

ARTICLE

FREE SPEECH CHALLENGES TO TRADEMARK LAW AFTER *MATAL V. TAM*

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ABSTRACT

Trademark laws and free speech are on a collision course. In *Matal v. Tam*, the U.S. Supreme Court clarified that trademark laws are speech regulations subject to First Amendment scrutiny when it held that the federal trademark law denying registration to potentially disparaging marks was unconstitutional. *Tam* opens the door to wide-ranging free speech challenges to trademark laws in the United States. Most trademark laws should survive constitutional scrutiny after *Tam*, including laws that facilitate the communication of source-identifying product information, promote fair competition, and protect consumers from misleading uses of marks. Some laws will not. For example, if courts apply the U.S. Supreme Court's traditional First Amendment jurisprudence to

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trademark dilution law, they should find this statute to be an unconstitutional regulation of nonmisleading commercial expression.

We should also consider whether the First Amendment right to freedom of expression is harmed when the government registers and protects trademark rights in certain language and product features that intrinsically communicated a non-source-identifying message before they were adopted or used as marks. Examples include words and designs that are descriptive, common, informational, or culturally-significant, and colors, representational shapes, and other pre-existing terms, symbols, or devices that were inherently valuable before they were claimed as marks. Regardless of whether these marks are deemed to be non-functional and distinctive after use in the marketplace, granting and enforcing trademark rights in this inherently valuable expression chills nonmisleading speech protected by the First Amendment and may be unconstitutional after *Tam*. At a minimum, Congress should clarify in the trademark statute that these marks only have a narrow scope of protection and it should add more statutory defenses.

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I. INTRODUCTION

Trademark laws and free speech are on a collision course. In 2017 in *Matal v. Tam*,¹ the U.S. Supreme Court held for the first time that a trademark law violated the Free Speech Clause in the First Amendment of the U.S. Constitution.² The *Tam* case involved a First Amendment challenge to the disparagement clause in Section 2(a) of the Lanham Act (the federal trademark law), which denied the benefits of registration to marks which may disparage people, institutions, beliefs, or national symbols.³ The U.S. Patent and Trademark Office (“USPTO”) used this law to reject Simon Tam’s application to register THE SLANTS as a mark for the entertainment services of his rock band on the ground that the

1. 137 S. Ct. 1744, 1751 (2017).

2. U.S. CONST. amend. I.

3. 15 U.S.C. § 1052(a) (2012).

mark may disparage people of Asian descent.⁴ The band's current lineup is entirely Asian-American, and Tam said his band wanted to register the mark to "reclaim' the term and drain its denigrating force."⁵

Although Tam's band could still use "The Slants" name without a trademark registration, the Court held the disparagement clause implicated the First Amendment because the law chilled expression by denying the benefits of registration to marks based on their content.⁶ Per the Court, this law "offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend."⁷ The Justices held that the disparagement clause was an invalid regulation of the viewpoint of expression,⁸ and applied the Court's traditional First Amendment jurisprudence to this trademark law.⁹ Importantly, the Court declined to apply free speech doctrines in this case that would have eliminated First Amendment protection for trademarks or resulted in highly permissive rational-basis review of the law.¹⁰ Among other things, the Court held that trademark registrations are not government speech,¹¹ and none of the Justices used rational-basis analysis when evaluating the constitutionality of the law.¹²

Tam opens the door to wide-ranging free speech challenges to

4. *Tam*, 137 S. Ct. at 1753–55.

5. *Id.* at 1751.

6. *Id.* at 1752–53 (discussing the benefits of federal registration of a trademark).

7. *Id.* at 1751.

8. Justice Samuel Alito wrote the majority opinion, *Id.* at 1751–60, and a plurality opinion in *Tam*. *Id.* at 1763–65 (Alito, J.) (plurality opinion). In addition, Justices Anthony Kennedy and Clarence Thomas wrote concurring opinions. *Id.* at 1765–69 (Kennedy, J., concurring); *id.* at 1769 (Thomas, J., concurring). Newly-appointed Justice Neil Gorsuch did not take part in the decision, and Justice Thomas did not join Part II of the majority opinion.

9. *Id.* at 1763–65 (Alito, J.) (plurality opinion); *id.* at 1765–69 (Kennedy, J., concurring).

10. *Id.* at 1757–60 (majority opinion); *id.* at 1763–65 (Alito, J.) (plurality opinion).

11. *Id.* at 1757–60 (majority opinion).

12. *Id.* at 1764 (Alito, J.) (plurality opinion) (applying intermediate scrutiny analysis without deciding whether it was the appropriate level of scrutiny); *id.* at 1767 (Kennedy, J., concurring) ("[T]he viewpoint based discrimination at issue here necessarily invokes heightened scrutiny."); *id.* at 1769 (Thomas, J., concurring) ("I continue to believe that when the government seeks to restrict truthful speech in order to suppress the ideas it conveys, strict scrutiny is appropriate, whether or not the speech in quest may be characterized as 'commercial.'"). The Court left open the question of whether the *Central Hudson* test or another First Amendment doctrine should be used when deciding free speech challenges to other provisions of the Lanham Act. *Id.* at 1763 n.16, 1764 n.17 (Alito, J.) (plurality opinion).

trademark laws in the United States.¹³ As explained in Part II of this Article, it is significant that the Court held that a trademark law regulated speech protected by the First Amendment and applied the Court's traditional constitutional balancing tests to the disparagement clause instead of adopting a new trademark-specific First Amendment doctrine. It is clear after *Tam* that we should evaluate the constitutionality of trademark statutes and regulations to determine if they violate the free speech right, and not assume that all laws regulating trademarks are constitutional or subject only to rational-basis constitutional review.

Unfortunately, the *Tam* Court declined to decide which First Amendment test(s) should be used when evaluating free speech challenges to trademark laws. It also did not take a position on whether trademark laws regulate noncommercial speech in addition to commercial speech. Nor did the Court discuss whether other trademark laws are content-based or content-neutral regulations of speech, or what government interests are sufficiently important to constitutionally justify these laws. We also don't know if courts should apply traditional First Amendment doctrines such as intermediate or strict scrutiny analysis to private causes of action for infringement or dilution of trademarks, or whether the limited public forum doctrine or another constitutional framework should be used to evaluate the constitutionality of other trademark registration laws.

This Article concludes that guidance on some of these issues can be found in the decisions of the Justices in *Tam* and other Supreme Court decisions relating to trademark and free speech law. It also provides some preliminary thoughts on how to apply the Court's First Amendment jurisprudence to trademark laws after *Tam*.¹⁴ Among other things, Part III of this Article argues that trademark laws apply to commercial and noncommercial speech and regulate the content (and sometimes the viewpoint) of speech.

13. For useful detailed information about the trademark laws discussed in this Article, see generally ANNE GILSON LALONDE & JEROME GILSON, *GILSON ON TRADEMARKS* (2017); J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* (5th ed. 2018).

14. The Court's First Amendment jurisprudence is sometimes unclear, unpredictable, and otherwise problematic, but certain rules can be identified. ERWIN CHERMERINSKY, *CONSTITUTIONAL LAW: PRINCIPLES AND POLICIES* 976–1220 (5th ed. 2015) (providing an overview of free speech law). This Article assumes the Court will continue to apply its traditional First Amendment doctrines when evaluating the constitutionality of other trademark laws. Whether the Court should adopt a different approach is beyond the scope of this Article. For a detailed discussion of the issues courts should consider when evaluating a free speech challenge to a trademark law in the United States or other countries, see generally Lisa P. Ramsey, *A Free Speech Right to Trademark Protection?*, 106 TRADEMARK REP. 797 (2016).

Since there is state action when a court awards an injunction or damages in a private trademark dispute, this Article contends we should evaluate whether trademark enforcement laws are constitutional and not just apply First Amendment scrutiny to trademark registration laws.

All three branches of government—legislative, judicial, and executive/administrative—must ensure that trademark laws are consistent with the First Amendment. Legislators should consider how trademark statutes conflict with the right to freedom of expression and make speech-protective revisions to these laws. Courts and decision-makers in trademark offices should interpret trademark laws in ways that protect expressive values. While the doctrine of constitutional avoidance directs courts to refrain from unnecessary First Amendment analysis of laws,¹⁵ judges must evaluate the constitutionality of trademark laws that harm protected expression if trademark defenses or other limitations on trademark rights do not apply in a particular dispute.

Some trademark laws will survive First Amendment scrutiny after *Tam* because they regulate speech that is not protected by the First Amendment. Government regulations of fraud and misleading commercial speech are generally constitutional because the First Amendment does not protect these categories of speech.¹⁶ Thus courts should find trademark registration and enforcement laws targeting fraudulent speech or misleading uses of marks in commercial expression to be valid regulations. Examples include laws prohibiting registration of deceptive marks and the confusing use of another's trademark in the marketplace.¹⁷

On the other hand, the U.S. Supreme Court has declared that speech regulations are presumptively unconstitutional and subject to strict or heightened scrutiny analysis when the law regulates noncommercial speech based on its content,¹⁸ or restricts any type of expression based on its viewpoint or ideas.¹⁹ Unless a categorical

15. *Edward J. DeBartolo Corp. v. Fla. Gulf Coast Bldg. & Const. Trades Council*, 485 U.S. 568, 575 (1988) (If “an otherwise acceptable construction of a statute would raise serious constitutional problems,” the canon of constitutional avoidance dictates that courts should “construe the statute to avoid such problems unless such construction is plainly contrary to the intent of Congress.”).

16. *United States v. Stevens*, 559 U.S. 460, 468–69 (2010); *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 565–66 (1980). See Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 SMU L. REV. 381, 414–21 (2008) (applying the Court’s free speech doctrines to trademark infringement law).

17. 15 U.S.C. §§ 1052(a), 1114(1), 1125(a)(1)(A) (2012).

18. *Brown v. Entm’t Merchs. Ass’n*, 564 U.S. 786, 799 (2011); *United States v. Playboy Entm’t Grp., Inc.*, 529 U.S. 803, 813, 817 (2000); Ramsey, *supra* note 16, at 427–31.

19. *Matal v. Tam*, 137 S. Ct. 1744, 1765–67 (2017) (Kennedy, J., concurring); *id.* at

exception to traditional First Amendment balancing applies to this law,²⁰ a content-based regulation of noncommercial expression can only survive constitutional scrutiny if the government can “prove that the restriction furthers a compelling interest and is narrowly tailored to achieve that interest.”²¹ Under this rigorous First Amendment test, “[i]f a less restrictive alternative would serve the Government’s purpose, the legislature must use that alternative.”²²

Heightened First Amendment scrutiny may be appropriate when considering the validity of the federal trademark infringement statutes since they do not explicitly exclude noncommercial uses of marks from their scope.²³ Some courts have interpreted the language in these statutes in a speech-protective way to require commercial use of the mark for liability.²⁴ But other courts believe infringement law is not limited to profit-seeking uses of trademarks and have applied the law in noncommercial contexts.²⁵ If the defendant’s expression is not commercial in a trademark dispute, the court cannot reject a First Amendment defense on the ground that misleading commercial speech is not constitutionally protected.

After *Tam*, courts should either require commercial use of a

1769 (Thomas, J., concurring); *Reed v. Town of Gilbert*, 576 U.S. ___, 135 S. Ct. 2218, 2226, 2230 (2015); *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 828–30 (1995).

20. Copyright law is an example. Neal Netanel, *First Amendment Constraints on Copyright after Golan v. Holder*, 60 UCLA L. REV. 1082, 1086–1103 (2013) (evaluating the Court’s recent copyright cases and use of “definitional balancing” by the Court); Ramsey, *supra* note 16, at 389, 414, 446 (noting the Court treated current copyright law as “categorically constitutional” when it held that further First Amendment scrutiny was not required for a new law that did not alter the traditional contours of copyright protection); Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After Eldred*, 44 LIQUORMART, and Bartnicki, 40 HOUS. L. REV. 697, 713–18 (2003) (discussing the “copyright exception” to the First Amendment).

21. *Reed*, 135 S. Ct. at 2231.

22. *United States v. Playboy Entm’t Grp., Inc.*, 529 U.S. 803, 813 (2000).

23. See 15 U.S.C. §§ 1114(1), 1125(a)(1)(A) (2012); see also Ramsey, *supra* note 16, at 403–04 (noting it is unclear from the text and “legislative history whether Congress intended to limit application of the Lanham Act to commercial speech”) (citing *Lamparello v. Falwell*, 420 F.3d 309, 313–14 (4th Cir. 2005); *Semco, Inc. v. Amcast, Inc.*, 52 F.3d 108, 111–12 (6th Cir. 1995)).

24. *E.g.*, *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 322–24 (4th Cir. 2015); *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research*, 527 F.3d 1045, 1051–54 (10th Cir. 2008); *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 676–77 (9th Cir. 2005); *Taubman Co. v. Webfeats*, 319 F.3d 770, 774–75, 778 (6th Cir. 2003).

25. *E.g.*, *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 92–93 (2d Cir. 1997) (applying the infringement statute to defendant’s confusing use of the mark UNITED WE STAND AMERICA to associate itself with the political movement that sponsored Ross Perot’s presidential campaign).

mark for infringement or determine that application of infringement law to this noncommercial expression satisfies strict scrutiny analysis. If the expression is misleading and consumers are confused by unauthorized use of the distinctive marks of political groups and other non-profit organizations, the law may be constitutional.²⁶ However, if this noncommercial use of the mark is not misleading, courts should refuse to find infringement. Of course, heightened scrutiny may not be necessary in such cases if the Court later determines that trademark infringement laws are—like copyright infringement laws—not subject to its traditional First Amendment balancing tests because of their speech-protective doctrines.²⁷ Until then, courts should confirm trademark infringement laws are applied in a manner consistent with the Court's current free speech jurisprudence. In addition, Congress should consider adding a commercial use requirement to the infringement statutes or requiring noncommercial use of another's mark to be explicitly misleading for infringement liability.

As explained in Part IV, one area of trademark law that is unlikely to survive First Amendment scrutiny after *Tam* is dilution law. The federal dilution statutes prohibit unauthorized use of another's famous mark which is likely to cause dilution by blurring or dilution by tarnishment.²⁸ Dilution by blurring is an association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the mark, while dilution by tarnishment is use of another's famous mark in a manner that is likely to harm the reputation of that mark.²⁹ Both dilution laws regulate expression that is inconsistent with the brand message or ideas conveyed by a famous mark. Moreover, courts often apply the tarnishment provision to expression that some may find offensive.³⁰ After *Tam*, these dilution statutes should be subject to heightened First Amendment scrutiny because they prohibit and punish commercial expression based on its ideas or viewpoint.³¹ This constitutional analysis will be fatal, as the dilution laws cannot even survive the Court's intermediate scrutiny test for regulations of nonmisleading commercial speech set forth in *Central Hudson*.³² This test requires the government

26. Ramsey, *supra* note 16, at 443–46.

27. *Id.* at 389, 414 & n.201, 446. If a new copyright law alters the traditional contours of copyright protection, however, it might be subject to further constitutional scrutiny. *Id.*

28. 15 U.S.C. § 1125(c).

29. *Id.* § 1125(c)(2).

30. *E.g.*, *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 388 (6th Cir. 2010).

31. *See infra* Part III.F.1.b. and Part IV.A.

32. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 564

to prove the law directly and materially furthers a substantial government interest and is narrowly drawn so as to not endanger free speech more than necessary to achieve that goal.³³ If courts apply this constitutional analysis to dilution law, they should find the law invalid under the First Amendment.

Part IV also argues that we should consider whether the First Amendment right to freedom of expression is harmed when the government registers and protects trademark rights in certain language and product features that intrinsically communicated a non-source-identifying message before they were adopted or used as marks. Examples include descriptive words and symbols,³⁴ common or informational slogans,³⁵ culturally-significant phrases and designs,³⁶ slurs and profanity,³⁷ colors, representational shapes, and other pre-existing words, names, symbols, or devices that were inherently valuable before they were claimed as marks.³⁸ Regardless of whether these marks are deemed to be non-functional and

(1980). Before *Tam* scholars argued that dilution law did not satisfy scrutiny under the *Central Hudson* test. See, e.g., Rebecca Tushnet, *Truth and Advertising: The Lanham Act and Commercial Speech Doctrine*, in TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH 294, 312–22 (Graeme B. Dinwoodie & Mark D. Janis eds., 2008); Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507, 555–58 (2008) [hereinafter Tushnet, *Gone in Sixty Milliseconds*]; Rebecca Tushnet, *More than a Feeling: Emotion and the First Amendment*, 127 HARV. L. REV. 2392, 2402–03 n.44 (2014) [hereinafter Tushnet, *More than a Feeling*]; Mary LaFrance, *No Reason to Live: Dilution Laws as Unconstitutional Restrictions on Commercial Speech*, 58 S.C. L. REV. 709, 711 (2007); Paul Alan Levy, *The Trademark Dilution Revision Act—A Consumer Perspective*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1189, 1192–93 (2006); Ramsey, *supra* note 16, at 425–27 & n.269. Elsewhere I have argued that the United States would not violate its international obligations under multilateral treaties and trade agreements regulating trademarks if it eliminated dilution law from the trademark statute and instead relied on infringement law to protect against confusing uses of well-known marks for dissimilar goods or services that indicate a connection between the parties and are likely to damage the trademark owner's interests. See Lisa P. Ramsey, *Free Speech and International Obligations to Protect Trademarks*, 35 YALE J. INT'L L. 405, 432–35 (2010) [hereinafter Ramsey, *Free Speech and International Obligations to Protect Trademarks*].

33. *Cent. Hudson*, 447 U.S. at 564–65; see also *Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017) (Alito, J.) (plurality opinion) (applying the *Central Hudson* test); *Edenfield v. Fane*, 507 U.S. 761, 767–71 (1993) (same).

34. Lisa P. Ramsey, *Descriptive Trademarks and the First Amendment*, 70 TENN. L. REV. 1095, 1110–21, 1146–70 (2003).

35. Lisa P. Ramsey, *Intellectual Property Rights in Advertising*, 12 MICH. TELECOMM. & TECH. L. REV. 189, 249–63 (2006).

36. Lisa P. Ramsey, *Reconciling Trademark Rights and Free Expression Locally and Globally*, in INTERNATIONAL INTELLECTUAL PROPERTY: A HANDBOOK OF CONTEMPORARY RESEARCH 341, 362–63 (Daniel Gervais ed., 2015).

37. Ramsey, *supra* note 14, at 881.

38. Lisa P. Ramsey, *Non-Traditional Trademarks and Inherently Valuable Expression*, in THE PROTECTION OF NON-TRADITIONAL TRADEMARKS 337 (Irene Calboli & Martin Senftleben eds., forthcoming 2018).

distinctive after use in the marketplace, granting and enforcing trademark rights in this inherently valuable expression chills non-misleading speech protected by the First Amendment and may be unconstitutional after *Tam*. At a minimum, Congress should clarify in the trademark statute that these marks only have a narrow scope of protection and it should add more statutory defenses.

Regardless of what specific First Amendment doctrine or test is used in the trademark context, this Article proposes that anyone evaluating the constitutional validity of a trademark law regulating expression protected by the First Amendment should: (1) consider the purpose of the specific law and whether that goal is sufficiently important given the type of expression that is being regulated; (2) confirm the law directly and materially advances that government interest; and (3) identify exactly how the law endangers free speech, and evaluate whether the law is narrowly tailored to harm expression no more than necessary or is the least speech-restrictive means for furthering that goal. This analysis is consistent with the Court's current First Amendment jurisprudence,³⁹ and is similar to the teleological or purposive approach to trademark laws advocated by some scholars.⁴⁰ Any advocate of a particular trademark theory—such as the protection of property rights in an investment in trademark goodwill to justify dilution law—must prove, at a minimum, that there is a substantial government interest in using trademark law to further that goal.⁴¹ Moreover, increasing First Amendment scrutiny of trademark laws will highlight the lack of evidence supporting allegations of certain types of trademark harms and require the government to explicitly consider how these laws harm expression.⁴² After *Tam* it is not acceptable to ignore or set aside free speech arguments raised in the trademark context.

II. THE U.S. SUPREME COURT'S DECISION IN *MATAL V. TAM*

During the last few decades, many commentators have argued that certain trademark laws conflict with expressive values

39. These issues are considered in both strict scrutiny analysis—see *Reed v. Town of Gilbert*, 576 U.S. ___, 135 S. Ct. 2218, 2231 (2015); *United States v. Playboy Entm't Grp., Inc.*, 529 U.S. 803, 813 (2000)—and in intermediate scrutiny analysis—see *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 564–65 (1980).

40. See, e.g., Graeme B. Dinwoodie, *The Death of Ontology: A Teleological Approach to Trademark Law*, 84 IOWA L. REV. 611 (1999).

