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The Confusion Trap: Rethinking Parody in Trademark Law

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THE CONFUSION TRAP: RETHINKING PARODY IN TRADEMARK LAW

David A. Simon*

Abstract: This Article suggests using existing doctrinal levers in trademark law to accommodate parodies in a more balanced fashion. To reach this conclusion, this Article examines the parody doctrine in U.S. trademark law using two lenses. The first lens is trademark doctrine itself. Here I explore the various approaches courts use to resolve trademark disputes involving parody. The other lens is copyright law. Through this lens I examine how courts deciding trademark parody disputes employ the Supreme Court’s most recent decision on parody in copyright, *Campbell v. Acuff-Rose Music, Inc.* (1994). I also use this decision to examine the relationship between copyright and trademark parody claims. In other words, I ask the following question: how, if at all, are copyright and trademark claims related in parody cases?

Each perspective reveals something different. The first perspective shows that most courts resolve infringement claims by evaluating parody within some form of the likelihood of confusion test. It also shows that most courts assess dilution claims by analyzing parody as a form of noncommercial speech. The second perspective shows that copyright and trademark claims are related in a positive direction: if a parody case involves both copyright and trademark claims, courts always find for the defendant (no infringement) on both claims. Filtering the analysis through these two lens, I seek to sketch two revised parody tests—one for infringement and one for dilution. Both tests attempt to differentiate parody analyses from the traditional likelihood of confusion and dilution tests. These new approaches—which strengthen speech protections but do not create absolute defenses—account for the legitimate interests of both trademark owners and parodists.

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A parody [of a trademark] must convey two simultaneous—and contradictory—messages: that it is the original, but also that it is not the original and is instead a parody.¹

—The United States Court of Appeals for the Second Circuit

For the purposes of copyright law, the nub of the definitions, and the heart of any parodist's claim to quote from existing material, is the use of some

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1. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490, 494 (2d Cir. 1989).

*elements of a prior author's composition to create a new one that, at least in part, comments on that author's works.*²

—The Supreme Court of the United States

INTRODUCTION

This Article argues that the current parody doctrine in trademark law needs adjustment. Currently courts analyze parody claims, and often draw on copyright law to resolve trademark claims that involve parody. This has resulted in a distortion of trademark law when applied to parodies—in part because courts focus too much on an expanded notion of confusion, and in part because courts draw broadly, instead of narrowly, from copyright law's approach to parody. Nevertheless, the surgical procedure trademark law needs can be relatively painless. Some courts already use the tools to make the necessary nips and tucks.

Trademark law—indeed language itself—is responsible for at least part of the problem courts have confronted in the parody context. Comedian George Carlin recognized the force and confusion of language when he quipped, “I recently went to a new doctor and noticed he was located in something called the Professional Building. I felt better right away.”³ It is the underlying features of language that makes regulating trademark law difficult: words are powerful. They rouse emotions. They evoke memories. They move you.⁴ With so much human potential, it is no wonder that people sue each other over them. “South Butt,”⁵ “Mutant of Omaha,”⁶ “Chewy Vuitton,”⁷ “Richard Grasso”⁸: Each one of these phrases incited a lawsuit⁹—and in each one of these lawsuits the defendant claimed the use of the word(s) was

2. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580 (1994).

3. *George Carlin Quotes*, THINKEXIST.COM, http://thinkexist.com/quotes/george_carlin/ (last visited Aug. 10, 2013).

4. See, e.g., Jon Hanson & David Yosifon, *The Situation: An Introduction to the Situational Character, Critical Realism, Power Economics, and Deep Capture*, 152 U. PA. L. REV. 129 (2003).

5. *North Face Apparel Corp. v. Williams Pharmacy, Inc.*, No. 4:09-cv-02029, 2010 WL 546921 (E.D. Mo. Feb. 9, 2009) (order denying South Butt's motion to dismiss).

6. *Mutual of Omaha Ins. Co. v. Novak*, 648 F. Supp. 905 (D. Neb. 1986), *aff'd*, 836 F.2d 397 (8th Cir. 1987).

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

8. *New York Stock Exch., Inc. v. Gahary*, 196 F. Supp. 2d 401 (S.D.N.Y. 2002).

9. The trademarks over which the companies sued were (in the order listed above) “North Face,” “Mutual of Omaha,” “Louis Vuitton,” and the “New York Stock Exchange.”

protected as a “parody.” And so the nature of words and their meaning makes evaluating them difficult. Parodies are no exception.

The issue of what constitutes a parody in trademark law, and what legal effect that finding should have, has been confusing courts for decades. Before several recent attempts to tackle the issue of parody in trademark law,¹⁰ the last comprehensive attempt to do so occurred in a law review article nearly twenty years ago.¹¹ Then, in 1994, there seemed to be hope for clarity: the United States Supreme Court decided *Campbell v. Acuff-Rose Music, Inc.*¹² There, the Court held that a parodic use of a copyrighted work could qualify as a noninfringing fair use.¹³ Parody, the Court stated, was a form of comment or criticism that ridicules the original work by, for example, mimicking its style.¹⁴ It can be distinguished from satire, which does not target the original work but instead uses it as a vehicle to express some other (perhaps critical) message.¹⁵ The Court reasoned that parody had a greater claim to fair use than satire.¹⁶ Parodists require the original works to make their comment or criticism. Satirists, on the other hand, have a weaker claim because they are not commenting or criticizing directly the work they use. Immediately, lower courts and commentators sought to apply and criticize the *Campbell* decision both in copyright and trademark contexts.¹⁷

10. *E.g.*, Stacey Dogan & Mark Lemley, *Parody as Brand*, __STAN. L. REV. __ (forthcoming 2013) (arguing that trademark parodies that use a mark without adopting it as a brand are categorically not actionable, and then proposing using nominative fair use to evaluate parodies that adopt the parodied mark as a brand); *see also* Bruce P. Keller & Rebecca Tushnet, *Even More Parodic than the Real Thing: Parody Lawsuits Revisited*, 94 TRADEMARK REP. 979, 980 (2004).

11. Arlen W. Langvardt, *Protected Marks and Protected Speech: Establishing the First Amendment Boundaries in Trademark Parody Cases*, 36 VILL. L. REV. 1 (1991).

12. 510 U.S. 569 (1994).

13. *Id.* at 580–94. *See, e.g.*, Keller & Tushnet, *supra* note 10, at 980 (“One of *Campbell*’s most significant—and unsatisfying—effects has been to elevate parody as a favored form of literary or artistic comment and devalue satire.”); *id.* at 983 (noting that *Campbell* elevated transformative uses to a special status and included parody, but not satire, in that category).

14. *Campbell*, 510 U.S. at 580.

15. *Id.* at 581.

16. *Id.*

17. *See, e.g., infra* Part II (detailing how courts have cited and incorporated *Campbell* into their trademark analyses); 6 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:156 (4th ed. 2012); Gary Meyers, *Trademark Parody: Lessons from the Copyright Decision in Campbell v. Acuff-Rose Music, Inc.*, 59 LAW & CONTEMP. PROBS. 181, 204–10 (1996) (arguing that *Campbell*’s alteration of the fair use factors is instructive to trademark law, and parody should similarly alter the confusion factors in trademark law). *See also* Aaron F. Jaroff, Comment, *Big Boi, Barbie, Dr. Seuss, and the King: Expanding the Constitutional Protections for the Satirical Use of Famous Trademarks*, 57 AM. U. L. REV. 641 (2008) (explaining how concepts from *Campbell* have been incorporated into trademark law). The analogy between

In a previous article, I explained how lower courts have applied *Campbell*'s general holding—a parody is a use of the original work to ridicule, criticize, or comment on it—in the copyright context.¹⁸ What I left out, however, was a discussion of parody in trademark law. This omission was intentional: *Campbell* was a decision about copyright law, and its implications for trademark law are uncertain.

This Article explores the gap left in my previous article, using *Campbell* as a guide to examine the parody doctrine in trademark. It argues that *Campbell* provides a few insights into parody that trademark law should consider incorporating. At the same time, the decision illustrates some pertinent differences between copyright and trademark that suggest trademark law might need to clarify and expand its current approach to parody. By collecting and analyzing all trademark cases that cite *Campbell*, this Article presents evidence that courts treat trademark and copyright parody claims similarly. It then questions whether this is a wise legal choice. In the process, this Article argues the existing dichotomy between likelihood of confusion and trademark defenses need not be so rigid. Such an inflexible division misses the valuable role that presumptions can play in analyzing trademark infringement claims involving parody. By slightly adjusting trademark doctrine, presumptions (and the other approaches advocated in this Article) can simultaneously reduce the threat of frivolous lawsuits by trademark owners and ensure legitimate claims against an infringer proceeds without unnecessary hurdles. Thus, this Article argues that presumptions and slight doctrinal adjustments can help adjust trademark law doctrine to accommodate the legitimate interests of both parodists and trademark owners.

The analysis, then, requires a comparison of parody and copyright and trademark law. And this begins, of course, with the meaning of the term “parody” itself. This starting point reveals, as the epigrams that begin this Article demonstrate, that copyright and trademark define parody similarly: both focus on how the parody both draws on and differentiates itself from the original.

The next obvious point of comparison is the legal analysis each regime uses to apply parody to its existing legal framework. Here

copyright and trademark parody analyses had been made prior to *Campbell*. See, e.g., Robert J. Shaughnessy, Note, *Trademark Parody: A Fair Use and First Amendment Analysis*, 72 VA. L. REV. 1079 (1986) (arguing that copyright fair uses and parody are relevant to parody analysis in trademark law).

18. David A. Simon, *Reasonable Perception and Parody in Copyright Law*, 2010 UTAH L. REV. 779.

differences emerge. In copyright, the parody analysis occurs *after* the infringement analysis, as a defense. Parody in trademark law, by contrast, operates *during* the infringement analysis. It is not, as courts and commentators tell us, a real defense.¹⁹ Because parody comes into play during the infringement analysis, the legal inquiry focuses on trademark infringement's staple concept: likelihood of confusion. Thus, it seems natural for courts to ask whether consumers are likely to be confused about the source of the parody's product,²⁰ as infringement occurs when consumers are likely to be confused over a product's source.²¹ The analysis of confusion is factor based, with courts looking to several factors, such as the similarity of the marks and marketing channels, the distinctiveness of the senior user's mark, and the user's intent.²² Confusion, then, remains the watchword for parody analysis in trademark law.

Perhaps trademark law's focus on consumer confusion is unsurprising given that preventing confusion is one of its main functions. Yet it is

19. 6 MCCARTHY, *supra* note 17, § 31:153 (noting that parody "is not an affirmative defense to an infringement charge" but "[r]ather . . . a way of arguing that there will be no trademark infringement because there will be no likelihood of confusion.").

20. That said, the parody definition is not *just* a likelihood of confusion test. It has one further element that makes it similar to the definition of parody laid out in *Campbell*. The parodic mark must in some way associate itself with the original mark—it must use the original to show that it is not the original. Throughout this Article, I refer to the "likelihood of confusion" test as "confusion" or "infringement" for short hand. Thus, when I say "infringement" or "typical infringement" I do not mean to include dilution actions.

21. 15 U.S.C. § 1125(a)(1)(A) (2006) (creating a cause of action for false designation of origin that is "likely to cause confusion . . . mistake, or to deceive as to the affiliation, connection, or association . . . as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . ."); 4 MCCARTHY, *supra* note 17, § 23:1 ("Likelihood of confusion' is the basic test of both common-law trademark infringement and federal statutory trade mark infringement." (footnotes omitted)); 1 MCCARTHY, *supra* note 17, §§ 3:8–3:9 (explaining that trademark law originally required products to emanate from a "physical source or origin," but has evolved to mean that "consumers [expect] all goods with the same mark to come from a single, but anonymous or indistinguishable source . . .").

22. 4 MCCARTHY, *supra* note 17, § 23:19 (explaining the factors listed by the RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 20–23 (1995), which include "1. The degree of resemblance between the conflicting designations; 2. The similarity of the marketing methods and channels of distribution; 3. The characteristics of the prospective purchasers and the degree of care they exercise; 4. The degree of distinctiveness of the senior user's mark; 5. Where the goods or services are not competitive, the likelihood that prospective buyers would expect the senior user to expand into the field of the junior user; 6. Where the goods or services are sold in different territories, the extent to which the senior user's designation is known in the junior user's territory; 7. The intent of the junior user; and 8. Evidence of actual confusion."). See also GRAEME B. DINWOODIE & MARK D. JANIS, TRADEMARKS AND UNFAIR COMPETITION: LAW AND POLICY 470–71 fig. 7.1 (2004) (listing each circuit's approach to the factor analysis and showing courts use between six and thirteen factors to analyze likelihood of confusion).

precisely this emphasis on confusion that raises questions about the parody doctrine itself. Parody is supposed to be a doctrine that insulates expressive speech from overzealous trademark owners. If instead it is merely a restated confusion test, then parody protects only so much speech as trademark law traditionally allows. That is odd for at least two reasons. First, it is superfluous for a legal doctrine to exist without having some effect. For this reason, the presence and recognition of the doctrine suggests that it is doing some extra work that trademark law cannot alone handle. Second, parody is a recognized doctrine in copyright law. And here the effects of the doctrine are quite strong.²³ Copyright and trademark law often cover—and claims are frequently brought regarding—the same objects. As a result, we have reason to think that parody may operate similarly in both legal regimes.

Yet on these facts, it is unclear whether parody is superfluous in trademark, or whether parody in practice operates similarly (in terms of outcome) in copyright and trademark. Using *Campbell* as a copyright lens, this Article analyzes this issue. First, this Article asks how courts citing *Campbell* have applied the parody doctrine in trademark law. If the commentators' conception of trademark parody is correct, we should find that courts merely restate the confusion tests in their parody analysis of trademark claims. The cases show that this is only partially true. Although most courts rely on the confusion test, few apply it without considering the parodic nature of the defendant's mark; parody, in other words, frequently influences how courts apply the confusion test. Yet, despite the diversity of methods used to analyze parody, not all are equally desirable. Some, however, provide valuable insights into what a better standard for parody might look like. The most promising approach appears in *Rogers v. Grimaldi*,²⁴ in which the court held that titular parody of a trademark in an expressive work was entitled to a presumption of fairness.²⁵

Although the lessons from *Rogers* and the other parody cases help describe the doctrinal tests, they do nothing to explain the relationship between copyright and trademark claims involving parody. To examine this relationship within the context of parody, *Campbell* again proves a useful way in. By focusing on cases that cite *Campbell*, this Article examines how courts have treated copyright and trademark claims when they appear in the same dispute. These cases show that trademark and

23. See generally Simon, *supra* note 18.

24. 875 F.2d 994 (2d Cir. 1989).

25. *Id.* at 1004–05.

copyright claims are directly related. Of the fifteen cases involving copyright and trademark dilution claims, courts decided those claims identically 100% of the time. The same was true for all of the twenty-two cases involving copyright and trademark infringement claims. Put another way, in every case in which a court found copyright infringement, it also found trademark dilution and/or infringement. Likewise, in every case where the court found no copyright infringement existed, it also found that no trademark dilution or confusion existed. This provides evidence that copyright and trademark claims are related in parody cases.

Given this relationship, it seems likely that *Campbell*, its analysis, and its definition of parody are all shaping the way in which courts apply parody to trademark law. But should they be? *Campbell*, after all, was a copyright dispute—and copyright and trademark law are two different legal regimes calibrated to different sets of interests and goals. Their different features, both legal and normative, might make copyright and trademark law awkward bedfellows in the parody context. By analyzing some differences between copyright and trademark, we find the answer to the question above is both yes and no. The answer is yes because *Campbell* casts parody as a defense that protects expressive speech. The answer is no because *Campbell* is too narrow when applied to the infringement or dilution analyses in trademark law. This is particularly true in light of the expanding scope of trademark law and the noticeable dearth of trademark defenses. Thus, this Article proposes using *Campbell* to refine courts' approaches to parody in trademark law.

Drawing on all of the foregoing analysis, this Article proposes two new tests for parody in trademark law—one for infringement and one for dilution. For infringement, the proposed test presumes parodies are noninfringing. The plaintiff can rebut that presumption by showing that a direct competitor sells the parodic product, and the product competes directly with the plaintiff's goods or services. If the plaintiff succeeds, the court should evaluate the parody using a modified version of likelihood of confusion factors. In the dilution context, this Article proposes treating parody as "noncommercial," expanding the statutory exemption to dilution under the Lanham Act to cover uses that qualify as "as a mark." Each of these tests uses a definition of parody more expansive than the one laid out in *Campbell*. That is, "parody" includes satirical uses of trademarks.

This Article proceeds as follows. Part I sets the table for the subsequent discussion. It examines and evaluates how courts have

decided confusion and dilution questions when parody is involved. Although the discussion primarily focuses on published cases²⁶ that cite *Campbell*, it includes other cases as well. Next, Part II takes us in three interrelated directions. First, we evaluate how courts citing *Campbell* resolve trademark and copyright parody claims in the same case. Using *Campbell* as a lens, this Article then explores the differences between copyright and trademark law. Finally, we determine what aspects of *Campbell* should be incorporated into a parody trademark doctrine. With a broad framework for trademark parody in view, Part III suggests two new defenses for parody—one for infringement and one for dilution.

I. THE CURRENT PARODY DOCTRINE IN TRADEMARK LAW

Parody analysis in trademark law has nuances that it lacks in copyright law. In copyright, parody shades the borders of the fair use defense, usually coloring the inquiry with a hue of fairness. In trademark, though, the story is complicated by courts' analytical techniques: although some courts use parody as a defense to infringement, most use parody to shade the *infringement* analysis. In this Part, I taxonomize each analytical approach courts take when resolving a traditional infringement (confusion) or dilution claim involving parody. Most—but not all—of these cases I analyze cite *Campbell*, for reasons I mentioned earlier. At the same time, I analyze these approaches, asking questions about their ability to adequately protect speech interests and trademark owners' rights. From this analysis I develop suggestions for how courts should address parody in trademark infringement and dilution claims.

A. *Approaches to Trademark Infringement Actions Involving Parody*

It turns out that, once courts find that a parody exists, they employ a variety of methods to determine whether and how that finding bears on the issue of confusion. Taking a certain approach can be determinative of infringement. Thus, it matters a great deal how courts approach the application of the parody finding. We start with the six approaches in cases citing *Campbell*.²⁷ After this tour, we make two more stops, focusing on a few cases that did not cite *Campbell*.

26. "Published" here means reported in Westlaw's database.

27. The Appendix explains exactly how I obtained the trademark parody cases citing *Campbell*. For now it's sufficient to note that I included only decisions in the database Westlaw retrieved when retrieving cases "citing" *Campbell*. Thus, if Westlaw's database does not include all decisions citing *Campbell*, then my sample is not the entire universe of cases.

1. *Parody Approaches in Infringement Cases Citing Campbell v. Acuff-Rose*

Courts citing *Campbell* use six different approaches to analyzing infringement claims that involve parodies. One method is the Infusion Approach, which uses a parody finding to alter how courts apply the traditional likelihood of confusion factors. Parody, in this category, narrows the scope of the confusion analysis. Second, courts use a Balancing Test when parody is at issue. The third approach does not require courts to alter their analyses at all; rather, it requires courts to apply the standard likelihood of confusion analysis. Under the fourth approach, courts treat parody as a form of Nominative Fair Use. Fifth, courts use the Alternative Means Approach, which asks whether the defendant could have made her point without using the plaintiff's trademark. Finally, some courts use the Separate Digit Approach, which characterizes parody as separate factor in the likelihood of confusion analysis.

As Table 1 shows, the majority of courts (53%) use the Infusion Approach. The next most popular approach is a Balancing Test, with 23% of courts using this method. A standard Confusion Test came in third, with 8% of courts using it. The last 16% of cases used three methods: 8% use Nominative Fair Use; 4% use an Alternative Means Test; and another 4% use a test that analyzes parody as a Separate Digit in the confusion analysis.

TABLE 1. APPROACHES TO TRADEMARK PARODY IN
INFRINGEMENT CASES CITING *CAMPBELL V. ACUFF-ROSE*

Parody Approach	Times Used	%
Infusion	14	53%
Balancing/Rogers	6	23%
Confusion	2	8%
Nominative Fair Use	2*	8%
Alternative Means	1	4%
Separate Digit	1	4%
Total	26	100%

* One case, *Mattel v. Walking Mountain Productions*, also used a nominative fair use analysis to evaluate a parody trade dress claim. This was counted in both categories, which explains the total number of uses at 26, even though there are only 25 cases in the sample.

Raw numbers, of course, do not explain the benefits of any particular approach. That information comes only from examining each one.

a. *The Infusion Approach*

Some courts take the view that parody is not an affirmative defense, “but merely a way of phrasing the traditional response that customers are not likely to be confused as to the source, sponsorship or approval.”²⁸ This approach—the most dominant in the cases I examined—weaves a finding of parody into the analysis of the confusion factors.²⁹ In some ways, it resembles how a parody finding in copyright affects the fair use inquiry.³⁰ Typically, a finding of parody will swing in the parodist’s favor certain traditional confusion factors: the strength of the mark,³¹ the degree of similarity between the two marks,³² the defendant’s intent,³³ product similarity,³⁴ and, to a lesser extent, actual confusion³⁵ and

28. *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1405 (9th Cir. 1997) (citing *Mutual of Omaha Ins. Co. v. Novak*, 648 F. Supp. 905, 910 (D. Neb. 1986), *aff’d*, 836 F.2d 397 (8th Cir. 1987)).

29. *E.g.*, *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research*, 527 F.3d 1045, 1057 (10th Cir. 2008); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC (Louis Vuitton II)*, 507 F.3d 252, 258–59 (4th Cir. 2007); *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 502 (2d Cir. 1996); *CCA & B, LLC v. F + W Media Inc.*, 819 F. Supp. 2d 1310, 1324 (N.D. Ga. 2011); *Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302, 1335–38 (N.D. Ga. 2008); *World Wrestling Fed’n Entm’t Inc. (WWE) v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413, 430–40 (W.D. Pa. 2003); *Charles Atlas, Ltd. v. DC Comics, Inc.*, 112 F. Supp. 2d 330, 337–40 (S.D.N.Y. 2000) (applying modified *Rogers* test from *Cliffs Notes* by assessing the expressive value of the defendant’s work and then walking through the likelihood of confusion factors as colored by a finding of parody with expressive value). *See also* *New York Stock Exch., Inc. v. New York, New York Hotel LLC*, 293 F.3d 550, 555–56 (2d Cir. 2002) (holding that use of modified versions of New York Stock Exchange marks on a casino in Las Vegas that replicated parts of New York City was parodic and noninfringing, and using the nature of the parody to inform the analysis of the strength of the mark); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 493–94 (2d Cir. 1989) (applying a variation of the *Rogers* test to parody).

30. *See, e.g.*, *Simon*, *supra* note 18, at 821–37. There is an important difference here. Fair use is a doctrine that evaluates a use *independent* of the infringement analysis. That is, the court analyzes fair use only if the work infringes the plaintiff’s copyright. Under the Infusion Approach, however, parody shapes the infringement analysis; it is not a defense to infringement. This is an important point, as we shall see, because it accentuates why the Infusion Approach alone is inadequate.

31. *Louis Vuitton II*, 507 F.3d at 261–62; *Hormel Foods*, 73 F.3d at 503; *WWE*, 280 F. Supp. 2d at 435; *Charles Atlas*, 112 F. Supp. 2d at 340–41.

32. *Louis Vuitton II*, 507 F.3d at 262; *Hormel Foods*, 73 F.3d at 503–04; *WWE*, 280 F. Supp. 2d at 432–35; *Charles Atlas*, 112 F. Supp. 2d at 340–41.

33. *Louis Vuitton II*, 507 F.3d at 263; *Hormel Foods*, 73 F.3d at 505; *WWE*, 280 F. Supp. 2d at 438; *Charles Atlas*, 112 F. Supp. 2d at 340.

34. *Louis Vuitton II*, 507 F.3d at 260–62 (describing how differences in products—the defendant’s dog toys versus the plaintiff’s luxury goods—illustrated parody).

