncontrolled dialogue. The general attitude of Western legal systems, which does not protect cultural signs against alteration except in exceptional cases, is the only acceptable position in a democratic society. This should not change when the cultural sign in question is a registered trademark.

Other cases of using trademarks to convey messages other than a critique on the trademark or its values involve situations where trademarks are used as rhetorical figures. Consider several examples. The slogans of an insurance company, “Mutual of Omaha” and “Mutual of Omaha’s Wild Kingdom,” were used in deviated versions to convey a message of nuclear protest—”Mutant of Omaha” and “Mutant of Omaha’s Mutant Kingdom.”³¹² In another example, a magazine published a mocking ad which altered Michelob’s slogan “One Taste and You’ll Drink It Dry” into “One Taste and You’ll Drink It Oily.”³¹³ The advertisement commented on an oil spill that affected the river from which the Michelob brewery took its water.³¹⁴ A book about O.J. Simpson was published under the title “The Cat NOT in the Hat!” bringing to mind the famous Dr. Seuss book “The Cat in the Hat.”³¹⁵ A religious organization distributed small “Christ Charge” cards closely resembling “Master Charge” credit cards.³¹⁶ The cards bore two interlocking circles similar to the “Master Charge” logo, with the words “Give Christ charge of your life.”³¹⁷

In each example, the use of the trademark was deemed infringing. The courts stated that a trademark owner’s property rights do not have to yield to First Amendment rights if there are adequate alternative avenues of communica-

³¹² *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 398 (8th Cir. 1987).

³¹³ *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 772 (8th Cir. 1994).

³¹⁴ *Id.*

³¹⁵ *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1396 (9th Cir. 1997).

³¹⁶ *Interbank Card Ass’n v. Simms*, 431 F. Supp. 131, 132 (M.D.N.C. 1977). “Master Charge” is the former name of “Master Card.” <http://en.wikipedia.org/wiki/MasterCard> (last visited Nov. 1, 2008).

³¹⁷ *Interbank Card Ass’n*, 431 F. Supp. at 132.

tion.³¹⁸ This reasoning significantly simplifies the complex cultural reality. Trademarks, in cases like these, are used as rhetorical figures—their familiar texts or appearances are deviated to produce a surprising effect. Rhetorical figures make the conveyed messages more convincing and memorable. As noted above, trademark owners often use rhetorical figures as effective marketing tools. Of course, it can be argued that there are plenty of rhetorical figures that are not protected as trademarks and, therefore, there is no need to use trademarks to convey messages unrelated to them. Every cultural sign, however, has a distinct meaning or, in terms of the Q model, a distinct configuration of links leading to it. Thus, the use of a cultural sign as a rhetorical figure gives the expressed message a unique meaning that can be conveyed by no other means. For example, even without trying to clarify the exact meaning of the expression, nothing can replicate the effect of O.J. Simpson as the Cat in the Hat.

As mentioned above, trademark owners often use strong and distinctive cultural signs as rhetorical figures in advertising, thereby diluting the meaning of the signs. The legal system, however, was not concerned with the public interest in protecting the phrase “Life, Liberty, and the Pursuit of Happiness” against dilution when it was used to build the Cadillac trademark.³¹⁹ At the same time, Michelob’s interests prevented the use of its trademark as a rhetorical figure to convey a message against pollution.³²⁰ There is no reason why trademarks should be regarded as cultural signs of a higher rank and protect against dilution of their meaning. Once trademarks enter the scene of playing with words, making sophisticated use of existing cultural signs to convey their messages, they should have to obey the rules of the game.

Of course, the cultural meaning of a trademark is diluted when it is used to express a wholly unrelated idea. But trademarks themselves are comprised of ideas that have nothing to do with the trademark itself, such as romantic love, joy, happiness and so forth. In terms of the Q model, the entire cultural meaning of trademarks consists of their links to other cultural signs. These links attribute the meaning of cultural signs to the trademark, while simultaneously weakening the signs to the same extent they strengthen the trademark.

The cultural meaning of a trademark is a material having a certain, limited mass. That is, people have a limited capacity for considering things important, exciting, interesting and so forth. Attaching great importance to some issues necessarily implies attaching less importance to other issues. When

³¹⁸ *Dr. Seuss Enters.*, 109 F.3d at 1400, 1405–06; *Anheuser-Busch*, 28 F.3d at 778; *Mutual of Omaha Ins.*, 836 F.2d at 402; *Interbank Card Ass’n*, 431 F. Supp. at 134.

³¹⁹ See *supra* note 67 and associated text.

³²⁰ *Supra* note 313–314 and associated text.

trademarks become the center of our attention, they necessarily push other issues aside. When they encompass a significant portion of the limited cultural meaning, they necessarily deprive other cultural signs of this meaning. If the law prevents trademark dilution through expressive speech on issues unrelated to the mark, it prevents redistribution of the cultural meaning and reinforces a distribution that favors the key position trademarks hold in our culture. For example, not letting the Michelob trademark be used to convey a message against pollution prevents the cultural meaning of Michelob from leaking out into the discussion on environmental issues. Indeed, it is a fair assumption that many people today are more informed about Michelob than they are about pollution.

In two relatively recent cases, trademarks were used as rhetorical figures to express wholly unrelated messages; yet the courts ruled in favor of the defendants, protecting their freedom of expression.³²¹ Both cases concerned purely political speech,³²² a fact that distinguishes them from the cases discussed above and explains the courts' reluctance to enjoin the defendants' speech. This precedent, however, should not be limited to the area of political speech.

c. The Nature of the Conveyed Message

“We observe a most interesting phenomenon: nonsense as a means of communication between people.”³²³

Even a defendant who directly challenges a trademark's cultural meaning is not always shielded from liability for tarnishment. Whether the trademark use would be permitted or enjoined depends largely on the question of *what* message the use conveys. Courts invariably allow expressions with messages that are easily decipherable and readily understandable.³²⁴ This principle is illu-

³²¹ MasterCard Int'l Inc. v. Nader 2000 Primary Comm. Inc., 70 U.S.P.Q.2d (BNA) 1046, 1054 (S.D.N.Y. 2004); *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682, 701 (N.D. Ohio 2002).

³²² *MasterCard Int'l*, 70 U.S.P.Q.2d at 1054; *Am. Family Life Ins.*, 266 F. Supp. 2d at 688.

³²³ A phrase I translated into English from the Polish writer, Stanislaw Jerzy Lec. STANISŁAW JERZY LEC, *UNKEMPT THOUGHTS* (1959).

³²⁴ *See, e.g.,* WHS Entm't Ventures v. United Paperworkers Int'l Union, 997 F. Supp. 946, 951, 953 (M.D. Tenn. 1998) (flyers that listed violations of a saloon and included a parody of the saloon's trademark were not found to violate the mark); *see also* *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 812 (9th Cir. 2003); *Mattel, Inc. v. MCA Records, Inc.*, 28 F. Supp. 2d 1120, 1156 (C.D. Cal. 1998).

strated by the Reddy Kilowatt and Smokey Bear cases, discussed above.³²⁵ However, when the message is more allegorical, less specific and does not criticize anything in particular, the outcome is less predictable. And yet, careful examination of the cases reveals some common guidelines.