41. See *infra* Parts III.F.1.c. and IV.A.

42. See *infra* Parts III.F.2, III.F.3 and IV.

and have suggested various speech-protective reforms of trademark statutes and common law doctrines.⁴³ In the past, courts

43. See, e.g., JACQUELINE LIPTON, INTERNET DOMAIN NAMES, TRADEMARKS, AND FREE SPEECH (2010); Rochelle C. Dreyfuss, *Reconciling Trademark Rights and Expressive Values: How To Stop Worrying and Learn To Love Ambiguity*, in TRADEMARK LAW AND THEORY, *supra* note 32, at 261; Lisa P. Ramsey, *First Amendment Limitations on Trademark Rights*, in 3 INTELLECTUAL PROPERTY AND INFORMATION WEALTH: ISSUES AND PRACTICES IN THE DIGITAL AGE 147 (Peter K. Yu ed., 2007) [hereinafter Ramsey, *First Amendment Limitations*]; Rebecca Tushnet, *Truth and Advertising: The Lanham Act and Commercial Speech Doctrine*, in TRADEMARK LAW AND THEORY, *supra* note 32, at 294; Margreth Barrett, *Domain Names, Trademarks and the First Amendment: Searching for Meaningful Boundaries*, 39 CONN. L. REV. 973 (2007); Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721 (2004); Michael K. Cantwell, *Confusion, Dilution, and Speech: First Amendment Limitations on the Trademark Estate*, 87 TRADEMARK REP. 48 (1997); Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158; Deven R. Desai, *Speech, Citizenry, and the Market: A Corporate Public Figure Doctrine*, 98 MINN. L. REV. 455 (2013); Rochelle C. Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397 (1990) [hereinafter Dreyfuss, *Expressive Genericity*]; Christine H. Farley & Kavita DeVaney, *Considering Trademark and Free Speech Rights Through the Lens of Regulating Tobacco*, 43 AIPLA Q.J. 289 (2015); Eric Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 EMORY L.J. 507, 552–96 (2005); Pratheepan Gulasekaram, *Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works*, 80 WASH. L. REV. 887 (2005); Laura A. Heymann, *The Public's Domain in Trademark Law: A First Amendment Theory of the Consumer*, 43 GA. L. REV. 651 (2009); Sonia K. Katyal, *Trademark Intersectionality*, 57 UCLA L. REV. 1601 (2010); Jessica M. Kiser, *Brandright*, 70 ARK. L. REV. 489 (2017); Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960 (1993); Robert N. Kravitz, *Trademarks, Speech, and the Gay Olympics Case*, 69 B.U. L. REV. 131 (1989); LaFrance, *supra* note 32, at 709–23; Arlen W. Langvardt, *Protected Marks and Protected Speech: Establishing the First Amendment Boundaries in Trademark Parody Cases*, 36 VILL. L. REV. 1, 103 (1991); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687 (1999); Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669 (2007); Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 216–24 (1998); Jacqueline D. Lipton, *Commerce Versus Commentary: Gripe Sites, Parody, and the First Amendment in Cyberspace*, 84 WASH. U. L. REV. 1327 (2006); Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367 (1999); William McGeeveran, *The Imaginary Trademark Parody Crisis (and the Real One)*, 90 WASH. L. REV. 713 (2015); William McGeeveran, *Life in the Fast Lane: Of Presumptions, Defenses, and Burdens*, 1 IP THEORY 25 (2010); William McGeeveran, *The Trademark Fair Use Reform Act*, 90 B.U. L. REV. 2267 (2010) [hereinafter McGeeveran, *The Trademark Fair Use Reform Act*]; William McGeeveran, *Four Free Speech Goals for Trademark Law*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1205 (2008); William McGeeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49 (2008); William McGeeveran & Mark P. McKenna, *Confusion Isn't Everything*, 89 NOTRE DAME L. REV. 253 (2013); Mark P. McKenna, *The Rehnquist Court and the Groundwork for Greater First Amendment Scrutiny of Intellectual Property*, 21 WASH. U.J.L. POL'Y 11 (2006); Malla Pollack, *Patriotism for Profit and Persuasion: Trademark, Free Speech, and Governance Problems with Protection of Government Marks in the United States*, 100 TRADEMARK REP. 1181 (2010); Ramsey, *supra* note 14, at 836–46; Ramsey, *supra* note 16, at 381–458; Ramsey, *supra* note 34, at 1096–1176; Sandra L. Riererson, *The Myth and Reality of Dilution*, 11 DUKE L. & TECH. REV. 212, 285, 292–97, 301–11 (2012); Jennifer E. Rothman, *Commercial Speech, Commercial Use, and the Intellectual Property Quagmire*, 101 VA. L. REV. 1929, 1937–1946, 2002–05, 2008–09 (2015); Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Cross-*

generally avoided First Amendment analysis of trademark statutes and did not apply the U.S. Supreme Court's traditional free speech doctrines to trademark laws challenged under the First Amendment.⁴⁴ That changed in *Tam*.⁴⁵

One reason lower courts may have hesitated to evaluate the constitutionality of trademark laws before *Tam* is that it was not clear that trademark laws were subject to First Amendment scrutiny. Some lower courts suggested that trademarks do not contain "speech" protected by the First Amendment when the mark is used solely to communicate information about the source of goods or services, and is not part of a communicative message.⁴⁶ There was also disagreement about whether the First Amendment applied to the disparagement clause and other trademark laws that chill speech without prohibiting or punishing it.⁴⁷ In addition, some

roads of Trademark Law, 27 CARDOZO L. REV. 105 (2005); Jeremy N. Sheff, *Brand Renegades*, 1 N.Y.U. J. INTELL. PROP. & ENT. L. 128 (2011); Hannibal Travis, *Of Blogs, eBooks, and Broadband: Access to Digital Media as a First Amendment Right*, 35 HOFSTRA L. REV. 1519, 1530–43, 1581–82 (2007); Hannibal Travis, *The Battle for Mindshare: The Emerging Consensus that the First Amendment Protects Corporate Criticism and Parody on the Internet*, 10 VA. J.L. & TECH. 1 (2005); Rebecca Tushnet, *Registering Disagreement: Registration in Modern American Trademark Law*, 130 HARV. L. REV. 867, 916–41 (2017); Tushnet, *More than a Feeling*, *supra* note 32, at 2392, 2396–2404; Rebecca Tushnet, *Fighting Freestyle: The First Amendment, Fairness, and Corporate Reputation*, 50 B.C. L. REV. 1457, 1475–79 (2009); Tushnet, *Gone in Sixty Milliseconds*, *supra* note 32, at 507, 546–58; Rebecca Tushnet, *Trademark Law as Commercial Speech Regulation*, 58 S.C. L. REV. 737 (2007); Volokh, *supra* note 20, at 732–39. Rebecca Tushnet has argued that several provisions of Section 2 of the Lanham Act may be unconstitutional under the First Amendment if we subject them to constitutional scrutiny. Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 92 NOTRE DAME L. REV. 381, 403–17 (2016) [hereinafter Tushnet, *The First Amendment Walks into a Bar*].

44. Ramsey, *supra* note 16, at 450–53. Some courts do protect freedom of expression in trademark disputes by interpreting trademark claims narrowly and trademark defenses broadly, and by creating and applying speech-protective common law trademark doctrines. *Id.* at 447–50, 454–57. See, e.g., *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1175–80 (9th Cir. 2010) (applying nominative fair use doctrine in case involving use of the mark LEXUS in domain names by independent Lexus brokers); *Louis Vuitton Malletier, S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 260–63 (4th Cir. 2007) (holding no trademark violation for "Chewy Vuiton" dog toy parody of LOUIS VUITTON handbags); *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 156 F. Supp. 3d 425, 434–35 (S.D.N.Y. 2016), *aff'd*, 674 F. App'x 16 (2nd Cir. 2017) (holding no trademark violation for canvas tote bags displaying caricatures of famous designer handbags and the phrase "My Other Bag").

45. *In re Tam*, 808 F.3d 1321, 1355–58 (Fed. Cir. 2015), *as corrected* (Feb. 11, 2016) (en banc), *aff'd sub nom.* *Matal v. Tam*, 137 S. Ct. 1744 (2017).

46. See, e.g., *SMJ Group, Inc. v. 417 Lafayette Rest. LLC*, 439 F. Supp. 2d 281, 291 (S.D.N.Y. 2006); *Gucci Am., Inc. v. Hall & Assocs.*, 135 F. Supp. 2d 409, 418 (S.D.N.Y. 2001); *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430, 1440 (S.D.N.Y. Mar. 24, 1997), *aff'd*, 152 F.3d 920 (2d Cir. 1998); see also *Yankee Publ'g Inc. v. News Am. Publ'g Inc.*, 809 F. Supp. 267, 275–76 (S.D.N.Y. 1992). This is incorrect. See *infra* Parts II.A and III.B; Ramsey, *supra* note 16, at 409–12; Ramsey, *supra* note 14, at 836.

47. Compare *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) ("With respect to appellant's First Amendment rights, it is clear that the PTO's refusal to register appellant's

judges argued that trademarks of private parties become government speech once they are registered by the USPTO, which would place this expression outside the scope of the First Amendment's Free Speech Clause.⁴⁸ Others have questioned whether the Supreme Court will treat trademark laws like copyright laws and other private causes of action that make the defendant's speech the grounds for potential liability, and hold that this category of speech regulations is not subject to scrutiny under the Court's traditional First Amendment balancing tests.⁴⁹ In addition, some judges have held (wrongly per other courts and commentators⁵⁰) that there is no government action that implicates the First Amendment when private trademark owners enlist courts to enforce their trademark rights with injunctions and damage awards in civil litigation.⁵¹

There was also significant disagreement before *Tam* about

mark [under the disparagement clause] does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant's First Amendment rights would not be abridged by the refusal to register his mark." (citations omitted), with *In re Tam*, 808 F.3d at 1339–45 (holding that Section 2(a)'s denial of the benefits of registration to marks which may disparage others chills speech of trademark owners and is an unconstitutional condition on expression). See also Ramsey, *supra* note 14, at 834–35, 860–61 (arguing that granting a trademark registration can harm free speech values more than denying it).

48. Compare *In re Tam*, 808 F.3d at 1374–76 (Lourie, J., dissenting) (trademark registrations could be restricted as government speech), and *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 447–48, 457–61 (E.D. Va. 2015) (the trademark registration program is government speech), with *In re Tam*, 808 F.3d at 1345 (trademark registrations are not government speech), and Ramsey, *supra* note 14, at 866–69 (same). Rebecca Tushnet argued that the disparagement clause is constitutional because trademark registration is similar to government endorsement and the government should be able to determine what speech it is willing to enforce as a trademark. Tushnet, *The First Amendment Walks into a Bar*, *supra* note 43, at 382–84, 389–93.

49. See, e.g., Ramsey, *supra* note 14, at 869–72; Ramsey, *supra* note 16, at 414, 446. Scholars have also recently subjected patent law to First Amendment analysis and suggested that the U.S. Supreme Court's approach to First Amendment conflicts in the copyright context may not be appropriate for patent law due to differences in the purpose and speech-protective doctrines of these intellectual property laws. Dan L. Burk, *Patents and the First Amendment*, 96 WASH. U. L. REV. 197, 217–218 (2018); Tun-Jen Chiang, *Patents and Free Speech*, 107 GEO. L. REV. (forthcoming 2018), https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3114931 [<https://perma.cc/3AXT-HA2R>].

50. Ramsey, *supra* note 16, at 407–09.

51. See, e.g., *Empire Home Servs., L.L.C. v. Empire Iron Works, Inc.*, No. 05-CV-72584-DT, 2007 WL 1218717, at *8 (E.D. Mich. April 23, 2007) (finding defendant's constitutional argument unpersuasive because "government restraints on commercial speech" are "simply not present in an intellectual property dispute between two private parties"); *Reddy Comm'ns, Inc. v. Env'tl. Action Found., Inc.*, 199 U.S.P.Q. (BNA) 630, 633–34 (D.D.C. 1977); *Interbank Card Ass'n v. Simms*, 431 F. Supp. 131, 133–34 (M.D.N.C. 1977). This is incorrect. See *infra* Part III.A; Ramsey, *supra* note 14, at 851–54; Ramsey, *supra* note 16, at 407–09.

whether trademark laws restrict noncommercial expression in addition to commercial expression,⁵² and whether such laws are content- or viewpoint-based regulations of speech rather than content-neutral laws.⁵³ It was also unclear whether trademark laws should be subject to strict constitutional scrutiny (which is often fatal),⁵⁴ more-relaxed intermediate scrutiny, highly-deferential rational basis review, or a different and perhaps new First Amendment test.⁵⁵ *Tam* answers some of these questions but not all of them.⁵⁶

52. See Ramsey, *supra* note 14, at 836–37; Ramsey, *supra* note 16, at 385 & n.15.

53. Compare *Dall. Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (treating trademark laws like content-neutral speech regulations and holding that trademark rights “need not ‘yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist’”), and *In re Tam*, 808 F.3d at 1378–79 (Reyna, J., dissenting) (arguing that the disparagement clause is a content-neutral regulation since the government’s purpose is to regulate the secondary effects of speech), with Lemley & Volokh, *supra* note 43, at 186, 206, 218–22 (arguing that trademark laws are content-based regulations of expression), and Volokh, *Freedom of Speech and Intellectual Property*, *supra* note 20, at 702–12 (same), and Ramsey, *supra* note 14, at 872–77 (same), and Ramsey, *supra* note 16, at 431–46 (same). In a case involving a First Amendment challenge to the Amateur Sports Act’s ban on unauthorized use of the Olympic marks, the U.S. Supreme Court determined that this law was a content-neutral regulation of expression. *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 536–37 (1987) (“Section 110 restricts only the manner in which the SFAA may convey its message. The restrictions on expressive speech properly are characterized as incidental to the primary congressional purpose of encouraging and rewarding the USOC’s activities. The appropriate inquiry is thus whether the incidental restrictions on First Amendment freedoms are greater than necessary to further a substantial governmental interest.”) (citing *United States v. O’Brien*, 391 U.S. 367, 377 (1968)). It is not clear whether the Court would reach a similar conclusion today with regard to the Lanham Act provisions regulating infringing and diluting uses of trademarks given the fact that the Court recently held that laws that are content based on their face are not converted into content-neutral regulations by the assertion that the government has a content-neutral justification for the law. *Reed v. Town of Gilbert*, 576 U.S. ___, 135 S. Ct. 2218, 2228 (2015). See also *infra* Part III.F.1.b.

54. Richard H. Fallon, Jr., *Strict Judicial Scrutiny*, 54 UCLA L. REV. 1267, 1313 (2007). While this analysis is often fatal, one empirical study showed that laws subject to heightened constitutional scrutiny actually survive this analysis 30% of the time. See Adam Winkler, *Fatal in Theory and Strict in Fact: An Empirical Analysis of Strict Scrutiny in the Federal Courts*, 59 VAND. L. REV. 793, 812–13 (2006). For an excellent critique of the strict scrutiny test, see generally Eugene Volokh, *Freedom of Speech, Permissible Tailoring and Transcending Strict Scrutiny*, 144 U. PA. L. REV. 2417 (1996).

55. See Ramsey, *supra* note 14, at 872–79 (discussing the different types of First Amendment scrutiny); Ramsey, *supra* note 16, at 421–46 (same).

56. See Lisa Ramsey, *The First Amendment Protects Offensive Trademarks*, REG. REV. (July 25, 2017), <https://www.theregreview.org/2017/07/25/ramsey-first-amendment-protects-offensive-trademarks/> [http://perma.cc/NZY5-LPSJ] [hereinafter Ramsey, *The First Amendment Protects Offensive Trademarks*]; Lisa Ramsey, *Symposium: Increasing First Amendment Scrutiny of Trademark Law After Matal v. Tam*, SCOTUSBLOG (June 20, 2017, 2:33 PM), <http://www.scotusblog.com/2017/06/symposium-increasing-first-amendment-scrutiny-trademark-law-matal-v-tam/> [http://perma.cc/F8FR-ZU4J] [hereinafter Ramsey, *Symposium*]. For law review commentary on the Court’s opinion, see generally

A. *Trademarks Are “Speech” Within the Meaning of the First Amendment*

Importantly, *Tam* clarified that use of a trademark is “speech,” and is not akin to non-expressive conduct or economic activities outside the First Amendment’s scope, when the Court held that the disparagement clause was subject to constitutional scrutiny. In the unanimous part of the opinion, the Court noted that trademarks have “expanded far beyond phrases that do no more than identify a good or service” and often consist of “catchy phrases that convey a message.”⁵⁷ It also said that “trademarks often have an expressive content. Companies spend huge amounts to create and publicize trademarks that convey a message. It is true that the necessary brevity of trademarks limits what they can say. But powerful messages can sometimes be conveyed in just a few words.”⁵⁸

Justice Samuel Alito explained in his plurality opinion (joined by Chief Justice John Roberts and Justices Clarence Thomas and Stephen Breyer) that the parties disagreed “on the question of whether trademarks are commercial speech and are thus subject to the relaxed scrutiny outlined in *Central Hudson*”⁵⁹ The government argued that “all trademarks are commercial speech,” while *Tam* claimed the disparagement clause should be subject to a more rigorous form of First Amendment scrutiny because “many, if not all, trademarks have an expressive component” and convey other messages in addition to source-identifying information.⁶⁰ *Tam* argued that trademarks can say something “about the product or service or some broader issue” and the mark “in this case illustrates this point. The name ‘The Slants’ not only identifies the band but expresses a view about social issues.”⁶¹ Justice Alito said there was no need to resolve this debate about whether trademarks convey noncommercial messages because—as discussed in

Clay Calvert, *Beyond Trademarks and Offense: Tam and the Justices’ Evolution on Free Speech*, 2017 CATO SUP. CT. REV. 25 (2017); Mark Conrad, *Matal v. Tam—A Victory for The Slants, a Touchdown for the Redskins, but an Ambiguous Journey for the First Amendment and Trademark Law*, 36 CARDOZO ARTS & ENT. L.J. 83 (2018); Theodore H. Davis, Jr. & John L. Welch, *United States Annual Review: The Seventieth Year of Administration of the Lanham Act of 1946*, 108 TRADEMARK REP. 1 (2018); Niki Kuckes, *Matal v. Tam: Free Speech Meets “Disparaging” Trademarks in the Supreme Court*, 23 ROGER WILLIAMS U. L. REV. 122 (2018).

57. *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017).

58. *Id.* at 1760.

59. *Id.* at 1763–64 (Alito, J.) (plurality opinion) (citing *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557 (1980)).

60. *Id.* at 1764.

61. *Id.*

more detail later—“the disparagement clause cannot withstand even *Central Hudson* review.”⁶²

All of the Justices in *Tam* implied that the source-identifying product information provided by a trademark would be classified as commercial speech, and explicitly held that First Amendment scrutiny of the disparagement clause was required regardless of whether the law only regulated speech that is commercial.⁶³ None of the Justices said that the Free Speech Clause of the First Amendment is not implicated at all if a mark only provides information about the source of goods or services. *Tam* therefore clarifies that trademarks are “speech” within the meaning of the First Amendment regardless of whether the mark solely identifies the source of goods or services, or also conveys other commercial or noncommercial messages.

B. Trademark Laws That Only Chill Expression Also Implicate the First Amendment

In *Tam*, the Court held that a trademark law burdening expression can violate the First Amendment just as much as speech regulations that prohibit or punish expression.⁶⁴ While the disparagement clause did not prevent the band from using THE SLANTS as a mark for the group’s entertainment services, *Tam* argued that the inability to get a registration discouraged the band’s use of this expression as a mark. In an interview with *Rolling Stone* magazine, *Tam* said “[f]or a lot of bands, you can’t get a record-label deal or a sync-licensing deal unless you have a registered trademark.”⁶⁵ Trademark registration provides significant benefits, and thus the Court held that the chilling effect of the disparagement clause was sufficient to implicate the First Amendment.⁶⁶ After *Tam*, it is clear that trademark laws can violate the free speech right in the First Amendment when they only chill expression without prohibiting or punishing it.⁶⁷

62. *Id.*

63. *Id.* at 1763–65; *id.* at 1765–68 (Kennedy, J., concurring); *id.* at 1769 (Thomas, J., concurring).

64. *See, e.g., id.* at 1763–65 (Alito, J.) (plurality opinion); *id.* at 1765–67 (Kennedy, J., concurring); *id.* at 1769 (Thomas, J., concurring).

65. Kory Grow, *Inside Asian-American Group the Slants’ Supreme Court Free-Speech Win*, ROLLING STONE (June 20, 2017, 5:41 PM), <http://www.rollingstone.com/music/news/inside-asian-american-band-the-slants-scotus-win-w488615> [<https://perma.cc/9SNS-LAH5>].

66. *Tam*, 137 S. Ct. at 1753–54 (majority opinion).

67. *See id.* at 1751–60; *see also* Eugene Volokh, *Supreme Court Unanimously Reaffirms: There Is No ‘Hate Speech’ Exception to the First Amendment*, WASH. POST: VOLOKH

C. *Private Trademarks Do Not Become Government Speech When They Are Registered by the Government*

In *Tam*, the Court also discussed “three arguments that would either eliminate any First Amendment protection or result in highly permissive rational-basis review” of the disparagement clause.⁶⁸ The government argued “(1) that trademarks are government speech, not private speech, (2) that trademarks are a form of government subsidy, and (3) that the constitutionality of the disparagement clause should be tested under a new ‘government-program’ doctrine.”⁶⁹ The government speech doctrine exempts regulations of the government’s own speech from First Amendment scrutiny even when the restrictions favor some viewpoints at the expense of others.⁷⁰ While trademarks of private parties are registered by the government on the trademark register, the Court concluded that those trademarks “are private, not government, speech” and are therefore protected by the First Amendment when the government considers them for registration.⁷¹

In his plurality opinion, Justice Alito also rejected the argument that the Court should apply First Amendment doctrines relating to government subsidies or create a new government-program doctrine that would permit less stringent constitutional scrutiny of the disparagement clause,⁷² but a majority of the Court did not rule on these issues.⁷³ The plurality acknowledged that cases in which the government creates a limited public forum for private speech were potentially more analogous than the government subsidy cases, but stressed that these cases only allow con-

CONSPIRACY (June 19, 2017), https://www.washingtonpost.com/news/volokh-conspiracy/wp/2017/06/19/supreme-court-unanimously-reaffirms-there-is-no-hate-speech-exception-to-the-first-amendment/?utm_term=.aa2213f7dfe8 [<http://perma.cc/BC4M-A5YE>].

68. *Tam*, 137 S. Ct. at 1757.

69. *Id.*

70. *Id.*

71. *Id.* at 1758–60; *see also id.* at 1768 (Kennedy, J., concurring). For a discussion of government speech doctrine after *Tam* and a proposal to use survey evidence in government speech cases, see Daniel Jacob Hemel & Lisa Larrimore Ouellette, *Public Perceptions of Government Speech*, 2017 SUP. CT. REV. 33, 34, 51–52 (2018).

72. *Tam*, 137 S. Ct. at 1760–63 (Alito, J.) (plurality opinion).

73. Justice Kennedy declined to address these issues in his concurring opinion because “the viewpoint discrimination rationale renders unnecessary any extended treatment of other questions raised by the parties.” *Id.* at 1765 (Kennedy, J., concurring). After *Tam*, the Federal Circuit rejected the argument that the trademark registration system is a government subsidy program in *In re Brunetti*, 877 F.3d 1330, 1342–45 (Fed. Cir. 2017), *petition for cert. filed*, 87 U.S.L.W. 3134 (U.S. Sept. 7, 2018) (No. 18-302).

tent- and speaker-based restrictions—not viewpoint discrimination.⁷⁴ Thus, the disparagement clause could not be saved by arguing that the trademark registration system is a limited public forum.⁷⁵ It is significant that none of the Justices subjected the disparagement clause to rational-basis review or held that trademarks or trademark registrations are categorically eliminated from constitutional protection under the First Amendment.⁷⁶

D. The Disparagement Clause Regulated Speech Based on Its Viewpoint

In *Tam*, the Court also rejected the argument that the disparagement clause does not regulate expression based on its content or viewpoint. When this case was below at the Federal Circuit Court of Appeals, Judge Jimmie Reyna argued in his dissenting opinion that this law was a content-neutral regulation of expression subject to more-relaxed intermediate scrutiny analysis because the government's purpose was to address the harmful secondary effects of speech rather than to suppress the content or viewpoint of speech.⁷⁷ The Justices must have disagreed, as none of them applied the First Amendment doctrines relating to content-neutral speech regulations when they evaluated the constitutionality of the disparagement clause.⁷⁸

Instead the Justices concluded that the disparagement clause regulated the viewpoint of speech protected by the First Amendment⁷⁹ and held that the government cannot ban registration of

74. *Tam*, 137 S. Ct. at 1761–63, 1763 n.16 (Alito, J.) (plurality opinion).