35. *Charles Atlas*, 112 F. Supp. 2d at 340 (“The fact that Atlas claims not to have noticed until *seven years* later ‘is a strong indicator that the [Flex Mentallo character] did not create a significant likelihood of confusion because [DC] was successful in conveying that the reference to [Atlas] was a [parody], and not a source identifier.’” (quoting *Yankee Publ’g Inc. v. News Am. Publ’g Inc.*, 809 F. Supp. 267, 274–75 (S.D.N.Y. 1992))).

consumer sophistication.³⁶

Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC (Louis Vuitton II),³⁷ is a good illustration of how a finding of parody colors the confusion factors. At issue in that case were the defendant's dog toys called "Chewy Vuiton," which mimicked the plaintiff's mark, "Louis Vuitton," under which the plaintiff sold luxury clothing and accessories (including dog accessories).³⁸ The court first made an initial inquiry into whether a parody existed,³⁹ much like *Campbell* instructed lower courts to do in copyright parody cases.⁴⁰ After finding a parody, the court evaluated the factors with this finding in mind.⁴¹

The court expressly discussed parody in relation to four factors. First, it noted parody was important in weighing the strength of the marks.⁴² While a strong mark will usually favor the plaintiff, "the opposite may be true when a legitimate claim of parody is involved."⁴³ This is because the parody needs to use a strong mark to be recognized as a parody; a weak mark would not likely be recognized as a parody.⁴⁴ Because a mark is strong, the court reasoned, consumers know that the parody is not the original.⁴⁵ Applying this framework to the mark at issue, the court found this factor favored the defendant.

Second, the court then explained that parody influenced its analysis of the marks' similarity.⁴⁶ Indeed, what makes a parody *qua* parody is its ability to be similar *enough* to the original to evoke it and comment on it.⁴⁷ This factor also favored the defendant because "[the defendant] appropriately mimicked a part of the LVM marks, but at the same time sufficiently distinguished its own product to communicate the satire."⁴⁸

36. *Hormel Foods*, 73 F.3d at 505.

37. 507 F.3d 252. This case did not discuss *Campbell* in the trademark section of the case. Nevertheless, its use of parody to alter the confusion analysis is illustrative of the Infusion Approach.

38. *Id.* at 257–58.

39. *Id.* at 260.

40. Simon, *supra* note 18, at 782.

41. *Louis Vuitton II*, 507 F.3d at 261–64.

42. *Id.* at 261–62.

43. *Id.* at 261.

44. *Id.*

45. *Id.* at 261–62. This is similar to the *Campbell* Court's statement that parodies need to use well-known, expressive works to be effective. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

46. *Louis Vuitton II*, 507 F.3d at 262.

47. *Id.*

48. *Id.*

The court also examined, thirdly, the defendant's intent, finding that the intent to parody "neutralized" this factor.⁴⁹ Rather than evidencing bad faith, "the intent [to parody] is to do just the opposite—to evoke a humorous, satirical association that *distinguishes* the products."⁵⁰ Finally, the court found the dissimilarity in products—was important in the parody analysis—weighed against a finding of confusion.⁵¹ Overall, the court found that the factors favored the defendant, and that "Haute Diggity Dog's marketing, sale, and distribution of 'Chewy Vuiton' dog toys [were] [not] likely to cause confusion . . . [because the toys were] an obvious parody."⁵²

Louis Vuitton II is not alone in using this test. Indeed, the Infusion Approach dominates the *Campbell* cases. Aside from being popular, this approach has some benefits. To some extent, it accounts for First Amendment considerations by altering the infringement analysis. When the court examines the similarity of the marks, for example, a parody can neutralize a factor that would otherwise weigh in favor of the plaintiff. This is similar to how *Campbell* treated parody with respect to section 107(2),⁵³ which asks what *kind* of work the defendant used.⁵⁴ Although highly expressive works typically receive more protection than factual ones, *Campbell* held that parodies must use highly expressive works; therefore, the defendant's use of a highly expressive work would not weigh in the plaintiff's favor.⁵⁵ In both cases, First Amendment concerns alter how courts apply infringement (for trademark) and fair use (for copyright) factors.

Because the parody finding just alters the application of the infringement factors, it provides the First Amendment less weight than it could; instead, it simply finds that the work is not confusing.⁵⁶ This becomes even clearer when one considers that these "altered" factors still may not tip the balance of parody in favor of noninfringement.⁵⁷

49. *Id.* at 263.

50. *Id.* (emphasis in original).

51. *Id.* at 260–62.

52. *Id.* at 263.

53. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 586 (1994).

54. 17 U.S.C. § 107(2) (2006) (stating as the second fair use factor "the nature of the copyrighted work").

55. *Campbell*, 510 U.S. at 586.

56. McCarthy characterizes parody this way too. 6 MCCARTHY, *supra* note 17, § 31:153 ("A parody of a trademark is not an affirmative defense to an infringement charge in the sense that laches or the statute of limitations is an affirmative defense. Rather, 'parody' is a way of arguing that there will be no trademark infringement because there will be no likelihood of confusion.").

57. *E.g.*, *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769 (8th Cir. 1994).

Indeed, the Infusion Approach is not a *defense* at all, as commentators repeatedly acknowledge.⁵⁸ Thus, speech interests get shorter shrift under this approach than they would under a defense to infringement.

b. Parody as First Amendment Balancing

First Amendment jurisprudence often resorts to ad hoc balancing, weighing various interests against each other.⁵⁹ Because parody implicates First Amendment concerns, some courts have used a Balancing Approach to resolve trademark claims that involve parody. Although the first court to use this approach (*Rogers v. Grimadli*) did so prior to *Campbell*, it is important to review because post-*Campbell* cases have also used variants of the *Rogers* test in their analysis. In *Rogers*, the court applied a Balancing Approach to resolve a trademark infringement claim involving the title of a movie.⁶⁰ “[I]n general,” the court wrote, “the [Lanham] Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”⁶¹ When the titular use of a mark included a celebrity’s name, free expression would win “unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.”⁶²

Subsequent cases citing *Campbell* have followed and modified this approach, making it less speech friendly.⁶³ In *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*,⁶⁴ for example, the court stated that “in deciding the reach of the Lanham Act in any case where an expressive work is alleged to infringe a trademark, it is appropriate to weigh the public interest in free expression against the public interest in

58. See *supra* note 19.

59. *E.g.*, *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 970 (10th Cir. 1996) (“[P]roof of trademark infringement under the Lanham Act requires proof of a likelihood of confusion, but, in the case of a good trademark parody, there is little likelihood of confusion, since the humor lies in the difference between the original and the parody.”); *World Wrestling Fed’n Entm’t Inc. (WWE) v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413, 431 (W.D. Pa. 2003) (“Parody, therefore, is not an affirmative defense, but only another factor to be considered in determining the likelihood of confusion. Whether a customer is confused is the ultimate question.” (footnote omitted)).

60. *Rogers v. Grimadli*, 875 F.2d 994, 999 (2d Cir. 1989).

61. *Id.*

62. *Id.*

63. See, *e.g.*, *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490 (2d Cir. 1989).

64. *Id.*

avoiding consumer confusion.”⁶⁵ But in applying the test,⁶⁶ the court fell back into the confusion trap, concluding: “we do not believe that there is a likelihood that an ordinarily prudent purchaser would think that [the defendant’s work,] *Spy Notes*[,] is actually a study guide produced by [the defendant], as opposed to a parody of [the plaintiff’s work,] *Cliffs Notes*.”⁶⁷

Both cases illustrate the benefits and drawbacks of the Balancing Approach. Although balancing is often criticized as too vague to be protective,⁶⁸ *Rogers* puts a free expression thumb on the infringement scale. Under *Rogers*, any expressive element will probably immunize a title from trademark infringement. Exceptions include titles that attempt to deceive—such as calling an unauthorized biography “an authorized biography.”⁶⁹

But balancing also has its drawbacks. Because the *Rogers* court had to hedge its bets, it allowed some infringement claims to go forward where the title was “explicitly misleading,” an inquiry that could be resolved only through contextual analysis.⁷⁰ But even more importantly, balancing often provides cover for old confusion memes to thrive. This is what happened in *Cliffs Notes*. There, the court found convincing the *Rogers* balancing approach but, in attempting to apply it, the court merely turned to an infusion-style likelihood of confusion assessment (without using the factors).⁷¹

So, if we are trying to learn from these approaches, the Balancing

65. *Id.* at 494.

66. *Id.* at 495 (“[T]aking into account that somewhat more risk of confusion is to be tolerated when a trademark holder seeks to enjoin artistic expression such as a parody, the degree of risk of confusion between *Spy Notes* and *Cliffs Notes* does not outweigh the well-established public interest in parody.”).

67. *Id.*

68. Rochelle Cooper Dreyfuss, *Reconciling Trademark Rights and Expressive Values: How to Stop Worrying and Learn to Love Ambiguity*, in *TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH* 261, 282 (Graeme B. Dinwoodie & Mark D. Janis eds., 2008) (“Balancing tests are notoriously unpredictable, making it risky for anyone who is contemplating an investment in expressive use. Thus, although there are not many U.S. cases that reach the constitutional issue, the few cases decided on that ground are difficult to reconcile.”); William McGeveran, *Rethinking Trademark Fair Use*, 94 *IOWA L. REV.* 49, 100–01 (2008) (criticizing the *Rogers* test for, among other things, being an unclear and fact-intensive standard).

69. *Rogers v. Grimadli*, 875 F.2d 994, 999 (2d Cir. 1989) (“Other titles contain words explicitly signifying endorsement, such as the phrase in a subtitle ‘an authorized biography.’ If such explicit references were used in a title and were false as applied to the underlying work, the consumer’s interest in avoiding deception would warrant application of the Lanham Act, even if the title had some relevance to the work.”).

70. *Id.*

71. *Cliffs Notes*, 886 F.2d at 494–97.

Approach teaches us that presumptions are important, as are grounded, understandable standards and rules to apply should the presumption fail. Any First Amendment test must, therefore, incorporate some kind of strong presumption for speech interests, or else it risks fostering the growth of the confusion-centered memes.

c. *Confusion*

Although the Infusion and Balancing Approaches are popular, others exist. One such approach is not really a parody analysis at all. Instead, courts apply the likelihood of confusion in the standard way. As in *MasterCard International Inc. v. Nader 2000*,⁷² courts never include a discussion of how parody alters the analysis.⁷³ Although its copyright analysis included a discussion of parody, the court's trademark analysis did not mention parody. Ultimately, the court found no confusion based on the dissimilarities of the nature, purpose, and use of the mark by Ralph Nader's campaign for political purposes.⁷⁴

As far as speech-protective tests go, this one is far from ideal. It does not expressly account for any speech-related interests⁷⁵ (such as those of the speaker and the listener). Instead, it relies on the standard likelihood of confusion analysis. But the whole point of having a parody doctrine is to recognize that important interests besides confusion are at stake. When a use makes fun of or criticizes the mark (or some other issue), the First Amendment cautions against (private) censorship. Using a standard likelihood of confusion analysis does not account for these interests. Mark similarity, intent of the parties, and product similarity, for example, cut in favor of the mark owner in such cases. In parody cases, by contrast, they do not. Proposals to use a standard confusion analysis miss this very basic point.⁷⁶ For this and other reasons discussed later,

72. No. 00 Civ.6068(GBD), 2004 WL 434404 (S.D.N.Y. Mar. 8, 2004).

73. *Id.*

74. *Id.* The trademarks at issue were, "THERE ARE SOME THINGS MONEY CAN'T BUY. FOR EVERYTHING ELSE THERE'S MASTERCARD," and "PRICELESS." *Id.* at *2. Nader used the phrases, "finding out the truth: priceless. There are some things money can't buy." *Id.* at *1.

75. See McGeeveran, *supra* note 68, at 71 (noting the confusion test fails "to address the normative value of free speech").

76. See Eric Sonju, "Likelihood of Confusion" is Confusing Enough: Why the Concept of Parody has No Place in a Likelihood of Confusion Analysis, 38 AIPLA Q.J. 349, 361-62 (2010) (arguing without explaining that "[p]arody should not be an additional factor in the likelihood of confusion test, . . . affect the application of the existing factors . . . [or] be used to justify greater risk of confusion out of concern for freedom of expression under the First Amendment."); Tammi A. Gauthier, Comment, *Fun & Profit: When Commercial Parodies Constitute Copyright or Trademark Infringement*, 21 PEPP. L. REV. 165, 203-04 (1993) (arguing that courts should determine trademark

the confusion test is inadequate.

d. Parody as Nominative Fair Use

Another approach—one taken by the court in *Mattel, Inc. v. Walking Mountain Productions*⁷⁷—analyzes parody under the judicially created doctrine of nominative fair use.⁷⁸ This doctrine applies where the defendant uses the plaintiff's mark to refer to the plaintiff's mark, generally for comparison or criticism.⁷⁹ So, for example, where an advertisement says, "Try our Product X. It has more ingredients than comparable Product Y®," nominative fair use would apply.

Nominative fair use, which replaces or supplements the factor-based confusion test, requires the plaintiff to show three elements.⁸⁰ First, the plaintiff's product or service in question must be one not readily identifiable without use of the trademark. Second, only so much of the mark or marks may be used as is reasonably necessary to identify the plaintiff's product or service. And third, the user must not use the mark in a way that suggests sponsorship or endorsement by the trademark holder.

The *Walking Mountain* court applied this three-part test in the parody context as to trade dress.⁸¹ In that case, the defendant had created a photography exhibit that used various Barbie dolls posing in sexually suggestive positions with food.⁸² The court found that the defendant satisfied the first element of the nominative fair use doctrine, noting that it would have been "extremely difficult" to comment on the image of Barbie without using the image of Barbie.⁸³ As to the second element,

infringement of commercial parodies by asking whether there is confusion in marketplace).

77. 353 F.3d 792, 809 (9th Cir. 2003).

78. *E.g., id.* (applying nominative fair use to the trade dress claim). Although the *Mattel* court applied the *Rogers* test to the confusion analysis of the trademark at issue, it did not do so for the trade dress at issue. *Id.* at 807–08. This way the court avoided deciding whether *Rogers* applied by applying the nominative fair use doctrine instead. *Id.* at 808.

79. *Id.* at 809 ("In contrast, a defendant's use of a plaintiff's mark is *nominative* where he or she 'used the plaintiff's mark to describe the plaintiff's product, *even if the defendant's ultimate goal is to describe his own product.*' The goal of a nominative use is generally for the 'purposes of comparison, criticism [or] point of reference.'" (emphasis in original) (citations and footnote omitted)).

80. *Id.* at 810 (describing the three elements of nominative fair use (quoting *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1151 (9th Cir. 2002))).

81. *Id.*

82. *Id.* at 796–97.

83. *Id.* at 810–11.

the court found that the defendant satisfied this fact-intensive⁸⁴ inquiry.⁸⁵ Using Barbie's torso and body to comment on the sexuality of Barbie, the court found, was no more than reasonably necessary.⁸⁶ Finally, the court found the last element was satisfied, dubbing it a "closer call" than the first two.⁸⁷ This element, the court noted, does not require the defendant to use the mark to affirmatively endorse the product or service at issue. Nevertheless, the court focused on what the defendant did to reduce the risk that individuals would suspect endorsement. Important to the court were the promotional materials that the defendant distributed with his work, which included statements that the defendant's aim was to criticize the work.⁸⁸ Critical commentaries, the court stated, were not likely to be sponsored by the trademark owner.⁸⁹ For these reasons, this was nominative fair use.

Although seemingly a good candidate for a parody defense, nominative fair use faces at least two conceptual deficiencies. First, asking whether the defendant satisfied the third element—does the use suggest sponsorship or endorsement?—is a lot like asking whether consumers would be confused about the source of the product or service.⁹⁰ In other words, the sponsorship/endorsement question is essentially the same question the confusion analysis seeks to answer, though framed in slightly different terms.⁹¹

84. *Id.* at 811 ("As we recognized in *Cairns*, '[w]hat is 'reasonably necessary to identify the plaintiff's product' differs from case to case.'" (quoting *Cairns*, 292 F.3d at 1151)).

85. *Id.*

86. *Id.* ("Given the photographic medium and Forsythe's goal of representing the social implications of Barbie, including issues of sexuality and body image, Forsythe's use of the Barbie torso and head is both reasonable and necessary.").

87. *Id.*

88. *Id.* at 811–12.

89. *Id.* at 812.

90. See Graeme B. Dinwoodie, *Lewis & Clark Law School Ninth Distinguished IP Lecture: Developing Defenses in Trademark Law*, 13 LEWIS & CLARK L. REV. 99, 111 (2009) ("[T]he third part of the test looks very much [like] a proxy for an assessment of likely confusion as to association, sponsorship or endorsement."); Samuel M. Duncan, Note, *Protecting Nominative Fair Use, Parody, and Other Speech-Interests by Reforming the Inconsistent Exemptions from Trademark Liability*, 44 U. MICH. J.L. REFORM 219, 239 (2010) ("Further, as in nominative fair use, in infringement cases the doctrine is, at its base, not that parody is *protected* speech, but that, if understood correctly, *parodic speech is not likely to cause confusion.*" (emphasis added)).

91. See 4 MCCARTHY, *supra* note 17, § 23:11 ("'[N]ominative fair use' was created to be an alternative method for analyzing if there is the kind of likelihood of confusion that constitutes trademark infringement."); *id.* ("[T]he 'nominative fair use' analysis is a 'defense' only in the sense that an accused infringer in certain cases can use the analysis to argue that there will be no infringement because there will be no likelihood of confusion."). But see *id.* (arguing that, "in the Third Circuit, 'nominative fair use' is indeed an affirmative defense. In its *Century 21* case, the Third Circuit took the thinking behind the Ninth Circuit analysis and turned it into a much more

Not all agree on this point. Stacey Dogan and Mark Lemley, for example, assert that nominative fair use contextualizes the inquiry in a way standard confusion analysis does not.⁹² They argue it requires the court to “assess how the use measures up against” the purpose for which the mark is used.⁹³ The confusion analysis, by contrast, is focused entirely on whether consumers are likely to be confused about the source or sponsorship of the mark.

It is not, however, entirely true that in the confusion analysis—at least as to parody—“the factfinder has no purpose against which to measure the nature of the use.”⁹⁴ As this Article demonstrates, courts repeatedly use parody as a way to shift the likelihood of confusion analysis. Under the Infusion Approach, for example, parody can alter the way courts apply the confusion factors. In such cases, courts apply those factors against the backdrop of parody and, consequently, its purpose. Additionally, it is not clear how merely having parody as a backdrop in the Nominative Fair Use Approach makes the inquiry into consumer perceptions any easier than it would be in another mode of analysis, such as the Infusion Approach. Indeed, the Infusion Approach achieves a similar goal with a more nuanced set of factors to apply.

Second, some courts have held that nominative fair use applies only when the defendant uses the plaintiff’s mark exactly (or nearly exactly).⁹⁵ This, of course, makes some sense, particularly if we import *Campbell*’s requirement that a parody comment on the underlying mark. But even if we take that position, it seems odd to require near identity to avoid infringement. If the mark is not identical—or even closely similar—then consumers will not be confused about the source.⁹⁶ All the more reason to allow parodies with non-identical marks—particularly if parody itself cannot overcome consumer confusion (or sponsorship/endorsement).

potent defensive tool.”).

92. Dogan & Lemley, *supra* note 10, at 37–38.

93. *Id.* at 38.

94. *Id.*

95. *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 444 F. Supp. 2d 1012, 1032–34 (C.D. Cal. 2006) (holding that the nominative fair use defense was not available to the defendant’s video game rendition of the plaintiff’s strip club because the defendant did not design the strip club in the video game to resemble plaintiff’s actual strip club, and stating that “because the [defendant’s] Game does not specifically identify the [plaintiff’s strip club] as such, the elements of the [nominative fair use defense] cannot readily be applied.”).

96. Marks that are not closely similar, and thus fall outside the scope of nominative fair use, may still refer to the plaintiff’s mark. To the extent that nominative fair use would not cover such instances when they involve parody, it would be unhelpful.

The nominative fair use defense therefore seems particularly inadequate for parodic or satirical uses of trademarks. First Amendment interests are difficult to locate where the analysis resembles the traditional likelihood of confusion test. Instead of a real defense, the doctrine of nominative fair use is a recasting of the likelihood of confusion test; it is a confusion trap. For these reasons, nominative fair use does not adequately protect First Amendment interests.

e. Alternative Means Approach

Occasionally, a court will apply an Alternative Means Approach and hold that a defendant is liable for infringement where she could have made her statement without using the mark in a confusing manner. One mark user, for example, told the story of the O.J. Simpson murder trial using some of Dr. Seuss' trademarks.⁹⁷ The court found the likelihood of confusion factors weighed in favor of infringement. As to what it called a "Possible First Amendment Defense," the court found none existed. Here, it adopted the Alternative Means Approach, which "dismisses First Amendment concerns where 'alternative avenues of communication' exist that might have been selected by the infringer to convey its message."⁹⁸ The court found its fair use analysis of the copyright claim adequately captured the "alternative means" approach as applied to trademark claim: the defendant can take only so much as necessary for the use, and no more. For the court, the use of the trademarks was clearly satire, not parody. As such, the defendant could have used alternative means to comment on the O.J. Simpson trial, as the criticism and comment of it were not directed at Dr. Seuss' trademarks.⁹⁹

Practically speaking, this approach is not different from the confusion analysis.¹⁰⁰ But theoretically, it is actually much worse. Under this test,

97. *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc. (Dr. Seuss I)*, 924 F. Supp. 1559 (S.D. Cal. 1996).

98. *Id.* at 1571 (quoting *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979)); *id.* ("The Court feels that the weight of Supreme Court authority indicates that it would favor adoption of the first approach as adequately accommodating the narrow instances when trademark protection cannot be viewed as a reasonable time, place, or manner restriction.").

99. *Id.* at 1569 (finding on the copyright claim that the nature, character, and purpose of the defendant's use of the central character illustration of *The Cat in the Hat* and the central rhyme in *Horton Hatches the Egg* weighed against fair use, but also that defendant could not justify taking the central character illustration from *The Cat in the Hat*, yet the defendant could justify its taking from *Horton Hatches the Egg* and *One Fish Two Fish Red Fish Blue Fish*); *id.* at 1571 (finding that a First Amendment defense for the trademark claim was unlikely to succeed based on the Court's copyright analysis).

100. *Id.* at 1573. Indeed, the court itself suggested that the confusion analysis is the only relevant

the court purports to account for the First Amendment, but, in actuality, it subjugates that interest to the confusion doctrine. There will always be “alternative means of achieving a satirical or parodic ends”¹⁰¹ that do not entail confusion. Much of the problem is rooted in a strict, but inapt, analogy to real property¹⁰²: trademarks are used to make speech that includes a statement about them; real property is used merely instrumentally to speak from some place. Yet courts treat trademarks as a location (i.e., as a parcel of real property) rather than as speech itself. So they conclude that the defendant has no need to use the trademark when she can always say what she wants some other way. In other words, why stand on the plaintiff’s mark to shout about the O.J. Simpson trial? Why not stand on some unowned parcel of land? Of course, this misses the important point that trademarks themselves are not merely owned “property,” but also speech itself. This conclusion, however, coupled with the express rejection of First Amendment interests, makes the Alternative Means Approach inadequate. It, too, is a confusion trap.

f. Parody as a Separate Factor or Digit

Another way courts use parody is to weigh it as a separate “digit” in the confusion analysis.¹⁰³ In other words, courts tack on the parody finding as something else to be weighed when determining likelihood of confusion.¹⁰⁴ The problem with this approach is that it completely ignores how parody affects the likelihood of confusion factors.¹⁰⁵ This is what happened in *Elvis Presley Enterprises, Inc. v. Capece (Elvis Presley II)*.¹⁰⁶ There, though, the court actually made a substantive finding *about* parody, rather than apply a parody test. It held that, although the defendant’s mark was a parody, it was not a parody of the

inquiry: “Where alternative means of achieving the satiric or parodic ends exist that would not entail consumer confusion, the First Amendment will not protect the parodist from being held to infringe.” *Id.* (footnote omitted).

101. *Id.*

102. Michael K. Cantwell, *Confusion, Dilution, and Speech: First Amendment Limitations on the Trademark State*, 87 TRADEMARK REP. 547, 555–56 (1997).

103. *Elvis Presley Enters., Inc. v. Capece (Elvis Presley II)*, 141 F.3d 188, 200 n.5 (5th Cir. 1998) (“We have considered parody separately from the other digits of confusion and recommend this approach, but in no way do we suggest at this time that the district court’s approach of considering parody within its analysis of the standard digits of confusion in itself constitutes reversible error.”).

104. *Id.* at 194 (“Parody is one such other relevant factor that a court may consider in a likelihood-of-confusion analysis.”).

105. *See infra* Part III.A.1.a.