Although it is a well-established principle that the First Amendment protects not only those whose jokes are funny,³²⁶ it seems that a witty parody is more likely to be protected than a stupid joke. Thus, in one case the defendant sold t-shirts bearing the inscription “Miami Mice,” featuring two comical cartoon mice resembling the “Miami Vice” television series characters.³²⁷ One of the t-shirts showed a shark pointing a machine gun at a bikini-clad mouse standing on a pier.³²⁸ The court concluded that the t-shirts parodied the tough, courageous and stylish “Miami Vice” detectives and, therefore, did not infringe the “Miami Vice” trademark.³²⁹ In another case, use of the acronym “BUFU”—“By Us, Fuck You”—in a satirical movie was held to be a protected parody of the trademark “FUBU”—“For Us, By Us.”³³⁰ Demonstrating his own good sense of humor, Justice Owen noted that the plaintiff’s action was “UFUB”—“Utterly Frivolous Under Biopsy.”³³¹

In contrast, a court did not find the joke funny when a magazine published a satirical pictorial essay, entitled “Monkeying around with Tarzan and Jane,” depicting Tarzan and his wife Jane “engaged in explicit sexual activities and conversation.”³³² Noting that the essay “poked fun” at Tarzan and Jane’s images, the court nevertheless found no excuse for the defendant’s “blatant infringement, dilution, and [creation of an] unwholesome setting.”³³³ The court found that the essay would cause irreparable harm to Tarzan and Jane’s reputa-

³²⁵ Reddy Commc’ns, Inc. v. Envtl. Action Found., Inc., 199 U.S.P.Q. (BNA) 630, 636 (D.D.C. 1997); LightHawk, The Envtl. Air Force v. Robertson, 812 F. Supp. 1095, 1104 (W.D. Wash. 1993).

³²⁶ See Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 583 (1994); Yankee Publ’g Inc. v. News Am. Publ’g Inc., 809 F. Supp. 267, 280 (S.D.N.Y. 1992).

³²⁷ Universal City Studios, Inc. v. T-Shirt Gallery, Ltd., 634 F. Supp. 1468, 1477 (S.D.N.Y. 1986).

³²⁸ *Id.*

³²⁹ *Id.* at 1477–78; see Universal City Studios, Inc. v. Casey & Casey, Inc., 622 F. Supp. 201, 204 (S.D. Fla. 1985), *aff’d*, 792 F.2d 1125 (11th Cir. 1986).

³³⁰ GTFM, LLC v. Universal Studios, Inc., No. 02 CV. 0506(RO), 2006 WL 1377048, at *1, *3 (S.D.N.Y. May 16, 2006).

³³¹ *Id.* at *3 & n.7.

³³² Edgar Rice Burroughs, Inc. v. High Soc’y Magazine, Inc., 7 Media L. Rep. (BNA) 1862, 1863–64 (S.D.N.Y. 1981).

³³³ *Id.* at 1863–64.

tion as “persons of high moral standards, [having] admirable traits of character, and [having] clean and attractive appearances”³³⁴ Another court reached a similar conclusion where an actress in a pornographic film entitled “Debbie Does Dallas” wore a uniform similar to the one worn by the Dallas Cowboys Cheerleaders.³³⁵ In that case, the court noted that anyone who saw the defendant’s sexually-depraved film would hardly be able to disassociate it from the Dallas Cowboys Cheerleaders.³³⁶

The above examples show two extremes—good sense of humor versus vulgarity. Most tarnishment cases, however, lie somewhere in between, resulting in confusing jurisprudence. Courts have allowed numerous parodies on trademarks: “Tiny Little Dog Fleas” as satire on “The Tiny Little Tea Leaf Tea,”³³⁷ “Morey Amsterdam’s Betty Cooker’s Crock Book For Drunks” as a lampoon on “Betty Crocker” cook books,³³⁸ Budweiser’s slogan “THIS BUD’S FOR YOU” used by a florist’s association³³⁹ and a poster depicting a pregnant Girl Scout reading “Be Prepared.”³⁴⁰ On the other hand, there are numerous examples of parodies that were enjoined for trademark infringement: “Super Stud” singing telegrams as a parody of Superman that included expressions such as “faster than a speeding tortoise” and “more powerful than an armpit,”³⁴¹ an insecticide commercial using the slogan “Where there’s life . . . there’s Bugs” as a deviated version of Budweiser’s slogan “Where there’s life . . . there’s Bud”³⁴² and “Garbage Pail Kids” stickers showing the “Cabbage Patch Kids” dolls in violent and sometimes noxious settings.³⁴³ Nothing apparently distinguishes these two groups of cases, save for the fact that different judges have a different sense of humor.

³³⁴ *Id.* at 1864.

³³⁵ *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204–05 (2d Cir. 1979).

³³⁶ *Id.* at 205.

³³⁷ *Tetley, Inc. v. Topps Chewing Gum, Inc.*, 556 F. Supp. 785, 790 (E.D.N.Y. 1983).

³³⁸ *Gen. Mills, Inc. v. Henry Regnery Co.*, 421 F. Supp. 359, 361 (N.D. Ill. 1976).

³³⁹ *Anheuser-Busch, Inc. v. Florists Ass’n of Greater Cleveland, Inc.*, 603 F. Supp. 35, 37, 39 (N.D. Ohio 1984).

³⁴⁰ *Girl Scouts of Am. v. Personality Posters Mfg. Co.*, 304 F. Supp. 1228, 1233–34 (S.D.N.Y. 1969).

³⁴¹ *DC Comics Inc. v. Unlimited Monkey Bus., Inc.*, 598 F. Supp. 110, 114–16 (N.D. Ga. 1984).

³⁴² *Chem. Corp. of Am. v. Anheuser-Busch, Inc.*, 306 F.2d 433, 435–38 (5th Cir. 1962).

³⁴³ *Original Appalachian Artworks, Inc. v. Topps Chewing Gum*, 642 F. Supp. 1031, 1032, 1036–37, 1039 (N.D. Ga. 1986); *see also* *Gen. Foods Corp. v. Mellis*, 203 U.S.P.Q. (BNA) 261, 262–64 (S.D.N.Y. 1979) (song entitled “I’m the Pop Rock King” found to infringe plaintiff’s trademark “Pop Rocks”).

An early post-TDRA tarnishment case dealt with the use of the words “Chewy Vuitton” for dog toys.³⁴⁴ Giving a generous interpretation to the newly formulated “fair use” defense, a Virginia federal district court denied the dilution claims and recognized “Chewy Vuitton” as a protected parody and a humorous play on Louis Vuitton’s high-end image.³⁴⁵ Several scholars regarded the decision as confirmation of the post-TDRA expanded protection for trademark parodies.³⁴⁶ This promising start, however, did not mark a new era for trademark parodies. About six months later, a Utah district court gave a less parody-friendly ruling in *Harris Research, Inc. v. Lydon*.³⁴⁷ In that case, the defendant sold t-shirts and stickers bearing an image resembling the famous “Chem Dry” trademark that read “Chem-Who?” accompanied by the slogan “Stickin It to the Little Guy.”³⁴⁸ The court concluded that the plaintiff was likely to succeed in showing that the trademark was tarnished, since the defendant’s use harmed the trademark’s reputation by creating a negative association.³⁴⁹ Clearly, it is still too early to speak of a substantial change in this field. The outcome of cases involving distorted uses of famous trademarks is still as difficult to predict now as it was before the TDRA.

The defendant’s identify seems to be an important factor in these cases. Courts usually do not enjoin speakers with a reputation for wholesome entertainment, such as Paramount Pictures,³⁵⁰ Walt Disney Company,³⁵¹ Universal Studios³⁵² or “The Muppet Show.”³⁵³ As part of their target audience, judges naturally understand their jokes better. However, any form of expression uttered by such respectable speakers is automatically presumed to have considerable cultural and social value and, thus, is regarded as primary subject matter under First Amendment protection. In contrast, expressions sold by unknown

³⁴⁴ *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 464 F. Supp. 2d 495, 507 (E.D. Va. 2006), *aff’d*, 507 F.3d 252 (4th Cir. 2007).

³⁴⁵ *Id.*

³⁴⁶ See, e.g., Deborah R. Gerhardt, *The 2006 Trademark Dilution Revision Act Rolls Out a Luxury Claim and a Parody Exemption*, 8 N.C. J. L. & TECH. 205, 226–27 (2007).

³⁴⁷ 505 F. Supp. 2d 1161 (D. Utah 2007).

³⁴⁸ *Id.* at 1164, 1166–67.

³⁴⁹ *Id.* at 1166, 1168.