75. *Id.* at 1763. In *Tam*, the Justices declined to decide whether the Court's limited public forum doctrine applies, *Tam*, 137 S. Ct. at 1763 & n.16, and afterwards the Federal Circuit held the trademark registration system was not a limited public forum. See *In re Brunetti*, 877 F.3d at 1345–48. But see Ned Snow, *Denying Trademark for Scandalous Speech*, 51 U.C. DAVIS L. REV. 2331, 2364–69 (2018) (arguing that the trademark registration system is a limited public forum and the law banning registration of scandalous marks is constitutional). If the trademark register is a limited public forum, trademark registration laws are still subject to constitutional scrutiny, but Congress can more easily regulate what marks can be registered in this forum. *Id.* The issue of whether the limited public forum doctrine applies to trademark registration laws is beyond the scope of this Article, but I have argued elsewhere that the answer is no. Ramsey, *supra* note 14, at 877–78.

76. Ramsey, *First Amendment Limitations*, *supra* note 43, at 147–49; Ramsey, *Symposium*, *supra* note 56.

77. *In re Tam*, 808 F.3d 1321, 1379 (Fed. Cir. 2015), *as corrected* (Feb. 11, 2016) (en banc) (Reyna, J., dissenting), *aff'd sub nom.* *Matal v. Tam*, 137 S. Ct. 1744 (2017).

78. See *Tam*, 137 S. Ct. at 1763–65 (Alito, J.) (plurality opinion); *id.* at 1765–69 (Kennedy, J., concurring); *id.* at 1769 (Thomas, J., concurring).

79. *Tam*, 137 S. Ct. at 1757–60 (majority opinion); *id.* at 1763 (Alito, J.) (plurality opinion); *id.* at 1765–69 (Kennedy, J., concurring).

trademarks based on the applicant's viewpoint or ideas.⁸⁰ Justice Alito noted in his plurality opinion that the Court's "cases use the term 'viewpoint' discrimination in a broad sense" and said "[g]iving offense is a viewpoint."⁸¹ In a separate concurring opinion (joined by Justices Ruth Bader Ginsburg, Sonia Sotomayor, and Elena Kagan), Justice Anthony Kennedy explained that viewpoint-based laws are a subset of content-based laws regulating speech:

The First Amendment guards against laws "targeted at specific subject matter," a form of speech suppression known as content based discrimination. . . . This category includes a subtype of laws that go further, aimed at the suppression of "particular views . . . on a subject." . . . A law found to discriminate based on viewpoint is an "egregious form of content discrimination," which is "presumptively unconstitutional."⁸²

E. The Disparagement Clause Does Not Satisfy Constitutional Scrutiny

After concluding the disparagement clause was a viewpoint-based regulation of protected expression, Justices Alito and Kennedy subjected this law to constitutional scrutiny under the Court's traditional First Amendment tests and held the law was invalid, although they used different free speech doctrines to come to this conclusion.⁸³ In his plurality opinion, Justice Alito held it was not necessary to decide what First Amendment test should be applied when evaluating the constitutionality of the disparagement clause because he concluded that "the disparagement clause cannot withstand even *Central Hudson* review."⁸⁴ "Under *Central Hudson*," he said, "a restriction of speech must serve 'a substantial interest,' and it must be 'narrowly drawn.' . . . This means, among other things, that '[t]he regulatory technique may extend only as far as the interest it serves.'"⁸⁵ Per Justice Alito, the government

80. *Id.* at 1751, 1757 (majority opinion); *id.* at 1763 (Alito, J.) (plurality opinion); *id.* at 1765–66 (Kennedy, J., concurring).

81. *Id.* at 1763 (Alito, J.) (plurality opinion).

82. *Id.* at 1765–66 (Kennedy, J., concurring) (citations omitted).

83. *Id.* at 1763–65 (Alito, J.) (plurality opinion); *id.* at 1767–68 (Kennedy, J., concurring); *id.* at 1769 (Thomas, J., concurring).

84. *Id.* at 1764 (Alito, J.) (plurality opinion).

85. *Id.* (quoting *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 564–65 (1980)).

advanced two reasons for regulating potentially disparaging expression in Section 2(a).⁸⁶ He said the first interest ultimately consisted of the purpose of “preventing speech expressing ideas that offend.”⁸⁷ This government interest was not sufficient to satisfy constitutional scrutiny because

that idea strikes at the heart of the First Amendment. Speech that demeans on the basis of race, ethnicity, gender, religion, age, disability, or any other similar ground is hateful; but the proudest boast of our free speech jurisprudence is that we protect the freedom to express “the thought that we hate.”⁸⁸

Justice Alito then explained that “protecting the orderly flow of commerce” was another asserted goal of the disparagement clause, and noted that disparaging marks “are analogized to discriminatory conduct, which has been recognized to have an adverse effect on commerce.”⁸⁹ But he said the disparagement clause

is not “narrowly drawn” to drive out trademarks that support invidious discrimination. The clause reaches any trademark that disparages any person, group, or institution . . . It is not an anti-discrimination clause; it is a happy-talk clause. In this way, it goes much further than is necessary to serve the interest asserted.⁹⁰

Justice Alito also noted the clause is “far too broad” because it “protects every person living or dead as well as every institution.”⁹¹ In addition, he cautioned that:

There is also a deeper problem with the argument that commercial speech may be cleansed of any expression likely to cause offense. The commercial market is well stocked with merchandise that disparages prominent figures and groups, and the line between commercial and non-commercial speech is not always clear, as this case illustrates. If affixing the commercial label permits the suppression of any speech that may lead to political or social “volatility,” free speech would be endangered.⁹²

Justice Alito’s analysis in his plurality opinion suggests trademark laws regulating nonmisleading commercial speech should,

86. *Id.*

87. *Id.*

88. *Id.* (citation omitted).

89. *Id.*

90. *Id.* at 1764–65.

91. *Id.* at 1765.

92. *Id.*

at a minimum, satisfy intermediate scrutiny analysis under the *Central Hudson* test.

In his concurring opinion, Justice Kennedy held this viewpoint-discriminatory trademark law is “a form of speech suppression so potent that it must be subject to rigorous constitutional scrutiny.”⁹³ With regard to the debate about whether trademark laws only regulate commercial speech, he said the “issue may turn on whether certain commercial concerns for the protection of trademarks might, as a general matter, be the basis for regulation.”⁹⁴ However, Justice Kennedy said this question was irrelevant in this dispute because

the viewpoint based discrimination at issue here necessarily invokes heightened scrutiny.

Commercial speech is no exception . . . to the principle that the First Amendment requires heightened scrutiny whenever the government creates a regulation of speech because of disagreement with the message it conveys. . . . Unlike content based discrimination, discrimination based on viewpoint, including a regulation that targets speech for its offensiveness, remains of serious concern in the commercial context. . . .

To the extent trademarks qualify as commercial speech, they are an example of why that term or category does not serve as a blanket exemption from the First Amendment’s requirement of viewpoint neutrality.⁹⁵

While Justice Kennedy said that heightened scrutiny of the disparagement clause is required and concluded it cannot survive this rigorous analysis,⁹⁶ he never set forth the exact language of the First Amendment test he used to conclude the law failed constitutional scrutiny.⁹⁷

Justice Thomas joined Justice Alito’s plurality opinion, which

93. *Id.* at 1765 (Kennedy, J., concurring).

94. *Id.* at 1767.

95. *Id.* (citations omitted).

96. *Id.* at 1765, 1767.

97. In *Tam*, Justice Kennedy quoted *Sorrell* for his “heightened scrutiny” approach and held the law did not satisfy this test without evaluating whether the law was narrowly tailored to further a compelling government interest. *Id.* at 1765–67 (quoting *Sorrell v. IMS Health Inc.*, 564 U. S. 552, 566 (2011)). Justice Kennedy wrote the majority opinion in *Sorrell*. In that case, the Court held that “[i]n the ordinary case it is all but dispositive to conclude that a law is content based and, in practice, viewpoint-discriminatory.” *Sorrell*, 564 U.S. at 571. That case also declined to set forth language courts should apply when using heightened scrutiny analysis and instead said the law failed to satisfy even *Central Hudson* scrutiny. *Id.* at 571–72; see also *Calvert*, *supra* note 56, at 49.

held that the disparagement clause did not satisfy “the less stringent test” in *Central Hudson*, but he also wrote a concurring opinion which briefly set forth his approach to constitutional analysis of laws regulating nonmisleading commercial expression.⁹⁸ He said “I write separately because ‘I continue to believe that when the government seeks to restrict truthful speech in order to suppress the ideas it conveys, strict scrutiny is appropriate, whether or not the speech in question may be characterized as “commercial.”’”⁹⁹ Thus at least five Justices believe that rigorous, heightened, or strict constitutional scrutiny—rather than *Central Hudson*’s intermediate scrutiny—is required for laws that regulate nonmisleading commercial expression because of its viewpoint or ideas.¹⁰⁰

F. The Disparagement Clause Is a Vague Law That Results in Haphazard Enforcement

When the case was below at the Federal Circuit, Judge Kathleen O’Malley argued in her concurring opinion that the disparagement clause was unconstitutionally vague due to the statute’s chilling effect on expression and the USPTO’s inconsistent and arbitrary decisions applying the law.¹⁰¹ A law may be void for vagueness under the Court’s free speech jurisprudence if the law does not provide sufficient guidance on what language is covered by the speech-regulation.¹⁰² The concern is that the threat of punishment will chill protected expression not intended to be covered by the law. In *Tam*, the U.S. Supreme Court focused its criticism of the disparagement clause on the fact the law discriminated based on viewpoint, and it declined to discuss whether the void for vagueness doctrine applied.¹⁰³ The Court did mention, however, that the disparagement clause is a vague law in the section of the opinion where it rejected Tam’s argument that the word “persons” in the disparagement clause does not reach marks that disparage racial

98. *Tam*, 137 S. Ct. at 1769 (Thomas, J., concurring).

99. *Id.*

100. *Id.* at 1765–69 (Kennedy, J., concurring); *id.* at 1769 (Thomas, J., concurring).

101. *In re Tam*, 808 F.3d 1321, 1358–63 (Fed. Cir. 2015), *as corrected* (Feb. 11, 2016) (en banc) (O’Malley, J., concurring).

102. *NAACP v. Button*, 371 U.S. 415, 433 (1963) (“Because First Amendment freedoms need breathing space to survive, government may regulate in the area only with narrow specificity.”) (citing *Cantwell v. Connecticut*, 310 U.S. 296, 211 (1940)); CHEMERINSKY, *supra* note 14, at 987–89 (discussing vagueness doctrine).

103. *See supra* Part II.D.

or ethnic groups.¹⁰⁴ The Court stated that “[t]he admitted vagueness of the disparagement test and the huge volume of applications have produced a haphazard record of enforcement.”¹⁰⁵ As discussed next in Part III, some other trademark laws are also vague but do not discriminate based on viewpoint, and thus it is possible that courts will consider a void for vagueness challenge to a trademark law in a different context.

III. INCREASING FIRST AMENDMENT SCRUTINY OF TRADEMARK LAWS AFTER *MATAL V. TAM*

In my article *A Free Speech Right to Trademark Protection?* published before the *Tam* decision, I set forth a framework for evaluating whether trademark laws violate the right to freedom of expression set forth in the First Amendment. I argued that a trademark law may be unconstitutional if the following “elements” of a free speech violation are established:

- (1) government action; (2) suppression or punishment of expression, or some other actionable harm to expression; (3) this use of the trademark qualifies as expression; (4) this is expression of an individual or non-government entity, rather than government speech; (5) this expression is not categorically excluded from protection; and (6) the trademark law does not satisfy constitutional scrutiny.¹⁰⁶

This framework is still useful after *Tam* and is consistent with the Court’s traditional First Amendment doctrines.¹⁰⁷ It should be relevant to anyone evaluating the constitutionality of a trademark law because it requires the decision-maker to clarify exactly why a trademark law is, or is not, valid under the First Amendment.

For example, in *Tam*, the disparagement clause was unconstitutional because (1) the government (2) denied the benefits of registration to applicants based on their expression and this was an actionable harm to expression; (3) trademarks are “speech” within the meaning of the First Amendment; (4) trademark registrations are private speech, not government speech; (5) the disparagement clause does not regulate expression that is categorically

104. *Tam*, 137 S. Ct. at 1755–57 (majority opinion).

105. *Id.* at 1756–57 & n.5.

106. Ramsey, *supra* note 14, at 849.

107. Before *Tam*, I argued that the second element of a free speech violation was not satisfied by the disparagement clause because granting trademark rights in disparaging terms harms expression more than denying registration to such marks. *Id.* at 832–44, 854–58. I was wrong on that point. As noted previously, the Court held in *Tam* that the chilling effect of the disparagement clause was sufficient to implicate the First Amendment and found the law unconstitutional. See *supra* Parts II.B and II.E.

excluded from First Amendment protection; and (6) the disparagement clause cannot withstand constitutional scrutiny under *Central Hudson* or a more stringent First Amendment test. If any one of these elements of a free speech violation had not been satisfied in *Tam* then it is unlikely the Court would have found the law invalid under the First Amendment.

Anyone challenging or considering the constitutionality of a different trademark law after *Tam* should consider whether all of these elements of a free speech violation are satisfied. If the trademark dispute involves a private company's restrictions on use of another's mark (such as in the terms and conditions of an online marketplace), regulations of government trademarks, viewpoint-neutral trademark laws targeting fraudulent speech or misleading commercial speech, or the law satisfies the relevant constitutional balancing test, there is likely no First Amendment violation. Appellate courts should use a de novo standard of review when evaluating free speech challenges to trademark laws and independently examine the record to ensure the judgment does not harm free expression.¹⁰⁸

A. *Is There Government Action in This Trademark Dispute?*

In the United States a restriction of expression only implicates the First Amendment if there is government action (also known as "state action"), meaning that the government—not a private party such as Amazon, Google, or Facebook—is the one suppressing, punishing, or otherwise harming expression.¹⁰⁹ The government is clearly regulating expression when Congress bans registration of certain marks under Section 2 of the Lanham Act and trademark examiners deny a registration under this provision. Thus, it is not surprising that the government did not argue in *Tam* that the state action requirement was not satisfied by Section 2(a)'s ban on registration of marks that may disparage others,

108. Cf. *Bose Corp. v. Consumers Union*, 466 U.S. 485, 499–502 (1984) (holding that appellate courts should use a de novo standard of review in a product disparagement case when determining whether a false statement was made with actual malice, and noting that "we have repeatedly held that an appellate court has an obligation to 'make an independent examination of the whole record' in order to make sure that the judgment does not constitute a forbidden intrusion on the field of free expression.") (quoting *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 284–86 (1964)). I thank Rebecca Tushnet for her comments on this point.

109. Ramsey, *supra* note 14, at 851–54; Ramsey, *supra* note 16, at 407–09. Private parties such as Amazon or Facebook can prohibit unauthorized use of trademarks and censor expression by users which incorporates the marks of others without implicating or violating the First Amendment because this private censorship is not government action. Ramsey, *supra* note 14, at 853 & n.225; Ramsey, *supra* note 16, at 407–09.

or by the USPTO's refusal to register Tam's mark. This was clearly government action. Any free speech challenge to federal or state trademark registration laws cannot be rejected on the ground that there is no government action. Moreover, there is state action when the government enforces trademark counterfeiting laws against a defendant in criminal courts, or U.S. Customs Officials seize goods displaying registered marks at the border and stop them from importation.

While some district courts have held there is no state action when the government is involved in enforcing a private party's trademark rights,¹¹⁰ appellate courts and commentators disagree.¹¹¹ Under current Supreme Court doctrine, it is clear that there is state action if the government is involved in enforcing private rights in civil litigation and it suppresses, punishes, or otherwise restricts expression to protect those rights.¹¹² Thus, trademark laws regulating infringement, dilution, and cybersquatting implicate the First Amendment, as do laws that allow private parties to sue in civil courts for counterfeiting. These trademark enforcement laws allow the government to prohibit or penalize unauthorized use of another's trademark and regulate that expression in other ways. A court's trademark injunction orders the defendant to stop using certain words, symbols, or other subject matter protected as a trademark, and the judge can award monetary damages and other remedies to the prevailing trademark owner.¹¹³ Rather than argue that there is no government action in a trademark lawsuit, the best way to respond to a First Amendment challenge to a trademark law is to contend that the law regulates speech that is categorically unprotected or argue that the law satisfies constitutional scrutiny, as discussed later.

B. Does This Trademark Law Suppress, Punish, Chill, or Otherwise Harm Expression?

After *Tam*, a trademark law may implicate the First Amendment if it bans, penalizes, or discourages expression, or harms free speech in other ways recognized by the Court's First Amendment

110. See the sources cited in *supra* note 51.

111. See *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 30 n.2 (1st Cir. 1987); *U.S. Jaycees v. Phila. Jaycees*, 639 F.2d 134, 145–46 & n.9 (3d Cir. 1981); MCCARTHY, *supra* note 13, § 31:143; Denicola, *supra* note 43, at 190–92 n.146; Ramsey, *supra* note 14, at 851–53; Ramsey, *supra* note 16, at 407–09.

112. *N.Y. Times v. Sullivan*, 376 U.S. 254, 265 (1964).

113. See 15 U.S.C. §§ 1114, 1117, 1125 (2012).

jurisprudence.¹¹⁴ Examples include trademark infringement, dilution, cybersquatting, and counterfeiting laws. These speech regulations prohibit and punish expression that violates another's trademark rights. Moreover, in *Tam* the Court clarified that the government cannot constitutionally justify a trademark regulation of speech by claiming it only chills expression or denies a government benefit without suppressing speech.

It is important to note, however, that trademark registration laws do not only discourage expression when they deny registration to certain subject matter based on its content or viewpoint.¹¹⁵ This Article argues that trademark statutes which *allow* the registration of "almost anything" that can convey information about the source of goods or services can also chill the use of words, names, symbols, or product attributes that are registered as trademarks.¹¹⁶ Once the USPTO grants a registration for a descriptive term, popular slogan, informational phrase, culturally-significant symbol, color, representational shape, or other inherently valuable product feature that is deemed to have acquired distinctiveness, this registration can have a chilling effect on the expression of competitors and others. It is likely to discourage use of identical or similar subject matter (as a mark or otherwise) in slogans, domain names, social media posts, advertising, and other communications directed to consumers. The registration provides notice of the trademark owner's exclusive right to use this mark with the listed goods or services, and the trademark owner can use the registration symbol with the mark to publicly stake a claim in it.¹¹⁷ Trademark registrations can be found through a search of the trademark register, and registrations are often cited in demand letters sent to third parties who are using identical or similar language when they advertise and sell their goods or services.¹¹⁸

114. See *supra* Part II.B.

115. See Ramsey, *supra* note 14, at 875–76.

116. Ramsey, *supra* note 38, at 338, 350, 355; Ramsey, *First Amendment Limitations*, *supra* note 43, at 151–53; see Ramsey, *supra* note 14, at 832–45; Ramsey, *Symposium*, *supra* note 56. The "almost anything" language is from *Qualitex* and refers to the Supreme Court's broad interpretation of the words "symbol" or "device" in the Lanham Act provision setting forth the subject matter that may qualify as a trademark. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

117. MCCARTHY, *supra* note 13, §§ 19:2, 19:9, 19:144, 19:145; Ramsey, *supra* note 34, at 1166–67, 1170.

118. See, e.g., Constance Grady, *How an Author Trademarking the Word "Cocky" Turned the Romance Novel Industry Inside Out*, VOX (July 24, 2018, 1:08 PM), <https://www.vox.com/culture/2018/5/15/17339578/cockygate-explained-romance-publishing-faleena-hopkins> [http://perma.cc/367N-AUNH].

A recent example of the chilling effect of a registration involves the mark COCKY, which was recently registered as a mark for use in connection with a series of romance novels (including *Cocky Heart Surgeon*, *Cocky Cowboy*, and *Cocky Senator*).¹¹⁹ The owner of the COCKY trademark registration informed several competing authors that they were infringing the mark by using this word in the titles of their books, and some authors changed their book titles after confirming that the word was registered as a mark.¹²⁰ A registration is also useful when a trademark owner asks private parties such as Amazon, Google, or Facebook to take down expression that incorporates the registered mark.¹²¹ For example, the owner of the COCKY registration complained to Amazon that other authors who used the word “Cocky” in the titles of their romance novels were infringing the registered mark.¹²² Amazon removed those books from its website and only added them back after several authors complained.¹²³ Thus, trademark laws allowing registration of certain marks can encourage self-censorship and private censorship by companies concerned about secondary trademark liability. They can implicate the First Amendment just like trademark enforcement laws and laws banning registration of matter that may disparage others.

C. *Does This Trademark Law Regulate “Speech” Within the First Amendment’s Scope?*

After *Tam*, the expressive component of a trademark is clearly “speech” within the meaning of the Free Speech Clause in the First Amendment, but the Court did not explicitly say that a trademark contains First Amendment “speech” when it solely provides information about the source of goods or services. Still, as explained in Part II, the opinions of the Justices suggest that a source-identifying use of a mark is “speech” rather than non-expressive conduct or something else outside the First Amendment’s scope.¹²⁴ Moreover, in *Sorrell*, the Court stated that “the creation and dissemination of information are speech within the meaning of the First

119. *Id.*

120. *Id.*

121. See generally Lisa P. Ramsey, *Brandjacking on Social Networks: Trademark Infringement by Impersonation of Markholders*, 58 BUFF. L. REV. 851 (2010) (discussing enforcement of trademark rights on social media sites such as Facebook and Twitter).

122. Grady, *supra* note 118.

123. *Id.*

124. See *supra* Part II.A.

Amendment.”¹²⁵ As explained by the Federal Circuit in *Brunetti*, trademarks “identify the source of a product or service, and therefore play a role in the ‘dissemination of information as to who is producing and selling what product, for what reason, and at what price.’”¹²⁶

The best approach when considering a First Amendment challenge to a trademark law after *Tam* is to conclude that the law is regulating “speech” covered by the First Amendment both when: (1) the distinctive mark only conveys information about the source of goods or services; and (2) when the mark conveys other non-source-identifying expression, such as descriptive information about the product’s qualities, ideas about the brand’s image, or political or social commentary.¹²⁷ This is all “speech” within the meaning of the First Amendment regardless of whether the message is commercial or noncommercial, or whether the mark is used by the trademark owner, competitors, or other companies or people. On the other hand, a procedural trademark law, such as a law setting forth the fees that must be paid to obtain a trademark registration, would not regulate First Amendment “speech” or implicate the First Amendment unless the law set forth different rules based on the content of a trademark applicant’s expression (*e.g.*, increased fees for registration of marks which may disparage others).