106. 141 F.3d 188 (5th Cir. 1998).

plaintiff's mark.¹⁰⁷ Therefore, the court said, the defendant did not need to use the plaintiff's mark for the parody.¹⁰⁸ In this sense, the court's analysis resembled lessons from both *Campbell* (a need to target the mark itself) and from *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc. (Dr. Seuss I)*¹⁰⁹ (a lack of alternative means of communicating the message). The court noted that "[the restaurant owner] himself conceded that the Defendants could have performed their parody without using Elvis's name. Without the necessity to use Elvis's name, parody does not weigh against a likelihood of confusion in relation to [the plaintiff's] marks."¹¹⁰ Under this approach, the concept of parody not only fails to save the defendant, "[i]t is simply irrelevant."¹¹¹

This approach shares the same pitfalls as the Infusion and Alternative Means Approaches, but enjoys none of their benefits. As an initial matter, it seeks to divorce parody from the confusion analysis by making it a separate factor to be weighed. That, of course, neglects the nature of a parody and how it can influence the confusion analysis. But even worse, the Separate Digit Approach breaks down into an Alternative Means Approach that is not itself a defense. At least the Alternative Means Approach *purported* to be a defense to infringement (though it is not). And the standard could actually excuse the use in some cases: if "no alternative means" actually existed (though this is a tight standard), the parodist is not liable. Here, the test is merely a *factor* in the confusion analysis. Thus, even if a parody exists (and no alternative means exist), then theoretically infringement could still occur. Once again, we find ourselves in a confusion trap.

2. *Other Approaches to Parody in Trademark Infringement Claims*

Although there are twenty-three trademark cases citing *Campbell*, there are many more trademark cases involving parody. Within these cases two other parody tests exist. We explore those here. First, we

107. *Id.* at 199–200.

108. *Id.* at 200 ("The Defendants' parody of the faddish bars of the sixties does not require the use of EPE's marks because it does not target Elvis Presley; therefore, the necessity to use the marks significantly decreases and does not justify the use."). The *Elvis* court's approach was later abrogated by a subsequent Fifth Circuit opinion, *Lyons P'ship v. Giannoulas (Giannoulas II)*, 179 F.3d 384, 389 (5th Cir. 1999). Although the *Giannoulas II* court rejected the narrow reading of the *Elvis* court's decision, it followed a similar analysis of the parody issue, requiring the defendant to reference the plaintiff's mark in some way. *Id.* at 388. It must do this, however, while simultaneously distinguishing itself as something other than the original. *Id.*

109. 924 F. Supp. 1559 (S.D. Cal. 1996), *aff'd*, 109 F.3d 1394 (9th Cir. 1997).

110. *Elvis Presley II*, 141 F.3d at 200.

111. *Id.*

examine courts that characterized parody as a per se Affirmative Defense. Then we explore the initial interest confusion doctrine, focusing on parodic uniform resource locators (URLs).

a. Parody as a Per Se First Amendment Defense

The least traditional approach has been to use a finding of parody as determinative of First Amendment protection.¹¹² In *GTFM, LLC v. Universal Studios, Inc.*,¹¹³ the defendant had created a movie in which it showed a clothing line titled BUFU (By Us, Fuck You), which parodied the plaintiff's actual clothing line FUBU (For Us, By Us) designed for "multicultural youth."¹¹⁴ The court analyzed only the parody issue, stating that parodies are "entitled to full protection under the First Amendment and pursuant to the substantial body of case law establishing 'safe harbors' for this form of comical expression."¹¹⁵ The court then granted summary judgment "because [the defendant] used 'BUFU' as a parody."¹¹⁶ The court cited a number of cases to support its legal holding—including *Yankee Publishing Inc. v. News America Publishing Inc.*,¹¹⁷ *L.L. Bean, Inc. v. Drake Publishers, Inc.*,¹¹⁸ and *Tommy Hilfiger Licensing, Inc. v. Nature Labs*¹¹⁹—but never explained the differences between these cases.¹²⁰ The court also claimed to review the likelihood of confusion factors, but it was clear that the decisive issue was whether the defendant's work was a parody.¹²¹

This approach seems deficient because it categorizes parody as protected without a thorough analysis of what a parody is. It also neglects to acknowledge or delineate what competing rights and interests are at stake. Thus, the conclusion is doubly bad. Not because it reached the wrong result (it did not)—but because it, first, fails to define parody

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

113. *Id.*

114. *Id.* at *1.

115. *Id.* at *2.

116. *Id.*

117. *Id.* n.4 (citing *Yankee Publ'g Inc. v. News Am. Publ'g Inc.*, 809 F. Supp. 267, 279 (S.D.N.Y. 1992)).

118. *Id.* (citing *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 34 (1st Cir. 1987)).

119. *Id.* (citing *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 414 (S.D.N.Y. 2002)).

120. *Id.* at *2.

121. *Id.* at *3 ("An explicit consideration of *each* of the eight *Polaroid* factors tips the scales entirely in favor of the defendants, and need not be discussed here." (emphasis in original)).

in any meaningful way, and, second, inappropriately applies First Amendment protection to *any* parody regardless of whether the speech is commercial or whether confusion exists.

b. Parodic URLs and Initial Interest Confusion

The last approach,¹²² which sometimes involves trademark disputes over domain names, operates within the doctrine of initial interest confusion. This doctrine holds actionable confusion that occurs away from the point of sale—that is, when the consumer initially sees the product but prior to her buying it.¹²³ The theory posits that some consumers' initial confusion, even if later dispelled, will cause them to buy the competing product. Why? Out of mere convenience. Notice no confusion exists at the point of sale; the confusion is actionable because it *eventually could lead to lost sales*. At least one court applying this doctrine in the context of domain names has found liability. On its view, initial interest confusion is tantamount to diverting future sales.¹²⁴

Cases in the parody context are no different. The most prominent case in this area is *People for the Ethical Treatment of Animals (PETA) v. Doughney*.¹²⁵ The plaintiff (PETA) was an organization that advocated

122. There is one other approach that appears in trademark disputes involving domain names, but it was rejected by the court that considered it. The approach was based on the requirement some courts impose that the defendant's use of a mark must be "commercial" to infringe. In one case, the court considered and rejected the argument that parody was a per se exception to the "commercial use" requirement, holding instead that it merely factored into the confusion test. *Utah Lighthouse Ministry, Inc. v. Discovery Computing, Inc.*, 506 F. Supp. 2d 889, 897–98 (D. Utah 2007) (stating that trademark law applies only to the use of a trademark in connection with a commercial transaction—i.e., a sale of a good or service (citing *Bosley Med. Inst., Inc. v. Kramer*, 403 F.3d 672, 674, 676–77 (9th Cir. 2005))), *aff'd*, 527 F.3d 1045, 1055, 1058 (10th Cir. 2008) (holding that "[p]arody is another factor to consider in determining the likelihood of confusion, and casts several of the above-cited six factors in a different light," agreeing with the district court's noncommercial use conclusion in the context of the Anti-Cybersquatting Protection Act's (ACPA) fair use provision (citing 15 U.S.C. § 1125(d)(1)(B)(i)(IV) (2006))). A similar analysis has been applied to determining bad faith under the ACPA, where one factor in determining bad faith is whether the defendant's use is bona fide noncommercial or fair. *See id.*

123. *See* 4 MCCARTHY, *supra* note 19, § 23:6.

124. *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1064 (9th Cir. 1999) ("Suppose West Coast's competitor (let's call it 'Blockbuster') puts up a billboard on a highway reading—'West Coast Video: 2 miles ahead at Exit 7'—where West Coast is really located at Exit 8 but Blockbuster is located at Exit 7. Customers looking for West Coast's store will pull off at Exit 7 and drive around looking for it. Unable to locate West Coast, but seeing the Blockbuster store right by the highway entrance, they may simply rent there.").

125. 263 F.3d 359 (4th Cir. 2001). The Ninth Circuit has rejected the *PETA* court's approach as to a finding of commercial use because it would too greatly silence speech. *Contra Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 679 (9th Cir. 2005) ("To the extent that the *PETA* court held that the Lanham Act's commercial use requirement is satisfied because the defendant's use of the

for animal rights. The defendant had registered the domain name “peta.org,” which led the Internet surfer to a webpage containing a disclaimer that it was not the organization PETA, as well as information, and links to other pages, about eating meat and other carnivorous activities.¹²⁶ The defendant also titled his webpage “People Eating Tasty Animals,” which contained abundant commentary on eating meat.¹²⁷

The defendant claimed his website was a parody and therefore not infringing under the Lanham Act. The Fourth Circuit disagreed. In finding infringement, the court relied on the doctrine of initial interest confusion. The court evaluated the domain name in isolation, focusing on how it conveyed only the message of affiliation with the plaintiff’s organization.¹²⁸ The court rejected the idea that the content of the website itself could negate confusion.¹²⁹

At first glance, the court’s decision seems understandable. Certain assumptions inherent in the court’s analysis, though, are not fleshed out. And those assumptions show the court’s conclusion is erroneous—that it fell into a variant of the confusion trap. First, the court assumes that the user is confused when she types in the URL. That could be true in some abstract sense. If I think that *peta.org* is the website for PETA, that is where I think I will be directed. But when I am not directed there—when I am sent to a parodic website, am I confused? Probably not. (The stronger argument is that consumers use domain names to *verify* that

plaintiff’s mark as the domain name may deter customers from reaching the plaintiff’s site itself, we respectfully disagree with that rationale. While it is true that *www.BosleyMedical.com* is not sponsored by Bosley Medical, it is just as true that it is *about* Bosley Medical. The *PETA* approach would place most critical, otherwise protected consumer commentary under the restrictions of the Lanham Act. Other courts have also rejected this theory as over-expansive.” (emphasis in original)).

126. *PETA*, 263 F.3d at 363 (“A viewer accessing the website would see the title ‘People Eating Tasty Animals’ in large, bold type. Under the title, the viewer would see a statement that the website was a ‘resource for those who enjoy eating meat, wearing fur and leather, hunting, and the fruits of scientific research.’ The website contained links to various meat, fur, leather, hunting, animal research, and other organizations, all of which held views generally antithetical to PETA’s views. Another statement on the website asked the viewer whether he/she was ‘Feeling lost? Offended? Perhaps you should, like, *exit immediately*.’ The phrase ‘*exit immediately*’ contained a hyperlink to PETA’s official website.” (emphasis in original)).

127. *Id.* at 362–63.

128. *Id.* at 366 (“Looking at [the defendant’s] domain name alone, there is no suggestion of a parody. The domain name *peta.org* simply copies PETA’s Mark, conveying the message that it is related to PETA. The domain name does not convey the second, contradictory message needed to establish a parody—a message that the domain name is not related to PETA, but that it is a parody of PETA.”).

129. *Id.* (“[T]his second message [(that the mark is not the original)] is not conveyed *simultaneously* with the first message, as required to be considered a parody.” (emphasis in original)).

they have reached the appropriate website.) This is important because the confusion question depends on how the consumer confronts the mark.

A consumer confronts the mark here in two ways. The first occurs in isolation as a URL that is typed in. In a basic way, however, the consumer is not confronting the mark at all here because the mark is not associated with anything—it is just a word or phrase. So if confusion occurs at this point, it is not really confusion as to any use of the mark; it just confusion that is taking place in the mind of the consumer as to where she might find the website she is looking for.

The actual confrontation, if it exists, takes place once the consumer gets to the website. It is at this point the prospective consumer wonders, is this website affiliated with the mark used in the URL? To use a products analogy: the consumer cannot be confused about the source of a product until she confronts the product. Just seeing the mark in isolation does not show confusion, and it is not part of the contextual confusion analysis.¹³⁰

This kind of analysis is not foreign to traditional trademark law disputes. In *Cliffs Notes*—the case involving a potentially misleading cover page—the court noted that consumers do not merely see a product and make a monolithic decision about its source. As they confront marks and products, consumers' expectations shift—what seems like confusion at first is later dispelled. As to the potentially confusing cover page, the court noted that consumers would not merely accept ambiguity as the wrong source: “[E]ven for those few readers who might be slightly confused by the cover, the most likely reaction would be to open the book.”¹³¹

There are two other points worth mentioning. First, the court has assumed that people traditionally get to the websites they desire by typing in the URL. Many internet surfers, however, use search engines to search for sites.¹³² People search for sites they do know, even those that they frequently visit. Additionally, many web browsers now save user history, so past websites visited “pop up” when particular letters are

130. See, e.g., *Int'l Ass'n of Machinists & Aerospace Workers v. Winship Green Nursing Ctr.*, 103 F.3d 196, 201 (1st Cir. 1996) (“[B]ecause the listed factors must be evaluated in context, any meaningful inquiry into the likelihood of confusion necessarily must replicate the circumstances in which the ordinary consumer actually confronts (or probably will confront) the conflicting mark.”).

131. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.*, 886 F.2d 490, 496 (2d Cir. 1989).

132. *What Internet Users Do Online*, PEW INTERNET & AMERICAN LIFE PROJECT, [http://www.pewinternet.org/Trend-Data-\(Adults\)/Online-Activites-Total.aspx](http://www.pewinternet.org/Trend-Data-(Adults)/Online-Activites-Total.aspx) (last visited Sept. 12, 2011). Perhaps this was not the case when *PETA* was decided.

entered into the URL bar by the user.¹³³ Still other browsers and search engines use an “autocomplete” feature, which suggests websites the user may be looking for.¹³⁴

Second, if this assumption is true—if users really try to get to websites (the content of which they know or are likely to know) by typing in a domain name (that they do not know) containing the defendant’s mark—then many times there will not be confusion because the consumers have nothing to be confused about. They know what the likely content of the website will be, and, when they reach the “wrong” website, they *know* that it is not where they wanted to go. When, for example, I type “www.american.com,” because I do not know the URL for American Airlines is “www.aa.com,” I am not confused about the source. I just do not know the correct URL. What I do know is that the website I want is owned and operated by American Airlines. When I arrive at the American Enterprise Institute’s online journal, *The American*, I am not confused; I know I have typed the wrong URL.

In such a case confusion cannot occur merely when I type in the URL; it can occur only once I have confronted the website. Websites—even with domain names—are experiential goods, though they do have some search good qualities.¹³⁵ This leads to the corollary point: consumers who are looking for an American Airlines website will not be confused once they get to a website that is not American Airlines, despite the domain name “www.american.com.”

Thus, the appropriate standard for assessing domain names—and claims of initial interest confusion—is to confront them as consumers do: in the context of the webpage to which they are linked. This, of course, is a statement about how the court should analyze confusion; that was the issue in the PETA case. But the reasoning applies aptly to any parody defense.

133. See, e.g., *Firefox Features, Browsing Made Easy, Awesome Bar*, MOZILLA.COM, <http://www.mozilla.com/en-US/firefox/features/#> (last visited July 13, 2011) (explaining how Awesome Bar allows you to “[g]et to your favorite sites quickly – even if you don’t remember the URLs,” as “the autocomplete function will include possible matches from your browsing history, bookmarked sites and open tabs”).

134. *Autocomplete*, GOOGLE.COM, https://support.google.com/websearch/answer/106230?hl=en&ref_topic=3081616 (last visited Aug. 11, 2013) (“As you type within the search box on Google, Autocomplete helps you find information quickly by displaying searches that might be similar to the one you’re typing. For example, as you start to type [new york], you may be able to pick searches for other New York-related search queries.”).

135. WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 117 n.51 (2003) (defining “experience goods” as those that have features difficult to obtain in advance and must be experienced to be consumed, and “search goods” as products with features that can be evaluated easily before purchase).

Users confront parodic websites, not when they type in the URL, but rather when they visit the webpage displayed at a particular URL. Thus, initial interest confusion is a doctrine especially unsuited for parodies online. To resolve this problem, courts should evaluate initial parody claims over domain names by looking to the content of the website *in conjunction* with the URL. At least one older case has taken such an approach in a non-internet setting.¹³⁶ Likewise, other parody claims of initial interest confusion must be particularly attuned to the way in which the consumer confronts the mark, not merely how the mark appears in isolation.

B. *Approaches to Trademark Dilution Actions Involving Parody*

Just as courts deciding infringement claims involving parody use a variety of approaches to resolve the claims, courts confronting dilution claims have their own methods for analyzing claims involving parody. The dilution cases citing *Campbell*¹³⁷ use six approaches to analyzing parody in dilution.¹³⁸ Because dilution can involve either actions for blurring (diminishing the distinctiveness of the mark) or tarnishment (causing associations to unsavory or inferior products or images), the approaches can vary by action. The most current dilution statute,¹³⁹ for example, provides courts with six factors to analyze a dilution claim;¹⁴⁰

136. Cf. *Cliff's Notes*, 886 F.2d at 496 ("Moreover, even for those few readers who might be slightly confused by the cover, the most likely reaction would be to open the book.").

137. *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC (Louis Vuitton II)*, 507 F.3d 252 (4th Cir. 2007); *Mattel, Inc. v. MCA Records, Inc. (Mattel III)*, 296 F.3d 894 (9th Cir. 2002); *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769 (8th Cir. 1994); *Burnett v. Twentieth Century Fox Film Corp.*, 491 F. Supp. 2d 962 (C.D. Cal. 2007); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC (Louis Vuitton I)*, 464 F. Supp. 2d 495 (E.D. Va. 2006); *Mastercard Int'l Inc. v. Nader 2000 Primary Comm. Inc.*, No. 00 Civ.6068(GBD), 2004 WL 434404 (S.D.N.Y. Mar. 8, 2004); *World Wrestling Fed'n Entm't, Inc. (WWE) v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413 (W.D. Pa. 2003); *Kane v. Comedy Partners*, No. 00 Civ. 158(GBD), 2003 WL 22383387 (S.D.N.Y. Oct. 16, 2003); *Charles Atlas, Ltd. v. DC Comics, Inc.*, 112 F. Supp. 2d 330 (S.D.N.Y. 2000); *Mattel, Inc. v. MCA Records, Inc. (Mattel II)*, 28 F. Supp. 2d 1120 (C.D. Cal. 1998); *Mattel, Inc. v. MCA Records, Inc. (Mattel I)*, No. CV 97-6791 WMB, 1998 WL 422641 (C.D. Cal. Feb. 18, 1998); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc. (Dr. Seuss I)*, 924 F. Supp. 1559 (S.D. Cal. 1996); *Elvis Presley Enters., Inc. v. Capece (Elvis Presley I)*, 950 F. Supp. 783 (S.D. Tex. 1996); *Schieffelin & Co. v. Jack Co. of Boca, Inc.*, 850 F. Supp. 232 (S.D.N.Y. 1994).

138. Within my calculations I include all dilution claims, including state law claims and claims under the prior federal dilution law (the Federal Trademark Dilution Act).

139. 15 U.S.C. § 1125(c) (2006).

140. *Id.* § 1125(c)(2)(B)(i)-(vi) (listing the six factors as the degree of similarity between the marks, how distinctive the famous mark is, how much the famous mark is used exclusively by the mark owner, how recognized the famous mark is, the intent of the user, and any actual association between the marks).

but no such factors exist to analyze a tarnishment claim.¹⁴¹ For this reason, courts have used in blurring but not tarnishment cases the same kind of Infusion Approach they sometimes employ in the infringement-parody context. Other times, however, courts use identical analyses for both blurring and tarnishment claims. The current law governing dilution—the Trademark Dilution Revision Act (TDRA)¹⁴²—for example, exempts from liability uses of marks in a “noncommercial” manner.¹⁴³ Because this defense applies to dilution generally, courts have applied it to both blurring and tarnishment claims.

Table 2 shows how courts citing *Campbell* analyze dilution claims in parody cases. The most popular defense has been to rely on the TDRA defense of noncommercial use. Indeed, courts analyze 54% of all dilution claims using this method. The approaches with the next highest usage rates are No Harm (15%) (for tarnishment only) and Per Se Non-Diluting findings (15%). The former occurs where the plaintiff fails to provide actual evidence that the defendant’s use tarnished its mark. The latter occurs where the court simply finds that parodies, in and of themselves, are not capable of dilution. The other approaches—Infusion, No Confusion, and Standard Dilution—are used rather minimally. In what follows, I explain in more detail each of these approaches, as well as their desirability.

141. *Id.* § 1125(c)(2)(C) (defining “‘dilution by tarnishment’ [as] association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark”).

142. Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312 (codified as amended at 15 U.S.C. § 1125(c)).

143. 15 U.S.C. § 1125(c)(3)(C).

TABLE 2. APPROACHES TO TRADEMARK PARODY IN
DILUTION CASES CITING *CAMPBELL V. ACUFF-ROSE*

Parody Approach	Blurring	Tarnishment	Times Used	%
Noncommercial	7*	7	14	54%
No Harm	0	4	4	15%
Per Se Non-Diluting	3	1	4	15%
Infusion	1	0	1	4%
No Confusion	1	1	2	8%
Standard Dilution	0	1	1	4%
Total	12	14	26	100%

*One case, *Mattel v. Walking Mountain Productions*, used the Noncommercial Approach for both the blurring and tarnishment claims. It is double counted, which explains the total of 26 total uses.

1. Noncommercial Use

As mentioned above, the Lanham Act provides three defenses to dilution—one of which is “noncommercial use of a mark.”¹⁴⁴ But just what constitutes a “noncommercial use”? Some courts have held that parody *just is* per se noncommercial use.¹⁴⁵ Others have been more thorough in their explanation. The most complete explanation of why a parodic use is a noncommercial use comes from a trio of courts deciding the same case, which involved the use of the Barbie trademark in a song.¹⁴⁶

To interpret the term “noncommercial use,” these courts used the legislative history of the TDRA. In their view, the legislative history showed that the TDRA was not meant to “prohibit or threaten noncommercial expression, such as parody, satire, editorial and other forms of expression that are not a part of a commercial transaction.”¹⁴⁷ Taking cues from the committee reports, the cases found First Amendment jurisprudence—which defined “commercial speech” as

144. *Id.*

145. See *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003); *Mattel, Inc. v. MCA Records, Inc. (Mattel III)*, 296 F.3d 894, 905 (9th Cir. 2002); *Burnett v. Twentieth Century Fox Film Corp.*, 491 F. Supp. 2d 962 (C.D. Cal. 2007); *Mastercard Int'l Inc. v. Nader 2000 Primary Comm. Inc.*, No. 00 Civ.6068(GBD), 2004 WL 434404 (S.D.N.Y. Mar. 8, 2004); *Mattel, Inc. v. MCA Records, Inc. (Mattel II)*, 28 F. Supp. 2d 1120 (C.D. Cal. 1998); *Mattel, Inc. v. MCA Records, Inc. (Mattel I)*, No. CV 97-6791 WMB, 1998 WL 422641 (C.D. Cal. Feb. 18, 1998); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc. (Dr. Seuss I)*, 924 F. Supp. 1559 (S.D. Cal. 1996).

146. *Mattel III*, 296 F.3d at 905; *Mattel II*, 28 F. Supp. 2d 1120; *Mattel I*, 1998 WL 422641.

147. *Mattel III*, 296 F.3d at 905 (quoting 141 CONG. REC. 38,559 (1995) (statement of Sen. Hatch)); *Mattel II*, 28 F. Supp. 2d at 1155 n.55 (quoting same).

speech that “does no more than propose a commercial transaction”¹⁴⁸ — to be the relevant interpretive tool.¹⁴⁹ A parody, then, is usually expressive speech that is not encompassed within this definition. Even if a parody had a commercial purpose, that alone is not enough to make the use “commercial” where the commercial purpose is “inextricably entwined with . . . expressive elements.”¹⁵⁰ In such a case, the speech “is not purely commercial.”¹⁵¹

These courts applied the noncommercial use exception to carry out Congress’ intent in drafting the bill. The question is whether parody fits within the noncommercial exception. After all, there are other possible candidate defenses: the TDRA explicitly mentions parody as a defense to dilution (when the use is fair and is “other than as a designation of source”).¹⁵² To that end, some have argued that assessing parody under the noncommercial exemption would render the fair use provision superfluous because it expressly exempts parody.¹⁵³ That is an overly narrow reading of the statute. The fair use provision merely mentions parody as a type of fair use of a mark “other than as a designation of source.”¹⁵⁴ In other words, it exempts parody (and criticism and commentary) as fair use when the parodic use is not done as a mark; it says nothing about parodic uses that are source identifying. Parodies that act as source identifiers also have expressive value, as the committee report indicates.¹⁵⁵

148. *Mattel III*, 296 F.3d at 906 (quoting *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184 (9th Cir. 2001) (quoting *Bolger v. Youngs Drug Prod’s Corp.*, 463 U.S. 60, 66 (1983)).

149. *Id.* (“To determine whether Barbie Girl falls within this exemption, we look to our definition of commercial speech under our First Amendment caselaw.” (citing H.R. REP. NO. 104-374, at 8, *reprinted in* 1995 U.S.C.C.A.N. 1029, 1035 (“[T]he exemption ‘expressly incorporates the concept of ‘commercial’ speech from the ‘commercial speech’ doctrine”); 141 CONG. REC. 38,560 (1995) (“[T]he exemption ‘is consistent with existing [First Amendment] case law” (alteration in original))); *Mattel II*, 28 F. Supp. 2d at 1155.