³⁵⁰ *Wham-O, Inc. v. Paramount Pictures Corp.*, 286 F. Supp. 2d 1254, 1261 (N.D. Cal. 2003).

³⁵¹ *Caterpillar Inc. v. Walt Disney Co.*, 287 F. Supp. 2d 913, 922 (C.D. Ill. 2003).

³⁵² *GTFM, LLC v. Universal Studios, Inc.*, No. 02. CV. 0506(RO), 2006 WL 1377048, at *2 (S.D.N.Y. May 16, 2006); *McFly, Inc. v. Universal City Studios, Inc.*, 228 U.S.P.Q. (BNA) 153, 157, 161 (C.D. Cal. 1985).

³⁵³ *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 503, 505, 507–08 (2d Cir. 1996).

entities that appear in X-rated films,³⁵⁴ underground comic books,³⁵⁵ sex magazines,³⁵⁶ on t-shirts,³⁵⁷ posters³⁵⁸ or novelties³⁵⁹ sold by unknown entities seem to have a lower chance of prevailing against an accusation of trademark tarnishment. The TDRA provides explicit exemption from dilution claims for trademark uses in news reporting and commentary,³⁶⁰ which further promotes the view that the official media channels should be extensively protected.

Further observations reveal that expressions are inevitably enjoined when they distort the trademark to raise radically unwholesome associations—usually with sex, and sometimes with illegal drugs—without conveying any additional message concerning the trademark.³⁶¹ The “Monkeying around” essay and the “Debbie Does Dallas” film are examples of such expressions—their only message concerning the respective trademarks involved a pornographic interpretation. Some additional examples are t-shirts bearing an imprint resembling the General Electric trademark reading “Genital Electric,”³⁶² a magazine parody of Pillsbury’s characters “Poppin’ Fresh” and “Poppie Fresh” engaged in

³⁵⁴ Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 467 F. Supp. 366, 376–77 (S.D.N.Y. 1979), *aff’d*, 604 F.2d 200 (2d Cir. 1979); Edgar Rice Burroughs, Inc. v. Manns Theatres, 195 U.S.P.Q. (BNA) 159, 162 (C.D. Cal. 1976).

³⁵⁵ Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 759 (9th Cir. 1978); DC Comics Inc. v. Unlimited Monkey Bus., Inc., 598 F. Supp. 110, 115–16 (N.D. Ga. 1984).

³⁵⁶ Edgar Rice Burroughs, Inc. v. High Soc’y Magazine, Inc., 7 Media L. Rep. (BNA) 1862, 1864 (S.D.N.Y. 1981); Pillsbury Co. v. Milky Way Prods., Inc., 215 U.S.P.Q. (BNA) 124, 135 (N.D. Ga. 1981).

³⁵⁷ Hard Rock Cafe Licensing Corp. v. Pac. Graphics, Inc., 776 F. Supp 1454, 1462–64 (W.D. Wash. 1991); Walt Disney Co. v. Powell, 698 F. Supp. 10, 12 (D.D.C. 1988), *aff’d in part & vacated in part*, 897 F.2d 565 (D.C. Cir. 1990); Gen. Elec. Co. v. Alumpa Coal Co., 205 U.S.P.Q. (BNA) 1036, 1036–37 (D. Mass 1979).

³⁵⁸ Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc., 600 F.2d 1184, 1186, 1188–89 (5th Cir. 1979); Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183, 1186, 1192 (E.D.N.Y. 1972).

³⁵⁹ Coca-Cola Co. v. Alma-Leo U.S.A., Inc., 719 F. Supp. 725, 728 (N.D. Ill. 1989); Am. Express Co. v. Vibra Approved Labs. Corp., 10 U.S.P.Q.2d (BNA) 2006, 2013 (S.D.N.Y. 1989).

³⁶⁰ 15 U.S.C. § 1125(c)(3)(B) (2006).

³⁶¹ *But see* L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 32–34 (1st Cir. 1987) (article identified as “L.L. Bean’s Back-To-School-Sex-Catalog” consisting of nude models using fake L.L. Bean products); Lucasfilm Ltd. v. Media Mkt. Group, Ltd., 182 F. Supp. 2d 897, 900–01 (N.D. Cal. 2002) (animated pornographic movie entitled Starballz parodying Star Wars).

³⁶² *Gen. Elec.*, 205 U.S.P.Q. at 1036.

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sexual intercourse³⁶³ and the words “New York New York \$lot Exchange” displayed on a replica of the facade of the New York Stock Exchange Building.³⁶⁴

Courts usually do not see a point in these types of trademark uses. In contrast to “Reddy Kilowatt” and “Miami Mice,” in these examples it was not clear what message the speakers wished to convey about the trademarks. Thus, although the defendants in *Dallas Cowboys Cheerleaders* argued that “Debbie Does Dallas” was a satire commenting on sexuality in athletics, the court disagreed stating that this barely discernable message did not entitle them to First Amendment protection.³⁶⁵ Similarly, in the “Monkeying around” example, the court rejected the publisher’s argument that the essay was merely social commentary on the erotic atmosphere created in the original “Tarzan” story and hence was constitutionally-protected speech.³⁶⁶ In most cases, the defendants did not even attempt to claim their speech was meaningful criticism.³⁶⁷ Indeed, it would be a hopeless endeavor to convince a judge that “Genital Electrics” or “New York-New York \$lot Exchange” has any critical point to make.

Such expressions, however, do have a point. Consider the fact that the magazine that published “Monkeying around” sold more than half a million copies.³⁶⁸ Furthermore, while the sales of “Cabbage Patch Kids” were around 40 million, more than 800 million “Garbage Pail Kids” stickers were sold.³⁶⁹ Someone apparently understood the point of these expressions and, unlike the

³⁶³ Pillsbury Co. v. Milky Way Prods., Inc., 215 U.S.P.Q. (BNA) 124, 125–26 (N.D. Ga. 1981).

³⁶⁴ N.Y. Stock Exch., Inc. v. N.Y., N.Y. Hotel, LLC, 293 F.3d 550, 553–54 (2d Cir. 2002). There are many other similar examples. See *Coca-Cola Co. v. Alma-Leo U.S.A., Inc.*, 719 F. Supp. 725, 726, 728 (N.D. Ill. 1989) (white bubble gum powder resembling cocaine in Coca-Cola look-alike bottles); *Eastman Kodak Co. v. Rakow*, 739 F. Supp. 116, 117 (W.D.N.Y. 1989) (“Kodak” as a stage name of a comedian using humor relating to bodily functions and sex); *Am. Express Co. v. Vibra Approved Labs. Corp.*, 10 U.S.P.Q.2d (BNA) 2006, 2007 (S.D.N.Y. 1989) (a credit card that looked similar to “American Express” but displayed the slogan “NEVER LEAVE HOME WITHOUT IT” with a condom concealed in a small pocket); *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1186 (E.D.N.Y. 1972) (“Enjoy Cocaine” posters).

³⁶⁵ *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979).

³⁶⁶ *Edgar Rice Burroughs, Inc. v. High Soc’y Magazine, Inc.*, 7 Media L. Rep. (BNA) 1862, 1863 (S.D.N.Y. 1981).

³⁶⁷ See e.g., *N.Y. Stock Exch., Inc. v. N.Y., N.Y. Hotel, LLC*, 293 F.3d 550 (2d Cir. 2002); *Am. Express Co. v. Vibra Approved Labs. Corp.*, 10 U.S.P.Q.2d (BNA) 2006 (S.D.N.Y. 1989); *Pillsbury Co. v. Milky Way Prods., Inc.*, 215 U.S.P.Q. (BNA) 124 (N.D. Ga. 1981); *Gen. Elec. Co. v. Alumpa Coal Co.*, 205 U.S.P.Q. (BNA) 1036 (D. Mass 1979).

³⁶⁸ *Edgar Rice Burroughs*, 7 Media L. Rep. at 1864.