D. *Is This Expression Private Speech or Government Speech?*

As explained in Part II.C, laws regulating government speech are generally not subject to First Amendment scrutiny. In *Tam* the Court held that trademarks of private parties do not become government speech when they are registered by the government.¹²⁸ If the government is the one using or applying to register a trademark, however, then that mark would qualify as government speech.¹²⁹ In such a situation, a statute or regulation prohibiting

125. *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 570 (2011) (holding that “prescriber-identifying information is speech for First Amendment purposes” in a case involving regulation of pharmacy records that reveal the prescribing practices of individual doctors).

126. *In re Brunetti*, 877 F.3d 1330, 1349 (Fed. Cir. 2017), *petition for cert. filed*, 87 U.S.L.W. 3134 (U.S. Sept. 7, 2018) (No. 18-302) (quoting *In re Tam*, 808 F.3d 1321, 1338 (Fed. Cir. 2015), *as corrected* (Feb. 11, 2016) (en banc)).

127. See MCCARTHY, *supra* note 13, § 31:139.25; Denicola, *supra* note 43, at 193; Lemley & Volokh, *supra* note 43, at 219–20; Ramsey, *supra* note 14, at 865–66; Ramsey, *supra* note 16, at 385, 409–12; Snow, *supra* note 43, at 1648–51.

128. *Matal v. Tam*, 137 S. Ct. 1744, 1758–60 (2017).

129. Ramsey, *supra* note 14, at 869. One example of a mark registered by the government is New York’s Metropolitan Transportation Authority’s registered trademark in the

the government from registering or using disparaging terms as marks would probably be constitutional. This is true because the government speech doctrine allows legislators to favor some viewpoints at the expense of others when the government is regulating its own expression.¹³⁰ When trademark laws apply to marks used by private parties, however, this speech of individuals, organizations, and companies is clearly within the scope of the First Amendment's protection after *Tam*.

E. Is This Expression Categorically Excluded from First Amendment Protection?

Trademark laws that regulate expression which is categorically excluded from First Amendment protection should be found constitutional after *Tam* unless the law discriminates based on viewpoint. In the United States, the Supreme Court has recognized that fraud and obscenity are among those historic and traditional categories of expression which the government can generally prohibit, punish, and otherwise regulate without violating the First Amendment.¹³¹ The Court has also said misleading commercial speech is not protected by the First Amendment.¹³² In *Alvarez*, a plurality of Justices refused to recognize a “categorical rule . . . that false statements receive no First Amendment protection,” and determined that false statements of fact made in a noncommercial context (such as false claims of receipt of military decorations or medals) may be constitutionally protected.¹³³ However, a majority of Justices have not endorsed this conclusion, and some of the Court's previous cases suggest otherwise.¹³⁴

phrase IF YOU SEE SOMETHING, SAY SOMETHING for “[p]romoting public awareness of public safety and security issues.” Registration No. 3,217,091.

130. *Tam*, 137 S. Ct. at 1757.

131. *United States v. Stevens*, 559 U.S. 460, 468–69 (2010); *Va. State Bd. of Pharm. v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 771 (1976); *Roth v. United States*, 354 U.S. 476, 483 (1957).

132. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 565–66 (1980); *Friedman v. Rogers*, 440 U.S. 1, 9–10 (1979); *Va. State Bd. of Pharmacy*, 425 U.S. at 771; *see also* *Thompson v. W. States Med. Ctr.*, 535 U.S. 357, 367 (2002); *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 554 (2001); *Greater New Orleans Broad. Ass'n v. United States*, 527 U.S. 173, 183 (1999); *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 500 n.9 (1996) (plurality opinion).

133. *See United States v. Alvarez*, 567 U.S. 709, 719, 729–30 (2012) (Kennedy, J.) (plurality opinion) (joined by Roberts, C.J., and Ginsburg and Sotomayor, JJ.).

134. *Id.* at 746–47 (Alito, J., dissenting) (“Time and again, this Court has recognized that as a general matter false factual statements possess no intrinsic First Amendment value.”) (citing *Illinois ex rel. Madigan v. Telemarketing Assocs., Inc.*, 538 U.S. 600, 612 (2003); *BE&K Constr. Co. v. NLRB*, 536 U.S. 516, 531 (2002); *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 52 (1988); *Keeton v. Hustler Magazine, Inc.*, 465 U.S. 770, 776 (1984);

In *Tam*, the disparagement clause was not targeted at obscenity, fraud, or misleading commercial speech, and a majority of the Court did not discuss whether these types of expression receive no First Amendment protection in the trademark context. However, Justice Kennedy's concurring opinion in *Tam* suggests at least four Justices believe fraud can be regulated or punished,¹³⁵ and that trademark laws are generally constitutional when they regulate confusing or misleading expression and protect consumers against commercial harms.¹³⁶ Justice Kennedy did not clarify whether this is true because fraud and misleading commercial speech are not protected by the First Amendment, or because laws regulating this expression would satisfy intermediate or strict constitutional scrutiny. Lower courts discussing trademark laws have cited *Central Hudson* for the proposition that misleading commercial speech is not protected by the First Amendment.¹³⁷ Moreover, if Section 2(a) of the Lanham Act banned registration of matter which is obscene (instead of marks that are only immoral or scandalous) this speech regulation would likely be constitutional.¹³⁸

It is important to note that trademark laws which discrimi-

Bill Johnson's Rests., Inc. v. NLRB, 461 U.S. 731, 743 (1983); *Brown v. Hartlage*, 456 U.S. 45, 60 (1982); *Herbert v. Lando*, 441 U.S. 153, 171 (1979); *Va. State Bd. of Pharmacy*, 425 U.S. at 771; *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 340 (1974); *Time, Inc. v. Hill*, 385 U.S. 374, 389 (1967); *Garrison v. Louisiana*, 379 U.S. 64, 75 (1964).

135. *Tam*, 137 S. Ct. at 1765 (Kennedy, J., concurring) ("Those few categories of speech that the government can regulate or punish—for instance, fraud, defamation, or incitement—are well established within our constitutional tradition.") (citing *United States v. Stephens*, 559 U.S. 460, 468 (2010)).

136. *Id.* at 1768 (noting that "[i]t is well settled . . . that to the extent a trademark is confusing or misleading the law can protect consumers and trademark owners" and quoting *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 579 (2011) for the point that "the government's legitimate interest in protecting consumers from 'commercial harms' explains 'why commercial speech can be subject to greater governmental regulation than noncommercial speech'").

137. See, e.g., *Gibson v. Tex. Dep't of Ins.—Div. of Workers' Comp.*, 700 F.3d 227, 235–36 (5th Cir. 2012); *TrafficSchool.com, Inc. v. Edriver Inc.*, 653 F.3d 820, 829–30 (9th Cir. 2011); *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1018 (3d Cir. 2008); *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 934 F. Supp. 868, 873 (N.D. Ohio 1996); *Gordon & Breach Sci. Publishers S.A. v. Am. Inst. of Physics*, 859 F. Supp. 1521, 1537 (S.D.N.Y. 1994); *Consumers Union of the U.S., Inc. v. New Regina Corp.*, 664 F. Supp. 753, 767 (S.D.N.Y. 1987).

138. In the case *In re Brunetti*, 877 F.3d 1330, 1349–50 (Fed. Cir. 2017), *petition for cert. filed*, 87 U.S.L.W. 3134 (U.S. Sept. 7, 2018) (No. 18-302), the Federal Circuit held the trademark provision barring registration of immoral or scandalous marks, 15 U.S.C. § 1052(a) (2012), was an unconstitutional regulation of expression in a trademark dispute involving an application to register the word FUCT for clothing. One of the judges wanted to interpret the statute narrowly to only apply to obscene speech and avoid constitutional analysis of the law, *id.* at 1357–61 (Dyk, J., concurring), but the majority declined to adopt this approach. *Id.* at 1355–57 (majority opinion).

nate based on viewpoint will not be immune from further constitutional scrutiny just because they regulate obscenity, fraud, or misleading commercial speech. If a trademark statute, administrative regulation, or decision by a judge or trademark examiner discriminates based on viewpoint then courts should apply strict or heightened scrutiny analysis to the law after *Tam*. The Court's decision in *R.A.V.* suggests that viewpoint-discriminatory laws are presumptively unconstitutional and subject to strict constitutional scrutiny even if the law regulates expression that is historically or traditionally unprotected by the First Amendment.¹³⁹

As courts generally allow government restrictions of obscenity, fraud, and misleading commercial speech without subjecting the laws to intermediate or strict scrutiny analysis, and *Tam* did not suggest that a different approach is required in trademark disputes, viewpoint-neutral trademark laws regulating this type of expression should be consistent with the First Amendment after *Tam*. Examples include the Lanham Act provisions in Section 2(a) which prohibit registration of matter which is "deceptive" or which "falsely suggests a connection" to certain people, institutions, beliefs, or national symbols.¹⁴⁰

When trademark registration laws do not regulate obscenity, fraud, or misleading commercial speech those provisions must at least satisfy *Central Hudson's* intermediate constitutional analysis. Examples include the trademark law requiring marks to be distinctive for registration and laws banning registration of generic terms and functional product features.¹⁴¹ These trademark provisions will (and should) be found constitutional.¹⁴² These laws

139. *R.A.V. v. City of St. Paul*, 505 U.S. 377, 383–92 (1992).

140. 15 U.S.C. § 1052(a) (2012). According to Ted Davis and John Welch, "many prohibitions on registration address false or misleading commercial speech and therefore should not trigger heightened scrutiny under the First Amendment. These include the bars on the registration of deceptive marks, deceptively misdescriptive marks, primarily geographically deceptively misdescriptive marks, and marks either falsely suggesting an association with a person or entity or likely to be confused with the marks of prior users," as well as the prohibition on the registration of flags and other government symbols. Davis & Welch, *supra* note 56, at 2 (citing 15 U.S.C. §§ 1052(a), 1052(e)(1), 1052(e)(3), 1052(d), 1052(b)). See also Tushnet, *The First Amendment Walks into a Bar*, *supra* note 43, at 406–10 (discussing the constitutionality of regulations of deceptive expression in trademark law before the Court's decision in *Tam*). Whether all of these laws are constitutional is beyond the scope of this Article.

141. 15 U.S.C. §§ 1052(e)(5), 1052(f), 1064(3).

142. See Davis & Welch, *supra* note 56, at 2–3 (noting that prohibitions on registration of generic terms, merely descriptive marks lacking acquired distinctiveness, primarily geographically descriptive marks lacking acquired distinctiveness, surnames lacking acquired distinctiveness, and functional matter "might be challenged as content-based and therefore subject to intermediate scrutiny under *Central Hudson*, but, if so, the government has a substantial interest in preventing the use of trademark law to acquire the exclusive rights

directly and materially promote fair competition and the dissemination of information about the source of goods or services, both of which are substantial government interests. The trademark rules are also narrowly drawn to protect expressive values because they allow (rather than prohibit) use of this expression by everyone. The distinctiveness requirement encourages the use and advertising of source-identifying subject matter as a mark, and only protects signs that actually identify and distinguish products in the marketplace. This rule, along with the ban on registration of subject matter that is generic or functional, helps ensure that inherently valuable language and product features remain in the public domain for use by all traders. Moreover, these laws do not harm expression of the alleged trademark owner in a significant way since the company claiming trademark rights can continue to use this non-distinctive expression or functional product feature even if it cannot obtain a registration for it.¹⁴³

Courts may be tempted to summarily conclude that trademark statutes prohibiting infringing uses of marks which are likely to confuse consumers, such as Sections 32(1) and 43(a)(1)(A) of the Lanham Act,¹⁴⁴ are constitutional after *Tam* because these laws regulate misleading commercial speech. The problem with this conclusion, however, is that current infringement laws also regulate speech which is noncommercial, as discussed next.¹⁴⁵

F. *Does the Trademark Law Satisfy Constitutional Scrutiny?*

Since the *Tam* Court did not create a new trademark-specific First Amendment doctrine to use when evaluating free speech challenges to trademark laws,¹⁴⁶ anyone interested in challenging the constitutionality of a trademark law should continue to apply the U.S. Supreme Court's traditional First Amendment doctrines unless and until the Court determines that a different approach

to the categories of claimed marks covered by them") (citing 15 U.S.C. §§ 1052(e)(1)–(2), 1052(e)(4)–(5)). See also Tushnet, *The First Amendment Walks into a Bar*, *supra* note 43, at 410–12 (discussing the constitutionality of the ban on registration of informational matter and product designs that have utilitarian functionality before the Court's decision in *Tam*). A detailed discussion of this issue is beyond the scope of this Article.

143. See Ramsey, *supra* note 14, at 835, 844, 855 (explaining that denying a registration is less harmful to freedom of expression than granting a registration because the language may still be used if the registration is denied, and granting a registration chills the expression of many people).

144. 15 U.S.C. §§ 1114(1), 1125(a)(1)(A).

145. See Ramsey, *supra* note 14, at 836–43; Ramsey, *supra* note 16, at 426, 450.

146. See *supra* note 12 and Part II.E.

should be used in this context. Trademark laws can definitely implicate the First Amendment after *Tam*,¹⁴⁷ but that does not mean they automatically violate the free speech right. Regardless of whether intermediate or strict scrutiny analysis applies to trademark laws under the Court's current First Amendment doctrines, legislatures and courts should (1) consider the purpose of the specific law and whether that goal is sufficiently important given the type of expression that is being regulated; (2) confirm the law directly and materially advances that government interest; and (3) identify exactly how the law endangers free speech, and evaluate whether the law is narrowly tailored to harm expression no more than necessary or is the least speech-restrictive means for furthering that goal.¹⁴⁸ The burden of proof is on the government or the party attempting to restrict another person's speech.¹⁴⁹

Of course, the U.S. Supreme Court may later conclude that trademark laws should, like the current copyright laws, not be subject to scrutiny under the traditional balancing tests applied to government regulations of speech. This First Amendment approach to trademark law is not recommended given the different purposes and speech-protective doctrines in these laws, but a full discussion of this issue is beyond the scope of this Article.¹⁵⁰

147. See *supra* Part II.

148. See Ramsey, *supra* note 16, at 421–46.

149. Sorrell v. IMS Health Inc., 564 U.S. 552, 571–72 (2011); *In re Brunetti*, 877 F.3d 1330, 1350 (Fed. Cir. 2017), *petition for cert. filed*, 87 U.S.L.W. 3134 (U.S. Sept. 7, 2018) (No. 18-302).

150. The Court has held that copyright laws are not categorically immune from challenges under the First Amendment, but it has also said that “further First Amendment scrutiny is unnecessary” when “Congress has not altered the traditional contours of copyright protection.” *Eldred v. Ashcroft*, 537 U.S. 186, 221 (2003); see also *Golan v. Holder*, 565 U.S. 302, 327–30 (2012). According to the Court, copyright is integral to free expression and copyright law's idea/expression dichotomy and fair use defense were sufficient to protect expressive values. *Golan*, 565 U.S. at 328. Scholars have criticized the Court's refusal to subject copyright law to stronger First Amendment scrutiny. See, e.g., DAVID L. LANGE & H. JEFFERSON POWELL, *NO LAW: INTELLECTUAL PROPERTY IN THE IMAGE OF AN ABSOLUTE FIRST AMENDMENT*, at ix–x, 114–46, 259–60, 305–24 (2009). Neal Netanel describes the Court's approach in the copyright law area as a “definitional balancing,” Netanel, *supra* note 20, at 1088–1103, while Eugene Volokh describes it as the “copyright exception” to the First Amendment. Volokh, *supra* note 20, at 713–18. I have discussed this issue briefly in other scholarship and think that despite trademark law's speech-protective statutes and common law doctrines, it is still not consistent with the First Amendment and has strayed from its traditional focus on preventing misleading uses of trademarks and promoting fair competition. See Ramsey, *supra* note 14, at 836–46; Ramsey, *supra* note 16, at 414–21. Unlike copyright law's statutory prohibition on protection of ideas, methods of operation, and other types of subject matter, 17 U.S.C. § 102(b) (2012), there appears to be no reasonable limit on what types of signs can qualify as a mark after the Court's conclusion in *Qualitex* that “almost anything” that can carry source-distinguishing meaning is eligible for regis-

1. *Preliminary Issues to Consider in the Constitutional Analysis.*

a. *Does This Trademark Law Only Regulate Commercial Speech, or Does It Also Apply to Noncommercial Speech?*

Comments from some of the Justices in *Tam* suggest that the distinction between commercial and noncommercial speech is less relevant today when evaluating the constitutionality of trademark laws regulating the content or viewpoint of expression.¹⁵¹ However, a majority of the Court has not said that the commerciality of a content-based law is irrelevant in determining the level of First Amendment scrutiny, nor has it said that *Central Hudson* is no longer good law. Thus, courts evaluating free speech challenges to trademark laws should determine whether the law regulates noncommercial speech in addition to commercial speech, as the speech regulation might be subject to more rigorous constitutional scrutiny if the law is also suppressing or chilling expression that is not commercial.

As I have discussed elsewhere in detail, trademark laws regulate both commercial and noncommercial speech.¹⁵² Thus, classification of the commerciality of a specific trademark (or expression incorporating a trademark) should be evaluated on a case-by-case basis. The U.S. Supreme Court's current definition of commercial speech is narrow—it is “speech that does no more than propose a

tration and protection. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995) (interpreting the words “symbol” or “device” in the definition of a trademark in Section 45 of the Lanham Act, 15 U.S.C. § 1127). In addition, the copyright statute contains a very broad fair use defense, 17 U.S.C. § 107 (2012), while the defenses to infringement in the trademark statute are narrow and limited. 15 U.S.C. § 1115 (2012). Unless and until Congress limits what types of signs can qualify as a trademark, eliminates claims for dilution, and adds more statutory defenses, courts should not assume that heightened First Amendment scrutiny is unnecessary in the trademark context, especially since trademark laws currently apply to nonmisleading and noncommercial uses of trademarks. *See infra* Parts III.F.1.a and IV.A.

151. *See, e.g., Tam*, 137 S. Ct. at 1765 (Alito, J.) (plurality opinion) (“If affixing the commercial label permits the suppression of any speech that may lead to political or social ‘volatility,’ free speech would be endangered.”); *id.* at 1767 (Kennedy, J., concurring) (“To the extent trademarks qualify as commercial speech, they are an example of why that term . . . does not serve as a blanket exemption from the First Amendment’s requirement of viewpoint neutrality.”); *id.* at 1769 (Thomas, J., concurring) (“I continue to believe that when the government seeks to restrict truthful speech in order to suppress the ideas it conveys, strict scrutiny is appropriate, whether or not the speech in quest may be characterized as ‘commercial.’”); *see also* Calvert, *supra* note 56, at 47–49 (noting the application of intermediate scrutiny to commercial speech is perhaps “tenuous” after *Tam*). Whether the Court should continue to consider the commerciality of laws regulating trademarks when determining the proper level of constitutional scrutiny is beyond the scope of this Article.

152. Ramsey, *supra* note 14, at 873–75; Ramsey, *supra* note 16, at 395–98.

commercial transaction.”¹⁵³ An example of commercial speech is advertising that disseminates information “as to who is producing and selling what product, for what reason, and at what price.”¹⁵⁴ Tutoring, legal advice, and medical consultation are not commercial speech under this definition because this expression does more than propose a commercial transaction.¹⁵⁵ The Court has also said expression with commercial and noncommercial components may be characterized as commercial speech where it (1) is an advertisement, (2) that mentions a specific commercial product, and (3) is motivated by economic concerns.¹⁵⁶

As noted by Justice Alito, “the line between commercial and non-commercial speech is not always clear.”¹⁵⁷ This lack of clarity in free speech law is problematic, as the decision of whether a trademark’s expression is commercial or noncommercial can have a significant impact on whether intermediate or strict constitutional scrutiny of the law is required under the Court’s current First Amendment jurisprudence. Courts considering free speech challenges to trademark laws must draw this line, however, unless they conclude (like Justice Alito in *Tam*) that the law does not even satisfy intermediate scrutiny under *Central Hudson*.¹⁵⁸ Justice Kennedy said in his *Tam* concurrence that the question of whether trademarks are commercial speech “may turn on whether certain commercial concerns for the protection of trademarks might, as a general matter, be the basis for regulation.”¹⁵⁹ He also stated that “[t]he central purpose of trademark registration is to facilitate

153. *Harris v. Quinn*, 134 S. Ct. 2618, 2639 (2014); *United States v. United Foods, Inc.*, 533 U.S. 405, 409 (2001).

154. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 765 (1976).

155. *Bd. of Trs. of the State Univ. of N.Y. v. Fox*, 492 U.S. 469, 482 (1989).

156. *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 66–67 (1983) (“The combination of all these characteristics . . . provides strong support for the District Court’s conclusion that the informational pamphlets are properly characterized as commercial speech.”); *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1015–18 (3rd Cir. 2008) (applying these three factors in a trademark dispute). For a detailed discussion of the Court’s commercial speech doctrine and how it is applied in intellectual property law, see generally Rothman, *Commercial Speech*, *supra* note 43.

157. *Matal v. Tam*, 137 S. Ct. 1744, 1765 (2017) (Alito, J.) (plurality opinion); see also Tamara R. Piety, *The First Amendment and the Corporate Civil Rights Movement*, 11 J. BUS. & TECH. L. 1, 4 (2016) (“No one knows exactly what commercial speech is.”); Ramsey, *supra* note 16, at 395 (noting it is “difficult, if not impossible, to draw an exact line between commercial and noncommercial speech in trademark disputes”); Rothman, *Commercial Speech*, *supra* note 43, at 1933 (“To date, no convincing basis has been articulated for distinguishing commercial and noncommercial speech.”).

158. *Tam*, 137 S. Ct. at 1763–64 (Alito, J.) (plurality opinion).

159. *Id.* at 1767 (Kennedy, J., concurring).

source identification.”¹⁶⁰ This latter statement was quoted by the Federal Circuit in *Brunetti* when it noted that trademark laws “targeting a mark’s source identifying information” (such as Section 2(e)’s ban on registration of descriptive or geographically descriptive marks without proof of distinctiveness) regulate the “commercial components of speech.”¹⁶¹

Trademark registration and enforcement laws clearly regulate speech that is commercial. Trademarks “identify the source of a product or service, and therefore play a role in the ‘dissemination of information as to who is producing and selling what product, for what reason, and at what price.’”¹⁶² When the mark is used to identify the source of commercial products or to advertise commercial goods or services available for purchase, it is commercial speech.¹⁶³ Thus trademark laws regulate commercial speech when they allow the registration of marks used by for-profit companies and protect these marks against infringement and other trademark violations by competitors in the marketplace.