150. *Mattel III*, 296 F.3d at 906 (quoting *Hoffman*, 255 F.3d at 1185).

151. *Id.*

152. 15 U.S.C. § 1125(c)(3)(A) (2006) (“Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person’s own goods or services, including use in connection with . . . (ii) . . . parodying . . . the famous mark owner or the goods or services of the famous mark owner.”); 152 CONG. REC. 19,238 (2006) (statement of Rep. Smith) (“Finally, amendments developed by the subcommittee and the other body will more clearly protect traditional first amendment [sic] uses, such as parody and criticism. These amendments provide balance to the law by strengthening traditional fair-use defenses.”).

153. Duncan, *supra* note 90, at 240–41.

154. 15 U.S.C. § 1125(c)(3)(A).

155. Simply because a use of a mark as a source identifier is “in commerce” does not mean that the use is “commercial.” See H.R. REP. NO. 104-374, at 8 (1995).

The noncommercial use defense seems like a reasonably good place to situate parody for a few reasons. First, it is true to the legislative history of the TDRA. Second, rather than having to start from scratch, the noncommercial use exception capitalizes on existing First Amendment jurisprudence. Of course, there are still issues about what counts as “noncommercial,” and how wide or narrow *that* definition is. Under the Ninth Circuit’s approach, for example, expressive elements render commercial purpose effete. Other courts, as one commentator has noted, do the opposite, finding that any commercial purpose, despite its expressive elements, will render a use “commercial” for the purpose of dilution.¹⁵⁶ Still, compared to the other analytical methods courts use, the noncommercial use exception is a suitable starting place for a parody analysis in the dilution context. The definition of “noncommercial” is something I take up in my proposal for a parody defense.

2. *No Harm (Tarnishment Only)*

Tarnishment claims are premised on two ideas. First, the owner of a famous mark has the right to decide what images, feelings, and notions people associate with it. Second, that right is violated by a use that creates an association with an inferior or unwholesome product or image. Even so, courts sometimes find under the No Harm Approach that no tarnishment occurs because the plaintiff has failed to produce evidence that the defendant’s use caused harm. That is, the plaintiff usually fails to show that the defendant’s use caused an association with an inferior or unsavory product.

In *Louis Vuitton II*, for example, the court dismissed the plaintiff’s argument that the defendant’s dog toys were potentially unsafe because “[t]here [was] no record support . . . that any dog has choked on a pet chew toy, such as a ‘Chewy Vuiton’ toy, or that there is any basis from which to conclude that a dog would likely choke on such a toy.”¹⁵⁷ Likewise, in *Elvis Presley Enterprises, Inc. v. Capece (Elvis Presley D)*,¹⁵⁸ “[t]he [c]ourt [found] [that] . . . , without any evidence to the contrary, . . . nude portraits hung in a bar for the purpose of mocking the tasteless decor of the sixties does not inspire negative or unsavory images of Elvis or Elvis related products or services in the minds of EPE

156. Patrick D. Curran, *Diluting the Commercial Speech Doctrine: “Noncommercial Use” and the Federal Trademark Dilution Act*, 71 U. CHI. L. REV. 1077, 1082–87 (2004).

157. *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC (Louis Vuitton II)*, 507 F.3d 252, 269 (4th Cir. 2007).

158. 950 F. Supp. 783 (S.D. Tex. 1996).

customers.”¹⁵⁹ Thus, dilution was not actionable in either case.

Although the No Harm Approach has worked in some cases, it lacks real speech protections. Proving harm is an element of a dilution claim, rather than a defense to one. Thus, requiring evidence of harm is an appropriate element of a dilution claim. But, by itself, the harm requirement does not protect parodies precisely because we expect (and at least one court found that) a parodic use to cause some kind of harm (tarnishment).¹⁶⁰ If this is true, proving harm will be easy in many cases where the defendant uses the mark in a parodic fashion. So simply requiring a plaintiff to prove harm will provide no protection for parodic uses. For these reasons, the No Harm Approach is not suited to provide protective cover for parody.

3. *Per Se Non-Diluting*

In some cases, courts will find that a parodic use simply does not dilute a famous mark. In *World Wrestling Federation Entertainment, Inc. (WWE) v. Big Dog Holdings, Inc.*,¹⁶¹ for example, the court was confronted with T-shirts that displayed caricatures (such as “Bone Cold Steve Pawstin”) of World Wrestling Federation characters (such as Stone Cold Steve Austin).¹⁶² Looking to other similar cases for guidance on the dilution claim, the court found that a parodic use was unlikely to erode the public’s identification with the parodied (that is, the original) mark.¹⁶³ To the contrary, the parodic use would likely increase such identification by reaffirming the original meaning to make a parody.¹⁶⁴

This approach is similar to what I argued for in my previous article on parody in copyright: parody should be considered per se fair use. The Per Se Non-Diluting Approach proposes essentially the same thing: if the use is a parody, it does not dilute the original. That is fine, as far as it goes. But a rigid parody defense might also have negative consequences. Because parody is often contrasted to satire (which is usually not protected), the defense may encourage courts to adopt a narrow definition of parody (as opposed to satire) to avoid the risk of allowing

159. *Id.* at 799.

160. *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 777 (8th Cir. 1994) (noting that survey results showed people thought negatively of the plaintiff’s mark as a result of the defendant’s parodic use).

161. 280 F. Supp. 2d 413 (W.D. Pa. 2003).

162. *Id.* at 420.

163. *Id.* at 441 (citing *Jordache Enters., Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987)).

164. *Id.*

or appearing to allow expansive uses of trademarks without the owner's permission. If that occurs, the defense could actually harm parodists, whose rights could decrease if the definition is cabined too much. (This scenario differs from copyright where a fair use defense is available even if the court finds the work is not a parody.)

Perhaps the biggest shortcoming of the *per se* defense, though, is also its strength: it immunizes all parodic uses from liability. Because the degree to which parody is immunized depends upon the term's definition, any balancing of interests occurs *ex ante*; that is, once we settle upon a definition, we cannot later reweigh the interests. That said, the *per se* defense has merit in recognizing a particular form of expressive speech that deserves protection from overzealous trademark owners. Below, I attempt to massage this virtue into a scheme that uses a *presumption* of fairness for parodies. To reduce the risk of speech suppression, I suggest we define parody in trademark more broadly than in copyright.

4. *No Confusion*

Other courts have decided that parody determinations should be the same for infringement and dilution. That was what the court did in *Kane v. Comedy Partners*,¹⁶⁵ holding that the defendant's parodic use eliminated any potential confusion.¹⁶⁶ After making that finding, the court held that no dilution existed (under state law) "[f]or the same reasons identified in the discussion of plaintiff's federal trademark claim."¹⁶⁷

This standard need not detour us long. Confusion is not an element of dilution under federal law (or state law). For this reason alone, we can discard the No Confusion Approach. Still, it is worth noting that the court was applying the *same* standard—whatever it was—to confusion and dilution parody defenses. Whether that is a good idea is an important question. Some have argued for identical standards.¹⁶⁸ But like the differences between copyright law and trademark law, the differences between dilution and infringement are important.

Even a little digging shows that the two require different defenses, even if they define parody identically. In Part III.A, for example, I propose a parody presumption for the confusion analysis. The plaintiff

165. No. 00 Civ. 158(GBD), 2003 WL 22383387 (S.D.N.Y. Oct. 16, 2003).

166. *Id.* at *8.

167. *Id.*

168. Duncan, *supra* note 90, at 243.

can rebut this presumption by showing that the defendant used the mark on closely related products sold by a direct competitor. That standard makes sense in the infringement context, where trademark law is worried about consumer confusion. But in the dilution context, trademark law is worried about the trademark's "image"—its distinctiveness—not confusion. Thus, the same kind of parody presumption makes little sense in dilution because dilution claims should not include parodic uses of marks on competing products. They will instead include claims where no consumer would be confused about who made the products or services on which the parodic mark appears. Thus, a new dilution test for parody should differ from the test used in the infringement analysis.

5. *Infusion (Blurring Only)*

The previous Part demonstrated that courts analyzing traditional infringement actions let parody color the likelihood of confusion factors. At least one court also has analyzed dilution by blurring in the same manner. In *Louis Vuitton II*, the court noted that "the fact that the defendant uses its marks as a parody is specifically relevant to several of the listed factors":

[F]actor (v) (whether the defendant intended to create an association with the famous mark) and factor (vi) (whether there exists an actual association between the defendant's mark and the famous mark) directly invite inquiries into the defendant's intent in using the parody, the defendant's actual use of the parody, and the effect that its use has on the famous mark. While a parody intentionally creates an association with the famous mark in order to be a parody, it also intentionally communicates, if it is successful, that it is *not* the famous mark, but rather a satire of the famous mark.¹⁶⁹

Parody similarly influenced the application of other factors, such as the similarity between the marks, the distinctiveness of the famous mark, and its famousness.¹⁷⁰ "Indeed, by making the famous mark an object of the parody," the court reasoned, "a successful parody might actually enhance the famous mark's distinctiveness by making it an icon."¹⁷¹

The Infusion Approach has some benefits as well as drawbacks. It

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

170. *Id.*

171. *Id.*

changes the dilution analysis to favor speech interests, just as the Infusion Approach does in the infringement analysis. The similarity of the two tests also means they share the same weakness: altering the factors is not a *defense* to dilution. Instead, it is a reframing of the *dilution* inquiry. For that reason, the test by itself is insufficient to protect speech interests.

6. *Standard Dilution*

Courts unconvinced by the merit of special treatment for parody will apply a standard dilution analysis. In other words, they will assess the dilution claim in parody cases as they would in any other case. The court in *Anheuser-Busch, Inc. v. Balducci Publications*¹⁷² used this approach when deciding whether tarnishment existed from an ad depicting Michelob beer as containing oil, which appeared in a “humor magazine” called *Snicker*.¹⁷³ The ad related to an oil spill affecting the water source that Anheuser-Busch used for its beer.¹⁷⁴ Under Missouri state law dilution, the court held (based on “the majority of those surveyed”) that the parodic advertisement “suggest[ed] that Michelob beer contains oil, [which] . . . obviously tarnishes the marks’ carefully-developed images.”¹⁷⁵

What is strange about this analysis is not that the court found tarnishment, but that it did so based expressly on the parodic nature of the use. That gets it wrong. One purpose of the First Amendment is to prevent others—in this case, trademark owners—from silencing speech that they do not like.¹⁷⁶ Why that statement should be less true in a commercial setting, particularly when the use is “truthful” or non-misleading, is not clear. The fact that the ad was a parody and casted Michelob in a negative light is just the point. But the *Balducci* court did not assess the First Amendment interests at stake. In this way, it made a crucial analytical mistake.

172. 28 F.3d 769 (8th Cir. 1994).

173. *Id.* at 772.

174. *Id.*

175. *Id.* at 777.

176. *See, e.g.,* L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 33 (1st Cir. 1987) (“If the anti-dilution statute were construed as permitting a trademark owner to enjoin the use of his mark in a noncommercial context found to be negative or offensive, then a corporation could shield itself from criticism by forbidding the use of its name in commentaries critical of its conduct.”); *see also* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25(2) cmt. *i* (1995) (explaining that expanding nontrademark dilution to cover nontrademark uses implicates free speech concerns and is better addressed by other causes of action).

That mistake seems obvious when comparing other parody dilution cases. As Table 3 shows, no matter what method courts used, all of them found no dilution existed—all, that is, except the *Balducci* court.

TABLE 3. PARODY CASES CITING *CAMPBELL* & FINDING TRADEMARK AND/OR TRADEMARK DILUTION

	<i>Trademark Infringement (%)</i> *	<i>No Trademark Infringement (%)</i>	Total (%)
<i>Trademark Dilution</i>	0 (0)	1 (7)	1 (7)
<i>No Trademark Dilution</i>	2 (100)	12 (93)	14 (93)
Total	2 (100)	13 (100)	15 (100)

*I excluded from this table one case¹⁷⁷ that found no trademark dilution, and then found both no trademark infringement and trademark infringement as to two separate marks.

II. *CAMPBELL* AS A LENS: THE RELATIONSHIP BETWEEN PARODY CLAIMS IN COPYRIGHT AND TRADEMARK LAW

A. *Parody Cases Citing Campbell: Trademark Infringement and Dilution Cases*

Part I examined a variety of approaches courts use to evaluate parody claims in trademark law. This Part examines how courts treat parody claims in trademark relative to parody claims in copyright. It does this first with a description of whether copyright and trademark parody claims relate to each other. Once that description is adumbrated, we can begin to examine how and why a relationship (if any) exists. To narrow our focus, we will again focus on cases citing *Campbell*.

Courts that cite or discuss *Campbell*'s statements about parody use *Campbell*'s pronouncements on parody differently. Of the twenty-five trademark cases that cite or discuss *Campbell*'s statements about parody,¹⁷⁸ only thirteen specifically cite *Campbell* in the trademark (or

177. *Elvis Presley Enters., Inc. v. Capece (Elvis Presley I)*, 950 F. Supp. 783 (S.D. Tex. 1996).

178. *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC (Louis Vuitton II)*, 507 F.3d 252 (4th Cir. 2007); *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003); *Mattel, Inc. v. MCA Records, Inc. (Mattel III)*, 296 F.3d 894 (9th Cir. 2002); *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806 (2d Cir. 1999); *Lyons P' ship v. Giannoulas (Giannoulas II)*, 179 F.3d 384

First Amendment) analysis of parody.¹⁷⁹ Some courts assert that *Campbell* is relevant to the parody determination in trademark.¹⁸⁰ One court that mentioned *Campbell* expressly disclaimed reliance on it for trademark parody analysis,¹⁸¹ another court distinguished *Campbell* in

(5th Cir. 1999); *Elvis Presley Enters., Inc. v. Capece (Elvis Presley II)*, 141 F.3d 188 (5th Cir. 1998); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc. (Dr. Seuss II)*, 109 F.3d 1394 (9th Cir. 1997); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996); *Anheuser-Busch, Inc.*, 28 F.3d 769; *CCA & B, LLC v. F + W Media Inc.*, 819 F. Supp. 2d 1310 (N.D. Ga. 2011); *Protectmarriage.com v. Courage Campaign*, 680 F. Supp. 2d 1225 (E.D. Cal. 2010); *Burck v. Mars, Inc.*, 571 F. Supp. 2d 446 (S.D.N.Y. 2008); *Burnett v. Twentieth Century Fox Film Corp.*, 491 F. Supp. 2d 962, 967–69 (C.D. Cal. 2007) (finding the work could be reasonably perceived as a parody and then holding use was fair); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC (Louis Vuitton I)*, 464 F. Supp. 2d 495 (E.D. Va. 2006); *Mastercard Int'l Inc. v. Nader 2000 Primary Comm., Inc.*, No. 00 Civ.6068(GBD), 2004 WL 434404 (S.D.N.Y. Mar. 8, 2004); *World Wrestling Fed'n Entm't, Inc. (WWE) v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413 (W.D. Pa. 2003); *Kane v. Comedy Partners*, No. 00 Civ. 158(GBD), 2003 WL 22383387 (S.D.N.Y. Oct. 16, 2003); *N.Y. Stock Exch., Inc. v. Gahary*, 196 F. Supp. 2d 401 (S.D.N.Y. 2002); *Charles Atlas, Ltd. v. DC Comics, Inc.*, 112 F. Supp. 2d 330 (S.D.N.Y. 2000); *Lyons P'ship v. Giannoulas (Giannoulas I)*, 14 F. Supp. 2d 947 (N.D. Tex. 1998); *Mattel, Inc. v. MCA Records, Inc. (Mattel II)*, 28 F. Supp. 2d 1120 (C.D. Cal. 1998); *Mattel, Inc. v. MCA Records, Inc. (Mattel I)*, No. CV 97-6791 WMB, 1998 WL 422641 (C.D. Cal. Feb. 18, 1998); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc. (Dr. Seuss I)*, 924 F. Supp. 1559 (S.D. Cal. 1996); *Elvis Presley I*, 950 F. Supp. 783; *Schieffelin & Co. v. Jack Co. of Boca, Inc.*, 850 F. Supp. 232 (S.D.N.Y. 1994).

179. *Mattel III*, 296 F.3d at 901–02 (discussing parody and citing *Campbell* in its First Amendment analysis under the *Rogers* test, and not engaging in the confusion analysis); *Grottanelli*, 164 F.3d at 813; *Giannoulas II*, 179 F.3d at 388 (citing *Campbell* to define parody); *Elvis Presley II*, 141 F.3d at 199 (noting *Campbell* as relevant to the parody question in trademark law and using it to define parody); *Balducci Publ'ns*, 28 F.3d at 776 (citing *Campbell* in discussion of First Amendment principles explaining why it did not negate confusion); *Protectmarriage.com*, 680 F. Supp. 2d at 1228 n.3; *Burck*, 571 F. Supp. 2d at 455 (quoting *Campbell* for propositions that defendant's use must comment on the plaintiff's mark, and that a parody can shed new light on the original); *N.Y. Stock Exch.*, 196 F. Supp. 2d at 411–12 (citing “reasonable perception” language and quoting *Campbell* for propositions as to First Amendment interests, and finding that a parody finding informs the trademark analysis); *Charles Atlas*, 112 F. Supp. 2d at 337–41 (defining parody using *Campbell* under the First Amendment analysis and having that inform its trademark analysis); *Giannoulas I*, 14 F. Supp. 2d at 953 (citing *Campbell* in good-faith intent portion of analysis); *Mattel II*, 28 F. Supp. 2d at 1134, 1142 (citing *Campbell* using “see also” signal for proposition that parody must focus on original, and also citing it in its discussion about how a parody can comment on associations people have with marks); *Mattel I*, 1998 WL 422641, at *12 (discussing *Campbell* and the definition of parody when analyzing the similarity of the marks in the confusion analysis); *Elvis Presley I*, 950 F. Supp. at 792 (quoting *Campbell* when defining parody when analyzing the strength of the mark).

180. *Elvis Presley II*, 141 F.3d at 199 (noting that *Campbell* “is relevant to the treatment of parody in the trademark context”); *Grottanelli*, 164 F.3d at 813 (“[T]rademark parody must be informed by the Supreme Court's recent elucidation in the copyright context of parodies allegedly protected by the defense of fair use.”).

181. *Schieffelin*, 850 F. Supp. at 249 n.9 (“The *Acuff-Rose* decision does not impact the court's decision here, inasmuch as the interests protected under the Lanham Act are not identical to those of the copyright holder.”).

passing,¹⁸² and yet another implied that it was not relevant to trademark parody claims.¹⁸³ No court cited *Campbell* in its dilution analysis.

Exactly how these courts analyze parody within each method is different. Some courts, for example, incorporate copyright case law by analyzing trademark parodies using *Campbell*.¹⁸⁴ Other courts simply apply trademark case law to the parody question, ignoring *Campbell* altogether.¹⁸⁵

More importantly, in cases with copyright and trademark infringement claims, some courts tend to decide the parody question (is the defendant's work a parody?) in the copyright context, and then apply that finding summarily to the remaining trademark-parody question (is the defendant's use of the plaintiff's mark confusing?).¹⁸⁶ In these cases, courts will make a finding as to copyright parody, relying on *Campbell*, and then analyze the trademark parody claim as if the copyright analysis of whether a parody existed applied equally to the trademark parody claim, engaging in little or no analysis of the latter issue. Thus, the copyright parody question sometimes is determinative of the trademark parody question.

182. *Protectmarriage.com*, 680 F. Supp. 2d at 1228 n.3 (“In this regard, the Lanham Act is unlike the Copyright Act. The Copyright Act includes a specific statutory provision defining “fair use” as non-infringing, 17 U.S.C. § 107, and this statutory provision protects parody.” (citing *Campbell v. Acuff-Rose Music*, 510 U.S. 569 (1994))).

183. *Louis Vuitton II*, 507 F.3d at 269 (“Finally, LVM argues that the district court erred in finding that Haute Diggity Dog’s use of the ‘CV’ and the background design was a fair use of LVM’s copyrighted Multicolor design. Because LVM attempts to use a copyright claim to pursue what is at its core a trademark and trade dress infringement claim, application of the fair-use factors under the Copyright Act to these facts is awkward.” (citing 17 U.S.C. § 107; *Campbell*, 510 U.S. at 577)).

184. See, e.g., *Elvis Presley II*, 141 F.3d at 199; see also *supra* Tables 1 & 2 (including cases that cite *Campbell* but do not involve a copyright claim).

185. E.g., *Schieffelin*, 850 F. Supp. at 249 n.9 (disclaiming reliance on *Campbell*).

186. *World Wrestling Fed’n Entm’t, Inc. (WWE) v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413, 430 (W.D. Pa. 2003); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc. (Dr. Seuss II)*, 109 F.3d 1394, 1400–01, 1405 (9th Cir. 1997) (finding a parody did not exist in the copyright realm, not examining parody in depth in the trademark analysis, and concluding the defendant infringed the plaintiff’s mark); *Kane v. Comedy Partners*, No. 00 Civ. 158(GBD), 2003 WL 22383387, at *3–8 (S.D.N.Y. Oct. 16, 2003); *Lyons P’ship v. Giannoulas (Giannoulas I)*, 14 F. Supp. 2d 947, 952, 954–55 (N.D. Tex. 1998), *aff’d*, 179 F.3d 384, 388 (5th Cir. 1999). In *Kane*, the court spent a considerable amount of time analyzing whether the copyrighted work at issue parodied the underlying work—a clip from the plaintiff’s show where she is dancing and singing the song, “I Love Dick.” 2003 WL 22383387, at *2. Then, in its assessment of the Lanham Act claim for the mark “The Sandy Kane Comedy T.V. Show,” which was displayed on the video, the court determined “clear[ly] that someone else’s work is being displayed and ridiculed.” *Id.* at *8. At least one other court has analyzed parody using what it saw as different standards in copyright and trademark. *CCA & B, LLC v. F + W Media Inc.*, 819 F. Supp. 2d 1310 (N.D. Ga. 2011).

Take, for example, the district court's decision in *Dr. Seuss I*¹⁸⁷ There the defendant had written a book about O.J. Simpson's trial and had used Dr. Seuss' style and trademarks—and similar images—to describe the story, which the defendant titled, *A Cat NOT in the Hat*.¹⁸⁸ The plaintiff sued for copyright and trademark infringement.

Before reaching the trademark question, the court analyzed the parody issue in the copyright context. It found that one of the defendant's works was not a parody and two were.¹⁸⁹ When analyzing the (various) trademarks at issue, the court seemed to assume that the defendant used the marks (but not the trade dress) in a parodic fashion, apparently letting the copyright finding flow into the trademark analysis. As a result, the *copyright parody finding* altered the *trademark likelihood confusion factors*—the strength of the marks,¹⁹⁰ the marks' similarity,¹⁹¹ and the defendant's intent¹⁹²—in the defendant's favor. Of course, that did not save the defendant,¹⁹³ as the district court granted a preliminary injunction, which the appeals court affirmed.¹⁹⁴

Viewing all these approaches together, it becomes apparent that courts have developed three methods of parody analysis. Where the plaintiff alleges copyright and/or trademark infringement claims and the defendant asserts its work or mark is a parody, the courts:

- (1) determine parody in its copyright analysis using *Campbell* and summarily applies that finding to its trademark (or First Amendment) analysis;
- (2) determine parody in its trademark analysis, drawing on *Campbell* to define or articulate reasoning or conclusion; or
- (3) determine parody using only trademark case law.

The question then becomes whether any of these approaches is more appropriate than the others. Answering that question requires us to determine to what extent copyright and trademark claims are linked.

The data show different relationships between copyright infringement

187. 924 F. Supp. 1559 (S.D. Cal. 1996), *aff'd*, 109 F.3d 1394 (9th Cir. 1997).

188. *Id.* at 1561.

189. *Id.* at 1570.

190. *Id.* (“The fact of copying, admitted in any parody case, is itself evidence of the strength of the marks.”).

191. *Id.* at 1570–71 (noting that the defendant's book had a subtitle of “A Parody” and the author's name as “Dr. Juice”).

192. *Id.* at 1571 (noting intent to parody does not weigh against the defendant and that “[t]he prominent labeling of the work as ‘A Parody,’ and the disclaimer sticker on the back indicate that this factor should weigh in favor of Penguin”).

193. *Id.* at 1562.