³⁶⁹ *Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*, 642 F. Supp. 1031, 1032 (N.D. Ga. 1986).

courts, found them amusing. Put simply, the expressions are allegorical messages that challenged the serious, wholesome and all-important aura surrounding the famous trademarks. They mock the “licensed” cultural meaning of trademarks and attempt to shake the trademark’s idealistic status in our consumer society. In other words, Tarzan and Jane’s reputation as “persons of high moral standards, admirable traits of character, and clean and attractive appearances . . .”³⁷⁰ is precisely what “Monkeying around” challenged. The fact that people show an interest in such expressions is the best evidence of their unwillingness to accept the “licensed” meanings of trademarks imposed on them by trademark owners.

When courts enjoin speech that tarnishes trademarks because it lacks a clear critical message, they ignore the cultural reality that the meaning of expression is not always based on facts and logic. The meaning of trademarks today is generally not based on any factual data concerning the goods or services sold under the marks.³⁷¹ Rather, a trademark’s meaning is created by linking it to various cultural signs that initially have nothing to do with it. The trademark absorbs some of the meaning embedded in the signs without any logical explanation as to why the signs’ cultural values should be incorporated in the mark. Thus, no one ever doubts the legitimacy of marketing techniques that attempt to convince society of the connection between Coca-Cola and sportsmanship or between Omega and intelligence, although these connections are wholly arbitrary and based on nothing more than psychological influence and rhetoric. However, when someone wishes to challenge the cultural meaning of a trademark, to suggest its connection to somewhat less wholesome cultural signs, the legal system would not allow this unless the suggested relation has some readily conceivable point. Thus, trademark owners have a very significant advantage in the discourse over the cultural meaning of their marks. To borrow a metaphor used by the Supreme Court in another context,³⁷² the legal system currently allows one of the sides of the debate to fight freestyle, while requiring the other to follow Marquis of Queensbury rules.

This restriction is very substantial indeed. Speech based on nothing but mere rhetoric can be more powerful than any logical conclusion, since such speech cannot be rebutted. Cultural meaning based solely on mental associations is very powerful, which is precisely what trademarks are about today. Customers are much more loyal to a brand when their loyalty is based, not on

³⁷⁰ *Edgar Rice Burroughs*, 7 Media L. Rep. at 1864.

³⁷¹ *See supra* Part II.

³⁷² *R.A.V. v. City of St. Paul*, 505 U.S. 377, 392 (1992).

rational reasoning, but on emotional preference.³⁷³ A consumer who has some concrete logical reason, such as a low price, for preferring one brand to another, is likely to switch brands when that brand is no longer the cheapest. However, a consumer who intuitively and inexplicably prefers the brand is more likely to stay loyal in the face of changing circumstances.

The same logic applies to expressions that challenge the “licensed” meaning of trademarks. Thus, while the image of “Reddy Kilowatt” can be rehabilitated if its owner shows more concern for environmental issues, there is nothing to be done against “Genital Electrics.” The court in *Dallas Cowboys Cheerleaders* was right when it stated that anyone who saw “Debbie Does Dallas” would hardly be able to disassociate the Dallas Cowboys Cheerleaders from the film.³⁷⁴ This reasoning, however, should not deny use of such powerful expressive tools to those who wish to alter the “licensed” meaning of a trademark. In doing so, the courts have essentially declared a victory for the “licensed” trademark’s meaning before symbolic discourse even starts. Given the clear evidence that many people are interested in tarnishing expressions, restricting them is, in fact, suppressing the resistance to the “licensed” reality and imprisoning the public to the trademark owners’ ideological visions.

Milton Friedman argued that the political process necessarily involves some coercion, because decisions made by the majority are binding on everyone.³⁷⁵ In the free market, however, such conformity is unnecessary since different views can be represented simultaneously.³⁷⁶ Hence, Friedman argued in favor of putting as many issues as possible in the hands of the market.³⁷⁷ Tarnishing expressions offered for sale are a classic case for “market democracy.” Enjoining the distribution of these expressions imposes the ideal aura of trademarks on all consumers and constitutes unnecessary governmental intervention when the market can allow a variety of views to be represented simultaneously.

In mainly protecting decipherable critical messages, the legal system ignores the cultural discourse revolving around the meaning of cultural signs. Interestingly, courts have recognized the legitimacy of such discourse in the field of politics—a caricature ridiculing a politician does not have to convey any

³⁷³ CELIA LURY, BRANDS: THE LOGOS OF THE GLOBAL ECONOMY 86–87 (John Urry ed., 2004); C. N. Allen, *A Psychology of Motivation for Advertisers*, 25 J. APPLIED PSYCHOL. 378, 383 (1941); Amitai Etzioni, *How Rational We?*, 2 Soc. F. 1, 10 (1987).

³⁷⁴ *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema Ltd.*, 467 F. Supp. 366, 377 (S.D.N.Y. 1979), *aff’d*, 604 F.2d 200 (2d Cir. 1979).

³⁷⁵ MILTON FRIEDMAN, CAPITALISM AND FREEDOM 23–24 (1962).

³⁷⁶ *Id.* at 23–24.

³⁷⁷ *Id.* at 24.

particular critical message to be protected.³⁷⁸ In contrast, the non-existent Tarzan and Jane are entitled to extensive protection of their highly moral character.³⁷⁹ This distinction is based on the assumption that, while political matters are so important that virtually any speech relating to them is valuable, matters relating to trademarks of commercial products and to various trademarked fictional characters are not. This assumption is fundamentally flawed. Trademarks play a central role in modern consumer culture. Trademarks influence our everyday lives no less than our politicians. Trademarks, rather than politicians, are often today's heroes and idols. Hence, it is crucial to recognize the right of all members of society to engage freely in discourse over a trademark's cultural meaning.

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.³⁸⁰ Judges, belonging to the cultural elite, silence the voices of other classes by condemning their aesthetic judgments.³⁸¹ At the end of the day, those with a more sophisticated sense of humor have more of a right to speak about trademarks. A sophisticated sense of humor is part of the “cul-

³⁷⁸ See *Hustler Magazine v. Falwell*, 485 U.S. 46, 54, 57 (1988). Where a magazine pictured an “interview” with a minister who stated that his “first time” was during a drunken incestuous rendezvous with his mother in an outhouse, the Supreme Court declined the plaintiff's libel claim. *Id.* at 48, 57. Emphasizing the importance of caricatures in political debate, the Court noted that, however outrageous the caricatures are, they still constitute protected speech. *Id.* at 53; see *Monitor Patriot Co. v. Roy*, 401 U.S. 265, 266–67, 277 (1971) (dismissing a libel action for a newspaper publication characterizing a senatorial candidate as a “former small-time bootlegger”). The situation in Germany is quite different—politicians are largely protected from harsh parodies. See Edward J. Eberle, *Public Discourse in Contemporary Germany*, 47 *CASE W. RES. L. REV.* 797, 897 (1997); Ronald J. Krotoszynski, Jr., *A Comparative Perspective on the First Amendment: Free Speech, Militant Democracy, and the Primacy of Dignity as a Preferred Constitutional Value in Germany*, 78 *TUL. L. REV.* 1549, 1575–76 (2004).

³⁷⁹ See *supra* notes 332–334 and associated text.

³⁸⁰ PIERRE BOURDIEU, *MASCULINE DOMINATION* 1–2 (Richard Nice trans., 2001) (“[A] gentle violence, imperceptible and invisible even to its victims, exerted for the most part through the purely symbolic channels of communication and cognition. . .”).

³⁸¹ See generally PIERRE BOURDIEU, *DISTINCTION: A SOCIAL CRITIQUE OF THE JUDGEMENT OF TASTE* (Richard Nice trans., 1984) (stating those in power define a society's aesthetics concepts and dominate the lower class's aesthetic concepts).

tural capital”³⁸² of the ruling class. Using this criterion, the courts reaffirm its social dominance. This issue becomes particularly obvious when well-established and socially acceptable sources become preferred to questionable speakers. This approach also reinforces the dominance of currently accepted aesthetic values that are promoted by well-established media, thereby hampering the rise of underground culture.