However, trademark registration and enforcement laws also apply to speech that is noncommercial. Even if trademark registration laws generally facilitate source identification and specific provisions target a mark’s source-identifying information, that does not mean these laws are always regulating commercial speech. As noted by the U.S. Supreme Court and Federal Circuit, source-identifying trademarks like THE SLANTS and FUCT can also convey political or social messages and espouse powerful viewpoints and ideas about a variety of topics in just a few words.¹⁶⁴ Trademarks can do more than propose a commercial transaction.

Moreover, political and religious organizations use marks to identify the source of their goods or services, and the U.S. government registers and protects their marks.¹⁶⁵ For example, the Second Circuit held that a political group supporting Ross Perot’s

160. *Id.* at 1768.

161. *In re Brunetti*, 877 F.3d 1330, 1349–50 (Fed. Cir. 2017), *petition for cert. filed*, 87 U.S.L.W. 3134 (U.S. Sept. 7, 2018) (No. 18-302) (citing 15 U.S.C. § 1052(e) (2012) of the Lanham Act). The Federal Circuit was contrasting these laws with Section 2(a)’s ban on registration of immoral or scandalous marks, which was a regulation of “the expressive components of speech.” *Id.* (citing 15 U.S.C. § 1052(a)).

162. *In re Brunetti*, 877 F.3d at 1349 (quoting *In re Tam*, 808 F.3d 1321, 1338 (Fed. Cir. 2015), *as corrected* (Feb. 11, 2016) (en banc)).

163. Ramsey, *supra* note 14, at 873–75; Ramsey, *supra* note 16, at 395–98.

164. *Tam*, 137 S. Ct. at 1760 (majority opinion); *In re Brunetti*, 877 F.3d at 1349.

165. See Ramsey, *supra* note 14, at 836–37, 874 & n.307; Ramsey, *supra* note 16, at 396–99. Note that while this is not a “commercial” use of the mark, it is a “trademark” use of the mark, meaning that it is use of a word, name, symbol, or device as a mark to identify the source of goods or services provided by that organization. See Ramsey, *supra* note 14,

1992 presidential campaign could sue for infringement of its mark “United We Stand America” registered for the service of conducting voter registration drives and other political services.¹⁶⁶ In addition, a national religious organization using the registered mark “Seventh-Day Adventist” for religious books, educational services, and health services successfully sued an unaffiliated church for infringement.¹⁶⁷ Such marks can communicate valuable source-identifying messages that help people identify and distinguish between organizations in their community. This information is useful not only when the non-profit groups are fundraising,¹⁶⁸ but also when they are providing free goods or services in a noncommercial setting. The source-identifying information conveyed by these marks does more than propose a commercial transaction, and the organizations are not using the marks to advertise a specific commercial product for an economic purpose. These trademarks are not commercial speech.

Case-by-case analysis is essential when determining the commerciality of a trademark enforcement law. For example, trademark dilution law only applies to commercial uses of trademarks,¹⁶⁹ but the trademark infringement statute does not explicitly require commercial use of the mark for liability.¹⁷⁰ Rather than focus on the message conveyed by the mark when it is used by the trademark owner, courts should ask whether the accused infringer’s expression is commercial and if this trademark law applies to it. A defendant may be using the trademark of a for-

at 874–75; Ramsey, *supra* note 16, at 400–01.

166. UNITED WE STAND AMERICA, Registration No. 1,844,852 (cancelled); United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc., 128 F.3d 86, 88 (2d Cir. 1997).

167. SEVENTH-DAY ADVENTIST, Registration No. 1,177,185; Gen. Conference Corp. of Seventh-Day Adventists v. Perez, 97 F. Supp. 2d 1154, 1156–69, 1164 (S.D. Fla. 2000).

168. See *Tam*, 137 S. Ct. at 1768 (Kennedy, J., concurring) (“Nonprofit organizations—ranging from medical-research charities and other humanitarian causes to political advocacy groups—also have trademarks, which they use to compete in a real economic sense for funding and other resources as they seek to persuade others to join their cause.”).

169. Federal dilution law only applies to commercial use of another’s distinctive and famous mark, 15 U.S.C. § 1125(c)(3)(C) (2012) (statutory exemption for “noncommercial use of a mark”), and the Ninth Circuit has held “noncommercial use of a mark” refers to speech that is noncommercial or fully protected by the First Amendment. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905–07 (9th Cir. 2002) (holding *Barbie Girl* song was not purely commercial speech despite the fact it was sold for profit and, therefore, the noncommercial use exemption to dilution liability applied).

170. 15 U.S.C. §§ 1114(1), 1125(a)(1). The use “in commerce” requirement in the infringement statutes is jurisdictional—Congress can only regulate trademarks under the Commerce Clause of the U.S. Constitution—and therefore is different than a commercial use requirement. See Ramsey, *supra* note 14, at 836–37; Ramsey, *supra* note 16, at 403 & nn.140–41.

profit company in a noncommercial manner. As noted previously, some courts hold that application of the infringement statute is not limited to profit-seeking uses of trademarks.¹⁷¹ Moreover, courts have applied infringement law to unauthorized uses of marks in parodies and other commentary on websites, artistic and literary works, and other types of expression which are arguably not commercial speech under the Court's First Amendment jurisprudence.¹⁷²

Courts protect expressive values in trademark cases involving artistic or literary works by applying a speech-protective doctrine called the *Rogers* balancing test, but they will still find infringement—and apply the law to noncommercial speech—if this use of the mark is explicitly misleading as to the source or content of the expression.¹⁷³ While this result may be constitutionally justified if

171. *E.g., United We Stand Am.*, 128 F.3d at 92–93.

172. *See, e.g.,* People for the Ethical Treatment of Animals v. Doughney, 263 F.3d 359, 362 (4th Cir. 2001); Dr. Seuss Enters., L.P. v. Penguins Books USA, Inc., 109 F.3d 1394, 1396 (9th Cir. 1997); Anheuser-Busch, Inc. v. Balducci Publ'ns, 28 F.3d 769, 771–73 (8th Cir. 1994); Dall. Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 202 (2d Cir. 1979); SMJ Grp., Inc. v. 417 Lafayette Rest. LLC, 439 F. Supp. 2d 281, 291 (S.D.N.Y. 2006); Planned Parenthood Fed'n of Am., Inc. v. Bucci, 42 U.S.P.Q.2d (BNA) 1430, 1440 (S.D.N.Y. 1997), *aff'd*, 152 F.3d 920 (2d Cir. 1998); Am. Dairy Queen Corp. v. New Line Prods., Inc., 35 F. Supp. 2d 727, 728 (D. Minn. 1998). *See also* Eric Goldman, *Online Word of Mouth and its Implications for Trademark Law*, in TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH 404, 414–24 (Graeme B. Dinwoodie & Mark D. Janis eds., 2008) (discussing different judicial interpretations of the Lanham Act's use in commerce requirement and application of trademark law to noncommercial expression); Ramsey, *supra* note 14, at 836–37 & n.164 (discussing cases); Ramsey, *supra* note 16, at 403–04 & nn.142–44 (same). Per the U.S. Supreme Court, the expression conveyed by a tutor, attorney, or doctor to her client when the services are rendered is not commercial speech even though the speaker is compensated for this information. Bd. of Trs. of the State Univ. of N.Y. v. Fox, 492 U.S. 469, 482 (1989). Moreover, books, magazines, plays, movies, video games, comic books, and other forms of entertainment that communicate ideas through different communication mediums are fully protected by the First Amendment despite the fact they are sold for profit. Brown v. Entm't Merchs. Ass'n, 564 U.S. 786, 790–98 (2011) (video games); Smith v. California, 361 U.S. 147, 150 (1959) (books); Joseph Burstyn, Inc. v. Wilson, 343 U.S. 495, 501–02 (1952) (motion pictures).

173. *See, e.g.,* Twentieth Century Fox Television v. Empire Distribution, Inc., 875 F.3d 1192, 1196–99 (9th Cir. 2017) (applying the test from *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) to use of mark in title of a television show); Univ. of Ala. Bd. of Trs. v. New Life Art, Inc., 683 F.3d 1266, 1276–79 (11th Cir. 2012) (applying *Rogers* test to use of marks in paintings); *Mattel*, 296 F.3d at 901–02, 905–96 (applying test to use of *Mattel's* BARBIE mark in *Barbie Girl* song). The *Rogers* balancing test requires courts to construe trademark law to apply “only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.” *Rogers*, 875 F.2d at 999. In such cases, incorporation of another's mark in the title or content of an artistic or literary work is not actionable unless this use of the mark “has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless [it] explicitly misleads as to the source or the content of the work.” *Id.*; *see* E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1099–1101 (9th Cir. 2008) (applying *Rogers* test to use of mark in the content of a video game). *See generally* Mark Bartholomew & John Tehranian, *The Changing Landscape of*

the speech is misleading, it is clear that trademark infringement laws currently apply to expression that is not commercial speech. Use of another's mark in advertising for creative works may be commercial speech,¹⁷⁴ and marks used by publishers, movie studios, and other entertainment companies to identify the source of their products should be classified as commercial speech.¹⁷⁵ But the titles and content of books, magazines, comic books, films, television shows, video games, photographs, paintings, sculptures, and other creative works should generally not be deemed commercial speech even when that expression is sold for profit.¹⁷⁶ After *Tam*, we should consider whether the First Amendment requires infringement statutes to only apply in commercial contexts, or allows courts to prohibit and punish misleading uses of marks in noncommercial expression using the *Rogers* balancing test or another trademark-specific free speech doctrine.

b. Does This Trademark Law Regulate Speech Based on Its Content or Viewpoint?

Under the Court's current First Amendment jurisprudence, content-neutral speech regulations are subject to a more relaxed form of constitutional scrutiny compared to laws which target expression based on its content or viewpoint.¹⁷⁷ For example, laws regulating the time, place, or manner of speech (such as the sound levels at concerts) are constitutional under the intermediate scrutiny test set forth in *Ward* if they are justified without reference to the speech's content, are narrowly tailored to serve a significant

Trademark Law in Tinseltown: From Debbie Does Dallas to The Hangover, in *HOLLYWOOD AND THE LAW* 47 (Paul McDonald et al. eds., 2015).

174. See *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1015–18 (3rd Cir. 2008) (in action for false endorsement based on use of a famous broadcaster's voice in a commercial about the upcoming release of Madden NFL 2006, holding that the advertisement "aims to promote another creative work" and is commercial speech).

175. See *supra* the discussion in the text and sources accompanying notes 162–63.

176. See *Brown*, 564 at 790–98; *Smith*, 361 U.S. at 150; *Burstyn*, 343 U.S. at 501–02. Use of another's mark in the title or content of news reporting and news commentary (such as blogs or social media posts) should also be deemed noncommercial speech if the mark is not used to identify the source of the information provided by the reporter or commentator. This expression is noncommercial because the mark does not propose a commercial transaction and this expression is not akin to a profit-motivated advertisement for a specific commercial product. On the other hand, use of a trademark to identify the source of news reporting (e.g., "The New York Times") may be classified as commercial speech, as the brand name of the informational product invites consumers to purchase or read the news, and helps advertise these goods or services. *Id.*; cf. 15 U.S.C. § 1125(c)(3)(B)–(C) (2012) (listing "news reporting and news commentary" separately from the "noncommercial use of a mark" exemption from dilution liability, which suggests Congress believed use of a mark in connection with news reporting may not always be noncommercial).

177. Ramsey, *supra* note 16, at 421–37.

government interest, and leave open ample alternative channels for communication of the information.¹⁷⁸ Thus anyone evaluating the constitutionality of a trademark law must determine whether that provision is a content-neutral regulation of speech or is instead a law that applies to particular subject matter because of its content or viewpoint.¹⁷⁹

Guidance on this issue can be found in *Tam* and other Supreme Court cases cited by the Justices in that decision. As noted previously, Justice Kennedy said in *Tam* that “[t]he First Amendment guards against laws ‘targeted at specific subject matter’, a form of speech suppression known as content based discrimination.”¹⁸⁰ He cites *Reed*, a case in which the Court held that a content-based regulation is a law that “applies to particular speech because of the topic discussed or the idea or message expressed.”¹⁸¹ Per the Court in *Reed*, “[a] law that is content based on its face is subject to strict scrutiny regardless of the government’s benign motive, content-neutral justification, or lack of animus toward the ideas contained in the regulated speech.”¹⁸² In *Tam*, Justice Kennedy also explained that laws “aimed at the suppression of ‘particular views . . . on a subject’” are an “‘egregious form of content discrimination’” and are “‘presumptively unconstitutional.’”¹⁸³

This Article argues that most, if not all, substantive trademark registration and enforcement laws apply to speech because of its content, and a few also regulate expression based on its viewpoint.¹⁸⁴ As I have discussed elsewhere in detail,¹⁸⁵ trademark examiners must examine the content of the word, name, symbol, or device that is desired to be registered as a trademark and ascertain the mark’s meaning or message when deciding whether to allow or deny an application to register this subject matter as a

178. See, e.g., *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989).

179. For a detailed discussion of these issues, see generally Ramsey, *supra* note 16, at 421–47.

180. *Matal v. Tam*, 137 S. Ct. 1744, 1765–66 (2017) (Kennedy, J., concurring) (quoting *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2230 (2015)).

181. *Reed*, 135 S. Ct. at 2227, cited in *Tam*, 137 S. Ct. at 1765–66 (Kennedy, J., concurring).

182. *Reed*, 135 S. Ct. at 2228.

183. *Tam*, 137 S. Ct. at 1765–66 (Kennedy, J., concurring) (first quoting *Reed*, 135 S. Ct. at 2230; and then quoting *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829–30 (1995)).

184. I use the phrase “substantive” here to distinguish these laws from “procedural” trademark laws, such as laws setting forth the fees that must be paid to obtain a trademark registration.

185. See generally Ramsey, *supra* note 14, at 875–76; Ramsey, *supra* note 16, at 429–42.

mark. The content of the alleged mark is extremely important when the examiner determines if that language or product feature is generic, descriptive, distinctive, or deceptive for the relevant goods or services; is likely to be confused with another mark; or should be denied registration on other substantive grounds set forth in the Lanham Act.¹⁸⁶

In addition, courts and juries compare the content of the defendant's expression to the plaintiff's mark when determining whether there is infringement or dilution of the mark.¹⁸⁷ Courts may also ban use by the defendant of the source-identifying word or other matter protected as a mark if there is a trademark violation and punish the defendant by awarding monetary damages to the plaintiff because of the confusing or diluting message expressed by the defendant to the public.¹⁸⁸ Per the Court, a law is content-based if it "is the content of the speech that determines whether it is within or without the statute's blunt prohibition."¹⁸⁹ For these reasons, most trademark laws are content-based speech regulations and are quite different from laws regulating the time, place, or manner of expression or other content-neutral laws.¹⁹⁰

Some people may argue that the *Tam* Court's determination that the disparagement clause is viewpoint-based (and thus content-based) results only from the government's purpose for regulating disparaging terms rather than from the fact that the law discriminates based on viewpoint on its face and as applied.¹⁹¹ They may contend that other trademark laws are generally content-neutral regulations of speech because, unlike with the offensive trademark provisions in Section 2(a), the government does not want to discourage use of the subject matter as a mark by the trademark owner nor does it disapprove of the expressive content

186. See 15 U.S.C. §§ 1052(a), (d), (e)(2) (2012). The Federal Circuit recently held that the immoral and scandalous mark provision was a content-based regulation of speech. *In re Brunetti*, 877 F.3d 1330, 1341–42 (Fed. Cir. 2017), *petition for cert. filed*, 87 U.S.L.W. 3134 (U.S. Sept. 7, 2018) (No. 18-302). The court also questioned the viewpoint-neutrality of the law, but declined to resolve the issue. *Id.* at 1341.

187. MCCARTHY, *supra* note 13, §§ 23:19-23:30, 24:116-24:117. For example, one of the factors that is relevant to the determination of whether there is dilution by blurring is "[t]he degree of similarity between the mark or trade name and the famous mark." 15 U.S.C. § 1125(c)(2)(B)(i).

188. See 15 U.S.C. §§ 1114, 1117, 1125.

189. *Carey v. Brown*, 447 U.S. 455, 462 (1980) (constitutional challenge to state statute prohibiting picketing at residences or dwellings but exempting peaceful picketing of a place of employment involved in a labor dispute).

190. See Ramsey, *supra* note 14, at 875; Ramsey, *supra* note 16, at 429–31, 435–36.

191. *Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017) (Alito, J.) (plurality opinion) (determining that the government's goal was "preventing speech expressing ideas that offend").

of the word, name, symbol, or device when it denies an application to register a specific mark or bans infringing use of another's distinctive mark.¹⁹² Trademark advocates may also say that trademark enforcement laws are content-neutral regulations because the government's goal is to protect property rights in an investment in goodwill symbolized by the mark and prevent free riding off this brand value. They may argue dilution laws are similar to laws prohibiting trespassing on land or punishing theft of another's personal property, and do not target expression based on its subject matter and viewpoint like a law regulating disparaging terms.¹⁹³ These arguments should fail because, as noted previously, the Court has held that "the government's benign motive, content-neutral justification, or lack of 'animus toward the ideas contained' in the regulated speech" cannot prevent strict scrutiny of a law "that is content based on its face."¹⁹⁴

While trademark registration and enforcement laws generally regulate expression based on its content, most trademark statutes do not discriminate based on the viewpoint of expression.¹⁹⁵ Language in the *Tam* Court's opinion provides some guidance as to whether other registration provisions in Section 2 of the Lanham Act regulate expression based on its viewpoint. When the Court was discussing the disparagement clause in the part of its opinion holding that trademark registrations are not government speech, it said that Section 2(a)—which bans registration of matter which is immoral, scandalous, and potentially disparaging, among other things—is the only provision that allows examiners to discriminate based on the viewpoint of the expression:

Except as required by the statute involved here, 15 U.S.C. § 1052(a), an examiner may not reject a mark based on the viewpoint that it appears to express. Thus, unless that section is thought to apply, an examiner does not inquire whether any viewpoint conveyed by a mark is consistent with Government policy or whether any such viewpoint is consistent with that expressed by other marks already on the

192. See *infra* Part III.F.1.c.

193. *Id.*; see also Ramsey, *supra* note 16, at 422–23 & nn. 250–53.

194. Reed v. Town of Gilbert, 576 U.S. ___, 135 S. Ct. 2218, 2228 (2015) (quoting Cincinnati v. Discovery Network, Inc. 507 U.S. 410, 429 (1993)).

195. See Ramsey, *supra* note 16, at 431–41; see also Volokh, *supra* note 20, at 703 (noting that intellectual property laws are generally viewpoint neutral); cf. Lemley & Volokh, *supra* note 43, at 218–29 (“[Some] courts have concluded that while trademark laws do restrict speech, they do so in a ‘content-neutral’ manner and are therefore permissible. These courts have apparently confused viewpoint-neutrality with content-neutrality.”).

principal register.¹⁹⁶

These statements suggest that trademark laws which ban registration of flags and other government insignia, generic terms, merely descriptive terms, marks likely to cause confusion with other marks, and other provisions in the Lanham Act allowing examiners to refuse registration to certain marks do not discriminate against speech based on its viewpoint.¹⁹⁷ It is important to note, however, that the Court's statement about viewpoint-neutral decisions by trademark examiners does not apply to trademark laws banning registration of marks that are likely to cause dilution of famous marks.¹⁹⁸ In an ex-parte examination of the registrability of a mark, an examiner cannot reject a mark on the ground that it is likely to cause dilution by blurring or tarnishment of another mark; such marks may only be refused registration in opposition or cancellation proceedings filed by third parties.¹⁹⁹ Thus, the Court neither explicitly nor implicitly commented on whether dilution laws regulate trademarks based on their viewpoint or ideas. They do.²⁰⁰

Dilution laws require courts to determine whether any viewpoint or ideas conveyed by a junior user's mark are consistent with the viewpoint or ideas expressed by the famous mark of the senior user. They only apply if the junior user's mark or trade name creates an association with a famous mark and that expression impairs the distinctiveness of the famous mark or harms its reputation.²⁰¹ These laws protect the unique brand message or ideas symbolized by the famous mark from inconsistent or different messages that blur or tarnish that meaning. Dilution laws do not apply where the defendant is using the mark in a manner consistent with the source-identifying meaning of the famous mark, such as use of the mark to refer to the trademark owner or its products in comparative advertising, parody, criticism, commentary, and news reporting.²⁰² They apply when the junior user's mark identifies the source of its own goods or services and is similar enough to the

196. *Matal v. Tam*, 137 S. Ct. 1744, 1758 (2017).

197. 15 U.S.C. § 1052(b)–(e) (2012).

198. *Id.* §§ 1052(f), 1125(c).

199. *Id.* § 1052(f).

200. Whether other trademark laws discriminate based on viewpoint is beyond the scope of this Article.

201. 15 U.S.C. § 1125(e)(2).

202. 15 U.S.C. § 1125(e)(3)(A)–(B). *See also* *Louis Vuitton Malletier, S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 267 (4th Cir. 2007) (“[B]y making the famous mark an object of the parody, a successful parody might actually enhance the mark’s distinctiveness by making it an icon. The brunt of the joke becomes yet more famous.”).

senior user's source-identifying mark to create an association, with the result that the protected word, name, symbol, or device now communicates two different meanings (two brands of products) rather than one meaning (only the product of the famous brand).²⁰³

The law prohibiting and punishing dilution by tarnishment is especially problematic from a free speech perspective. Allegations of tarnishment often involve use of the protected mark with goods or services that some people might find unsavory, including commercial products related to sex, drugs, or other potentially offensive subject matter.²⁰⁴ As noted by Justice Kennedy in *Tam*, “[a] law that can be directed against speech found offensive to some portion of the public can be turned against minority and dissenting views to the detriment of all.”²⁰⁵ Companies accused of dilution may be communicating minority or dissenting views when they use a phrase or symbol claimed as a famous mark by a more-established trademark owner. The junior user's mark tarnishes the senior user's mark by substituting a negative meaning for the positive meaning conveyed by that language or design protected as a mark. It is not clear what message Victor Moseley was trying to convey when he used the mark VICTOR'S SECRET for his shop selling sex toys and other sex-related products, but this non-confusing message was not consistent with Victoria's Secret brand image and was suppressed because it was likely to tarnish the famous VICTORIA'S SECRET mark.²⁰⁶

203. *Visa Intern. Serv. Ass'n v. JSL Corp.*, 610 F.3d 1088, 1092 (9th Cir. 2010) (explaining that “dilution always involves use of a mark by defendant that is ‘different’ from the plaintiff's use; the injury addressed by anti-dilution law in fact occurs when marks are placed in new and different contexts, thereby weakening the mark's ability to bring to mind the plaintiff's goods or services”).