194. F.3d 1394 (9th Cir. 1997).

and trademark infringement and dilution. Table 4 shows the relationship between copyright and dilution infringement findings. There is only one case in which a court found dilution, and it occurred in a case where no copyright claim existed. In the seven cases where courts found copyright infringement, no court found dilution. Thus, it does not appear there is a relationship between dilution and copyright parody findings. It follows, then, that the data do not reveal a relationship between *Campbell* and dilution claims.

TABLE 4. PARODY CASES CITING *CAMPBELL* & FINDING COPYRIGHT OR TRADEMARK DILUTION

	<i>Copyright Infringement (%)</i>	<i>No Copyright Infringement (%)</i>	<i>No Copyright Claim (%)</i>	Total (%)
<i>Trademark Dilution</i>	0 (0)	0 (0)	1 (12)	1 (6)
<i>No Trademark Dilution</i>	7 (100)	2 (100)	7 (88)	16 (94)
Total	7 (100)	2 (100)	8 (100)	17 (100)

*One case¹⁹⁵ that found trademark infringement and no trademark infringement as to two separate marks. This decision was excluded from calculations

The story is different, however, for trademark infringement claims. As Table 5 shows, in every case where a plaintiff alleged both copyright and trademark infringement, courts made corresponding infringement findings: if a court found that no copyright infringement existed, it also found no trademark infringement—and vice versa.

195. *Elvis Presley Enters., Inc. v. Capece (Elvis Presley II)*, 950 F. Supp. 783 (S.D. Tex. 1996).

TABLE 5. PARODY CASES CITING *CAMPBELL* FINDING
COPYRIGHT OR TRADEMARK INFRINGEMENT

	<i>Copyright Infringement (%)</i>	<i>No Copyright Infringement (%)</i>	<i>No Copyright Claim (%)*</i>	Total (%)
<i>Trademark Infringement</i>	2 (100)	0 (0)	3 (25)	5 (22)
<i>No Trademark Infringement</i>	0 (0)	9 (100)	9 (75)	18 (78)
Total	2 (100)	9 (100)	12 (100)	23 (100)

*I excluded from this table one case¹⁹⁶ that found no copyright infringement then found both no trademark infringement and trademark infringement as to two separate marks.

More specifically, there were eight cases where courts found no copyright infringement. In all of these cases the courts also found no trademark infringement. By contrast, in the two cases where courts found copyright infringement, the courts also found trademark infringement. At least in trademark parody cases citing *Campbell*, some relationship exists between infringement findings in copyright and trademark—and between the use of *Campbell* and the parody doctrine in each.

What is occurring in the remaining twelve cases (citing *Campbell*) where only a trademark parody was at issue is less clear. Focusing on the three cases in which the defendant's parody defense failed might help clarify things.¹⁹⁷ If these cases share similarities, they might tell us something about why, methodologically, the courts find parodies infringing. These cases also might give use clues as to how the incorporation or exclusion of *Campbell* influences courts' decisions.

These three cases teach two basic lessons. First, the outcomes in each case are a function of how extensively the court incorporates the parody into the likelihood of confusion analysis. Second, these courts have either expressly applied *Campbell* to trademark law, or disclaimed it. Just why they have done so raises important issues, as we will see in a moment.

196. *Id.*

197. *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812–13 (2d Cir. 1999); *Elvis Presley II*, 141 F.3d 188; *Schieffelin & Co. v. Jack Co. of Boca, Inc.*, 850 F. Supp. 232 (S.D.N.Y. 1994).

Let us start with *Schieffelin & Co. v. Jack Co. of Boca, Inc.*¹⁹⁸ The product at issue was a Dom Poppingnon label, which the defendant had affixed to a plastic champagne bottle filled with popcorn seeds.¹⁹⁹ When the owners of the Dom Pérignon mark (used on Champagne) sued, the defendant claimed the use of the mark was to parody Dom Pérignon.²⁰⁰ The court held the Dom Poppingnon mark infringed.²⁰¹ The question is, why?

The answer lies in the two lessons I mentioned above. First, the court minimally incorporated speech concerns. Although the court purported to use an “infusion” approach—weaving First Amendment/parody considerations into the likelihood of confusion analysis—it did so only with two of the eight *Polaroid* factors.²⁰² As to the “good faith” *Polaroid* factor, the court analyzed it in light of the parody.²⁰³ It found the defendant had an intent to parody, which meant that the factor did “not weigh against defendants.”²⁰⁴ As to the similarity of the marks, the court recognized that the defendant selected a well-known mark because “one would hardly make a spoof of an obscure or unknown product[.]”²⁰⁵

Yet, in analyzing the other confusion factors, the court paid little attention to First Amendment (or parodic) considerations. So, for example, it did not apply any parody considerations to its analysis of the strength of the plaintiff’s mark²⁰⁶—something other courts finding parody, such as *Louis Vuitton II*²⁰⁷ (discussed in Part I)—have done.²⁰⁸ The court also failed to discuss the issue of parody in its analysis of the similarity of the products,²⁰⁹ the likelihood of bridging the gap,²¹⁰ the

198. 850 F. Supp. 232.

199. *Id.* at 235.

200. *Id.*

201. *Id.* at 253.

202. *See* *Polaroid Corp. v. Polaroid Elects. Corp.*, 287 F.2d 492 (2d Cir. 1961), *cert. denied*, 368 U.S. 820 (1961) (listing eight factors to help assess the likelihood of confusion).

203. *Schieffelin*, 850 F. Supp. at 247–48 (“Although resolution of the issue of parody implicates other factors in the *Polaroid* test, most particularly the similarity of the marks and the existence of actual confusion, the court will address those issues here.”).

204. *Id.* at 248.

205. *Id.*

206. *See id.* at 243–44.

207. 507 F.3d 252, 261 (4th Cir. 2007) (“While it is true that finding a mark to be strong and famous usually favors the plaintiff in a trademark infringement case, the opposite may be true when a legitimate claim of parody is involved.”).

208. *Schieffelin*, 850 F. Supp. at 242–44.

209. *Id.* at 244–45.

210. *Id.* at 245.

quality of the defendant's products,²¹¹ or the sophistication of the purchasers.²¹²

Second, the *Schieffelin* court explicitly held that *Campbell* did not apply to trademark law. "The [*Campbell v.*] *Acuff-Rose* decision," the court wrote, "does not impact the court's decision here"²¹³ Why? Because "the interests protected under the Lanham Act are not identical to those of the copyright holder."²¹⁴ But the court never went on to say how the interests of trademark users are different from copyright users. Nor, for that matter, did the court even mention the fact that the *rights* of a trademark owner may be different from the rights of a copyright owner. Finally, it didn't mention other possible interests, or how these rights and interests may interact or differ from those in copyright.

The two lessons from *Schieffelin* also can be seen in *Elvis Presley II* and *Harley-Davidson, Inc. v. Grottanelli*.²¹⁵ *Elvis Presley II* involved defendants who owned a 1960s-themed nightclub called "The Velvet Elvis," which served food, beer, and liquor, and which also featured live music.²¹⁶ In *Grottanelli*, the defendant owned a motorcycle repair shop that used a bar-and-shield logo similar to Harley-Davidson's on his trademark/logo, which was used in advertisements.²¹⁷

Recall the first lesson from *Schieffelin* was that the court tightly constrained the parody analysis to more easily find confusion. Likewise, in both *Elvis Presley II* and *Grottanelli*, we see similar kinds of analytical "constraining." In *Elvis Presley II*, for instance, the court—rather than focus on how the parody *informed* the confusion analysis (and restrict it tightly)—applied "parody" as "one . . . other relevant factor that a court may consider in a likelihood-of-confusion analysis."²¹⁸ This analytical maneuver allowed it to reverse both the lower court's finding of noninfringement and its "infusion" analysis.²¹⁹

211. *Id.* at 250. The court found this factor "neutral" because popcorn did not compete with champagne.

212. *Id.* In this factor, the court still found it weighed in favor of the defendants.

213. *Id.* at 249 n.9 (citing *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema*, 604 F.2d 200, 205–06, n.9 (2d Cir. 1979)).

214. *Id.*

215. 164 F.3d 806 (2d Cir. 1999).

216. 141 F.3d 188, 192 (5th Cir. 1998).

217. 164 F.3d at 809.

218. 141 F.3d at 194.

219. *Id.* at 200 (noting that "the district court made determinations on five of the seven digits of confusion which either ignored relevant advertising evidence or relied upon the Defendants' parody of the sixties lounge scene. These errors have permeated the district court's findings of fact on the likelihood of confusion and on each of those digits of confusion.").

Whereas *Elvis Presley II* limited the impact of parody by treating it as a separate factor, *Grottanelli* did so explicitly by explaining the competing product itself could not as readily function as a parody. It noted first that “[t]he signage on [the defendant’s] business is, in effect, trademark use for a competing service, since Harley-Davidson offers motorcycle repair services through its authorized dealers, and Grottanelli’s placement of his bar-and-shield logo on his newsletter and T-shirts promotes his repair and parts business.”²²⁰ Because the defendant offered a competing service, the court held that, “[i]n this context, parodic use is sharply limited.”²²¹

In addition to narrowing their analyses, both courts, like *Schieffelin*, mentioned *Campbell*’s relevance to the trademark parody dispute before them. But unlike the *Schieffelin* court—which expressly disclaimed *Campbell*—the courts in *Grottanelli* and *Elvis Presley II* expressly endorsed and applied *Campbell*. “The Supreme Court’s parody explication [in *Campbell*] as to [expressive] copyright[able] work[s],” the *Grottanelli* court stated, “is relevant to trademarks, especially a trademark parody that endeavors to promote primarily non-expressive products such as competing motorcycle repairs.”²²² In this context, the court found that that the defendant’s parody was weak. It did not—as *Campbell* required—adequately target the original.²²³

This same rationale was also used by the court in *Elvis Presley II*. Like in *Grottanelli*, the *Elvis Presley II* court first noted that, although it had “yet to consider parody in relation to trademark law[,] . . . the Supreme Court [in *Campbell*] considered parody in the copyright context, which is relevant to the treatment of parody in the trademark context.”²²⁴ Then, unlike the *Schieffelin* court, the *Elvis Presley II* court explained what parts of *Campbell* applied. It claimed that, to render it noninfringing, parody in trademark—like parody in copyright—must target the original for comment or criticism.²²⁵

What is interesting about *Elvis Presley II*, *Grottanelli*, and *Schieffelin*

220. *Grottanelli*, 164 F.3d at 812–13.

221. *Id.* at 813.

222. *Id.* (citation omitted).

223. *Id.* (“Grottanelli’s mark makes no comment on Harley’s mark; it simply uses it somewhat humorously to promote his own products and services, which is not a permitted trademark parody use.”).

224. *Elvis Presley II*, 141 F.3d at 199 (citing *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 776 (8th Cir. 1994); 6 MCCARTHY, *supra* note 17, § 31:153; Myers, *supra* note 17, at 181).

225. *Id.* at 199–200 (“[A] parody of a mark needs to mimic the original mark and from this necessity arises the justification for mimicry, but this necessity wanes when the original mark is not the target of parody.”).

is that they invoke similar analytical techniques, but disagree on the applicability of *Campbell*. This disagreement raises an important question for courts dealing with trademark parody: should *Campbell* apply and, if so, to what extent?

B. Campbell's Lessons for Trademark Law

In this subpart I suggest that a trademark parody doctrine—while using a few basic lessons from *Campbell*—should be more expansive than the one announced by the Supreme Court. I suggest this because of several differences between copyright and trademark law.

In the first instance, it is helpful to say whether we should adopt a *Campbell*-like definition of parody. That is, should we provide a parody/satire-like framework from which to determine whether parody exists? The answer is both yes and no. The answer is “yes” because the parody/satire distinction can help define the relevant *kind* of uses the legal concept of parody covers—even if we decide, as I urge later, that the variety of uses covered by parody should expand. Part of this incorporation is also practical: for all the differences between copyright and trademark law, they both must account for similar speech interests—First Amendment interests.²²⁶ Just *how* each regime accounts for each interest, however, will be different. And so here we can invoke the answer “no” to the previous question. We shall see that, due to a variety of differences between copyright and trademark, the protection afforded to parody and satire should be, as a matter of doctrine, broader in trademark law than in copyright. Thus, although both copyright and trademark law ought to and do advance interests of expressive speech, their protection of each will look different legally.

The distinct purposes of copyright and trademark law suggest that the test—or at least the scope of the test—for each will be different. Trademark law, unlike copyright, is not designed to provide a monopoly right; it is designed to prevent, among other things, consumer deception. Indeed, trademark law has mechanisms that prevent monopoly control. Descriptive marks (with no secondary meaning),²²⁷ or names that are,²²⁸ or marks that become, generic²²⁹ are not given any rights whatsoever.²³⁰

226. Others have explored these differences too. See Jaroff, *supra* note 17, at 664–66.

227. 15 U.S.C. § 1052(e)(1) (2006) (stating that one cannot register a mark that is “merely descriptive or deceptively misdescriptive” of the goods to which it is affixed).

228. 2 MCCARTHY, *supra* note 17, § 12:1 (“[A] generic name of a product can never function as a trademark to indicate origin.” (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 15, cmt. a (1995))).

229. David A. Simon, *Register Trademarks and Keep the Faith*, 49 IDEA 233, 247 (2009)

Unlike copyrights, which are expressly designed to provide monopoly power for a limited time, trademarks serve the same purpose (preventing consumer fraud) throughout their entire existence. This is important because the key question for fair use is whether the parody causes market harm.²³¹ If it does not, copyright excuses the use. That is, indeed, one of *Campbell's* lessons.²³²

Although *Campbell's* specific focus on market harm to a monopoly right may not be appropriate for trademark, the idea of market harm itself is not foreign to trademark law. The difference between copyright and trademark is that each is concerned with a separate the *kind* of market harm, with trademark's harm being more narrowly cabined by the law's purpose. In copyright, the *Campbell* court worried about a substitution problem: will the work at issue provide an adequate alternative to the original? If so, then the copyright owner suffers harm and the work is not a parody. So, for example, the lyrics of 2-Live Crew's *Pretty Woman* did not risk substituting for those purchasing of Roy Orbison's *Oh Pretty Woman*.²³³ *Campbell's* emphasis on substitution reflects copyright law's more general concern for the harm a potential work might cause to the *entire* market for the original. The concept of the entire market has grown to include markets for derivative works, and, indeed, markets for almost any potential use of the original.

Trademark, by contrast, is concerned with a different kind of harm than copyright, and it has two components: harm to the consumer (purchasing the wrong good) and harm to the markholder (lost or diverted sales). The consumer is harmed when she buys one product while intending to buy another. This means she may have bought goods of a quality other than she expected. As a result of such deception, she receives the "wrong" goods. Note this is different from the harm in copyright, which requires no likelihood of confusion; it requires only

("Trademarks can also *become* generic by losing their source-identification value if used too often in inconsistent ways, or in ways that rob them of their source-identifying function.")

230. Other limitations include things like marks that are functional. 15 U.S.C. § 1115(b)(8) (listing functionality as a defense to an incontestable mark).

231. *See, e.g.,* Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 566 (1985) ("This last factor [effect on the market] is undoubtedly the single most important element of fair use.")

232. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 591 (1994) ("But when, on the contrary, the second use is transformative, market substitution is at least less certain, and market harm may not be so readily inferred. Indeed, as to parody pure and simple, it is more likely that the new work will not affect the market for the original in a way cognizable under this factor, that is, by acting as a substitute for it ('superseded[ing] [its] objects').")

233. The Court remanded on the question of whether the defendant took more of the music than necessary. *Id.* at 589.

that the good provide an adequate substitute for the original. Thus, the markholder is harmed not just because the competing product was an adequate substitute for the original. Rather, harm occurs because the consumer's confusion over the source of the product results in lost sales or reputation (particularly if the goods are of worse quality) of the markholder's product or service.

Lost sales and reputational harms do not necessarily occur when confusingly similar marks are used on products, services, or other objects not authorized by the mark owner.²³⁴ The nature and context of the use in question is what makes the harm more or less likely to occur. So harm to sales and reputation based on confusion is most likely to occur when the plaintiff's and defendant's mark appear on similar goods sold to similar markets. Thus, a pair of moon boots bearing the mark Twizzies are less likely to cause consumer confusion with Twizzler's licorice than chewing gum bearing the same mark. So where consumers are most likely to be misled—on goods or services closely related to the ones on which the original mark appears—trademark harm occurs and the law seeks to prevent it.

But the market harm here is quite narrow, so that dissimilar goods or dissimilar purchasers make harm unlikely—even if there is a “potential” market for the mark. Thus, *Campbell* teaches that market harm can be a relevant component to any parody analysis of trademark law. It also demonstrates that “market harm” means something different—something narrower—in trademark than in copyright. Trademark “market harm” occurs only where goods are closely related, sold in similar markets, and using confusingly similar marks. Potential substitution—which copyright uses to determine infringement in the parody context—is not by itself the test for infringement in trademark law. Why? Because it is likely that for any given good, there are many competing goods, some or all of which may serve as adequate market substitutes. Trademark harm, then, occurs only when those similar products or services have affixed to them a confusingly similar mark, or when the use of a mark implies sponsorship or endorsement. This conclusion is also true for the concept of dilution, which is not concerned with market harm *at all*. Dilution is concerned, rather, with harm to the reputation of the mark, not the market in which it is sold. Thus, as Dogan and Lemley note, harm occurs when a nearly identical mark appears on a good of lower quality (tarnishment) or on an

234. For a recent exploration of confusion and its overgrowth in trademark law, see William McGeeveran & Mark McKenna, *Confusion Isn't Everything*, NOTRE DAME L. REV. (forthcoming 2013).

unrelated good (blurring).

Second, the constitutional basis for trademark law is weaker than the legal basis for copyright law. A specific Constitutional provision (Article I, Section 8, Clause 8) provides authors with legal rights (copyrights) to exploit their work for money.²³⁵ But trademark law has no analogous provision. Instead, it grows from the Commerce Clause²³⁶—a clause that stands as the basis for numerous statutes and regulations, not just trademark law.²³⁷ Indeed, it took the Supreme Court fifty-three years from the adoption of the U.S. Constitution (including the Bill of Rights) to grant relief on a trademark claim.²³⁸

The Constitution empowers copyright law but gives no similar priority to trademark law. This suggests that trademark law should be weaker than copyright law with respect to how strongly it regulates speech. In many respects, this is true. But in other respects trademark rights are at least as strong as copyright rights. In the context of the First Amendment, in particular, this important difference has not attracted much judicial attention. Indeed, the idea that First Amendment safeguards *exist* in trademark law is usually deemed sufficient. The same is true in copyright, where a once-promising standard to ensure First Amendment limits on copyright²³⁹ failed to materialize into anything

235. U.S. CONST. art. I, § 8, cl. 8 (“The Congress shall have power . . . [t]o promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries . . .”).

236. *See* U.S. CONST. art. I, § 8, cl. 3 (“The Congress shall have power . . . [t]o regulate commerce with foreign nations, and among the several states, and with the Indian tribes . . .”); *The Trade-Mark Cases*, 100 U.S. 82, 93–94 (1879) (holding that Article I, Section 8, Clause 8 of the U.S. Constitution did not provide a basis for federal trademark law).

237. *See, e.g.*, Religious Land Use and Institutionalized Persons Act of 2000 (RLUIPA), 42 U.S.C. § 2000cc to -5 (2006); Federal Arbitration Act (FAA), 9 U.S.C. §§ 1–16 (2006).

238. 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. 3, 11 (2010). The Constitution was adopted on September 17, 1787. U.S. CONST. And it wasn’t until 1870—eighty years after Congress enacted the first Copyright Act—that Congress enacted the first Federal Trademark Law. *Compare* Copyright Act of 1790, 1 Stat. 124, May 31, 1790, available at <http://www.copyright.gov/history/1790act.pdf>, with Trademark Act of 1870, ch. 230, 16 Stat. 198 (held unconstitutional by *The Trade-Mark Cases*, 100 U.S. 82). It’s interesting to note that Congress enacted the first Copyright Act on May 30, 1790, and the Constitution was ratified by Rhode Island on May 29, 1790. Further still, the Bill of Rights was not ratified until December 15, 1791. U.S. CONST. amend. I–X, pmb1.

239. *Golan v. Gonzales*, 501 F.3d 1179, 1187–97 (10th Cir. 2007) (finding that Congressional action that alters the traditional contours of copyright protection should be analyzed under the First Amendment), *remanded to* 611 F. Supp. 2d 1165 (D. Colo. 2009) (holding that URAA violated the intermediate scrutiny standard to which content neutral regulations are subjected), *rev’d sub nom.* *Golan v. Holder*, 609 F.3d 1076 (10th Cir. 2010), *aff’d*, ___ U.S. ___, 132 S. Ct. 873 (2012).

significant.²⁴⁰ The point, however, is that trademark law's potential for overreaching isn't a function of a constitutional mandate. Given trademark's weaker Constitutional basis, additional speech safeguards are both legally less bothersome and more appropriate. In particular, it means that, for parody in trademark law, First Amendment interests should provide broader coverage than the standard articulated in *Campbell*.

One might counter that rights granted by the Copyright Act are stronger than those granted by the Lanham Act. Copyrights provide the owner with a wide range of tools to censor.²⁴¹ Trademark law, by contrast, provides protection against only likely consumer confusion,²⁴² sponsorship, and endorsement, and, in some cases, dilution of mark distinctiveness.²⁴³ It follows, then, that trademark's speech protections would not be as robust as copyright's. But such comparisons are too simple. Copying a book or even a few minutes of a popular song is typically infringement. And the owner will be in a nice position to enforce her rights. But what about using a mark on a product in an advertisement, in a movie, or in a television or radio broadcast? The answer is not always clear—and, even when it is, the trademark owner likely can assert her rights because the costs of defending are so astronomically high.²⁴⁴ Indeed, clearance rights are often required for the trademarks, just as for copyrighted works, used in movies and

240. *Golan*, 132 S. Ct. at 885–91 (holding that the URAA's restoration to copyright works in the public domain did not alter the traditional contours of copyright protection because it left in place the idea/expression dichotomy and the fair use defense, and holding that Congress has the power to remove works from the public domain to comply with foreign obligations).

241. Dilution occurs where the use weakens (“blurring”) or makes unwholesome (“tarnishment”) the consumer's association between the mark and goods to which it is affixed by the owner. Compare 15 U.S.C. § 1125(c)(2)(B) (2006) (describing dilution by blurring), with *id.* § 1125(c)(2)(C) (describing dilution by tarnishment); see also *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 419 (2003) (explaining dilution by blurring and by tarnishment).

242. Copyrights provide the owner with six rights—reproduction, preparation of derivative works, distribution of copies, public performance, public display, public transmission (for sound recordings)—which essentially allow the owner to control where and how a work appears, and any adaptations of the work. 17 U.S.C. § 106 (2006).

243. 15 U.S.C. § 1125(a); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992) (stating that “liability under § 43(a) requires proof of the likelihood of confusion”).

244. Mark Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1696 (1999) (noting that, as a result of trademark propertization, we require more trademark licensing, which “is expensive. The more we propertize, the more transaction costs we impose on everyone.”); McGeveran, *supra* note 68, at 61–64 (explaining the risks for artists and small businesses in using trademarks and how they avoid using them altogether to avoid liability, and also noting the increased costs to using trademarks, such as rights clearances).

television.²⁴⁵ Thus, regardless of theory, trademarks can often be used like copyrights (that is, to censor), even though they are, in theory and historically, tools to control deceit.²⁴⁶ Part of this may stem from dilution's rhetorical effect on trademark theory: the dilution right is premised on the theory the trademark owner must be able to protect and control the "property interest" in the mark.²⁴⁷

Even assuming for the moment that there are significant and meaningful practical differences in the rights of copyright and trademark owners, there is still reason to think a parody doctrine needs to be broader in trademark than in copyright. Unlike copyright, trademark does not have the broad "fair use" provision that copyright law does. Instead, trademark's *real*²⁴⁸ fair use defense permits a use of a mark, "otherwise than as a mark, . . . which is descriptive of and used fairly

245. *E.g.*, McGeeveran, *supra* note 68, at 62–64.