The scope of the freedom to mock a famous trademark strongly depends on the court’s interpretation of the “fair use” defense. Courts should choose a consistent policy that denies tarnishment claims whenever a famous trademark is used in a way that clashes with its idealized image, regardless of whether the distorting expression has any readily decipherable message.³⁸³ Yet, such a policy may be more difficult to defend after the enactment of the TDRA, since protection against tarnishment is now explicitly incorporated into federal law. If any expression that distorts a famous trademark’s ideal aura is exempted as “fair use,” it is hard to see what will be covered by the protection against a “harming association.”

d. The Likelihood of Consumer Confusion

Interestingly, in most tarnishment cases, courts have concluded that the defendant’s use was likely to confuse consumers. For example, courts have assumed that consumers would believe trademark owners had approved the “Enjoy Cocaine”³⁸⁴ posters, the “Genital Electrics”³⁸⁵ t-shirts, the “Monkeying around” essay³⁸⁶ and many other tarnishing uses.³⁸⁷ Sometimes plaintiffs even presented evidence of actual confusion.³⁸⁸ For instance, in one survey, over half

³⁸² For background on the concept of “cultural capital,” see PIERRE BOURDIEU, *THE FORMS OF CAPITAL* 243–44 (Richard Nice trans., 1983).

³⁸³ The decision in *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 464 F. Supp. 2d 495, 499 (E.D. Va. 2006) provides precedent for this approach. The court defined protectable parody broadly, as “juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner.” *Id.* at 499.

³⁸⁴ *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1188–91 (E.D.N.Y. 1972).

³⁸⁵ *Gen. Elec. Co. v. Alumpa Coal Co.*, 205 U.S.P.Q. (BNA) 1036, 1036–37 (D. Mass 1979).

³⁸⁶ *Edgar Rice Burroughs, Inc. v. High Soc’y Magazine, Inc.*, 7 Media L. Rep. (BNA) 1862, 1863 (S.D.N.Y. 1981).

³⁸⁷ See, e.g., *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403–05 (9th Cir. 1997); *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 774–75 (8th Cir. 1994); *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 398–401 (8th Cir. 1987); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema Ltd.*, 467 F. Supp. 366, 377 (S.D.N.Y. 1979), *aff’d*, 604 F.2d 200 (2d Cir. 1979).

³⁸⁸ *Anheuser-Busch*, 28 F.3d at 775; see *Mutual of Omaha Ins.*, 836 F.2d at 400.

of the people actually believed that Michelob's approval was needed to publish the mocking ad "One Taste And You'll Drink It Oily."³⁸⁹ The likelihood of consumer confusion in such cases usually leads the courts to establish traditional trademark infringement, providing an additional basis for enjoining the tarnishing speech. The TDRA strengthens this line of judicial practice by making tarnishing uses impossible to exempt when consumer confusion is likely. Unlike the previous anti-dilution law, the TDRA confines the "fair use" exemption to dilution cases, thus making clear that traditional trademark infringement involving likelihood of consumer confusion will never be considered a "fair use."³⁹⁰

However, the very phenomenon of confusion in tarnishment cases is much more alarming than the consequences of this confusion for trademark owners, let alone consumers. Consumer confusion in such cases means that the "licensed" culture has taken deep roots in our society. This kind of consumer confusion means that the public has grown accustomed to the idea that every trademark use must be authorized. People are likely to believe that the trademark owner approved the use, even when the trademark is used to convey a political message wholly unrelated to the trademark or when the trademark is mocked. This means that trademark owners are largely regarded as the sole legitimate origin of trademark use, even when that use is merely expressive. People believe that trademark owners are the only entities that can decide how the trademarks will be interpreted, in which contexts they may be used, and what ideas can be associated with them. In other words, the public has already learned to accept the position that trademark owners are powerful censors of speech related to their marks.

If we were told about a society where people believed that every poster bearing the name of the likeness of their political leader must have been approved by him, we would probably assume that those people live under a strict dictatorship. Meanwhile, our society has already learned to accept the same type of censored reality: where trademark owners play the dictator's role, where people do not expect trademarks to be used without the consent of their owners, and where the power to preserve a trademark's "licensed" meaning is taken for granted.

Of course, everyone should have the right *not* to speak, which explains the courts' concern that the public may attribute statements to the trademark owner that the owner never made. However, although one court noted that the purchaser of a book parodying a famous trademark has the same right not to be

³⁸⁹ *Anheuser-Busch*, 28 F.3d at 772, 775.

³⁹⁰ 15 U.S.C. § 1125(c)(3) (2006).

confused as a purchaser of a can of peas,³⁹¹ there is a significant difference between confusion related to the source of goods and confusion related to the source of speech. In other words, the question “have you made this product?” is entirely different from the question “have you said that?” or rather, “have you given your consent for people to talk about you like that?” In terms of the Q model, these are two different kinds of links.

The right not to speak becomes an extremely powerful tool for suppressing unwanted speech and creating public beliefs about the trademark owner’s right to control expressive uses of their marks when it is combined with the consumer confusion test. The mechanism of consumer confusion turns on the views of the minority who believe in needing the trademark owners’ consent for certain uses of their trademarks. This mechanism steadily increases the scope of uses that only trademark owners can mandate. Thus, only a small minority of the consumers believing that a trademark owner has approved a certain expression is enough to enjoin such expression based on the trademark owner’s rights. This view of a minority turns into reality and the rest of the public is eventually educated to accept the minority view.

There is no similar mechanism for the right not to speak outside the trademark context. When no one explicitly ascribes a speech to someone who did not say it, the question whether somebody would mistakenly believe that she approved the speech where she was somehow mentioned simply does not arise. Imagine if someone conducted a survey to investigate whether the public believes that George W. Bush has approved the use of his name with a swastika instead of an “S.” Further, imagine that some of the people surveyed believed that he did approve such a use or that such use of the president’s name is impossible without his consent. Should society then restrict this kind of speech because of this finding of actual confusion? If a survey shows that a substantial number of people are confused, serious concerns as to democratic awareness and public education are raised.

In the context of tarnishment, it is especially important to realize that the mechanism of consumer confusion is actually a tool for creating public perceptions. Courts should thoroughly consider the political consequences of reinforcing the belief that mocking a trademark or using it as an expressive tool requires approval from its owner. Courts should ask themselves if this censored reality is the reality we want to live in.

³⁹¹ Charles Atlas, Ltd. v. DC Comics, Inc., 112 F. Supp. 2d 330, 337 (S.D.N.Y. 2000) (citing Rogers v. Grimaldi, 875 F.2d 994, 997 (2d Cir. 1989)).

As already mentioned, the TDRA excludes the possibility of recognizing a confusing trademark use as non-infringing.³⁹² Thus, protecting tarnishing uses is more difficult today, since a substantial part of the consuming public believes that the trademark owner has approved the use. The best way to solve this problem without amending current legislation would be to narrowly interpret the term “consumer confusion,” as confusion related to the origin of a product or a service, not as confusion related to the source of speech.

C. The Property Rhetoric of Trademark Law

Courts often rely on property rhetoric to justify their decisions in trademark cases.³⁹³ Thus, trademark owners have a property right that provides various exclusive rights, including: (1) to display their marks on merchandise;³⁹⁴ (2) to obtain domain names that include their marks;³⁹⁵ and (3) to decide where their marks will be used and to protect them against injury from undesirable associations.³⁹⁶ By relying on property rhetoric, the courts escape the necessity of balancing the conflicting interests underlying trademark cases. For instance, does the public interest in the existence of unlicensed, inexpensive merchandise outweigh trademark owners’ interest in exploiting the economic value of their trademarks? What is more important in the context of the Internet: to raise public awareness of problematic issues related to trademarks or to enable consumers to quickly and easily access a trademark owner’s official site? Does the public interest in using trademarks as expressive tools, in parodies, mocking them or shaking trademarks’ idolized status, outweigh trademark owners’ interest in preserving the “licensed” meaning of their marks?