204. *See, e.g., V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 388 (6th Cir. 2010) (stating the law may “create a kind of rebuttable presumption, or at least a very strong inference, that a new mark used to sell sex-related products is likely to tarnish a famous mark if there is a clear semantic association between the two,” and placing the burden to show the use is not tarnishing on the defendant); *Lorillard Tobacco Co. v. Cal. Imps., LLC*, 886 F. Supp. 2d 529, 537 (E.D. Va. 2012) (use of mark in connection with sale of synthetic marijuana); *PepsiCo, Inc. v. #1 Wholesale, LLC*, 84 U.S.P.Q.2d (BNA) 1040, 1044 (N.D. Ga. 2007) (use of PEPSI marks “on goods commonly associated with the concealment of illicit narcotics”).

205. *Matal v. Tam*, 137 S. Ct. 1744, 1768–69 (2017) (Kennedy, J., concurring).

206. *See V Secret Catalogue*, 605 F.3d at 384–88 & n.4; *id.* at 389 (“We agree that the tarnishing effect of the Moseley's mark on the senior mark is somewhat speculative, but we have no evidence to overcome the strong inference created by the case law, the Restatement, and Congressional dissatisfaction with the burden of proof used in this case in the Supreme Court. The new law seems designed to protect trademarks from any unfavorable sexual associations. Thus, any new mark with a lewd or offensive-to-some sexual association raises a strong inference of tarnishment.”).

Justice Alito noted in *Tam* that the Court’s “cases use the term ‘viewpoint’ discrimination in a broad sense,” and said that “[g]iving offense is a viewpoint.”²⁰⁷ Thus, the concept of viewpoint discrimination in the Court’s First Amendment cases should be broad enough to encompass laws targeting unauthorized uses of marks to convey different messages that tarnish or blur the brand message or ideas conveyed by a famous mark.

Advocates of trademark dilution laws may argue that they are viewpoint-neutral because the dilution statutes protect all marks that are sufficiently famous and distinctive, including racist marks and marks that celebrate certain racial groups. It is true that dilution laws protect famous marks regardless of their viewpoint. The problem with this argument, however, is that the focus should be on the message conveyed by the junior user’s mark, and whether it is different than the meaning communicated by the senior user’s famous mark, when courts evaluate whether dilution laws are viewpoint-neutral laws. Dilution law allows the government to suppress the junior user’s expression after it determines that this message is inconsistent with the brand message conveyed by the senior user’s mark. Thus dilution law targets speech based on its viewpoint or ideas even though the law protects all marks that are famous and distinctive from dilution.

c. What Government Interests Are Asserted to Justify This Law, and Are They Substantial or Compelling?

If courts apply the *Central Hudson* intermediate scrutiny test in trademark disputes, they must determine whether the goal(s) justifying a specific trademark law are substantial government interests.²⁰⁸ The Court does not always defer to the legislature on this issue,²⁰⁹ and thus it may be helpful to review past cases where the Court found the government interest to be substantial and consider if the asserted purpose of the trademark provision is similarly important. For example, the Court determined there was a substantial government interest in “preventing the use of tobacco products by minors.”²¹⁰ In addition, it deemed “(1) reducing the social costs associated with ‘gambling’ or ‘casino gambling,’ and

207. *Tam*, 137 S. Ct. at 1763 (Alito, J.) (plurality opinion) (citing *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 831 (1995)).

208. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n N.Y.C.*, 447 U.S. 557, 563–66 (1980).

209. See CHEMERINSKY, *supra* note 14, at 1144–69 (discussing examples of the government’s justifications for restricting commercial speech and the Court’s evaluation of whether these goals are substantial government interests).

210. *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 555–56, 564–65 (2001).

(2) assisting States that ‘restrict gambling’ or ‘prohibit casino gambling’ within their own borders” to be substantial government interests.²¹¹ On the other hand, the Court has determined that there is not a substantial interest in facilitating state efforts to regulate disclosures relating to alcohol content,²¹² shielding “recipients of mail from materials that they are likely to find offensive,”²¹³ or “preventing speech expressing ideas that offend.”²¹⁴

If courts decide to apply strict or heightened scrutiny to a trademark provision, either because it regulates noncommercial expression or discriminates based on viewpoint, they will need to confirm that the government has a compelling interest in regulating this expression.²¹⁵ Examples of interests found by the Court to be compelling include “‘protecting the integrity of the judiciary’ and ‘maintaining the public’s confidence in an impartial judiciary.’”²¹⁶ The Court also said combating corruption and the appearance of corruption in politics might be compelling state interests.²¹⁷ On the other hand, it concluded that “leveling the playing field” in terms of candidate resources was not a compelling interest,²¹⁸ nor was an objective of shielding children from sexual content and indecent speech in the home.²¹⁹ Other goals the Court determined were not compelling include preventing “the corrosive

211. *Greater New Orleans Broad. Ass’n v. United States*, 527 U.S. 173, 176, 185–86 (1999).

212. *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 485–86 (1995).

213. *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 70–71 (1983).

214. *Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017) (Alito, J.) (plurality opinion).

215. *Reed v. Town of Gilbert*, 576 U.S. ___, 135 S. Ct. 2218, 2231 (2015); *Brown v. Entm’t Merchs. Ass’n* 564 U.S. 786, 790–91, 799 (2011). The Court has recently used the term “heightened review” or “heightened scrutiny” rather than “strict scrutiny” to describe a level of constitutional scrutiny in cases involving content-based regulations of speech, but it has not clarified how strong the government interest must be when evaluating the constitutionality of a law under that test. *See, e.g., Golan v. Holder*, 565 U.S. 302, 319–20 (2012); *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011). *See also Tam*, 137 S. Ct. at 1767 (Kennedy, J., concurring) (“The viewpoint based discrimination at issue here necessarily invokes heightened scrutiny.”).

216. *Williams-Yulee v. Fla. Bar*, 135 S. Ct. 1656, 1666–68 (2015) (holding that a law prohibiting judges and judicial candidates from personally soliciting funds for their campaigns satisfied strict scrutiny analysis) (quoting *Fla. Bar v. Williams-Yulee*, 138 So. 3d 379, 385 (Fla. 2014)).

217. *Ariz. Free Enter. Club’s Freedom Club PAC v. Bennett*, 564 U.S. 721, 750–51, 753–54 (2011) (holding a statute that allowed publicly funded candidates for state office to receive the same amount of funds as privately financed candidates was unduly burdensome on expression and did not survive strict scrutiny).

218. *Id.* at 748–50.

219. *United States v. Playboy Entm’t Grp., Inc.*, 529 U.S. 803, 806–07, 813–14 (2000) (holding that a statute requiring cable companies to fully scramble sexually-oriented programming or limit their transmissions to hours when children were unlikely to be viewing was an overbroad regulation and was invalid under the First Amendment).

and distorting effects of immense aggregations of wealth that are accumulated with the help of the corporate form and that have little or no correlation to the public's support for the corporation's political ideas" and protecting dissenting shareholders from these harms.²²⁰

Anyone evaluating the constitutionality of a trademark law should first consider whether the trademark statute identifies government interests that might be asserted to justify a specific regulation of expression. Section 45 of the Lanham Act explicitly sets forth the intent of Congress with regard to the federal trademark laws:

The intent of this chapter is to regulate commerce within the control of Congress by [1] making actionable the deceptive and misleading use of marks in such commerce; [2] to protect registered marks used in such commerce from interference by State, or territorial legislation; [3] to protect persons engaged in such commerce against unfair competition; [4] to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and [5] to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.²²¹

In *Tam*, the Court discussed some of these goals of the federal trademark law. With regard to the purpose of protecting persons against unfair competition (which is similar to promoting fair competition), the Court explained: "This system of federal registration helps to ensure that trademarks are fully protected and supports the free flow of commerce. '[N]ational protection of trademarks is desirable,' we have explained, 'because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.'"²²² The goals of making deceptive and misleading uses of marks actionable, and preventing fraud and deception by use of registered marks, were referenced by Jus-

220. *Citizens United v. FEC*, 558 U.S. 310, 318–19, 348–50, 361–62 (2010) (finding a federal law violated the First Amendment when it prohibited corporations and unions from using their general treasury funds to make independent expenditures for speech expressly advocating the election or defeat of a candidate).

221. 15 U.S.C. § 1127 (2012).

222. *Matal v. Tam*, 137 S. Ct. 1744, 1752 (2017) (quoting *S. F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 531 (1987) and citing *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U. S. 189, 198 (1985) ("The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.")).

tice Kennedy in his concurring opinion when he said it is “well settled” that the government can regulate uses of trademarks that are “confusing or misleading” to “protect consumers and trademark owners.”²²³

One trademark goal discussed frequently in the Court’s decisions—including *Tam*—but not mentioned in the Congressional intent paragraph of Section 45 relates to the government’s interest in using trademark law to facilitate the communication of information about the source of goods or services.²²⁴ In *Tam*, the Court explained that:

“The principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan’s goods from those of others” A trademark “designate[s] the goods as the product of a particular trader” and “protect[s] his good will against the sale of another’s product as his” It helps consumers identify goods and services that they wish to purchase, as well as those they want to avoid.²²⁵

Justice Kennedy made a similar point in his concurring opinion in *Tam* when he stated that “[t]he central purpose of trademark registration is to facilitate source identification.”²²⁶

These intentions, principles, and purposes of trademark laws discussed in the Lanham Act and the Court’s opinions may be asserted to be substantial or compelling government interests when trademark laws are challenged under the First Amendment. This Article argues that three of these goals can be used to justify many trademark registration and enforcement laws, and should qualify

223. *Tam*, 137 S. Ct. at 1768 (Kennedy, J., concurring); see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767–68 (1992) (“The Lanham Act was intended to make ‘actionable the deceptive and misleading use of marks’ and ‘to protect persons engaged in . . . commerce against unfair competition.’”) (quoting 15 U.S.C. § 1127).

224. See, e.g., *Tam*, 137 S. Ct. 1751–52 (majority opinion); *id.* at 1768 (Kennedy, J., concurring); *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. ___, 135 S. Ct. 1293, 1299–1300 (2015); *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28–29 (2001) (explaining that the design or packaging of a product can serve to identify the product with its manufacturer or source); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212–13 (2000) (“Although the words and packaging can serve subsidiary functions . . . their predominant function remains source identification.”); *id.* at 213 (noting that “product design almost invariably serves purposes other than source identification”); *Qualitex, Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162–64 (1995) (explaining that colors can help identify and distinguish a specific brand of products and discussing the benefits of protecting a source-identifying mark).

225. *Tam*, 137 S. Ct. at 1751 (majority opinion) (first quoting *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. ___, 135 S. Ct. 1293, 1299 (2015); and then quoting *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918)).

226. *Id.* at 1768 (Kennedy, J., concurring).

as substantial (if not compelling) government interests. These trademark goals are: (1) preventing fraudulent, deceptive, or misleading uses of marks; (2) promoting fair competition; and (3) facilitating the communication of source-identifying information about goods or services.²²⁷ Both consumers and trademark owners benefit—and constitutionally-protected expression is less likely to be harmed—when trademark laws are designed to directly and materially advance these goals.

Trademark owners may argue that another goal of trademark law is protection of trademarks against misappropriation of the owner's investment in business goodwill and advertising symbolized by the mark.²²⁸ A property rights justification for trademark

227. Scholars have said some of these goals are fundamental values or are among the main purposes of trademark law. See, e.g., Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461, 463, 467, 470–71, 481–82, 496–99 (2005) (arguing that trademark law “aims to promote more competitive markets by improving the quality of information in those markets” and that reducing consumer search costs and encouraging goodwill investment are only “critical intermediate objectives of the trademark system”); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1695 (1999) (“We give protection to trademarks for one basic reason: to enable the public to identify easily a particular product from a particular source.”); Lunney, *supra* note 43, at 432 (protection of trademarks may be justified if it improves the flow of information about the source of goods or services); McGeveran & McKenna, *supra* note 43, at 254, 292 (arguing that “fair competition and effective communication” are fundamental values “which should lie at the heart of trademark law’s protection”). Whether other trademark goals discussed in the Congressional intent paragraph of Section 45 are substantial or compelling is beyond the scope of this Article.

228. MCCARTHY, *supra* note 13, at § 2:2 (stating that one goal of trademark law is to protect a property right in a trademark); *id.* at § 24:72 (explaining that dilution law treats trademarks as property); Dall. *Cowboys Cheerleaders, Inc. v. Pusycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (“Plaintiff’s trademark is in the nature of a property right.”); cf. *S. F. Arts & Athletics, Inc. v. U. S. Olympic Comm.*, 483 U.S. 522, 539 & 541 n.19 (1987) (stating that the Amateur Sports Act’s ban on unauthorized use of the Olympic marks was a reasonable way to protect the USOC’s “legitimate property right,” and it was reasonable for Congress to “determine that unauthorized uses, even if not confusing, nevertheless may harm the USOC by lessening the distinctiveness and thus the commercial value of the marks”); *id.* at 532 (when a word acquires value as a result of an entity’s efforts, that entity constitutionally may obtain a limited property right in the word); *id.* at 541 (“The mere fact that the SFAA claims an expressive, as opposed to a purely commercial, purpose does not give it a First Amendment right to ‘appropriat[e] to itself the harvest of those who have sown.’”) (quoting *Int’l News Serv. v. Associated Press*, 248 U.S. 215, 239–240 (1918)); *United States v. Alvarez*, 567 U.S. 709, 743–44 (2012) (Alito, J., dissenting) (“It is well recognized in trademark law that the proliferation of cheap imitations of luxury goods blurs the ‘signal given out by the purchasers of the originals.’ In much the same way, the proliferation of false claims about military awards blurs the signal given out by the actual awards by making them seem more common than they really are, and this diluting effect harms the military by hampering its efforts to foster morale and esprit de corps.” (internal citation omitted)). *S. F. Arts & Athletics* is the primary case cited in support of the constitutionality of trademark dilution law. Volokh, *supra* note 20, at 736–38 (discussing problems with the Court’s analysis and the fact it is inconsistent with *Cohen v. California*, 403 U.S. 15 (1971)).

laws—whether based on Lockean labor-desert, natural rights, or moral rights theories—generally treats brand value as protectable property and is focused on prohibiting free riding on that value, preserving the uniqueness of the mark, and protecting the trademark owner’s reputation.²²⁹ These trademark goals are used to justify dilution laws and other trademark laws that do not require proof of consumer confusion, unfair competition, or other actual harm in the marketplace for liability.²³⁰

The language about trademark laws in that case and *Alvarez* is dicta, and the cases can be distinguished because the goals and doctrines of trademark law are very different. For example, the Court said the Amateur Sports Act provides stronger protection than trademark law and explains why stronger protection of the word Olympics is so important in *S. F. Arts & Athletics*, 483 U.S. at 530–32. Moreover, the Court has recently increased First Amendment scrutiny of commercial speech regulations. Ramsey, *supra* note 16, at 390–95; Ramsey, *supra* note 34, at 1131–33. And the Court just held for the first time in *Tam* that a trademark law violated the First Amendment even if it only regulated commercial speech. See *supra* Part II. Thus, courts should evaluate the constitutionality of dilution laws and other content-based regulations of nonmisleading expression with an open mind after *Tam* if a free speech challenge is made to these trademark laws. Once the Justices are fully briefed on this issue, they may determine that trademark dilution laws are unconstitutional regulations of commercial expression protected by the First Amendment. See *infra* Part IV.A.

229. See, e.g., Jerre B. Swann & Theodore H. Davis, Jr., *Dilution, An Idea Whose Time Has Gone; Brand Equity as Protectable Property, the New/Old Paradigm*, 84 TRADEMARK REP. 267, 267–70, 282–99 (1994). For an argument that trademarks are property but do not give the owner a right to exclude on par with a fee simple in real estate, see Adam Mossoff, *Trademark as a Property Right* 14–15 (George Mason Law & Economics Research Paper Series No. 17–15, 2017), https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2941763 [<http://perma.cc/4BA6-QL8B>]. For a discussion and critique of Lockean labor-desert, natural rights, and moral rights theories of trademark law, see Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 560–74, 583–622 (2006); Mark A. Lemley & Mark P. McKenna, *Owning Mark(et)s*, 109 MICH. L. REV. 137, 181–84 (2010); Jeremy N. Sheff, *Marks, Morals, and Markets*, 65 STAN. L. REV. 761, 762–64, 768–74 (2013); Jeremy N. Sheff, *Veblen Brands*, 96 MINN. L. REV. 769, 819–21 (2012). For a discussion of the parallels between acquiring real property through adverse possession and acquiring rights to the exclusive use of trademarks, see generally Jake Linford, *Trademark Owner as Adverse Possessor*, 63 CASE W. RES. L. REV. 703 (2013). For a non-U.S. perspective, see Lionel Bently, *From Communication to Thing: Historical Aspects of the Conceptualisation of Trade Marks as Property*, in TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH 3 (Graeme B. Dinwoodie & Mark D. Janis eds., 2008).

230. See Rebecca Tushnet, *Stolen Valor and Stolen Luxury: Free Speech and Exclusivity*, in THE LUXURY ECONOMY AND INTELLECTUAL PROPERTY: CRITICAL REFLECTIONS 121, 130–43 (Haochen Sun, Barton Beebe & Madhavi Sunder eds., 2015) (noting that protection of an investment in brand value, prevention of free riding, and other property-based justifications for laws prohibiting trademark dilution and post-sale confusion that do not require proof of material consumer deception or other actual harm are unlikely to satisfy constitutional scrutiny); Denicola, *supra* note 43, at 194 (“In view of the uncertain economic underpinnings of the misappropriation and dilution rationales, however, the ‘substantialness’ of this regulatory interest might well be questioned when the use causes no deception. Such a judgment must surely depend in part upon the extent to which speech interests are in fact being sacrificed to attain the desired end.” (footnote omitted)); Kenneth L. Port, *The Commodification of Trademarks: Some Final Thoughts on Trademark Dilution*,

In *Tam*, the Court notes that trademark law protects a trademark owner's "good will [sic] against the sale of another's product as his," "secur[es] to the producer the benefits of good reputation," and "secure[s] to the owner of the mark the goodwill of his business."²³¹ Yet it is not clear, however, whether these quotes set forth the purpose of dilution laws,²³² or if they simply describe the result of any type of trademark protection. Trademark infringement laws protect a trademark owner's goodwill and reputation when they prohibit passing off and other confusing uses of trademarks.²³³

46 HOFSTRA L. REV. 669, 669–70, 675 (2017) (arguing the dilution statute creates property rights in trademarks but courts usually do not recognize such a right).

231. *Matal v. Tam*, 137 S. Ct. 1744, 1751–52 (2017).

232. 15 U.S.C. § 1125(c) (2012). For example, Hugh Hansen says this language shows the Court is "supportive of trademark law" and that the purpose of dilution law is to protect the goodwill of the mark owner. It protects against the "whittling away" of a mark's goodwill by unauthorized users. It also protects against increased consumer search costs. Tarnishment protects the goodwill of a product's mark by preventing it from being associated when there is no likelihood of confusion with inferior or undesirable products. And finally, it is highly unlikely that a court will feel comfortable eliminating state dilution laws that are over 65 years old or federal laws, whatever the reason.

Hugh Hansen, *Symposium: Most Important Free Speech Case in Many Years*, SCOTUSBLOG (June 22, 2017, 11:52 AM), <http://www.scotusblog.com/2017/06/symposium-important-free-speech-case-many-years/> [<http://perma.cc/2PFV-AJ7V>]. With regard to Hansen's last point about courts feeling uncomfortable overturning laws that are over 65 years old, the disparagement clause was added to the federal trademark law in 1946, Trademark Act of 1946, Pub. L. No. 79–489, § 2(a), 60 Stat. 724, 725, and the Court had no problem finding it invalid in *Tam*. See *supra* Part II.E. And after *Tam*, the Federal Circuit held the immoral and scandalous mark provision in Section 2(a) was an invalid regulation of expression, *In re Brunetti*, 877 F.3d 1330, 1357 (Fed. Cir. 2017), *petition for cert. filed*, 87 U.S.L.W. 3134 (U.S. Sept. 7, 2018) (No. 18-302), despite the fact this law enacted in 1905 was more than 100 years old. Trademark Act of 1905, § 5, 33 Stat. 724, 725.

233. 15 U.S.C. §§ 1114(1), 1125(a)(1)(A); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992) (discussing how protection of trade dress under Section 43(a) of the Lanham Act serves these goals); *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) (In an infringement action, the Court held that allowing merely descriptive marks to obtain incontestable status "promotes the goals of the statute. The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers. . . . National protection of trademarks is desirable, Congress concluded, because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation."); Lunny, *supra* note 43, at 431 n.244 (noting protection of goodwill and encouragement of quality are effects, not purposes, of deception-based trademark protection). Infringement of a mark dilutes the value of the mark. See *United States v. Alvarez*, 567 U.S. 709, 735 (2012) (Breyer, J., concurring) ("Trademarks identify the source of a good; and infringement causes harm by causing confusion among potential consumers (about the source) and thereby diluting the value of the mark to its owner, to consumers, and to the economy. . . . [T]rademark statutes are focused upon commercial and promotional activities that are likely to dilute the value of a mark. Indeed, they typically require a showing of likely confusion, a showing that tends to ensure that the feared harm will in fact take place.").

Thus, the fact that trademark laws protect a company's investment in business goodwill and its brand image does not decide the issue of whether protection of property rights in language claimed as a mark should itself be one of trademark law's goals or qualify as a substantial government interest in the trademark context. It should not.²³⁴

One reason is that trademarks—the thing alleged to be “property”—contain expression protected by the First Amendment. Trademarks are different than real or personal property such as land, a house, or a car. A car can be used in certain ways that communicate a message (*e.g.*, a luxury car may convey a message about the wealth of the owner), but this tangible thing protected as property is quite different than words such as JEEP CHEROKEE or INFINITI which are protected as trademarks. Trademarks are nonrivalrous and intangible things. More than one person or company can use a word claimed by another as a mark at the same time (DELTA airlines and DELTA faucets are examples) but you cannot drive your car once a thief has stolen it. When laws prohibit trespassing on private land, breaking and entering, or stealing personal property (such as your car or American flag in front of your house), these laws do not protect property rights in expression—they protect property rights in tangible things that you own regardless of whether the property conveys a message. There is a big difference between using language claimed by another as a mark in expression and walking out of someone's home or a store carrying stolen goods in your backpack or physically destroying or stealing the trademark owner's sign displaying its mark in front of the store.