246. *See, e.g.*, Menedez v. Holt, 128 U.S. 514, 523 (1888) ("The intentional use of another's trade-mark is a fraud."); Taylor v. Carpenter, 23 F. Cas. 742, 744 (C.C.D. Mass. 1844) (Story, J.) (holding that the defendant violated the plaintiff's trademark rights on black spools "in imitating and using any of the labels and spools, with a view to deceive the public"); Southern v. How, Popham 143, 79 Eng. Rep. 1243 (K.B. 1618); *see also* Sidney A. Diamond, *The Historical Development of Trademarks*, 65 TRADEMARK REP. 265, 287–88 (1975) ("The beginning of legal protection for trademarks as such generally is traced to a 1783 dictum in an English case, [Singleton v. Bolton, 3 Doug 293 (1783),] stating that an action for damages would lie based upon fraud."); Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 819 (1927) ("The protection of trademarks originated as a police measure to prevent 'the grievous deceit of the people' by the sale of defective goods, and to safeguard the collective good will and monopoly of the guild."); FRANK SCHECHTER, *THE HISTORICAL FOUNDATIONS OF LAW RELATING TO TRADEMARKS* 4–6 (1925) (quoting POLLOCK ON TORTS 312–13 (12 ed. 1923) and other sources, including courts, to illustrate that trademarks were used to prevent fraud, and that, although disagreement existed, court decisions "tend[ed] to insist upon deception of the public as not merely a *test* of a violation of a trade-mark right but as the *basis* of relief against such violation . . ."). Others have argued, however, that deceit was not the only interest trademark law sought to protect. *See generally* Mark McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839 (2007) (arguing that trademark law originally grew out of a desire to protect producers' interests, such as diversions of trade). Currently, at least, trademark can be said to have roughly three interests it seeks to promote: those of consumers, trademark holders, and competition.

247. Schechter, *supra* note 246, at 822–30 (arguing that trademark protection should be broad in scope, should protect her rights beyond merely confusion as to anonymous source, and should include protection for use of trademark on nonrelated goods); *id.* at 831 (arguing that the "uniqueness or singularity [of a mark] is vitiated or impaired by its use upon either related or non-related goods[.]" and that its uniqueness and "degree of [the marks] protection depends . . . upon the extent to which, through the efforts or ingenuity of its owner, it is actually unique and different from other marks").

248. The Supreme Court in *KP Permanent* held that the fair use defense did not require the defendant to disprove confusion, and that the defense applied even when some confusion exists. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 121–22 (2004) ("Since the burden of proving likelihood of confusion rests with the plaintiff, and the fair use defendant has no free-standing need to show confusion unlikely, it follows (contrary to the Court of Appeals's view) that some possibility of consumer confusion must be compatible with fair use, and so it is.")

and in good faith only to describe the goods or services of such party, or their geographic origin.”²⁴⁹ But beyond this provision and a few other specific defenses,²⁵⁰ trademark safeguards consist largely as a patchwork designed to leave breathing space for speech²⁵¹ and, specifically, parody. (Copyright has these too.²⁵²) Indeed, sometimes these “fair use defenses” are not defenses at all, but, as in the case of nominative fair use (for confusion), merely reformulations of the likelihood of confusion analysis trademark law already requires.

This lack of a catch-all, free-speech rule of reason is problematic, particularly in the parody space. In my previous article on parody in copyright, I proposed a narrow test that would immunize parodies from copyright infringement.²⁵³ I argued this test given copyright law’s free-speech safety-net: fair use. “Where the work fails the test,” I wrote, “hand-wringers need not worry too much, as the fair use test still applies.”²⁵⁴ But with trademark law, no such fallback position exists. Where a defense of nominative fair use fails, a defendant infringes.

249. 15 U.S.C. § 1115(b)(4) (2006).

250. *See id.* § 1115(b)(1)–(9).

251. Only certain kinds of words can be trademarked (arbitrary marks, fanciful marks, and descriptive marks that have acquired secondary meaning). *E.g.*, *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9–11 (2d Cir. 1975) (explaining the difference between arbitrary, fanciful, and descriptive marks). In fact, the Lanham Act bars some marks entirely from protection (“scandalous” or “disparaging” marks cannot be gain protection under U.S. law). 15 U.S.C. § 1052(a) (preventing registration of words or phrases on the principle register if they “[c]onsist[] of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute”). Beyond that, trademark law can regulate uses only insofar as the commerce clause allows (it protects only trademarks used “in commerce”)—and sometimes requires a particular *kind* of use in commerce (use “as a trademark,” i.e., used to identify the source of a product). 1 MCCARTHY, *supra* note 17, § 3:3. Even regulatable uses are subject to limitations: traditional infringement claims rely on a showing of likelihood of confusion; dilution claims require famous mark, near identity between the marks at issue, and a similar standard (likelihood of dilution). 15 U.S.C. § 1125(c). Finally, trademark law also has its own set of speech-sensitive defenses, including fair use, *id.* § 1115(b)(4), abandonment, *id.* § 1115(b)(2), and some protection for news reporting, commentary, and parody. *E.g.*, *id.* § 1125(c)(3) (providing exclusions from dilution).

252. For those well-versed in copyright, trotting these out is rote: the idea/expression dichotomy (ideas aren’t copyrightable, only expressions of ideas are copyrightable), 17 U.S.C. § 102(a) (2006), the inability to copyright facts (facts about the world are free for all, *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 344 (1991), unless they are originally arranged, *id.*, or are facts about fictional works, *e.g.*, *Castle Rock Entm’t, Inc. v. Carol Publ’g Group, Inc.*, 150 F.3d 132, 138–39 (2d Cir. 1998)); the originality requirement (a phonebook cannot be copyrighted, unless it’s cleverly arranged, *Feist*, 499 U.S. at 345); and, of course, fair use (whatever is not covered by these other doctrines should fall within this catch-all defense). 17 U.S.C. § 107.

253. *See* Simon, *supra* note 18, at 837–44.

254. *Id.* at 848.

Worse still, this defense is not much different (if it all) from the likelihood of confusion inquiry.

Furthermore, the safeguards that do not wade into likelihood of confusion territory are often insufficient. Whether a mark is a “use in commerce,”²⁵⁵ for example, is a rather broad standard.²⁵⁶ Even imposing a more demanding standard of whether the use is “commercial” or “as a mark” may not be strong enough.²⁵⁷ Although this safeguard fares better than the “use in commerce” standard, it ultimately does not address the many cases where the use, although not advertising a product, is still used as a mark. Where, for example, a character in a movie plows a tree with a Caterpillar® tractor, does the Caterpillar trademark signify Caterpillar’s sponsorship or endorsement of, or affiliation with, the movie?²⁵⁸ Or, for a racier example, imagine a pornographic film where the star wears Dallas Cowboy cheerleader attire.²⁵⁹ Depending on how Caterpillar or the Cowboys *feel* about such uses, they may decide to sue—and, depending on how the judge deciding the case feels,²⁶⁰ they may win.²⁶¹ It also fails as a safeguard because it has definitional problems that result in factual determinations similar to the likelihood of confusion analysis.²⁶² These shortcomings work to discourage the

255. 15 U.S.C. § 1125(a)(1) (providing a cause of action for infringement when “[a]ny person who, on or in connection with any goods or services, or any container for goods, *uses in commerce*” a mark in a way likely to cause confusion or deceive as to sponsorship or endorsement (emphasis added)); *id.* § 1125(c) (providing a cause of action for dilution when a person “commences use of a [famous] mark or trade name in commerce” that is likely to cause blurring or tarnishment).

256. *Id.* § 1127 (defining “use in commerce” as “bona fide use of a mark in the ordinary course of trade, and not merely to reserve a right in a mark”).

257. 1 MCCARTHY, *supra* note 17, § 3:3.

258. See Mark Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 416–22 (2010) (collecting cases of dubious claims of trademark infringement, including Caterpillar’s claim that “use of Caterpillar tractors in the movie [*Tarzan*] to bulldoze the forest would cause consumers to think Caterpillar was actually anti-environment . . .”). See *Caterpillar Inc. v. Walt Disney Co.*, 287 F. Supp. 2d 913 (C.D. Ill. 2003) (finding use of the Caterpillar trademark did not give rise to liability because it did not suggest Caterpillar sponsored or endorsed the movie or its message).

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

260. See, e.g., *id.* The Second Circuit at various points expressed disdain for the film, which colored its analysis of the infringement and dilution claims. The court, for example, described the film, “‘Debbie Does Dallas,’ [as] a gross and revolting sex film whose plot, to the extent that there is one, involves a cheerleader at a fictional high school, Debbie, who has been selected to become a ‘Texas Cowgirl.’” *Id.* at 202. It goes on to state that “[t]he movie consists largely of a series of scenes graphically depicting the sexual escapades of the ‘actors.’” *Id.* at 203.

261. Indeed, the plaintiff won in *Dallas Cowboys*. *Id.* at 204–05 (upholding a preliminary injunction on the grounds that consumers would likely be confused as to the source of the Dallas Cowboys cheerleader uniform, which the court found to be a protectable mark).

262. McGeveran, *supra* note 68, at 78–81 (explaining that “the ultimate question posed by the trademark use doctrine asks if a particular use invites an interpretation as a source identifier. The

reworking and subsequent use of trademarks for expressive purposes.²⁶³

Growing trademark rights also counsel in favor of a broader parody defense. Since 1870, the potential trademark action has expanded from its original test of likelihood of confusion as to competing products. It now includes claims for initial interest confusion,²⁶⁴ post-sale confusion,²⁶⁵ likelihood of dilution for blurring²⁶⁶ and for tarnishment,²⁶⁷ trade dress infringement,²⁶⁸ cybersquatting,²⁶⁹ and infringement of merchandising rights.²⁷⁰ And, although doctrines like dilution impose more requirements (like mark fame and identity), those requirements are spurious²⁷¹ or ever expanding.²⁷² Growing rights have become even more problematic as courts have found evidence of consumer confusion from surveys showing confusion rates as low as 6%,²⁷³ 10%,²⁷⁴ 11%,²⁷⁵

most straightforward basis to determine whether an expressive use carries source-identifying significance is to ask whether those who come into contact with it perceive it that way.”).

263. Cf. Peter Jaszi, *On the Author Effect: Contemporary Copyright and Collective Creativity*, in *THE CONSTRUCTION OF AUTHORSHIP* 29, 47–48 (Martha Woodmansee & Peter Jaszi eds., 1994) (arguing that requiring parody to target the original work in copyright forces the law to “acknowledge[] [parody’s] subordinate position in the hierarchy of works, and, by extension, the subordinate position of its creator in the hierarchy of ‘authors.’ . . . [T]his . . . operates to discourage artists whose methods entail reworking preexisting materials, while rewarding those whose dedication to ‘originality’ qualifies them as true ‘authors’ in the Romantic sense.”).

264. *E.g.*, *Checkpoint Sys., Inc. v. Check Point Software Tech., Inc.*, 269 F.3d 270, 294–95 (3d Cir. 2001) (recognizing initial interest confusion as “probative of a Lanham Act violation”).

265. *E.g.*, *Gen. Motors Corp. v. Urban Gorilla, LLC*, 500 F.3d 1222, 1227 (10th Cir. 2007) (finding post-sale confusion “relevant to the trade dress infringement inquiry” where defendants sold “body kits,” which were body-tops that could be affixed to the chassis of a truck to make it look like a Hummer).

266. 15 U.S.C. § 1125(c)(2)(B) (2006).

267. *Id.* § 1125(c)(2)(C).

268. *Id.* § 1125(a)(3); *Wal-Mart Stores, Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 209, 213–14 (2000) (noting that “marks registrable under § 2 [of the Lanham Act] . . . has been held to embrace . . . ‘trade dress’—a category that originally included only the packaging, or ‘dressing,’ of a product, but in recent years has been expanded by many Courts of Appeals to encompass the design of a product,” and holding trade dress protection for product designs that have acquired distinctiveness).

269. 15 U.S.C. § 1125(d) (creating a cause of action for registering in bad faith or trafficking in domain names confusingly similar to existing trademarks).

270. *E.g.*, *Boston Prof’l Hockey Ass’n v. Dallas Cap & Emblem Mfg.*, 510 F.2d 1004, 1008, 1012 (5th Cir. 1975) (holding owner of Toronto Maple Leaves trademark could sustain a trademark infringement action based solely on the use of the mark on a product, regardless of confusion as to source).

271. Dinwoodie, *supra* note 90, at 114 (noting that nonfamous marks may actually be more susceptible to dilution than famous marks).

272. Lemley, *supra* note 244, at 1698–99 (observing that dilution now seemingly includes nonfamous and nonidentical marks).

273. *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 772–73 (8th Cir. 1994).

and 16%.²⁷⁶ Dogan and Lemley point out that much of this evidence is founded on improperly crafted surveys²⁷⁷—but courts accepted it nonetheless.

This “rights expansion” has not gone unnoticed, at least by scholars.²⁷⁸ Simultaneous with the growth of rights was the broadening of things subject to trademark protection, which grew to include colors,²⁷⁹ notes or melodies,²⁸⁰ buildings,²⁸¹ facades,²⁸² and the shape of golf courses.²⁸³ Over-enforcement and licensing practices grew simultaneously—cease-and-desist letters are sent as a matter of course and licenses are generally sought for every use of a mark in movies.²⁸⁴

274. *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 400 (8th Cir. 1987) (finding evidence of confusion based on survey where 10% of those surveyed agreed that Mutual of Omaha “goes along” with Novak’s product); *James Burrough, Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 278–79 (7th Cir. 1976) (finding significant for confusion a survey showing 15% of those surveyed “referred to Beefeater liquor” when shown the defendant’s restaurant sign with the word Beefeater).

275. *Humble Oil & Ref. Co. v. Am. Oil Co.*, 405 F.2d 803, 817 (8th Cir. 1969) (finding 11% confusion “not an insignificant percentage”).

276. *Quality Inns Int’l v. McDonald’s Corp.*, 695 F. Supp. 198, 219 (D. Md. 1988) (finding 16.3% confusion “is an appreciable number that cannot be dismissed”).

277. Dogan & Lemley, *supra* note 10, at 10–11.

278. See Dreyfuss, *supra* note 68, at 274–76; Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 WIS. L. REV. 625, 632–41 (explaining how trademark rights have expanded); Lemley & McKenna, *supra* note 258 (criticizing trademark’s expansion, which made actionable uses that are likely to confuse as to sponsorship or affiliation); McGeeveran & McKenna, *supra* note 234 (describing how and why the concept of confusion has grown with somewhat distant regard for the underlying harm for which confusion is supposed to serve as a proxy). See generally Dinwoodie, *supra* note 271; Lemley, *supra* note 244.

279. See *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 166 (1995) (holding that color of dry-cleaning press pads could serve as a trademark).

280. See, e.g., TRADEMARK REG. NO. 916522, SERIAL NO. 72349496 (3-note NBC Chime sound mark).

281. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 763 (1992) (holding that building’s layout and theme could qualify as trade dress by showing inherent distinctiveness); *White Tower Sys. v. White Castle Sys. of Eating Houses Corp.*, 90 F.2d 67, 69 (6th Cir. 1937) (finding that unfair competition law provided protection to the plaintiff’s style of building); Andrew T. Spence, Note, *When a Landmark Cannot Serve as a Trademark: Trademark Protection for Building Designs in Light of Rock and Roll Hall of Fame and Museum, Inc. v. Gentile Productions*, 2 WASH. U. J.L. & POL’Y 517 (2000).

282. E.g., *N.Y. Exch. v. N.Y., N.Y. Hotel, LLC*, 293 F.3d 550, 557 (2d Cir. 2002) (finding that “NYSE’s mark consisting of its architectural facade and name is inherently distinctive”).

283. Lemley, *supra* note 244, at 1713.

284. See Grinvald, *supra* note 278, at 643–51 (arguing that large corporations are engaged in trademark “bullying,” where they use their size and power to prevent (often legal) uses of their marks by smaller businesses); Lemley & McKenna, *supra* note 258, at 420 (“Whatever fraction of the total universe of trademark cases these cases constitute, there are enough of them that recipients of cease and desist letters from mark owners have to take the objections seriously.”); McGeeveran, *supra* note 68, at 62–64.

At the same time, a corresponding number of real defenses have remained noticeably absent from trademark law. Most of the defenses in trademark law are not defenses at all,²⁸⁵ but safeguards (like “use as a mark”) or merely reformulations of the confusion test (like nominative fair use). As a result, users have two options; pay or forgo the use.²⁸⁶ For these reasons, some scholars argue that trademark law needs real defenses²⁸⁷—or even constitutional speech protections²⁸⁸ or presumptive fair uses²⁸⁹—to rebalance the law. The parody doctrine provides an opportunity to craft such a real defense, and to make it broad enough to do more than protect against (low amounts of) consumer confusion.

Oddly enough, how courts have applied *Campbell* in trademark parody cases is instructive on how such a real defense should and should not be structured. *Campbell*, after all, was a decision about a kind of “real” copyright defense. Fair use applies *after* the court finds infringement rather than before, as *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*²⁹⁰ requires of fair use in trademark. Nevertheless, the guiding principle in both *Campbell* and *KP Permanent* is the same: a real defense immunizes conduct *even if it is (or may be) infringing*. Courts forget this important similarity when importing parody analyses from copyright to trademark. Consider how courts routinely note that *Campbell* merely altered the fair use analysis; the decision didn’t even purport to address the copyright infringement analysis. In trademark law, however, courts have applied the *Campbell* decision to the trademark *infringement* analysis.²⁹¹ In doing so, they have overlooked the important difference between a theory of liability and a defense to that theory. That oversight means that the parody doctrine in trademark law is not really a defense at all—but rather a way to avoid infringing the work. So, to the extent one wants a stronger trademark law parody defense, *Campbell* may actually show how to build one—by moving toward something resembling real defense.

For all of these reasons, the parody doctrine in trademark law should

285. *But see* 15 U.S.C. § 1115(b)(4) (2006) (fair use defense); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004).

286. Grinvald, *supra* note 278, at 654–57.

287. Dinwoodie, *supra* note 271.

288. Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law* (Univ. of San Diego Sch. of Law, Research Paper No. 08-075, 2008), *available at* http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1273944.

289. McGeveran, *supra* note 68.

290. 543 U.S. 111 (2004).

291. *See supra* note 17; *infra* Part III.

be more robust than the one announced in *Campbell* and applied by lower courts. This means dispensing with the requirement that the parody must target the mark at issue. A broader parody defense, then, will include uses that do not merely target the mark, but use the mark in some expressive way to ridicule or poke fun at any subject. That is, it will include what the *Campbell* court called “satire.” To the extent that *Campbell* excused infringing conduct, trademark law could learn from that decision. I argue that we need a parody defense that can survive in spite of confusion in some cases. In the next Part, I explore what these defenses would look like.

III. CHANGING THE PARODY DOCTRINE IN TRADEMARK INFRINGEMENT ACTIONS

In the last Part, we saw that copyright and trademark law have different purposes, different sources of authority, different speech protections, and different strengths of rights. Real trademark defenses, I also argued, have not kept pace with expanding trademark rights. I argued that these differences and facts are relevant, and that parody in trademark law should be more attuned to them than it currently is. I briefly suggested some general approaches to broadening the trademark parody defense. What was missing, however, was a different, more directed normative discussion. Although Part I discussed the merits of various approaches, it didn’t discuss which approach, if any, was best. In this Part, I engage in that normative discussion. In what follows, I propose two new parody defenses—one for infringement and one for dilution.

A. *A Presumption-Based Defense for Parody*

Recall that courts use around nine different analytical methods for evaluating parody in trademark law.²⁹² Although each method purports to account for speech interests, all but two of these methods were merely restatements of the traditional confusion test. As scholars have pointed out, confusing speech does not necessarily equal (false or) misleading speech,²⁹³ the latter being an important constitutional standard for regulation. But more importantly, I have already given a few reasons why we may not want to throw all our speech eggs in the confusion basket. Here is a recap:

292. See *supra* Part I.

293. See Ramsey, *supra* note 288.

Rights Expansion: The traditional concept of consumer confusion has grown to include initial interest confusion, post-sale confusion, merchandising rights, dilution (which no longer in practice requires fame or mark identity), and trademarks have expanded to include colors, melodies, golf courses, buildings, facades, etc.

Low Confusion Threshold: Although trademark law requires the plaintiff to show a likelihood of consumer confusion as to source, courts have accepted survey confusion rates as low as 6%, 10%, 11%, and 16%.²⁹⁴

Quest to Stamp out All Confusion/Dilution: Courts have tried to eradicate *all* confusion or dilution, rather than appreciable confusion as to a particular source, or appreciable dilution as to famous and identical marks.

No Growth of Real Defenses: While trademark rights have expanded, real defenses (that don't depend on confusion) have not.

Confusion Approaches Are not Defenses: Courts altering the confusion factors—as *Campbell* has altered the fair use factors—fail to understand that fair use in copyright is a real defense, not a way of reframing the infringement issue.

Confusion is not Speech Friendly: The confusion test is unsympathetic to speech interests that also may be confusing.

Perhaps the most promising method of analyzing trademark parody was the Balancing Approach. As originally conceived, the Balancing Approach asked if the title of a work had any artistic relevance to the underlying work. If it did, then the use was presumptively noninfringing. This was a real defense. Its major advantage was placing a presumption in favor of speech. But it, too, had its own shortcomings. Namely, it was so broad and unruly that subsequent courts were able to hijack it, converting it into a standard likelihood of confusion analysis. In other words, it is a confusion trap.

1. *The Presumption-Infusion Approach*

The cases show that courts are attracted to the doctrine of confusion. It seems to easily account for all possible problems in one neat, little test. But we have seen that this is not true. So what to do? With a broader parody definition, we need to make some speech presumptively immune from trademark actions. That is, we should take the Court's

294. See *supra* notes 262–65.

holding in *KP Permanent* and apply it to more than just “fair use,” as defined by the Lanham Act. The Supreme Court in *KP Permanent* explained that “the common law of unfair competition also tolerated some degree of confusion from a descriptive use of words contained in another person’s trademark.”²⁹⁵ And so, it held, does the Lanham Act’s fair use defense.

This is what Graeme Dinwoodie means by a “real defense”—one that allows uses despite the potential infringement that may occur in its absence.²⁹⁶ We should apply the lessons of *Campbell* and *KP Permanent* to parody in trademark law by making it more like a real defense. We should make parody and satire presumptively protected First Amendment speech.²⁹⁷ Thus, if the court determines the defendant’s use qualifies as a parody or satire, then a presumption of noninfringement applies. That view is generally in line with some First Amendment scholars, who *presume* all speech is protected unless shown otherwise.²⁹⁸ Thus, it is incumbent on trademark owners to show that speech is not protected.²⁹⁹ This approach avoids constitutional conflict: it erects a doctrine that accounts for first amendment interests, preventing a collision with a constitutional question.³⁰⁰

But why treat parody as presumptively protected? Because parody is a type of speech that has value regardless of its potentially confusing nature. Without a robust parody doctrine, we risk incurring “a rather

295. 543 U.S. 111, 119 (2004).

296. Dinwoodie, *supra* note 271, at 134 (arguing that *KP Permanent* is important because “[i]t shows that even where the harm that the prima facie cause of action seeks to prevent may be implicated, other concerns—for example, competition, or perhaps the protection of free speech—might warrant, on balance, that we live with some minor harm to the trademark owner in order to preserve those other values. That is a real defense.”).

297. Ramsey has argued that the burden of proof in First Amendment cases shouldn’t be on the user but instead on the trademark owner, who must show that the speech is unprotected. Ramsey, *supra* note 288, at 421 (“Moreover, the burden of proof on the misleading or commercial nature of the speech should remain with the trademark holder or the government. In some cases, the court has erroneously stated that the burden of proof was on the defendant when it raised a First Amendment challenge, probably because the First Amendment was listed as an ‘affirmative defense.’”).

298. See, e.g., Michael J. Perry, *Freedom of Expression: An Essay on Theory and Doctrine*, 78 NW. U. L. REV. 1137, 1146 (1983) (stating that “the principle of freedom of expression . . . forbids presumptively, not absolutely. . . . [I]f the principle is to be a strong one—and few would deny that it should be—only a strong justification for governmental interference can be acceptable. So, government may not interfere with information or ideas useful in evaluating public policy or performance unless it has a strong justification for doing so.”).

299. Ramsey, *supra* note 288, at 421.

300. *Id.* at 448 (“Courts must first attempt to resolve any conflict between trademark law and the First Amendment by interpreting trademark claims narrowly and trademark defenses broadly in ways that protect expression.”).

significant [societal] cost . . . Sometimes that cost takes the form of lost opportunities: [i]mportant political and societal commentary and works of art may be suppressed entirely.”³⁰¹ The cost increases as judges use their discretion to deem infringing those parodies they find distasteful.³⁰² That is doubly true given all of the aforementioned threats to social or political speech that threaten the interests of a trademark holder.

With courts continually trying to wipe out all confusion and dilution, the presumption reminds courts “that the Lanham Act is not a general anti-copying statute—and indeed that not all copying . . . is bad.”³⁰³ Trademark law is not about preventing others from *using* trademarks; it is about preventing particularized harms (confusion and, to a lesser extent, dilution).³⁰⁴ Something closer to a real parody defense will force courts to remind themselves that “free-riding” to make valuable social commentary is not the same thing as causing particularized harm to the public (or instrumentally to the trademark owner).