The courts’ use of property rhetoric obscures these underlying conflicts, making the outcomes of the decisions seem inevitable and even giving the feeling that the legal system only enforces preexisting natural rules. However, re-

³⁹² § 1125(c)(3).

³⁹³ See, e.g., *Boston Athletic Ass’n v. Sullivan*, 867 F.2d 22, 27 (1st Cir. 1989); *Boston Prof’l Hockey Ass’n, Inc. v. Dallas Cap & Emblem Mfg.*, 510 F.2d 1004, 1014 (5th Cir. 1975).

³⁹⁴ See, e.g., *Boston Athletic Ass’n*, 867 F.2d at 27; *Boston Prof’l Hockey Ass’n, Inc.*, 510 F.2d at 1014.

³⁹⁵ In this case, the ACPA states so explicitly. 15 U.S.C. § 1125(d)(1)(B)(i) (2006).

³⁹⁶ See, e.g., *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 541 (1987); *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402–03 (8th Cir. 1987); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979); *Chem. Corp. of Am. v. Anheuser-Busch, Inc.*, 306 F.2d 433, 437 (5th Cir. 1962); *Walt Disney Co. v. Powell*, 698 F. Supp. 10, 12 (D.D.C. 1988), *aff’d in part & vacated in part*, 897 F.2d 565 (D.C. Cir. 1990); *Interbank Card Ass’n v. Simms*, 431 F. Supp. 131, 133–34 (M.D.N.C. 1977).

garding the trademark right as property, rather than simply a right to be protected against unfair competition,³⁹⁷ is a normative decision made by the legal system. The scope of property rights depends entirely on the extent to which the legal system in general, and courts in particular, are willing to protect those rights. It cannot be argued that the property right of the trademark owner is the right to protect the economic value of the trademark, since its value is the outcome of the legal protection. Therefore, this argument is circular.³⁹⁸ For instance, the market for decorative merchandise would not be a source of profit for trademark owners if decorative uses of trademarks were not considered infringing uses. Similarly, the “licensed” meaning of a trademark would not provide economic value if the use of a trademark to convey an expressive message was not considered an infringing use.³⁹⁹

The courts’ use of property rhetoric allows for very far-reaching suppression of free speech. Though free speech receives extensive protection against governmental restrictions, it is not protected against restrictions stemming from private property rights. Governmental restrictions of speech are subject to severe judicial scrutiny; they must be “narrowly tailored” to serve compelling public interests.⁴⁰⁰ Yet when the restriction of speech stems from private intellectual property rights, no such constraints are recognized.⁴⁰¹ As one court stated, “the First Amendment is not a license to trammel on legally recognized rights in intellectual property.”⁴⁰²

³⁹⁷ Trademark law is considered to be part of unfair competition law. *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918); *Union Nat’l Bank of Tex., Laredo, Tex. v. Union Nat’l Bank of Tex., Austin, Tex.*, 909 F.2d 839, 844 n.10 (5th Cir. 1990).

³⁹⁸ See Felix Cohen, *Transcendental Nonsense and the Functional Approach*, 35 COLUM. L. REV. 809, 815 (1935).

³⁹⁹ For an extensive analysis of the economic aspects of protecting the non-informational value of trademarks, see KATYA ASSAF (ZAKHAROV), *IMAGE IN DER WERBUNG* 5–37, 54–59 (2007). For a condensed version of this analysis, see Katya Assaf (Zakharov), *The Scope of Protection of Trademark Image—Including Comments on a Recent Decision of the Israeli Supreme Court*, 36 INT’L REV. INDUS. PROP. COPYRIGHT L. 787 (2005).

⁴⁰⁰ See, e.g., *Republican Party of Minn. v. White*, 536 U.S. 765, 765 (2002); *Kusper v. Pontikes*, 414 U.S. 51, 58–59 (1973); *Dunn v. Blumstein*, 405 U.S. 330, 343 (1972).

⁴⁰¹ See, e.g., *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (“The propriety of a preliminary injunction where such relief is sought is so clear that courts have often issued an injunction without even mentioning the [F]irst [A]mendment.”); *Interbank Card Ass’n v. Simms*, 431 F. Supp. 131, 134 (M.D.N.C. 1977) (“The Court finds that . . . the defendant in the name of the First Amendment cannot as a matter of law infringe upon the plaintiff’s service mark or trademark in the Master Charge credit cards and window stickers.”).

⁴⁰² *Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc.*, 600 F.2d 1184, 1188 (5th Cir. 1979).

The extensive protection of free speech in the United States prevents restrictions on racist appeals,⁴⁰³ hate speech⁴⁰⁴ and Nazi demonstrations.⁴⁰⁵ The same legal thought results in no protection for cultural signs, important as they can be. Governmental content-based restrictions on free speech are nearly always unconstitutional.⁴⁰⁶ However, when a famous trademark is the subject, there is almost no limit to the speech restrictions that may be imposed in order to preserve the trademark's ideal aura. Thus, property rights function like a broad license to suppress free speech. Restrictions that cannot be imposed by the government in the name of the public interest are common and seem even natural when based on a private property right. But is preserving the positive connotations of "Coca-Cola" really more important for our society than protecting African-American or Jewish people from hurtful and humiliating speech? Is the unique meaning of Mickey Mouse really more important for us than that of the U.S. flag?⁴⁰⁷

Property rhetoric tends to hypnotize the courts and prevent analysis of the real issues at stake. Such far-reaching restrictions on free speech, restrictions that seem so alien to U.S. legal thought, are made possible by representing them as an exercise of private property rights, rather than governmental constraints. For example, by enjoining the distribution of "Christ Charge" cards, the court explicitly noted the absence of any governmental involvement with the asserted First Amendment violations.⁴⁰⁸

⁴⁰³ See, e.g., *Virginia v. Black*, 538 U.S. 343, 347–48 (2003); *Brandenburg v. Ohio*, 395 U.S. 444, 444–45 (1969); *Doe v. Univ. of Mich.*, 721 F. Supp. 852, 853–54, 868 (E.D. Mich. 1989).

⁴⁰⁴ See, e.g., *R.A.V. v. City of St. Paul*, 505 U.S. 377, 379–80, 396 (1992); *Texas v. Johnson*, 491 U.S. 397, 399 (1989).

⁴⁰⁵ See, e.g., *Collin v. Smith*, 447 F. Supp. 676, 702 (N.D. Ill. 1978), *aff'd*, 578 F.2d 1197 (7th Cir. 1978).

⁴⁰⁶ See, e.g., *Tinker v. Des Moines Indep. Cmty. Sch. Dist.*, 393 U.S. 503, 517 (1969); *Thompson ex rel. Thompson v. Waynesboro Area Sch. Dist.*, 673 F. Supp 1379, 1387 (M.D. Pa. 1987). *But see Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) ("The prohibition of the Lanham Act is content neutral, and therefore does not arouse the fears that trigger the application of constitutional 'prior restraint' principles.").

⁴⁰⁷ It should be noted that, in cases in which a trademark consists of a name or a likeness of a living person, some limitations to "tarnishing" uses should be recognized based on the laws against libel, slander, and incitement. For instance, in contrast to the flag, burning a picture of a living individual should not be allowed.

⁴⁰⁸ *Interbank Card Ass'n v. Simms*, 431 F. Supp. 131, 133–34 (M.D.N.C. 1977).

The distinction between private and governmental censorship is, however, an artifice. The state creates and enforces property rights.⁴⁰⁹ The state decides to grant commercial conglomerates the power to control the cultural meaning of their trademarks. The veil of property rhetoric must be stripped to see if granting such power is good policy.