234. Tushnet, *supra* note 230, at 130–43; Denicola, *supra* note 43, at 165, 194; Port, *supra* note 230, at 669–74; *cf.* *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 34–35 (2001) (“The Lanham Act . . . does not protect trade dress in a functional design simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller.”); *id.* at 29 (“Trade dress protection must subsist with the recognition that in many instances there is no prohibition against copying goods and products. In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying [C]opying is not always discouraged or disfavored by the laws which preserve our competitive economy.”). Another example is Irina Manta's argument that trademark laws provide hedonic experiences to consumers and—“through the creation of status [or luxury] goods—incentivize socially desirable behavior such as hard work and productivity that may increase overall economic welfare.” Irina Manta, *Branded*, 69 S.M.U. L. REV. 713, 713 (2016); *see also generally* Irina Manta, *Hedonic Trademarks*, 74 OHIO ST. L.J. 241 (2013). Regardless of whether trademark laws do these things, it does not follow that providing hedonic experiences or incentivizing hard work should be goals of trademark law or qualify as substantial government interests in the constitutional analysis of dilution law or other trademark laws.

Moreover, a property theory of trademark law protects the exclusive right to use language, designs, or product attributes as marks in connection with certain goods or services based on the money and effort spent to advertise and sell products under that brand.²³⁵ Protection of such an investment strikes at the heart of the First Amendment because it is equivalent to the government selling words, symbols, colors, and other product features that can be used to communicate in the marketplace to the highest bidder. This is similar to government auctions of the broadcast spectrum, except it is significantly more harmful to First Amendment values because trademark laws are not content-neutral speech regulations. While the immediate effect of our trademark laws is protection of limited property rights in distinctive marks, the ultimate aim of trademark law is not to protect property rights in marks or reward the trademark owner for its investment in goodwill and reputation symbolized by the mark.²³⁶ Thus, courts should not deem this goal to be a substantial government interest when they evaluate whether trademark laws are constitutional. Yet even if they do find this interest to be substantial, the trademark law must still satisfy the other factors in the constitutional analysis, as discussed next.

2. *Trademark Laws Regulating Nonmisleading Commercial Speech Must at Least Satisfy Intermediate Scrutiny Analysis.*

Under the Court's traditional First Amendment jurisprudence, restrictions of nonmisleading commercial speech are only constitutional under *Central Hudson* if the government can show (1) there is a "substantial" government interest in regulating this expression, (2) the law "directly advances" this interest, and (3) the law is "narrowly drawn" and "is not more extensive than is necessary to serve that interest."²³⁷ This test was recently applied

235. Cf. Laura A. Heymann, *Metabranding and Intermediation: A Response to Professor Fleischer*, 12 HARV. NEGOT. L. REV. 201, 218–19 (2007) ("A dilution action essentially argues . . . 'we have spent a lot of money and effort on telling consumers what they should think about our brand, and the defendant's activities have caused them to think something different.'").

236. See 15 U.S.C. § 1127 (2012) (discussing the intent of the Lanham Act, which does not include this goal). Cf. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) ("The immediate effect of our copyright law is to secure a fair return to an 'author's' creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good. 'The sole interest of the United States and the primary object in conferring the monopoly,' this Court has said, 'lie in the general benefits derived by the public from the labors of authors.'" (quoting *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932))).

237. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557,

by Justice Alito in his plurality opinion in *Tam*²³⁸ and by the Federal Circuit in *Brunetti*.²³⁹

In *Central Hudson* and subsequent cases applying intermediate scrutiny analysis, the Court has provided some guidance in how to apply the *Central Hudson* factors to a law regulating commercial speech. It has “said that ‘the last two steps of the *Central Hudson* analysis basically involve a consideration of the “fit” between the legislature’s ends and the means chosen to accomplish those ends.”²⁴⁰ “[T]he regulatory technique must be in proportion to [the government’s] interest” and “[t]he limitation on expression must be designed carefully to achieve [this] goal.”²⁴¹

A law does not directly advance a substantial interest of the government “if it provides only ineffective or remote support for the government’s purpose.”²⁴² The government has the burden to show that the challenged regulation advances its interests “in a direct and material way.”²⁴³ This burden “is not satisfied by mere speculation or conjecture; rather, a governmental body seeking to sustain a restriction on commercial speech must demonstrate that the harms it recites are real and that its restriction will in fact alleviate them to a material degree.”²⁴⁴

Moreover, the speech restriction must be “narrowly drawn,” which means “[t]he regulatory technique may extend only as far as the interest it serves.”²⁴⁵ Thus, “[t]he State cannot regulate speech that poses no danger to the asserted state interest, . . . nor can it completely suppress information when narrower restrictions on expression would serve its interest as well.”²⁴⁶ Later in *Fox* the Court clarified that the government need not show this commer-

565–66 (1980).

238. *Matal v. Tam*, 137 S. Ct. 1744, 1764 (Alito, J.) (plurality opinion).

239. *In re Brunetti*, 877 F.3d 1330, 1349–50 (Fed. Cir. 2017), *petition for cert. filed*, 87 U.S.L.W. 3134 (U.S. Sept. 7, 2018) (No. 18-302) (declining to decide whether the immoral and scandalous mark provision in 15 U.S.C. § 1052(a) discriminates based on viewpoint, which would require heightened scrutiny, and holding the law was “unconstitutional even if treated as a regulation of purely commercial speech reviewed according to the intermediate scrutiny framework established in *Central Hudson*”).

240. *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 486 (1995) (quoting *Posadas de Puerto Rico Assocs. v. Tourism Co. of Puerto Rico*, 478 U.S. 328, 341 (1986)); *see also Sorrell v. IMS Health Inc.*, 564 U.S. 552, 572 (2011).

241. *Cent. Hudson*, 447 U.S. at 564.

242. *Id.*

243. *Edenfield v. Fane*, 507 U.S. 761, 767 (1993).

244. *Id.* at 770–71.

245. *Cent. Hudson*, 447 U.S. at 564.

246. *Id.* at 565.

cial regulation is the least restrictive means for serving the government's goal.²⁴⁷ Still, as explained by Justice Alito in *Tam*, a law is not narrowly drawn when it “goes much further than is necessary to serve the interest asserted” and is “too broad” in its application.²⁴⁸ Part IV applies *Central Hudson's* intermediate scrutiny analysis to two different types of trademark laws to provide an example of how to evaluate free speech challenges to trademark laws regulating nonmisleading commercial speech after *Tam*.

3. *Trademark Laws Regulating Noncommercial Speech or Discriminating Based on Viewpoint Must Satisfy Strict or Heightened Scrutiny Analysis.*

If the trademark law applies to noncommercial speech because of its content or to any type of expression based on its viewpoint or ideas, then it should be subject to strict or heightened scrutiny analysis after *Tam*.²⁴⁹ As noted previously, such laws are presumptively invalid.²⁵⁰ Under the Court's current First Amendment jurisprudence, these trademark laws can only withstand strict scrutiny review if the government can prove that the law furthers a compelling interest and is narrowly tailored to achieve that interest.²⁵¹ If the trademark law can be designed to serve that interest in a less speech-restrictive way, the government must use that alternative.²⁵² The government “must specifically identify an ‘actual problem’ in need of solving, . . . and the curtailment of free speech must be actually necessary to the solution.”²⁵³ As trademark dilution laws regulate expression based on its viewpoint or ideas, they should be subject to strict or heightened constitutional scrutiny. This will be fatal since these laws cannot satisfy *Central*

247. *Bd. of Trs. of the State Univ. of N.Y. v. Fox*, 492 U.S. 469, 476–81 (1989).

248. *Matal v. Tam*, 137 S. Ct. 1744, 1764–65 (2017) (Alito, J.) (plurality opinion).

249. *Id.* at 1767 (Kennedy, J., concurring); *In re Brunetti*, 877 F.3d 1330, 1342, 1349 (Fed. Cir. 2017), *petition for cert. filed*, 87 U.S.L.W. 3134 (U.S. Sept. 7, 2018) (No. 18-302); *Brown v. Entm't Merchs. Ass'n*, 564 U.S. 786, 799 (2011) (holding that a law that “imposes a restriction on the content of protected speech” is invalid unless the government “can demonstrate that it passes strict scrutiny”).

250. *Reed v. Town of Gilbert*, 576 U.S. ___, 135 S. Ct. 2218, 2231 (2015); *R.A.V. v. City of St. Paul*, 505 U.S. 377, 382 (1992); *In re Brunetti*, 877 F.3d at 1342.

251. *Reed*, 135 S. Ct. at 2231; *In re Brunetti*, 877 F.3d at 1342.

252. *United States v. Playboy Entm't Grp., Inc.*, 529 U.S. 803, 813 (2000); *In re Brunetti*, 877 F.3d at 1342.

253. *Brown*, 564 U.S. at 799 (quoting *Playboy*, 529 U.S. at 822–23). This “is a demanding standard.” *Id.*

Hudson's intermediate scrutiny test, as discussed next.

IV. EXAMPLES OF FIRST AMENDMENT ANALYSIS OF TRADEMARK LAWS AFTER *MATAL V. TAM*

Although *Tam* and *Brunetti* held that trademark laws banning registration of offensive language conflict with the First Amendment,²⁵⁴ commentators may argue that U.S. trademark laws are still generally consistent with the free speech right.²⁵⁵ Most are, but some are not. After *Tam*, dilution laws are probably unconstitutional.²⁵⁶ Moreover, we should consider the constitutionality of trademark laws allowing the government to register and protect certain marks containing inherently valuable expression.

A. *Dilution Laws*

Anyone evaluating the constitutionality of dilution laws must first determine what trademark purposes are asserted to justify this regulation. These government interests should be compelling since dilution laws suppress expression based on its viewpoint or ideas. Dilution laws must also be narrowly tailored or necessary to solve actual problems caused by the unauthorized use of marks which create an association with a famous mark. At a minimum, dilution laws must directly and materially advance a substantial

254. *Tam*, 137 S. Ct. at 1751; *In re Brunetti*, 877 F.3d at 1335.

255. See, e.g., Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 COLUM. J. L. & ARTS 187, 188–89, 191–201 (2004).

256. See, e.g., Davis & Welch, *supra* note 56, at 3–4 (noting that the dilution by tarnishment provision could be unconstitutional after *Tam*); Port, *supra* note 302, at 669, 675, 678–80, 705–06 (arguing dilution law is unconstitutional and discussing several problems with dilution law); Christine Farley, *Symposium: Free Speech Comes to Trademark Law*, SCOTUSBLOG (June 20, 2017, 2:25 PM), <http://www.scotusblog.com/2017/06/symposium-free-speech-comes-trademark-law/> [<http://perma.cc/6Q3F-KSQQ>]; Ramsey, *The First Amendment Protects Offensive Trademarks*, *supra* note 56; Ramsey, *Symposium*, *supra* note 56; Rebecca Tushnet, *Slightly Cooler Take on Tam*, 43(B)LOG (June 21, 2017), <http://tushnet.blogspot.com/2017/06/slightly-cooler-take-on-tam.html> [<http://perma.cc/56AG-W7B5>]; see also Note, *First Amendment—Freedom of Speech—Trademarks—Matal v. Tam*, 131 HARV L. REV. 243, 252 (2017) (noting *Tam* casts doubt on the dilution by tarnishment provision). *But see*, e.g., Hansen, *supra* note 232 (arguing the *Tam* decision does not threaten dilution law); Irina Manta, *Symposium: The Cacophony of Trademarks is Not Government Speech*, SCOTUSBLOG (June 20, 2017, 5:06 PM) <http://www.scotusblog.com/2017/06/symposium-cacophony-trademarks-not-government-speech/> [<http://perma.cc/R7EK-H8G8>] (same). As noted previously, several commentators argued that dilution law was unconstitutional before *Tam*. See *supra* note 32.

government interest under the *Central Hudson* test and be narrowly drawn to not harm expression more than necessary.

Preventing fraudulent, deceptive, or misleading uses of trademarks is a substantial (and compelling) government interest, but dilution laws apply even where there is no “actual or likely confusion.”²⁵⁷ Thus this purpose of the Lanham Act cannot be used to justify the law. Dilution laws may prevent unfair competition in some circumstances. Yet these speech regulations are not narrowly drawn to further this substantial government interest, as they apply in situations where the parties are not competitors and there is no unfair diversion of trade, passing off, or other harm to competition.²⁵⁸ Facilitating the communication of source-identifying product information is another important goal of trademark law, but dilution law does not directly or materially advance this interest. Even if the defendant’s non-confusing use of an identical or similar mark (*e.g.*, VICTOR’S SECRET) makes the famous mark less unique or harms the reputation of the famous mark (*e.g.*, VICTORIA’S SECRET), the famous mark still provides information about the source of the senior user’s products after the defendant’s diluting message regardless of whether consumers must think for a moment to determine which brand is identified by that mark.²⁵⁹

257. 15 U.S.C. § 1125(c)(1) (2012). *See, e.g.*, LaFrance, *supra* note 32, at 716 (noting dilution law regulates nonmisleading expression).

258. 15 U.S.C. § 1125(c)(1) (stating that dilution law applies regardless “of competition”). *See, e.g.*, Christine Haight Farley, *Why We Are Confused About the Trademark Dilution Law*, 16 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 1175, 1183–86 (2006) (noting that some trademark advocates suggest that dilution law “is really about preventing the unfair advantage that results from the non-confusing use of a famous mark” and therefore this law really serves as an expanded unfair competition law without strict boundaries).

259. LaFrance, *supra* note 32, at 720–21; Tushnet, *Gone in Sixty Milliseconds*, *supra* note 32, at 527–45; *cf.* Sorrell v. IMS Health Inc., 564 U.S. 552, 572–74, 577 (2011) (holding that the statute prohibiting pharmaceutical companies from using prescriber-identifying information for marketing purposes was unconstitutional because it “does not advance in a permissible way” the government interests of medical privacy and other health-related benefits); Lorillard Tobacco Co. v. Reilly, 533 U.S. 525, 555–56, 557–61 (2001) (holding law prohibiting smokeless tobacco or cigar advertising within 1,000 feet of schools satisfied the third factor of the *Central Hudson* test due to ample evidence). Protection of famous trademarks such as TIFFANY’S against dilution may reduce consumer search costs, as the junior user’s mark may force consumers to “think harder—incur as it were a higher imagination cost—to recognize the name as the name of the [senior user’s] store.” Ty Inc. v. Perryman, 306 F.3d 509, 511 (7th Cir. 2002). Regardless of whether this is true, reducing consumer search costs should not qualify as a substantial government interest in the trademark context. Not only is this goal not included in the Congressional intent language in the Lanham

As discussed in Part III, protection of property rights in an investment in trademark goodwill is not a substantial government interest.²⁶⁰ Yet even if courts think it is, the government and trademark advocates must prove dilution laws directly and materially further this trademark goal. There is not sufficient evidence that diluting uses of famous marks actually harm the distinctiveness, reputation, or fame of such marks (their trademark goodwill), or that dilution laws prevent any of these harms in a material way.²⁶¹ Moreover, the laws are under-inclusive because many noncommercial uses of marks could impair the mark's distinctiveness and harm its reputation but this expression is not prohibited by dilution laws.²⁶² The laws are also over-inclusive because some uses of

Act, but—unlike the trademark purpose of facilitating the communication of source-identifying product information—a focus on reducing consumer search costs in trademark law could significantly harm fair competition by new entrants to the market and may stifle the free flow of nonmisleading commercial expression. A full discussion of this issue is beyond the scope of this Article.

260. See *supra* Part III.F.1.c. See also LaFrance, *supra* note 32, at 718–22 (arguing that dilution laws are not supported by a substantial government interest).

261. See Tushnet, *supra* note 230, at 142; Barton Beebe, Roy Germano, Christopher Jon Sprigman & Joel H. Steckel, *Testing for Trademark Dilution in Court and in the Lab*, 86 U. CHI. L. REV. (forthcoming 2019) (November 2018 draft on file with the author); Paul J. Heald & Robert Brauneis, *The Myth of Buick Aspirin: An Empirical Study of Trademark Dilution by Product and Trade Names*, 32 CARDOZO L. REV. 2533, 2561–62 (2011); Tushnet, *Gone in Sixty Milliseconds*, *supra* note 32, at 528, 545 (criticizing dilution studies). Rebecca Tushnet argues that courts could protect speech interests in dilution law by requiring proof that the association impairs the distinctiveness of a famous mark, such as evidence of a change in consumer behavior. Tushnet, *supra* note 230, at 143. The Court has stated that evidence that is ambiguous, contingent, indirect, or remote is not sufficient to justify government regulations of protected expression. See *Brown v. Entm't Merchs. Ass'n*, 564 U.S. 786, 799–801 (2011) (discussing studies suggesting a link between violent video games and increased aggression in minors and holding that this “ambiguous” evidence of harm was not sufficient to regulate protected expression, where the evidence only provided proof of correlation rather than causation, had methodological flaws, and the harm was very small); *Ashcroft v. Free Speech Coal.*, 535 U.S. 234, 250, 253–54 (2002) (demanding more proof of link between images and actual instances of child abuse in case involving virtual child pornography, and finding the evidence presented by the government was “contingent and indirect” and established “no more than a remote connection between speech that might encourage thoughts or impulses and any resulting child abuse”); cf. *Herb Reed Enters., L.L.C. v. Fla. Ent. Mgmt., Inc.*, 736 F.3d 1239, 1250 (9th Cir. 2013) (finding arguments of irreparable harm “cursory and conclusory” and requiring specific evidence of harm). In the commercial speech context, speculation and conjecture are also not sufficient to prove that a speech regulation directly and materially advances the asserted government interest. *Edenfield v. Fane*, 507 U.S. 761, 770–71 (1993); see also *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 502–05 (1996) (plurality opinion) (discussing the lack of evidentiary support provided to demonstrate how the law would advance the government's interests).

262. 15 U.S.C. § 1125(e)(3)(C) (2012); Tushnet, *Gone in Sixty Milliseconds*, *supra* note 32, at 544–58 (discussing examples). See also *Williams-Yulee v. Fla. Bar*, 135 S. Ct. 1656, 1668 (2015) (explaining that where a speech restriction is under-inclusive, this may be reason to doubt “whether the government is in fact pursuing the interest it invokes, rather

another's mark that violate dilution laws due to an association between the two marks may not actually affect the distinctiveness or reputation of the mark.²⁶³ Thus the law is overbroad rather than narrowly drawn and regulates speech that poses no danger to the government interest asserted to justify dilution law.

Trademark dilution laws also fail the last factor of the *Central Hudson* test because they suppress too much commercial speech protected by the First Amendment. Dilution laws protect trademark rights in marks across industries. This is a substantially excessive restriction on nonmisleading expression in the marketplace. These broad trademark rights are especially problematic due to the fact that there is not "an inexhaustible supply of unclaimed trademarks that are at least as competitively effective as those already claimed."²⁶⁴ Dilution laws harm expression more than necessary because they do not take into account the free speech right of other companies to have a variety of language and product attributes available to choose from when selecting a mark or trade name.²⁶⁵ Any free speech right of a trademark owner to

than disfavoring a particular speaker or viewpoint"); *Reed v. Town of Gilbert*, 576 U.S. ___, 135 S. Ct. 2218, 2232 (2015) (discussing the problems with under-inclusive speech regulations); *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 412, 417–18 (1993) (finding under-inclusive speech regulations unconstitutional).

263. Arguably there was no actual harm to the reputation of the mark in *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 388 (6th Cir. 2010), nor was there impairment of the distinctiveness of the marks in *Visa Intern. Service Ass'n v. JSL Corp.*, 610 F.3d 1088 (9th Cir. 2010) (finding dilution of the VISA marks by use of the name EVISA and domain name eVisa.com for a multilingual education and information business); *Louis Vuitton Malletier v. Hyundai Motor Am.*, No. 10 Civ. 1611, 2012 WL 1022247 (S.D.N.Y. Mar. 22, 2012) (finding dilution by use of a logo similar to the Louis Vuitton logo displayed on a basketball for one second during Hyundai's "Luxury ad"); *Nike, Inc. v. Nikepal Int'l, Inc.*, No. 05 Civ. 1468, 2007 WL 2782030 (E.D. Cal. Sept. 18, 2007) (finding dilution of Nike's mark based on use of the mark NIKEPAL in connection with the distribution of glass syringes and other laboratory products); see Beebe, Germano, Sprigman & Steckel, *supra* note 261, at 9–11 (discussing the survey in the NIKEPAL case). See also *Greater New Orleans Broad. Ass'n v. United States*, 527 U.S. 173, 176, 185–89 (1999) (holding the law did not satisfy *Central Hudson* and was overly broad because it prohibited broadcast advertising regarding lotteries and casino gambling by private casinos located in states where gambling was legal).

264. Barton Beebe & Jeanne C. Fromer, *Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion*, 131 HARV. L. REV. 945, 948 (2018).

265. Cf. *Thompson v. W. States Med. Ctr.*, 535 U.S. 357, 367–74 (2002) (holding law prohibiting distributors of compounded drugs from advertising the drugs was more extensive than necessary to serve the government's substantial government interests of "preserv[ing] the effectiveness and integrity of the FDA's new drug approval process and the protection of the public health that it provides" and "preserv[ing] the availability of compounded drugs for those individual patients who, for particularized medical reasons, cannot use commercially available products that have been approved by the FDA").

control the coherence of its brand message should be weighed against the free speech right of many companies to adopt and use an identical or similar word, symbol, color, or other product feature as a mark for different goods or services.

Dilution laws have a substantial chilling effect on commercial expression because the laws are vague and create uncertainty about what expression is allowed or prohibited. There is no U.S. registry for “famous” marks to provide more predictability about what marks are protected against dilution, and registration of the mark on the principal trademark register is not even required for dilution protection. Moreover, the parties’ marks need not be identical and the goods or services can be dissimilar for a dilution claim. Dilution liability also does not require proof of actual economic harm or actual blurring or tarnishment. Likely dilution is sufficient.²⁶⁶ Thus it is difficult to determine when a mark is famous and whether a particular unauthorized use of this mark violates the dilution law.