A presumption, though, is typically rebuttable, and I suggest that this also be true in a more limited way for trademark parody. Under my proposal, the plaintiff can rebut the parody presumption only by showing the following elements by a preponderance of evidence:

301. Lemley, *supra* note 244, at 1696.

302. Langvardt, *supra* note 11, at 93 (“[S]ome courts in trademark parody cases have adopted a rather loose view of what constitutes likelihood of confusion, often because the courts’ distaste for the defendant’s parody.”); *see also* Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721, 812 (2004) (“When courts find parodies, satire, and other nonpermissive uses of trademarks objectionable for content-based reasons, they are very likely to find either trademark infringement, trademark dilution, or sometimes both. Courts have energetically enjoined unauthorized commercial uses or invocations of trademarks which include sex and drug references, and anything found to be ‘unwholesome.’”); Dreyfuss, *supra* note 68, at 293 (“My examination of the current crop of cases disclosed another revealing factor. Judges who are attracted to arguments grounded in expressive concerns tend to be colorful writers. They characterize disputes as fights between Davids and Goliaths; they make reference to Umberto Eco, Samuel Johnson, Chaucer, Shakespeare, Pope, Voltaire, Fielding, Hemingway, and Faulkner. No one ever accused Alex Kozinski—the self-styled judge of the ‘Court of Appeals for the Hollywood Circuit’—of writing turgid prose. In contrast, it is clear from the way certain judges write that they just don’t get it—that they are not gripped by language and remain unworried by trademark holders’ assault on the arsenal guarding ‘the vibrancy of our culture.’ I wonder, too, about their sense of humor.”). A similar phenomenon has been documented in copyright. *See, e.g.*, Rebecca Tushnet, *My Fair Ladies: Sex, Gender, and Fair Use in Copyright*, 15 AM. U. J. GENDER SOC. POL’Y & L. 273 (2007).

303. Lemley, *supra* note 244, at 1714.

304. Dreyfuss, *supra* note 68, at 285 (“Intellectual property is not, however, about preventing free rides. If free riding were always actionable, we could not, for example, enjoy a neighbor’s garden or learn from a colleague’s teaching technique. One merchant could not benefit from the interest a rival generates for a product category. Intellectual property law is aimed at preventing more particularized kinds of harm. Thus, evidence that does no more than demonstrate that an economic benefit was derived from a use, such as a parodic use, of a mark should not suffice to establish trademark infringement.”).

- (1) the alleged parody of the mark appears on, or is, a closely related product or service; and
- (2) the product or service on which the mark appears is:
 - (i) offered for sale
 - (ii) by a direct competitor.

Once these elements are met the court should invoke an Infusion Approach, as stated in *Louis Vuitton II*. Put another way, if the plaintiff shows by a preponderance of evidence that the parodic mark appears on a direct competitor's closely related product, this partially rebuts the presumption of protection. The burden, however, remains on the plaintiff to show that there is a likelihood of confusion. In analyzing the claim, courts should adjust the confusion factors to account for parodic interests by taking the Infusion Approach. If they can show confusion in this context, the defendant will be liable for trademark infringement. Where the plaintiff cannot prove all of these elements exist, her infringement claim dies. I call this the Presumption-Infusion Approach, or PI.

Readers will quickly notice that I have used a variety of important terms without defining them. Any test that purports to achieve some goal must be properly defined, and this one is no exception. So in defining the important words—"parody," "closely related," and "direct competitor"—we must remember that the goal of the Presumption Approach is to carve out breathing space for speech where consumer fraud is unlikely to occur. The first task we undertook in Part I, where we noted that *Campbell*'s definition was too narrow. Thus, parody here includes not only uses of a mark that comment on the original, but also those that use the mark as a vehicle to comment on society. In other words, it would include parody and satire as the Court defined those terms in *Campbell*. Thus, the court in *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc. (Dr. Seuss II)*³⁰⁵ would have analyzed the trademark claim differently. Rather than assessing the likelihood of confusion (and ruling material issues of fact existed),³⁰⁶ the court would have found the contested uses "Dr. Juice" and "A Cat NOT in the Hat" to be parodic and presumptively privileged.

Next we have to say what it means for a product or service to be "closely related." A defendant's product or service is "closely related" to the plaintiff's when it is intended to be used for the same purposes as the one to which the original mark is fixed. The divisions should be rather general, with uses being defined by traditional categories such as eating

305. 109 F.3d 1394 (9th Cir. 1997).

306. *Id.* at 1403–05.

and drinking, clothing, jewelry, furniture, etc., though the categories need not mirror those used by the USPTO. Where, for example, a company offers for sale Champagne in a bottle, a user's Champagne bottle filled with popcorn seeds would qualify. So would two books—such as the *Dr. Seuss* and *Dr. Juice* books—regardless of their content. Thus, a company that placed its trademark on motorcycles could reliably assert that a similar parodic mark placed on motorcycle parts was “closely related.”³⁰⁷

One caveat should be noted. Given the large-scale categories, some further divisions may be necessary. Two categories come to mind, though others may arise as the rule is implemented. One is the use of a mark on T-shirts and hats. Because markowners often leverage their brand to print T-shirts, hats, and the like, a more restrictive rule might be necessary in cases of these goods. Likewise, uses of marks on websites should not all be lumped together. Here, the websites themselves should be examined to determine whether the product or service they offer is closely related to the product or service offered by the markholder.

Even goods or services that are closely related, though, can be produced by entities that are not “direct competitors.” And, although both concepts are linked to one another, the purpose of the “direct competitors” element is to further cabin the ability of large corporate interests to suppress speech. This tactic is neither revolutionary nor foreign to trademark law. In the past, some courts held that only direct competitors had standing to sue under the Lanham Act.³⁰⁸

Under this proposal, a “direct competitor” must be one who competes in the same market generally as the parodic user. That is, one asks whether the market the parodic user targets is the same as the market targeted by the mark owner, looking at *all* the goods on which both marks appear. Thus, in *Dr. Seuss II*, the plaintiff would not have been able to satisfy this element. While Dr. Seuss aimed his books primarily at children, the defendant used the trademarks in a book designed for adults. This disparity in consumer markets would prevent the plaintiff from rebutting the presumption. Contrast that scenario with *Grottanelli*, where the defendant sought to sell products to the same demographic—namely, motorcycle enthusiasts.

307. *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 810–12 (2d Cir. 1999).

308. *See, e.g., Shonac Corp. v. AMKO Int'l Inc.*, 763 F. Supp. 919, 933–34 (S.D. Ohio 1991). “Competition,” though, could and was read more broadly than mere market competition, but also “competition for reputation and status.” Randolph Stuart Sergent, *Building Reputational Capital: The Right of Attribution Under Section 43 of the Lanham Act*, 19 COLUM.-VLA J.L. & ARTS 45, 53 (1995).

There is something peculiar about this proposal: it seems to use at least two of the likelihood of confusion factors. To ask whether products are “closely related,” one might say, is merely to rephrase the confusion factor of “similarity of goods.” Likewise, the “direct competitors” element may be merely a recasting of the “sophistication of consumers” factor in likelihood of confusion analysis. Although similarities between the two exist, pointing out these similarities misses a critical distinction between them. Whereas the “similarity of goods” and “sophistication of consumers” factors are part of the likelihood of confusion test, the elements used in PI operate as a trigger. If the plaintiff cannot satisfy them, then there is no likelihood of confusion analysis to undertake. A determination about the similarity of the goods on which the mark appears may in fact carry over into the confusion analysis. And even if the likelihood of confusion test does apply, the plaintiff’s ability to rebut the presumption does not determine that confusion will exist. Indeed, the Infusion Approach may counsel against just such an outcome even where the goods are similar. It is an analysis the court will have to undertake during the infringement analysis.

2. *Why Use This Presumption-Infusion Approach?*

These definitions, combined with the Presumption-Infusion Approach, work to safeguard parodies and satire from overzealous or crotchety trademark owners (or irascible or humorless judges). This defense does not fall into the confusion trap; it carves out space for free speech even where some confusion may exist. At the same time, the Presumption-Infusion Approach does not neglect confusion or trademark rights either. What it does, instead, is apply an even-handed test to a limited situation where trademark harm is not likely to occur. So trademark owners do not have much trademark harm to worry about.

This approach provides several benefits. First, the *Rogers*-style presumption ensures that we err on the side of protecting speech, rather than trademark owners’ interests. It cordons off a portion of speech that is likely to have social or political value (parody and satire). In this respect it resembles *KP Permanent*’s non-confusion-based safeguard for speech. For even if some confusion is likely, it won’t be recognized unless it has the potential to cause particularized harm to trademark owners.

Second, this test protects trademark owners’ rights too: the presumption is not absolute; it extends only to speech not likely to cause trademark-style harms. Crafting the presumption this way ensure that simply calling a use a parody—or even a finding that a use is a parody—does not negate the rights of trademark owners. A presumption refocuses

trademark law on harms related to confusion about related products³⁰⁹—the narrower harm traditionally protected by trademark law.³¹⁰ Where the parodic products are not related or in direct competition, the trademark law has no harm to protect against. The presumption has a built-in balance—the scale is tipped in favor of noncompetitive speech, even if it may be confusing.

As soon as we introduce direct competition, however, the scale automatically reweighs the interests at stake. Rebutting the presumption triggers an Infusion Approach (i.e., a modified confusion analysis), where the presence of a parodic or satirical use alters the court’s analysis of whether confusion is likely. Thus, when a parodic or satirical use appears on a competing good or service, parody—though still given special treatment—may not be given as much leeway.

Using the Infusion Approach as a fallback has at least three benefits. First, it provides protection to speech interests and trademark owners at different places, and where both sets of interests are most important. Speech interests are weakest when the parodist seeks to confuse consumers into buying a closely related product sold by a competitor. Second, these circumstances are precisely the circumstances under which trademark rights are traditionally understood to operate—trademark law prevents confusion and consumer fraud. This approach accounts for this fact by narrowing protection for parody and satire when products compete directly. Finally, it achieves the objective without relying on the traditional confusion analysis.³¹¹

The sum advantage of the Presumption-Infusion Approach is concomitantly to reduce trademark law’s chilling effect on speech and to protect the markholder’s legal interests. Creating presumptions—perhaps similar to those that exist in some aspects of libel law,³¹² for

309. See McGeveran, *supra* note 68, at 71–72 (“The multifactor [likelihood of confusion] test was designed for use in the paradigmatic trademark dispute where the need to accommodate speech interests does not arise. If two merchants want to use similar identifiers for their products, both litigants’ interests are primarily commercial rather than expressive, and neither one of them adds much additional speech to public discourse. Furthermore, both merchants’ interests align with certain *public* interests in efficient markets: guarding against confusion and allowing the best or most informative brand names.”).

310. Lemley & McKenna, *supra* note 258, at 423.

311. Other approaches have tried to make space for parody by increasing the plaintiff’s burden of proof when the parody was of a commercial nature. See, e.g., Langvardt, *supra* note 11, at 93 (arguing that, in the case of commercial parody, courts should have a “disinclination to find confusion unless the evidence demonstrates a realistic *probability* of confusion, not merely some *possibility* of confusion” (emphasis in original)).

312. See *N.Y. Times v. Sullivan*, 376 U.S. 254 (1964); 3 RODNEY A. SMOLLA & DAVID NIMMER, SMOLLA & NIMMER ON FREEDOM OF SPEECH § 23:1 (2011) (“It is worth noting that while the *New*

example—reduces the trademark owner’s leverage to bully settlements for parodic or satirical uses. The plaintiff must be prepared to offer more than a theory of confusion. Indeed, she must show that there is even a threat that the parodic use will compete with the original product. These are demands trademark law typically makes, but often have been lost in the expansion of trademark rights and markowners’ zeal for enforcement.

By now, it should be apparent how this could be applied to thwart claims against uses like Mutant of Omaha (Omaha Mutual), Michelob Oily (Michelob), and Barbie Girl (Barbie).³¹³ The Mutant of Omaha mark, for example, would prevail without any inquiry into confusion. So would Michelob Oily and the use of Barbie Girl in the title of a song. The test can just as easily be applied to trade dress claims, such as using a Barbie Doll in photography (Food Chain Barbie).³¹⁴

On the other hand, the *Louis Vuitton II* case—the one with the dog toy called Chewy Vuitton—would probably meet the PI test. The burden, of course, would be on Louis Vuitton to show that the parody appeared on a closely related product offered for sale by a direct competitor. A dog toy may be a “closely related product” vis-à-vis Louis Vuitton, which sells “pet accessories—collars, leashes, and dog carriers”³¹⁵ There might be an argument that Chewy Vuitton would not qualify as a direct competitor, assuming Louis Vuitton made extremely high-end dog products. But even if Chewy Vuitton and Louis Vuitton were direct competitors and the PI elements were met, the court would fall back into the Infusion Approach. Here, as we say in the 4th Circuit’s original decision, the factors cut in favor of Chewy Vuitton. These cases illustrate that the truly simple cases will be filtered out by the PI test, with the more debatable cases resolved in a reasonable manner with the Infusion Approach.

York Times decision dealt largely with the fault standards that apply to defamation law, in its aftermath courts have frequently held that other common-law or statutory defamation doctrines may also reflect First Amendment values, and may indeed come to be understood as required by First Amendment principles.”); DAVID A. ELDER, DEFAMATION: A LAWYER’S GUIDE § 1:9 (2011) (“At common law defamation per se (whether libel or slander) created a presumption of malice, a subterfuge for strict liability. This presumption has been displaced where First Amendment fault requirements for public persons or private persons as to matters of public concern apply but is probably still operational in the purely private-non public concern arena.” (footnotes omitted)).

313. *Mattel, Inc. v. MCA, Inc. (Mattel III)*, 296 F.3d 894 (9th Cir. 2002).

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

315. *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC (Louis Vuitton II)*, 507 F.3d 252, 258 (4th Cir. 2007).

B. A Broad Noncommercial Defense for Parody in Dilution Actions

Although trademark infringement is the more traditional cause of action, trademark owners can use trademark dilution to quash parodic and satirical uses of their marks. If we break down dilution by kind (blurring and tarnishment), we can see that courts like to apply different tests where parodies are at issue. Yet, for both blurring and tarnishment claims, courts resolved 50% of all cases using section 1125(c)(3)(C), which exempts from dilution “[a]ny noncommercial use of a mark.”³¹⁶ For blurring and even tarnishment, this defense seems to be the best equipped to handle parody. I propose using this defense for noncommercial parodic uses of a mark in the dilution context. For commercial parodies, I argue that two separate standards should apply. For tarnishment, commercial parodies should be totally exempt from dilution actions. Blurring actions, however, need to evaluate commercial parodies using an infusion-style approach, altering the statutory factors used to evaluate dilution by blurring.

For noncommercial parodies, this means relatively broad protection. Unlike the Presumption-Infusion Approach I proposed for infringement, this test is not a presumption; it is a complete defense—a *real* defense. Noncommercial speech simply is not actionable dilution. This is probably better than the Presumption-Infusion Approach for at least two reasons. First, dilution imbues trademarks with more of a property-like quality than infringement actions.³¹⁷ The action itself is premised on the idea that the trademark holder “owns” the image or brand of the mark. Thus, a stronger speech protection here—particularly one grounded in the First Amendment—is less threatening to the fundamental purpose of trademark law than it would be if it existed in the infringement context.

Second, a presumption that uses competition-criteria is misplaced in the dilution context. Dilution is aimed at uses of non-confusing marks on non-competing products. When a company uses Victoria’s Secret on motor oil, or McDonald’s on motorcycle parts, dilution is the appropriate remedy under current law. No one is confused by the use of the mark

316. 15 U.S.C. § 1125(c)(3)(C) (2006).

317. Both opponents and supporters recognized dilution as a form of property interest. *Compare* 151 CONG. REC. 6937 (2005) (statement of Rep. Wu) (arguing in opposition to the TDRA because “this bill will change trademark law to make it easier for large companies to sue individuals and businesses for trademark dilution, thus potentially creating rights in perpetuity for trademarks. This bill states that no actual harm will have to be proven; large companies will be able arbitrarily to file lawsuits against small businesses and private citizens.”), *with* 152 CONG. REC. 19,238 (2006) (statement of Rep. Smith) (“Diluting needs to be stopped at the outset. Once it occurs, the goodwill of a mark cannot be restored.”).

because the products are so distant (everyone knows McDonald's does not make motorcycle parts and Victoria's Secret makes lingerie, not motor oil). At the same time, dilution protects McDonald's and Victoria's Secret against just this kind of use because it is likely to "lessen [their marks'] distinctiveness."³¹⁸

Yet mark owners often bring dilution claims for competing goods. Victoria's Secret, for example, brought a dilution claim against Victor's Secret, a small store selling lingerie and adult items.³¹⁹ Starbucks sued a coffee company that marketed its charred roast coffee under the mark Charbucks, alleging dilution.³²⁰ These are cases where dilution should not have a foothold; these are cases where plaintiffs use dilution to hedge confusion claims.

Theoretically, it should be impossible to win a dilution claim against a nearly identical mark on a competing product; that seems to be exactly the situation infringement (or counterfeiting³²¹) was meant to cover. When no confusion exists, though, trademark owners seek to find liability any way they can, so they assert a dilution claim. Given dilution should not apply where competing products are at issue, the precise formulation of the Presumption-Infusion Approach I advocated for the parody defense in infringement doesn't apply to dilution.

So if my previous proposal doesn't translate to the dilution context, what approach should we take? Once we've settled on noncommercial use as the place for parody—and we've used the same definition for parody in both infringement and dilution actions—the next question is, what constitutes "noncommercial"?

Given the legislative history indicating the word "noncommercial" was meant to draw on First Amendment doctrine, that is the place we should look.³²² As noted before, the Supreme Court has defined

318. Actually, it may do just the opposite. *See* Dinwoodie, *supra* note 271, at 114 (noting famous marks may actually be less likely to be diluted than nonfamous ones). But, still, this seems like the prototypical case that dilution was meant to cover.

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

320. *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97 (2d Cir. 2009).

321. *See, e.g.*, 15 U.S.C. § 1115(1)(b) (2006) (providing liability for use of counterfeit mark); 18 U.S.C. § 2320 (2006) (making it a crime to knowingly use "a counterfeit mark on or in connection with goods services"); *id.* § 2318 (making criminal trafficking in counterfeit labels, documentation, or packaging).

322. Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, § 2, 120 Stat. 1730 (2006); H.R. REP. NO. 104-374, at 4 (1995), *reprinted in* 1995 U.S.C.C.A.N. 1029, 1031 ("The bill will not prohibit or threaten 'noncommercial' expression, as that term has been defined by the courts."); 151 CONG. REC. 6936 (2005) (statement of Rep. Berman) ("While not universally supported, this bill has now garnered the support of the ACLU for accommodating its first amendment concerns. In section 2(c)(3), the bill addresses the balance between the rights of trademark holders and the first

commercial speech as speech that does “no more than propose a commercial transaction.” This kind of speech is “expression related solely to the economic interests of the speaker and its audience.”³²³ To that end, commercial speech has a dual function: to make the speaker money but also to inform the consumer and society of a product by distributing information.³²⁴ Thus, economic motivations alone are not the only question when it comes to deciding what is commercial speech.³²⁵ An overwhelming discussion of important public issues may render speech noncommercial despite economic motivations.³²⁶ A mere passing reference to social issues, however, will not.³²⁷ Where commercial and noncommercial elements are “inextricably intertwined,” the scale tips toward noncommercial.³²⁸

Using this “framework,” courts have taken different approaches to defining “noncommercial.” One commentator has described two different types of analysis, which in a different setting some race theorists would call the rule of hypodescent: a drop of one “race” makes a mixed-race person from that race.³²⁹ One set of courts (the “all is commercial” courts) take the view that *any* element of commerciality

amendment by providing an exemption for purposes of identifying and parodying, criticizing or commenting on the famous mark. The trade groups representing intellectual property owners, AIPLA, INTA and IPO, have all endorsed this bill.”); 152 CONG. REC. 19,238 (2006) (statement of Rep. Sensenbrenner) (noting that the proposed amendment to the FTDA, among other things, “creates a free-speech exclusion for noncommercial use of a mark”); 152 CONG. REC. 2942 (2006) (statement of Sen. Leahy) (“Furthermore, Senator HATCH and I were successful in including language that definitively shelters important constitutionally protected first amendment freedoms from being caught up in the liability net.”).

323. *Cent. Hudson Gas v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 561 (1980).

324. *Id.* at 561–62 (“Commercial expression not only serves the economic interest of the speaker, but also assists consumers and furthers the societal interest in the fullest possible dissemination of information.”).

325. *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 67 (1983) (“[T]he fact that [the speaker] has an economic motivation for [the speech] . . . would clearly be insufficient by itself to turn the materials into commercial speech.” (citation omitted)).

326. *Id.* at 67–68.

327. *Cent. Hudson*, 447 U.S. at 562 n.5 (rejecting Justice Stevens’s view, which “would grant broad constitutional protection to any advertising that links a product to a current public debate. But many, if not most, products may be tied to public concerns with environment, energy, economic policy, or individual health and safety. . . . There is no reason for providing similar constitutional protection [for statements on public issues] when such statements are made only in the context of commercial transactions.”).

328. *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 474 (1989) (finding that the subjects included in advertisement—which included discussion of topics such as economics and home life—were not inextricably intertwined with the advertisement and therefore were commercial speech).

329. MARVIN HARRIS, *PATTERNS OF RACE IN THE AMERICAS* (1964).

renders speech commercial.³³⁰ Another group of courts (the “all is protected” courts), by contrast, find that *any* drop of expression renders a use noncommercial. Criticizing this “all is commercial” approach, the commentator notes that courts frequently focus on economic harm to the mark holder, which although part of the dilution inquiry, is irrelevant to the First Amendment doctrine of commercial speech.³³¹ At the same time, immunizing any speech with a hint of non-commerciality may go too far.³³² So the commentator suggests courts pay more attention to the content of the speech and its benefits to the speaker, rather than its negative influence on the trademark holder.³³³

Others have proposed various methods for discerning what constitutes commercial speech. Lisa Ramsey argues that trademarks are commercial speech when the reasonable consumer believes the “language partly or primarily identifies the source or licensor of the product.”³³⁴ On this view, where some speech is not purely commercial or noncommercial—that is, “hybrid” speech—courts should deem it noncommercial “[w]here the noncommercial nature of the speech predominates, or the commercial and noncommercial components are inextricably intertwined.”³³⁵

Arlen Lanvardt has argued for a somewhat different standard. He proposes a framework for analyzing the commerciality of parodies based on three principles provided by the Supreme Court. First, “when the trademark parodist has used his version of a trademark to help market a good or service other than the parody itself, the parody is almost certainly commercial in nature.”³³⁶ Second, economic motive does not

330. Curran, *supra* note 146, at 1078, 1082–87.

331. *Id.* at 1096–97.

332. *Id.* at 1098–99 (noting that a previous case, *Bolger*, “recognized that messages may ‘constitute commercial speech notwithstanding the fact that they contain discussions of important public issues[,]’ [and] thus reaffirmed the notion that ‘[a]dvertisers should not be permitted to immunize [commercial speech] from government regulation simply by including references to public issues.’” (quoting *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 67–68 (1983) (footnote omitted))).

333. *Id.* at 1097 (“[T]he ‘all is commercial’ cases imply that commercial harm to a trademark owner is an important element in determining the scope of the FTDA’s ‘noncommercial use’ exemption. But the Court has never taken such an approach in its commercial speech decisions. To the contrary, the Court’s precedents focus on the commercial *benefits* accruing to the speaker, and not the commercial *detriment* befalling other parties, when classifying speech as ‘commercial’ or ‘noncommercial.’” (footnotes omitted)).

334. Ramsey, *supra* note 288, at 401.

335. *Id.*

336. Langvardt, *supra* note 11, at 84.

render noncommercial speech commercial.³³⁷ Third—similar to Lisa Ramsey’s argument—courts should classify hybrid speech according to whether commercial or noncommercial aspects of the speech predominate.³³⁸ In all cases, the law protects the speech of publishers and the press as noncommercial expression because of the social value (education, information, and entertainment) of the speech.

Thus, when crafting a standard for non-commerciality, these commentators have some good advice. Courts should focus on the speech content, not the economic harm it may cause to the trademark holder. The question of harm, if it is taken up at all, is done so in the elements of dilution, not the exceptions to it. Additionally, courts should use First Amendment law to define commercial speech, as the Ninth Circuit did when it quoted *Central Hudson* to resolve a dilution claim under section 1125(c). That also means understanding that the definition of commercial speech is context-specific.³³⁹

In light of these considerations, these scholars’ approaches, when combined, seem quite palatable. Courts should focus on the speech and not the harm to the trademark owner: hybrid speech will be noncommercial where noncommercial elements dominate or are inextricably intertwined with noncommercial expression.