The cultural meaning of trademarks should not be protected merely because the trademark owner invested money and effort in creating that meaning. This “natural right” argument presupposes that a valuable asset was created by investing labor in un-owned property.⁴¹⁰ This, however, is not the case with cultural signs, which give trademarks their meaning. Cultural signs such as Nike (the Goddess), the Statue of Liberty or the notion of happiness are more properly described as goods belonging to society as a whole, rather than as goods belonging to no one in particular. Just as one cannot build a house in the middle of a public park and then claim a property right to it, trademark owners cannot claim a property right in the cultural meaning of their marks based on the argument of the investment of their labor. Rather, the question should be whether there is a sufficient public interest that can justify such property rights.⁴¹¹

Intellectual property rights are granted to encourage the creation of intangible assets. Particularly, trademark rights are granted in order to encourage trademark owners to invest in the quality of their goods and services, thereby creating and maintaining the goodwill of their businesses.⁴¹² Protection of trademarks against consumer confusion as to the origin of goods or services wholly satisfies this purpose. However, when a trademark’s cultural meaning is regarded as part of a property right in the mark, the trademark owner is encouraged to invest in the creation of cultural meaning, rather than in the quality of its goods and services.

The cultural meaning of trademarks is created by employing psychological methods to create associative links in the consumer’s mind between the trademark and the desired cultural signs.⁴¹³ These marketing techniques dilute the non-commercial signs of our culture, populate our living environment and

⁴⁰⁹ Joseph William Singer, *Legal Realism Now*, 76 CAL. L. REV. 465, 487–94 (1988).

⁴¹⁰ JOHN LOCKE, OF CIVIL GOVERNMENT 129–41 (Ernest Rhys ed., E. P. Dutton & Co. 1943) (1689).

⁴¹¹ I would like to thank Dr. Yossi Dahan for this remark. For a different analysis of the Lockean argument in the context of culturally meaningful intellectual properties, see Gordon, *supra* note 4, at 1606–09.

⁴¹² MCCARTHY, *supra* note 11, at §§ 2:3–2:4.

⁴¹³ See *supra* Part II.

control the contents of our communication media. These techniques strengthen materialistic values in our society; whereas empirical studies show that such values have an adverse effect on personal well-being.⁴¹⁴ I believe that commercial corporations should be discouraged, rather than encouraged, from creating cultural meaning in their trademarks. The extensive protection of trademarks is one of the factors that make the investment in their cultural meaning so beneficial. It is one of the reasons for the current state of affairs in which advertising is predominantly designed to attribute cultural meaning to trademarks and not to provide any information about products or services. The economic value of our mental associations encourages trademark owners to think of more and more sophisticated ways to interject their trademarks in the narratives of our culture. This makes commercial speech, which is generally considered less valuable than other types of speech, a powerful and dominant force in our society.

Meaningful trademarks enrich our cultural domain and provide us with a distinctive means of expression,⁴¹⁵ as the phrase “her mind is Tiffany-twisted”⁴¹⁶ illustrates. However, this enrichment is not a sufficient reason to protect a trademark’s cultural meaning.⁴¹⁷ Even if we ignore the negative effects of the process of creating culturally meaningful trademarks on our cultural and social environment, there is still a strong argument to deny this kind of protection. This is because trademark law deals with a very special kind of property—the property in semantic links. To a certain extent, trademark law determines what people should believe about trademarks. In essence, a trademark is a property right over a territory existing in people’s minds. Therefore, the scope of trademark protection should be established very cautiously.

The original purpose of trademark law was simply to protect the semantic link implying that the trademark owner is the origin of the respective goods or services. That is, trademark law grants the trademark owner the right to have people believe it is the origin of these goods or services. However, if the trademark owner’s property right includes the trademark’s cultural meaning, it actually means that the trademark owner also has the right that people associate its trademark with certain positive values that constitute its “licensed” meaning. This is a very far-reaching right to control what people think. Even if the

⁴¹⁴ TIM KASSER, *THE HIGH PRICE OF MATERIALISM* 5–22 (2002).

⁴¹⁵ See William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267, 272–75 (1988) (arguing that trademarks enrich our language in several ways).

⁴¹⁶ *Supra* note 218.

⁴¹⁷ See Justin Hughes, “Recoding” *Intellectual Property and Overlooked Audience Interests*, 77 TEX. L. REV. 923, 927–28 (1999) (arguing that the public interest in the stability of “proper-tized” cultural objects justifies protection against alteration of their meaning).

trademark's contribution to our cultural domain is highly appreciated, the public's interest in trademarks as cultural signs cannot justify this control. As an analogy, the public has an interest in protecting cultural signs like the national flag and the image of the U.S. Congress. However, since such protection inevitably dictates what people should associate these signs with, and what they should believe about the entities that these signs represent, our legal system denies this kind of protection. The same logic should lead the legal system to deny protection of trademarks as cultural signs as well. Unfortunately, the TDRA asserts just the opposite position—defining dilution as an association impairing the distinctiveness and the reputation of a famous mark—which explicitly incorporates positive associations into the trademark's property right.⁴¹⁸ The TDRA's "likelihood of dilution" standard of proof makes the property right in associations especially strong.

Trademark rights should be limited to the establishment and protection of the semantic link that points at the trademark owner as the origin of its goods or services. Trademark law should not protect any other semantic links. Specifically, the law should not protect a semantic link that points at the trademark owner as to the origin of a trademarked cultural sign. A trader of merchandise bearing a famous trademark should be able to benefit from the merchandise's association with the trademark owner, since this type of mental association is not relevant to the focus of trademark protection. The same is true for links pointing to the trademark owner as the origin of speech. Trademark law should not provide protection against confusion with respect to the question of whether the trademark owner approves certain speech.

More importantly, trademarks should not be protected against uses that change existing semantic links. When a trademark is used to misrepresent the user as the trademark owner and the origin of goods and services, such a use changes nothing in the semantic network. Since consumers believe that the trademark owner is the origin of the goods or services, no alterations in the semantic network occur. Just like authorized uses, confusing uses merely reinforce the existing semantic link, which indicates the trademark owner as the source of the respective goods or services. The fact that the trademark owner is, in fact, not the origin of goods and services in an unauthorized use changes nothing from the semiotic perspective, since consumers, unaware of the confusion, continue to perceive the trademark as a source identifier.⁴¹⁹ The protection

⁴¹⁸ 15 U.S.C. § 1125(c)(2)(A) (2006).

⁴¹⁹ ECO, *supra* note 16, at 179. For a somewhat different analysis of this issue, see Jacoby, *supra* note 125, at 1042–45.

of this semantic link against unauthorized exploitation is the primary target of trademark law. Therefore, such unauthorized uses must be enjoined.

However, uses that alter the semantic links leading to a famous trademark should not be enjoined. In a democratic society, the major role of speech is to present multiple views, so that the discourse over various social issues resembles a dialogue rather than a monologue. Therefore, it is important to protect speech that challenges the existing consensus.⁴²⁰ In terms of the Q model, any type of speech that modifies the semantic network's existing structure, either by adding a new link or by altering an existing one, should be extensively protected. This kind of speech is what Eco referred to as "aesthetic text."⁴²¹ "Aesthetic text" empowers people's imaginations and invites them to question the long-established and uncontroversial social conventions. In a democratic society, individuals have a basic right to be exposed to this kind of speech. When such speech is suppressed, the very heart of democracy is at stake.

When consumers knowingly buy imitations of trademarked goods, they add a new semantic link to the trademark, a link that implies that imitations of the trademark are possible—thus shaking the original trademark's exclusive authority. Similarly, when a famous trademark is used on goods so distant from its original use that no confusion occurs, a new link with the trademark is created, which weakens the existing links. Similarly, when a trademark is used to convey an unrelated idea or that clashes with its image, new associative links emerge that alter the semantic configuration that forms its "licensed" cultural meaning.