The dilution statute does contain defenses for noncommercial uses of marks, news reporting and news commentary, and also for descriptive and nominative fair uses of marks otherwise than as a designation of source in commercial speech, including in comparative advertising, parody, criticism, and commentary.²⁶⁷ Yet these fair use defenses do not apply if the defendant wants to use identical or similar language or product features as a mark to sell different commercial products. An example is Haute Diggity Dog’s “Chewy Vuitton” dog toy parody of the Louis Vuitton mark. The defendant could not take advantage of the statutory parody defense because it was using “Chewy Vuitton” as a mark for dog toys.²⁶⁸ The defendant eventually prevailed because the court held this parody was not an infringing or diluting use of the mark, but only after spending time and money to defend its right to use this nonmisleading expression.²⁶⁹

Just like trademark examiner decisions applying the disparagement clause,²⁷⁰ court decisions applying the vague language in

266. 15 U.S.C. § 1125(e).

267. *Id.* § 1125(e)(3).

268. *Louis Vuitton Malletier, S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 267 (4th Cir. 2007).

269. *Id.*

270. *See supra* Part II.F.

dilution laws can be subjective and inconsistent. They can discourage protected commercial expression. Small businesses with limited financial resources are more likely to self-censor and not register or use certain words or symbols as marks once the owner of a famous mark—likely a large company who can afford the cost of trademark litigation—claims that use of its mark with dissimilar goods or services is likely to dilute that mark.²⁷¹ *Tam* clarifies that the chilling effect of a trademark law can implicate the First Amendment just like laws that prohibit and punish expression.²⁷² For the reasons set forth above, dilution laws cannot withstand intermediate constitutional scrutiny or strict scrutiny analysis. If federal and state legislatures do not acknowledge this fact and remove dilution laws from the trademark statutes, courts should conclude that these regulations of the content of protected expression are invalid under the First Amendment.

B. Trademark Registration and Protection of Inherently Valuable Expression

While *Tam* held that laws denying registration to disparaging terms can unconstitutionally chill the use of slurs as marks, this Article argues that trademark laws are also inconsistent with the First Amendment when the government *allows* the registration of certain words, names, symbols, or devices that were inherently valuable before that subject matter was adopted or used as a mark.²⁷³ The phrase “inherently valuable” is used in this Article to refer to expression that had intrinsic communicative value due to its contribution to the marketplace of ideas and information *before* it was used as a mark,²⁷⁴ and not that this non-source-identifying message is beneficial or high-value speech under the Court’s First Amendment jurisprudence.

271. See Levy, *supra* note 32, at 1202–03; McGeeveran, *Rethinking Trademark Fair Use*, *supra* note 43, at 64; James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 YALE L.J. 882, 891–92, 907–27 (2007); Leah Chan Grinvald, *Policing the Cease-And-Desist Letter*, 49 U.S.F. L. REV. 411, 427–37 (2015); Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 WIS. L. REV. 625, 639, 662–63; Rierson, *supra* note 43, at 302.

272. See *supra* Part II.B.

273. See Ramsey, *The First Amendment Protects Offensive Trademarks*, *supra* note 56; Ramsey, *Symposium*, *supra* note 56.

274. Ramsey, *supra* note 38, at 340 & n.18. Of course, the First Amendment can also be implicated when trademark laws regulate marks that have developed non-source-identifying meaning after they were adopted as marks, such as the “Barbie” mark. Dreyfuss, *Expressive Genericity*, *supra* note 43, at 402–08. The focus in this Article, however, is on a mark’s expressive value before it was adopted or used as a trademark.

Examples of inherently valuable expression claimed by companies, organizations, or individuals as trademarks (some of which are registered) include the descriptive term FAIR & BALANCED for the news reporting services of Fox News, the common phrase LIFE IS GOOD for clothing, and slogans associated with political or social movements such as “#METOO” for lipstick, perfume, wristbands, and legal services, and MAKE AMERICA GREAT AGAIN and BLACK LIVES MATTER for clothing, printed publications, and various other goods and services.²⁷⁵ Other examples include the informational slogan IF YOU SEE SOMETHING, SAY SOMETHING for promoting public awareness of public safety and security issues; the phrase I LOVE YOU for wine and perfume; and the iconic devil’s horn hand gesture (which also means “I love you” in American Sign Language) used by Gene Simmons—the front-man of the rock band Kiss—for his entertainment services.²⁷⁶

Other problematic assertions of trademark rights include Disney’s application to register the culturally-significant term DIO DE LOS MUERTOS for entertainment services (a film about the Day of the Dead holiday) and various types of merchandise, and a private company’s registration of the names of historic places such as YOSEMITE NATIONAL PARK and BADGER PASS (a ski resort in Yosemite) for clothing.²⁷⁷ Profanity such as FUCT for clothing and slurs such as THE SLANTS for entertainment services are

275. FAIR & BALANCED, Registration No. 2,213,427; LIFE IS GOOD, Registration No. 2,025,737; #METOO, U.S. Trademark Application Serial No. 87,653,745 (cosmetics and fragrances) (abandoned), U.S. Trademark Application Serial No. 87,699,756 (wristbands) (abandoned), U.S. Trademark Application Serial No. 87,705,568 (legal consultation services) (abandoned); MAKE AMERICA GREAT AGAIN, Registration No. 5,020,556; BLACK LIVES MATTER, U.S. Trademark Application Serial No. 87,659,312 (abandoned). For commentary on laws allowing registration and protection of descriptive terms and popular slogans, see generally Ramsey, *supra* note 34; Ramsey, *supra* note 35, at 249–63.

276. IF YOU SEE SOMETHING, SAY SOMETHING, Registration No. 3,217,091; I LOVE YOU, Registration No. 4979951 (wine), U.S. Trademark Application Serial No. 78,908,568 (fragrances) (abandoned); Eriq Gardner, *Gene Simmons Seeks to Register Trademark on Iconic Rock Hand Gesture*, HOLLYWOOD REP. (June 14, 2017), <https://www.hollywoodreporter.com/thr-esq/gene-simmons-seeks-register-trademark-iconic-rock-hand-gesture-1013378> [<http://perma.cc/B8PL-L94K>]; U.S. Trademark Application Serial No. 87,482,739 (“The mark consists of a hand gesture with the index and small fingers extended upward and the thumb extended perpendicular.”) (abandoned).

277. DIA DE LOS MUERTOS, U.S. Trademark Application Serial No. 85,920,880 (education and entertainment services) (abandoned), U.S. Trademark Application Serial No. 85,920,876 (toys, snow globes, and other merchandise); YOSEMITE NATIONAL PARK, Registration No. 2,715,307; BADGER PASS, Registration No. 3,731,325. For commentary on laws allowing registration and protection of culturally-significant words, symbols, or creative works and name of historic landmarks, see Ramsey, *supra* note 36, at 347; Rebecca S. Curtin, *Zombie Cinderella and the Undead Public Domain*, 86 TENN. L. REV. (forthcoming 2018); Justin Hughes, *Landmark Trademarks*, 52 WAKE FOREST L. REV. 1163 (2017); Martin R.F. Senftleben, *Public Domain Preservation in EU Trademark Law—A Model for*

additional examples of terms that communicated messages before they were adopted as marks.²⁷⁸ Features of products can also be inherently valuable before they were claimed as marks. An example is the color green used as a mark in connection with storage bags used to keep fruits and vegetables fresh,²⁷⁹ which can convey an environmentally-friendly message.²⁸⁰ Shapes representing natural objects can also be inherently valuable in the marketplace, including a bottle in the shape of a human skull registered by Globefill, Inc. as a mark for alcoholic beverages sold under the brand name Crystal Head Vodka.²⁸¹ Just like a sculpture or painting of a skull, skull-shaped packaging or products can communicate expression about death or be used to celebrate Halloween or the Day of the Dead.²⁸²

According to the Supreme Court, almost anything capable of carrying source-distinguishing meaning can serve as a trademark and communicate information about the source of goods or services.²⁸³ Descriptive words, common symbols, popular slogans, informational phrases, colors, product shapes, and other product features can usually only be registered in the United States if they have acquired distinctiveness through use, function as a mark, and are not functional or decorative, so current trademark laws protect fair competition and freedom of commercial expression to some degree.²⁸⁴ But registration is not required for protection, and common law trademark rights in such marks may be asserted in a demand letter or complaint alleging trademark violations and chill the expression of those who cannot afford to litigate a trademark dispute.

There are also other reasons these internal speech-protective

Other Regions?, 103 TRADEMARK REP. 775, 799–800 (2013) (proposing that governments categorically deny trademark protection to culturally significant artistic and literary works in the public domain).

278. *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017) (noting that “Slants” is a derogatory term for persons of Asian descent” and Tam’s band decided to take “this slur as the name of their group”); *In re Brunetti* 877 F.3d 1330, 1337 (Fed. Cir. 2017), *petition for cert. filed*, 87 U.S.L.W. 3134 (U.S. Sept. 7, 2018) (No. 18-302) (discussing evidence of prior use of the term “fuct” by the public before the applicant applied to register this term as a mark).

279. Evert-Fresh Corporation owns registrations for the color green and the phrase GREEN BAGS for plastic storage bags that preserve fruit, vegetables, and flowers. Registration Nos. 2,280,244; 2,359,179.

280. See Ramsey, *supra* note 38, at 339.

281. Registration No. 4,043,730.

282. Ramsey, *supra* note 38, at 338–39.

283. *Qualitex Co. v. Jacobson Prods., Co.*, 514 U.S. 159, 162 (1995).

284. See 15 U.S.C. §§ 1052(e)(5)–(f) (2012); see also Ramsey, *supra* note 38, at 346 (discussing the distinctiveness requirement); Alexandra Roberts, *Failure to Function*, 103 IOWA L. REV. (forthcoming 2018) (discussing how subject matter can fail to function as a mark).

safeguards are not sufficient to prevent trademark laws from chilling protected expression.²⁸⁵ After five years on the principal trademark register such marks can become immune from cancellation on the ground they lack distinctiveness. If certain requirements are satisfied, they can also become incontestable in litigation. This means that the accused infringer—including a company that entered the market six years after the mark was registered—cannot argue the descriptive term, color, product feature, or other non-inherently-distinctive mark is invalid because it never acquired distinctiveness.²⁸⁶ Registering trademark rights in inherently valuable subject matter is likely to discourage use of that language or product attribute by others even when the expression is not misleading, as neither infringement nor dilution laws require proof of actual confusion.²⁸⁷ When “truthful and nonmisleading expression will be snared along with fraudulent or deceptive commercial speech, the [government] must satisfy the remainder of the *Central Hudson* test by demonstrating that its restriction serves a substantial state interest and is designed in a reasonable way to accomplish that end.”²⁸⁸

Current trademark doctrines recognize that certain marks are weaker than others and that automatic protection of these marks does not further trademark law’s goals. For example, the *Abercrombie* test used to determine the distinctiveness of word marks provides that descriptive terms are only protected with proof of acquired distinctiveness, and are not as strong as fanciful and arbitrary marks.²⁸⁹ In addition, the *Seabrook* test used to determine the inherent distinctiveness of logos and product packaging designs requires proof of acquired distinctiveness for protection of common shapes and other subject matter that is not unique.²⁹⁰ Finally, in *Qualitex* and *Wal-Mart*, the Supreme Court

285. Ramsey, *supra* note 38, at 346–47, 348, 356–57 (discussing the limitations of the distinctiveness and non-functionality requirements); Ramsey, *supra* note 14, at 836–44; Ramsey, *supra* note 16, at 414–21; Ramsey, *supra* note 34, at 1159–69.

286. See 15 U.S.C. §§ 1064, 1065; *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U. S. 189, 191–94 (1985). For criticism of the doctrine of incontestability, see generally Rebecca Tushnet, *Fixing Incontestability: The Next Frontier?*, 23 B.U. J. SCI. & TECH. L. 434 (2017); Kenneth L. Port, *The Illegitimacy of Trademark Incontestability?*, 26 IND. L. REV. 519 (1993).

287. See Ramsey, *supra* note 38, at 354; Ramsey, *supra* note 14, at 832–45.

288. *Edenfield v. Fane*, 507 U.S. 761, 768 (1993); see also *McIntyre v. Ohio Elections Comm’n*, 514 U.S. 334, 351–53 (1995) (holding that Ohio statute prohibiting anonymous political or campaign literature was unconstitutional even though it applied to false or misleading statements because it also applied to nonmisleading expression).

289. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9–10 (2nd Cir. 1976).

290. *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977).

held that colors and product designs cannot be protected as trademarks without proof they have acquired distinctiveness.²⁹¹ Rather than encourage companies to spend money to acquire distinctiveness in descriptive terms, common shapes, colors, and product designs and get “dibs” on this inherently valuable expression, we should consider excluding some or all of these things from the types of subject matter eligible for trademark registration and protection. This is the approach used for generic terms, and it will likely do a better job promoting competition and facilitating the communication of source-identifying product information.²⁹²

When trademark laws allow registration and protection of inherently valuable expression, they enable trademark owners to free ride on the underlying non-source-identifying meaning of language, symbols, or product features used as marks for certain products while giving trademark owners the exclusive trademark right to stop competitors and others from doing exactly the same thing. It is not unreasonable to prefer strong trademark protection for your own marks but still want the ability to choose from a plethora of language, symbols, colors, and other product features when creating new products, packaging, store or website layouts, or marketing materials. Once a company claims trademark rights in a mark, trademark laws create an incentive to invest in advertising of the mark to ensure it is considered distinctive. They also encourage firms to police their marks through demand letters and trademark lawsuits to discourage arguments that third party use of the word, design, or product attribute shows the mark lacks distinctiveness or has been abandoned. A small business falsely accused of infringement or dilution may not be able to afford to litigate and obtain the benefit of trademark law’s speech-protective doctrines. It may instead self-censor its expression or pay money for using inherently valuable expression that should remain in the public domain free for use by all. This is a problem since the right to free speech in the United States includes the right to choose the vehicle of your expression.²⁹³

We can directly and materially advance the primary goals of

291. *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 163 (1995); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.* 529 U.S. 205, 212 (2000).

292. Ramsey, *supra* note 38, at 345, 358; *cf.* Ralph H. Folsom & Larry L. Teply, *Trademarked Generic Words*, 89 YALE L.J. 1323, 1330–40 (1980).

293. *See, e.g.*, *Cohen v. California*, 403 U.S. 15, 26 (1971); CHEMERINSKY, *supra* note 14, at 976–85, 1087, 1117–18; *see also* *Matal v. Tam*, 137 S. Ct. 1744, 1766 (2017) (Kennedy, J., concurring) (“The First Amendment’s viewpoint neutrality principle protects more than the right to identify with a particular side. It protects the right to create and present arguments for particular positions in particular ways, as the speaker chooses.”).

trademark law by encouraging the adoption and use of stronger inherently distinctive trademarks and protecting those marks from unfair competition and misleading use by others. Descriptive terms, colors, product shapes, and other features of a product are usually not as effective at identifying and distinguishing the source of products compared to arbitrary or fanciful words, logos, and product packaging.²⁹⁴ Thus, denying trademark registration and protection for certain expression that is inherently valuable will encourage the use of inherently distinctive marks that do a superior job communicating source-identifying information. It will also better protect fair competition because these pre-existing words, symbols, and product features will remain available for use by everyone unless this subject matter is protected by another intellectual property law. There is not a substantial government interest in dividing up all of the inherently valuable expression among existing brands or in granting a limited property right in these types of marks. The free speech right is better protected if trademark law does not create incentives to use such language or product attributes as trademarks and police these marks against others who use similar expression in the marketplace. The government can further trademark law's goals and make trademark laws more consistent with the First Amendment by refusing to register marks containing inherently valuable expression or only protecting narrow rights in such marks.²⁹⁵

At a minimum, Congress should amend the trademark statute and regulations to clarify that such marks only have a narrow scope of protection. Among other things, they should only allow registration and protection of inherently valuable expression upon substantial and strong proof of acquired distinctiveness through use. A majority of consumers surveyed should believe this language or product feature claimed as a mark primarily identifies the alleged trademark owner as the source of the goods or services and is not simply descriptive, informational, decorative, ornamental, or other non-source-identifying expression. Inherently valuable expression registered as a mark should never become immune from cancellation nor should it become incontestable in litigation.

294. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213 (2000) (noting that “product design almost invariably serves purposes other than source identification”); see also Ramsey, *supra* note 38, at 353 (product attributes); Ramsey, *supra* note 34, at 1156–59 (descriptive terms).

295. Ramsey, *supra* note 38, at 357–60; Ramsey, *supra* note 36, at 362–66; Ramsey, *supra* note 34, at 1169–70. Elsewhere I have argued that refusing to register descriptive terms and symbols would not violate the United States' international obligations under multi-lateral treaties and trade agreements regulating trademarks. Ramsey, *Free Speech and International Obligations to Protect Trademarks*, *supra* note 32, at 409, 417–20.

The challenger or accused infringer should always be able to show the mark has not acquired distinctiveness, especially if that company was not even open for business during the five years after the trademark owner obtained the registration. When the mark consists of words or designs that are descriptive, common, informational, or culturally-significant, or colors, representational shapes, and other pre-existing terms, symbols, or devices that were inherently valuable before they were claimed as marks, federal and state legislatures should require proof that unauthorized use of this mark is misleading and commercial for trademark liability. Dilution claims should not be allowed. In addition, the trademark statute will be more narrowly tailored to prevent unfair competition if it requires the parties' goods or services to be identical or closely related for a finding of infringement.

Expressive values and fair competition will also be better protected if the government adds more statutory defenses to the infringement statutes to exempt certain unauthorized uses of marks from liability where that expression is less likely to be fraudulent, deceptive, or misleading. If the government continues to register and protect subject matter that is inherently valuable, it must add a statutory defense for fair use of words, names, symbols, colors, representational shapes, and other matter which is informative, decorative, ornamental, or functional for the defendant's goods or services, or which conveys other inherently valuable non-source-identifying messages when used in commerce.²⁹⁶ It is also critical to add a fair use defense to the infringement statutes for comparative advertising, news reporting, consumer product reviews, teaching, scholarship, criticism, commentary, parody, satire, and other editorial, educational, literary, or artistic uses of trademarks.²⁹⁷ By including the phrase "fair use" in the statute, the legislature will give courts discretion to find against the defendant if this is necessary to further trademark law's goals of preventing misleading uses of marks or unfair competition.

296. Ramsey, *supra* note 38, at 360. As competition is not required for liability, subject matter claimed as a mark may not be informative, decorative, ornamental, or functional for the plaintiff's goods or services but it may be for different goods or services sold by the defendant accused of trademark violations.

297. See Ramsey, *supra* note 14, at 454–57; see generally Graeme Dinwoodie, *Developing Defenses in Trademark Law*, 13 LEWIS & CLARK L. REV. 99 (2009); McGeeveran, *The Trademark Fair Use Reform Act*, *supra* note 43. Current dilution law has some of these defenses but not all of them. 15 U.S.C. § 1125(c)(3) (2012). If Congress does not eliminate dilution from the trademark law then the statutory defenses proposed in this Article should also apply to dilution claims.

The statutory descriptive fair use defense²⁹⁸ and other internal speech-protective safeguards in the infringement statute are not sufficient to protect such expressive uses of marks.²⁹⁹ Some of these proposed statutory defenses exist in the common law,³⁰⁰ but putting them in the statute will increase clarity and predictability. It will make it easier for accused infringers to find out about the defense when they do not have an attorney. It may also make it easier for them to obtain a favorable settlement or prevail early in litigation on a motion to dismiss. Codifying these defenses could also help accused infringers convince private parties such as Amazon, Google, or Facebook that they do not need to remove expression which incorporates another's mark just because a trademark owner has complained about this unauthorized use of its mark.

In *Tam*, the Court explained that trademarks can convey messages unrelated to source identification, but the Court did not clarify whether there is a substantial or compelling government interest in granting exclusive trademark rights to language which intrinsically conveys a non-source-identifying message. This Article argues there is not. The Court did not distinguish between "catchy phrases" and other subject matter that conveyed non-source-identifying messages *before* they were used as marks (such as descriptive words, popular slogans, slurs, and profanity) and non-source-identifying messages created by the trademark owner or the public *after* that language was claimed as a mark. Examples include the word "Barbie" for toys and the distinctive logos of luxury brands, sports teams, and universities displayed on expressive merchandise.³⁰¹ The government should be wary of granting exclusive trademark rights to language and product features that conveyed information and other valuable messages before they were adopted or used as a mark. The fact that trademarks convey messages unrelated to source-identification should raise concerns about whether trademark laws granting exclusive rights in this

298. 15 U.S.C. § 1115(b)(4).

299. See *supra* note 285.

300. Comparative advertising is an example. See *Smith v. Chanel, Inc.*, 402 F.2d 562, 565–66 (9th Cir. 1968).

301. Trademark owners and their customers can both invest trademarks with new meanings unrelated to the source or quality of goods or services sold under that mark. See Deborah Gerhardt, *Trademarks as Entrepreneurial Change Agents for Legal Reform*, 95 N.C. L. REV. 1519 (2017); Deborah Gerhardt, *Social Media Amplify Consumer Investment in Trademarks*, 90 N.C. L. REV. 1491 (2012); Deborah Gerhardt, *Consumer Investment In Trademarks*, 88 N.C. L. REV. 427 (2010); Dreyfuss, *Expressive Genericity*, *supra* note 43, at 402–08. See also ORLY LOBEL, YOU DON'T OWN ME: HOW MATTEL V. MGA ENTERTAINMENT EXPOSED BARBIE'S DARK SIDE (2017) (providing a detailed history of the Barbie brand for toys and the value created in the mark by Mattel and the public).

expression violate the First Amendment. Like an injunction banning use of the phrase as a mark, registration of that language will stifle use of that expression by others.

V. CONCLUSION

After *Tam*, legislators, courts, and decision-makers at the USPTO must consider whether trademark laws are consistent with the First Amendment. It is important to closely examine the asserted purpose of the challenged trademark law and determine whether that goal is sufficiently important. At a minimum, the trademark law must directly and materially advance a substantial government interest and be narrowly drawn to harm expression no more than necessary. In trademark disputes involving nonmisleading or noncommercial expression, defendants accused of trademark violations should consider including a First Amendment defense in an answer filed in response to a trademark complaint or file a motion to dispose of the case on free speech grounds. The court can then choose to protect expressive values using trademark law's internal speech-protective safeguards or it can apply constitutional scrutiny to the law.

After *Tam*, courts cannot reject a free speech challenge to a trademark law on the ground that trademarks are not "speech." Nor can lower courts declare that trademark laws are categorically excluded from application of the Supreme Court's traditional First Amendment balancing tests. If this trademark dispute does not involve misleading commercial speech or the trademark law regulates expression based on its viewpoint or ideas, the court should consider whether the law survives intermediate or strict scrutiny analysis and find it invalid under the First Amendment if it fails that test.

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