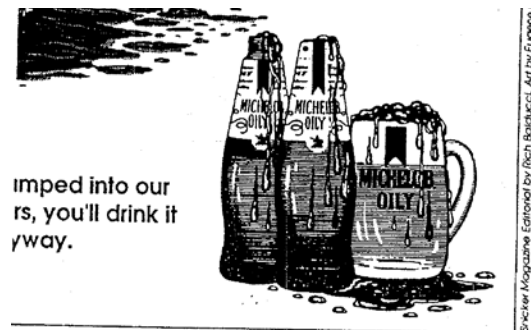
Under this definition the advertisement in *Anheuser-Busch, Inc. v. Balducci Publications*³⁴⁰ would have qualified as a noncommercial parody. As I described above, the ads depicted Michelob beer as oily. To better inform the reader, I’ve displayed them here.

337. *Id.* (“The second principle[] [is] that speech otherwise appearing to be noncommercial is not transformed into less protected commercial speech simply because the speaker has an economic motive . . .”).

338. *Id.* at 85 (“Under the third guiding principle, if the trademark parody possesses both commercial and noncommercial characteristics, it should be treated as a commercial parody when the commercial aspects predominate and as a noncommercial parody when the noncommercial aspects weight more heavily.”).

339. Indeed, cases like *Fox* suggest that the test for hybrid speech is functional and fact-specific: if you could make the commercial aspect of the speech without the noncommercial elements, the speech is commercial. *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 474–75 (1989) (“Including these home economics elements no more converted AFS’s presentations into educational speech, than opening sales presentations with a prayer or a Pledge of Allegiance would convert them into religious or political speech. As we said in *Bolger*, communications can ‘constitute commercial speech notwithstanding the fact that they contain discussions of important public issues We have made clear that advertising which ‘links a product to a current public debate’ is not thereby entitled to the constitutional protection afforded noncommercial speech.”) (quoting *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 67–68 (1983) (citation omitted)). I would counsel against such an approach as it resembles the Alternative Means Approach.

340. 28 F.3d 769, 776 (8th Cir. 1994).



The *Anheuser-Busch* court concluded that tarnishment had occurred because consumers might think Michelob actually contained oil. But under this noncommercial test, we would ask not whether tarnishment occurred (that is a question of harm to the trademark owner). We would ask instead whether the use was noncommercial. The expression here

was for “mock advertisement.”³⁴¹ The point was to make a comment about a recent oil spill that may have contaminated Michelob beer’s source water.³⁴² There is not any evidence of economic motive of the speaker; indeed, the speech is primarily informative. Thus, it is noncommercial.

But what about a closer case—a case where the speech might seem commercial? Take the case Langvardt finds to be commercial speech and therefore unprotected: *Mutual of Omaha Insurance Co. v. Novak*.³⁴³ There the defendant used the mark Mutual of Omaha (the name of an insurance company) to make t-shirts, mugs, and other paraphernalia with the mark “Mutant of Omaha” in a variety of phrases relating to nuclear war. The front of one T-shirt read, “Nuclear Holocaust Insurance” or “Sponsored by Mutant of Omaha Nuclear Holocaust Insurance Co.”³⁴⁴ The backside of the shirt read, “When the world’s in ashes we’ll have you covered.”³⁴⁵ Langvardt concludes the speech was commercial because the defendant produced a variety of goods, sold them in a variety of places, and used different designs on each shirt.³⁴⁶ But the question here is not solely the economic benefit to the parodists. We also need to examine the expression itself, which makes a comment on important public issue: nuclear proliferation. Although the commercial gain may seem to make this commercial speech, it is not clear what element—commercial or noncommercial—predominates. Instead, it appears the two are mixed hybrid speech. In such a case, the use should be deemed noncommercial and, thus, nondiluting.

While seemingly broad, the definition of noncommercial I propose is appropriate in the dilution context. Because parodic marks are both expression and advertisement under my proposed definition, parodies may be less likely than other uses of marks to qualify as commercial

341. *Id.* at 772.

342. *Id.*

343. 648 F. Supp. 905 (D. Neb. 1986).

344. *Id.* at 907.

345. *Id.*

346. Langvardt, *supra* note 11, at 88–89 (“The defendant did not sell the shirts as a one-time endeavor. Instead, he sold reasonably large quantities of them at various locations that were typical outlets for miscellaneous goods. He also sold various other items bearing his Mutant of Omaha designs. The fact that the defendant had several different designs which he used on the shirts and other items is also significant: it gives the impression that, in a business sense, he had launched a whole Mutant of Omaha ‘line.’ Consideration of these facts leads to a conclusion that the parody in *Mutual of Omaha* was predominantly commercial despite having a significant noncommercial component. Therefore, though the call was close, the *Mutual of Omaha* court was probably correct in finding a commercial use.” (footnotes omitted)).

speech. As a result, parodies might enjoy more protection than other uses of marks. Although this brings parody close to a per se defense in dilution, there is reason to think that is just the appropriate standard: broad protection with some room for dilution claims. After all, dilution is not an attempt to regulate false or misleading commercial speech: even the weakest-but-successful dilution claims do not involve misleading speech—that is precisely why the dilution statute exists: to regulate nonconfusing (which courts have assumed is the same as misleading³⁴⁷) “truthful” trademark uses that can dilute mark value. Dilution regulates nonmisleading commercial speech, which presents a fundamentally different proposition for First Amendment purposes.

Courts should not be making the same assumption for dilution that they make for infringement (i.e., confusion is commensurate with misleading). No court analyzing dilution should fall into the lurking confusion traps: they should not analyze confusion, and they shouldn’t use dilution as a way to circumvent a finding of no confusion. Thus, the regulation of diluting commercial speech is itself less than immune from constitutional challenge.

That argument has particular force in light of *44 Liquormart, Inc. v. Rhode Island*.³⁴⁸ The Supreme Court’s plurality opinion³⁴⁹ in *44 Liquormart* stated that a more rigorous review applies when laws regulate commercial speech “unrelated to consumer protection.”³⁵⁰ Although dilution laws might have some relevance to consumer protection (a stronger brand means consumers can find things more easily), they are not related to consumer protection in any strict sense. The purpose of dilution laws is brand-maintenance.

Further supporting a broad defense for commercial parody is its social value beyond mere consumer information; parody usually criticizes or comments on society or the trademark itself. For these reasons, even parodies designed to make a profit should have some protections—where, for example, the mark, or the product on which the mark appears, *is* the parody (or part of the parody),³⁵¹ the commercial nature of the use should not affect the analysis. Additionally, parodies in the dilution context (with which we are concerned) will always be used *as a mark*

347. Scholars contest whether this is actually so. Ramsey, *supra* note 288.

348. 517 U.S. 484 (1996).

349. Plurality opinions are those in which five or more justices agree on a particular result but not the rationale for that result. For more on plurality opinions, see James F. Spriggs II & David R. Stras, *Explaining Plurality Decisions*, 99 GEO. L.J. 515 (2010).

350. *44 Liquormart*, 517 U.S. at 485–86.

351. The Chewy Vuiton products are just one example of this.

(otherwise they fall under the fair use defense). If a mark is used as a source identifier, courts will likely find the use to be commercial—because it is affixed to a good or service. There may be exceptions, such as nonprofits, but even those would be at risk. Consider again the *Anheuser-Bush* case. Imagine that instead of an advertisement in a magazine, the graphics had appeared on T-shirts, as in *Mutual of Omaha*. A court may find this use to be commercial. But, as noted before, dilution protection extends to truthful and nonmisleading commercial speech. Without it being tested constitutionally, at the very least expressive forms of communication like parody should be protected. To accomplish this task, we take a broad definition of noncommercial, including most parodic uses.

Even though the standard I propose would include more speech within the noncommercial parody heading, there is still a risk courts could narrow the scope of the defense. And, under my proposed framework, a commercial parody doesn't meet the TDRA exception—so at this point it would be considered diluting. But if our goal is to protect parodies in a systematic way, then we should limit courts' ability to curtail that protection. Indeed, even if courts abided by the interpretation I proposed, there's always a risk courts could narrow it at some later date.

In other words, I assume that, despite the broad definition I propose, some courts will inevitably narrow their conception of noncommercial speech. Imagine, for example, that South Butt, instead of selling clothes under the mark meant to parody North Face, sold toilet paper, diapers, or other hygienic products.³⁵² Imagine further it coined a slogan, “never stop eating,” “never stop sweating,” or something to that effect. In this case, a court may be tempted to find the use “commercial” even under the broad definition I have proposed. That conclusion, I suggest, would be incorrect. Assuming this narrowing occurs, however, what would happen to the dilution claims?³⁵³

For a tarnishment claim, it seems impossible to divorce the expression (the play on words and humor) from the harm (negative associations as a result of associating North Face with excretion). (Some argue that this is not the kind of harm at least tarnishment is designed to protect against.³⁵⁴) That is just the point: any harm suffered by a parody will

352. *North Face Apparel Corp. v. Williams Pharmacy, Inc.*, No. 4:09CV2029RWS, 2010 WL 546921 (E.D. Mo. Feb. 9, 2009) (order denying South Butt's motion to dismiss).

353. For this example we can assume a court finds the mark famous and nearly identical.

354. Dogan & Lemley, *supra* note 10, at 11 (arguing that tarnishment does not mean “‘saying something bad about the trademark owner,’ rather . . . [it means] ‘branding your own inferior or

result from the expressive component of the mark's use—either criticizing or commenting on the mark, or using it to comment on some other important social issue. It is impossible to sort out the harm from the expression. The mock advertisement in *Anheuser-Bush* claiming water source contamination *was* the harm—just as the message about nuclear warfare was the harm in *Mutual of Omaha*. Although one case targeted the mark owner and one did not, in both cases the harm derived from the expressive content. So too is it the case with my hypothetical: the South Butt mark is not just about toiletry products—it is about making fun of North Face, or being funny and using the North Face mark to do it.³⁵⁵ The point is that expression and harm are tied together, and inseparable in the case of parody. Thus, to protect speech interests, I propose that parodies be totally exempt from liability in tarnishment actions.

Dilution by blurring, however, is a different story. Although commercial parodies could in theory dilute the mark, courts analyzing blurring claims involving parody have generally found this not to be the case.³⁵⁶ In Part I.B, I explained the different approaches courts use to evaluate parody. While I have supported using the noncommercial use exemption to protect parody, that method depends on courts correctly defining noncommercial speech broadly. Given the risk that they will do the opposite (i.e., courts may find parodies to be commercial when the parodies use the mark to sell a product commercial), another layer of protection is needed. Enter the Infusion Approach: in dilution cases, a parody finding colors the blurring factors, much as some courts do with the confusion factors. This adds another layer of protections for parodies that may have some commercial component.

While it is not a defense, the Infusion Approach should suffice as a further safeguard for expressive commercial parodies. The approach captures the reality that commercial parodies have expressive value—and that, even though commercial, this expressive value might actually enhance, rather than dilute, the famous mark's distinctiveness.³⁵⁷ That might not be the case for every parody—but certainly for some. And it is much better for speech to allow courts to sort out whether that is the case

noxious good with the plaintiff's mark").

355. Although I've advocated a broad definition of parody, many dilution claims against commercial parodies will more closely resemble the *Campbell* rationale—that is, they will target the mark itself. That is not always true.

356. See, e.g., *supra* Tables 2, 3, & 4.

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

than it is to simply declare commercial parodies dilutive.

Thus, in the end, the test for dilution I propose is similar in form—and in some ways substance—to the Presumption-Infusion Approach I suggested for infringement. The main difference in my dilution approach—which I call the Defense-Infusion Approach—is that it includes, as the name implies, a defense to dilution claims. For tarnishment claims, the defense applies regardless of whether the parody is commercial. For blurring claims, however, the defense applies only to noncommercial parodies. Where a claim for blurring is based on a commercial parody, courts should, after finding by a preponderance of the evidence that the use is commercial, analyze the blurring factors in the TDRA colored by a finding of parody. This defense is quite strong—indeed, stronger than the Presumption-Infusion Approach. But a stronger defense makes sense in the context of dilution, where trademark owners are given more property-like interests and, thus, more ability to silence expressive speech.

CONCLUSION

When courts confront parody within trademark law, they typically use doctrine to accommodate the First Amendment interests it invokes. In traditional trademark infringement actions, courts sometimes alter their confusion analyses to account for parodic uses of trademarks. In dilution actions, courts sometimes find parodic uses to fall within the provision exempting from liability “noncommercial” uses of a trademark. In other cases, courts engage in ad hoc balancing, weighing quasi-property interests against the interests of the user (not necessarily even the interest in expression *per se*), or they may discuss the value of information.

Regardless of approach, courts typically characterize disputes as contests between a property right of the trademark holder and the user’s ability to use (make speech with) that mark without infringing those rights. The question is set up to favor the trademark owner: does the use of the mark infringe on her rights, and to what extent? But surely users have rights too—rights apart from making nonconfusing uses of trademarks. Indeed, this characterization of trademark disputes as “property right” versus “privileged use” or “exceptions” can cloud the analysis, largely because the concept of a trademark right as property has galvanized courts to eliminate any and all confusion and dilution.³⁵⁸ In

358. See Dreyfuss, *supra* note 68, at 293 (arguing that courts have rejected strict interpretations of constitutional approaches because they are trying to safeguard all confusion and dilution); *id.* at 277

pursuit of that goal, trademark actions now include initial interest confusion, post-sale confusion, merchandizing rights, etc. Further narrowing the potential uses by non-mark-owners is courts' willingness to find liability for likelihood of confusion when surveys revealed confusion rates as low as 11%, 13%, and 16%, and dilution for less-than-famous marks. These facts mean that the burden of proof on the trademark owner is less than demanding.³⁵⁹

Broadening trademark rights while free-speech defenses remain static poses real problems for expressive users, like parodists and satirists. Under this conception, a privileged "use" does not seem to carry much legal clout when compared to a "right" conferred by statute. After all, if you have a "right" to use a trademark, the other person has an affirmative obligation to refrain from violating your right.³⁶⁰ With rightsholders constantly asserting those rights, and with the conceptual scale tilted in their favor, the law and the judiciary lose sight of the other interests at stake. Nearly sixty years ago, Thomas Emerson identified this problem eloquently:

[T]he protection of property interests constitutes the day-to-day job of the government apparatus. Protection of freedom of expression is more abstract, more remote, less insistent. Furthermore, advancement of the competing social interest is more likely to be the direct concern of the groups which influence and control the government machinery. And the problem of self-control may be even more difficult in a government bureaucracy than in an individual.³⁶¹

Although discussing express government regulation and enforcement, Emerson's point applies aptly to trademark law. Courts are in the business of resolving trademark disputes—and trademark holders are in the business of bringing those suits. As more trademark owners clamor for liability, courts (and Congress) have recognized new standards of

("At the normative level, it shifts the focus from the pure signaling capacity of the mark (its ability to denote source and quality) to other functions (such as instilling cachet in the brand). Because it suggests that *all* of the value in a mark belongs to the trademark holder, this shift reinforces the notion that every free ride is actionable.").

359. Bartow, *supra* note 302, at 769 ("The implication that a mark holder only has to convince a court that consumers are likely to be confused momentarily suggests the burden of proof on this issue can be feather-light indeed. In addition, the proposition that fleeting confusion cannot be effectively cured at any point in a transaction is confusing in its own right.").

360. See generally Wesley Newcomb Hohfeld, *Some Fundamental Legal Conceptions as Applied in Judicial Reasoning*, 23 YALE L.J. 16 (1913).

361. Thomas I. Emerson, *Toward a General Theory of the First Amendment*, 72 YALE L.J. 877, 928 (1962).

liability through legislation and judicial enforcement. In the courts, the trademark owner's influence is much more subtle. Indeed, the law itself sets up trademark disputes to favor owners. After all, it is much easier for courts to "enforce" the Lanham Act than to carefully consider any countervailing interests—interests that are not readily apparent simply by reading the Act's text in isolation.

But law—and courts—should be particularly attuned to First Amendment interests. The law plays a prominent role in protecting *people's* rights, not just trademark owners'. Expanding trademark rights marginalizes users in favor of large groups who exercise political control over the dimensions of trademark law and policy.³⁶² Trademark owners—as evidenced by their lawsuits—attempt to censor others based on the content of their speech. Given the fact that confusion (or dilution) is the watchword even in parody cases, we should start to either move away from confusion or supplement the confusion analysis to provide more space for parodic uses.

To remedy this problem, I proposed we revise the parody doctrine in trademark law, both for traditional infringement and dilution. First, I explained how courts have taken a variety of approaches to analyzing infringement and dilution claims where the mark is used allegedly as a parody. Each approach had its deficiencies and benefits. The primary problem was that almost none of them fashioned a satisfactory safeguard for speech. Indeed, most approaches in the confusion analyses were merely confusion tests dressed up in different legal rhetoric.

To avoid the confusion trap, I proposed two new parody "safeguards," one for infringement and one for dilution. Both tests used the same definition of parody I suggested earlier in the article, encompassing both "parody" and "satire" as defined by *Campbell*. In the infringement analysis, I proposed avoiding the confusion trap by using a presumption. This defense would presume parody and satire are protected expression. The plaintiff, however, could rebut this presumption by showing that the parodic mark appears on closely related products or services sold by direct competitors. Once the plaintiff rebuts the presumption, a court should determine whether the parodic mark is likely to confuse, taking into account how the parodic nature of the use alters this analysis. For

362. *Id.* at 901 ("The expansion of organization in our society has left the unorganized sectors peculiarly vulnerable to infringement of their rights. Freedom of expression within the organized group (including the government) by the nonbelonging individual, by the small group, and in connection with the organization of new groups, faces overwhelming hazards. In our highly conformist society it is from these sources that much of the social value in freedom of expression springs. Yet these deviant individuals and groups, lacking any other base, must find vindication of their rights primarily in resort to the judicial process.").

dilution claims, I suggested courts analyze whether parodies qualify as “noncommercial uses” under the TDRA. For tarnishment claims, this meant parody was a per se defense. For blurring claims, parody altered the factors courts use to determine liability. Placing parodies under this rubric safeguards speech in the face of strong, non-traditional trademark rights—rights designed to protect only the trademark owners’ interests, not the public’s.

The aim of these alterations is to better protect expressive speech while simultaneously upholding the purposes of trademark law. And, because these modifications do not require any statutory alterations, courts can implement them immediately. If they do, the law will free up more expressive space within trademark law; users of those marks won’t feel as chilled by the effects of expansive trademark rights. The result: More speech and fewer trademark lawsuits.

APPENDIX: METHODOLOGY: EXAMINING PARODY IN RECENT CASES

This Article focuses on the relationship between *Campbell*, parody, and trademark law. This Article studied trademark parody cases that cite or discuss *Campbell v. Acuff Rose, Inc.*³⁶³ *Campbell* represented the Court’s first major attempt to classify parody in over forty years.³⁶⁴ To find all trademark parody cases citing *Campbell*, in March of 2010 I entered the citation into Westlaw and conducted a “Citing References” search. The search returned 4,254 documents citing *Campbell*. I narrowed these results by asking Westlaw to return only cases and administrative decisions citing *Campbell*. This returned 386 cases. I further narrowed the cases to those involving the words “parody & trademark,” which returned seventy-three cases. On January 30, 2011, I re-performed this search for all cases after March 2010. The search revealed six new cases, only one of which was relevant and included in the results.³⁶⁵

Next, I manually examined each case of the seventy-three cases to determine whether the trademark infringement claim—either traditional infringement or dilution claims—included a discussion of parody or an argument that involved parody.³⁶⁶ This did not require the section

364. Simon, *supra* note 18, at 780.

365. This case was *CCA & B, LLC v. F + W Media Inc.*, 819 F. Supp. 2d 1310 (N.D. Ga. 2011).

366. The one exception to this was *Mastercard Int’l Inc. v. Nader 2000 Primary Comm., Inc.*, No.

discussing trademark law and parody to directly cite *Campbell*. It was sufficient that *Campbell* was cited somewhere in the decision. The reason for this method was to include cases where *Campbell* may have been an underlying factor in the Court's decision, even if the case was not discussed in great detail. I completed this task moving circuit to circuit—that is, by examining manually all the cases starting with the United States Court of Appeals for the First Circuit and ending with the United States Court of Appeals for the Federal Circuit.

When examining these cases, I often encountered more than one decision from the same case: sometimes a district court would render a decision on trademark parody, which would then be appealed and decided by the appellate court. So, for example, a district court may grant summary judgment for the defendant, finding no trademark infringement on parody-related grounds. A party then appeals that decision, and the appellate court either reverses or affirms the decision below. In such situations, I included in my data multiple decisions by different courts in the same case. In other words, I included appeals and remanded decisions so long as they cited or discussed *Campbell*. If the district court cited *Campbell* but, on appeal, the appellate court did not, I included only the district court decision in my calculations.

After collecting and sorting cases in the manner described, twenty-three cases remained.

As far as content goes, I included only cases involving trademark or trade dress where parody was at issue. Thus, I excluded from discussion noninfringements based on nonparodic rationales, such as genericide. Excluding these cases avoided tapping into claims on which *Campbell* has no bearing. For an example, see *Harley-Davidson, Inc. v. Grottanelli*,³⁶⁷ where the court found the word “Hog” had become generic as applied to motorcycles.³⁶⁸ In that case, I focused only on the claim as to the valid trademark, which consisted of a bar and shield logo.

I used the same exclusionary practice for trade dress infringement claims: I did not count them in my tables if a court decided them on nonparodic grounds, such as when a court resolved the trade dress claim by a finding of no secondary meaning.³⁶⁹ I excluded these because the

00 Civ. 6068(GBD), 2004 WL 434404 (S.D.N.Y. Mar. 8, 2004). I included this case—despite it not discussing parody in its trademark analysis—because its copyright claim was so closely tied to its trademark claim. Even excluding this case, the data, and the relationships that it shows, remain unchanged.

367. 164 F.3d 806 (2d Cir. 1999).

368. *Id.* at 810–12.

369. *Mattel, Inc. v. MCA Records, Inc. (Mattel II)*, 28 F. Supp. 2d 1120, 1152–54 (C.D. Cal.

claims did not involve a discussion of parody and, therefore, were not relevant to this Article. Where a trade dress claim was resolved on the same grounds as the infringement claim, I counted them both as only one claim.³⁷⁰

I also excluded from my calculations right of publicity claims because they do not bear on trademark law parody questions directly. Even in cases that involved trademark parody and some other claim such as right of publicity, I did not code for any part of the nontrademark claim.

I did, however, code for two variable trademark parody cases that involved copyright claims. I coded for (1) whether the case involved a copyright claim, and, if so, (2) whether that court found copyright infringement. I coded for copyright claims because they bore directly on whether trademark and copyright claims were related vis-à-vis *Campbell*. Claims were counted as “infringement” in both copyright and trademark cases where a court (1) granted summary judgment or (2) entered a preliminary injunction on the plaintiff’s claim.

I also coded for how courts determined infringement, both for traditional infringement and dilution. For the sake flow and argument, I explained these approaches when we confront them in Part III and IV. Here I’ll briefly explain my general approach. First, I read all 23 decisions. I then found patterns in the courts’ analyses. For traditional infringement claims, courts citing *Campbell* used six approaches when parody was present. I discovered three other approaches in cases not citing *Campbell*. For dilution claims, I again found six approaches to determining dilution in cases citing *Campbell*. Although I omitted from my survey *all* cases failing to cite *Campbell*, I did not find any other approaches in the cases I did examine. In Part II, I explain my findings and analysis as to each of these approaches. For the time being, the particulars of the approaches are not relevant.

1998); *Schieffelin & Co. v. Jack Co. of Boca, Inc.*, 850 F. Supp. 232, 251 (S.D.N.Y. 1994) (finding Dom Pérignon champagne bottle had not acquired secondary meaning).

370. See generally *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC (Louis Vuitton II)*, 507 F.3d 252 (4th Cir. 2007); *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC (Louis Vuitton I)*, 464 F. Supp. 2d 495 (E.D. Va. 2006); *World Wrestling Fed’n Entm’t Inc. (WWE) v. Big Dog Holdings, Inc.*, 280 F. Supp. 2d 413 (W.D. Pa. 2003); *Mattel, Inc. v. MCA Records, Inc. (Mattel I)*, No. CV 97-6791 WMB, 1998 WL 422641 (C.D. Cal. Feb. 18, 1998).