Although not all of these uses constitute "speech" in the traditional sense, they all should be protected under the First Amendment. Such uses alter the semantic network and, thus, should be considered "aesthetic text"—symbolic communication that should be protected as speech. The fact that commercial entities often are responsible for such uses is irrelevant, since the reason for protection is the right of the public to *hear* these messages. That is, the mentioned uses are valuable, not because of the user's freedom of speech, but because of the right of the public to be exposed to alternative interpretations, to hear something other than the authoritarian tone of the "licensed" cultural meaning cherishing the exclusivity and solemnity of commercial trademarks.

Just as the name of a political candidate symbolically connotes the ideology her party endorses, famous trademarks are the ultimate symbols of the commercial corporations' ideology, which endorses such values as the impor-

⁴²⁰ A similar argument was made by Prof. Shiffrin in STEVEN H. SHIFFRIN, *DISSENT, INJUSTICE, AND THE MEANINGS OF AMERICA* 46 (1999).

⁴²¹ ECO, *supra* note 16, at 261–76.

tance of consumption and the incontestability of the capitalistic world order. These values have a dominant position in our culture and trademarks are the cultural signs that symbolize this dominance. Any use that alters the “licensed” meaning of a trademark weakens the hegemony of the commercial ideology. Any such use, even if made for commercial benefit and even if not constituting “speech” in the traditional sense, is analogous to voicing a counter-hegemonic view and should, therefore, be permitted, even encouraged. By protecting trademark meanings from alteration, the legal system implicitly favors commercial ideology over alternative world-views and helps commercial corporations’ efforts to make such ideology seem natural and indisputable. Restricting uses that challenge the cultural meaning of trademarks is equivalent to protecting the views of a dominant social group and to preserving the existing dynamics of social and cultural power.

A trademark’s cultural meaning should simply not be considered a subject of property at all. That is, the property right of the trademark owner should not encompass the territory in consumers’ minds, where the associations and beliefs of the cultural meaning of trademarks exist. Then, users who wish to exploit this meaning will not have to demonstrate a valuable interest as the right to freedom of speech, which may help the user prevail against the trademark owner’s interests. As cultural signs, trademarks should enjoy no privilege over other signs. The entire discourse over meanings of cultural signs should be free.

I am aware of the fact that for many decades, the scope of trademark rights in the United States and other Western countries has gradually expanded. Thus, this article’s proposal for a narrower scope of trademark protection may seem an unrealistic attempt to move the clock backwards. The broad interpretation of the term “consumer confusion” and the extensive protection against trademark dilution seem to be facts of life that are here to stay. Although some improvements can be achieved by creative interpretation of the existing law—and this article makes several suggestions in this direction—it is clear that this technique has a limited capacity to bring about fundamental change. Confining trademark protection to cases of genuine confusion about the source of goods or services would require substantial changes in federal and state legislation, some of which would probably be impossible in light of today’s international law.⁴²² However, there is no reason for pessimism. The fact that legal protection of trademarks has grown extensive over time does not necessarily indicate that this

⁴²² Several international treaties, of which the Agreement on Trade-Related Aspects of Intellectual Property is the most potent, provide expanded protection to famous trademarks. See *Agreement on Trade-Related Aspects of Intellectual Property Rights*, art. 16, Apr. 15, 1994, 33 I.L.M. 81.

tendency will continue. As the history of patent law illustrates, the opposite can occur—after protection grows very strong and brings about undesirable consequences, the legal attitude can radically change to restrict the scope of rights.⁴²³ Since the emergence of trademark law, its protection has been moving in one direction—the direction of expanding trademark rights. It is high time for the pendulum to swing back.

V. CONCLUSION

The practice of attributing cultural meaning to trademarks has substantial dilutive effects on other cultural signs and contributes to the commercialization of our social and cultural spaces. This practice, however, cannot either be banned altogether or severely limited. In a democratic society, the government should not be able to protect the meaning of cultural signs against alterations, except in very special and rare cases. At the same time, the law should not provide incentives that encourage the practice of commercializing cultural signs.

When the law protects a trademark's cultural meaning, it makes the practice profitable and actually encourages the creation of such meaning. The process of creating cultural meanings for commercial trademarks charges the cultural signs exploited in the process with a commercial connotation. Allowing various entities, such as universities, museums, famous singers and actors, and police departments, to register and merchandise their insignias as trademarks

⁴²³ The United States became an independent sovereign nation in the midst of the Industrial Revolution, a period marked by great admiration of human skills, *inter alia*, inventive skills. The importance of patent protection was so strongly recognized during this time that the U.S. Constitution explicitly grants Congress the power to grant such protection. See U.S. CONST. art. I, § 8, cl. 8. Over a long period of time, patent protection was more or less moving in one direction, steadily expanding in scope. See Adam Mossoff, *Who Cares What Thomas Jefferson Thought about Patents?*, 92 CORNELL L. REV. 953, 989–1009 (2007). After the stock market crash of 1929 and the Great Depression, however, courts became hostile towards patents, considering them as one of the factors contributing to market monopolization and economic recession. See Simone A. Rose, *Patent “Monopolyphobia”: A Means of Extinguishing the Fountainhead?*, CASE W. RES. L. REV. 509, 548 (1999). This attitude was expressed by Justice Jackson in *Jungerson v. Ostby & Barton Co.* in his statement that “the only patent that is valid is one which [the Supreme] Court has not been able to get its hands on.” 335 U.S. 560, 572 (1949). Patent law blossomed again in the early 1980s and since then the scope of patent protection has gradually increased again. See, e.g., Leonard J. Feldman et al., *Independent Ink at the Crossroad of Antitrust and Intellectual Property Law: The Court’s Holding Regarding Market Power in Cases Involving Patents and Implications in Cases Involving Copyrights*, 30 SEATTLE U. L. REV. 407, 419 (2007); Lilly He, *In Re Bilski En Banc Rehearing on Patentable Subject Matter: Farewell to Business Method Patents?*, 14 B.U. J. SCI. & TECH. L. 252, 252–53 (2008).

encourages such entities to commercialize the cultural signs representing them. Thus, today trademark law provides implicit encouragement for the creation of a certain type of meaning to cultural signs—the commercial corporations' meaning.

This outcome is undesirable. The law should not favor certain types of meaning for cultural signs. Cultural signs reflect our society's values and conventions. For individuals, cultural signs are means of understanding the reality around them. On the social level, cultural signs determine whether certain things will be perceived as natural or abnormal, certain issues as important or negligible, and so forth. In a democratic society, cultural signs should reflect, as much as possible, the real values and beliefs of its members; their meaning should evolve in a free dialogue between individuals. The law should avoid pushing this dialogue in a certain direction by favoring certain meanings of cultural signs over other meanings.

Furthermore, when the law encourages trademark owners to imbue cultural signs with commercial meaning, it provides implicit support for the ideological visions endorsed by commercial corporations. This ideology has already acquired a dominant position in our society. It becomes increasingly entrenched, as trademark owners are encouraged to attribute cultural meaning to their trademarks, thereby adding commercial connotations to other cultural signs. In addition, this ideology is promoted by encouraging non-commercial institutions to create commercial trademarks out of their insignia. In other words, the ideology of consumption promoted by commercial corporations has a very strong position, *inter alia*, because mythological and historical figures, educational institutions, popular singers and actors, as well as values like love and happiness, all have commercial connotations. In a democratic society, generally there is a very high interest in a multitude of views, with the resulting social discourse resembling a dialogue rather than a monologue. In our society, there is a significant interest in shaking up the hegemony of commercial ideology. The greater the number of important cultural signs that are free from commercial connotations, the weaker this hegemony will be and the more space that will be left for alternative social values. Therefore, the law should avoid encouraging the commercialization of cultural signs.

The cultural meaning of trademarks is built upon our society's public lands: in the area of our culture. It exists in our minds and thoughts. No one should be allowed to claim a property right over this territory.