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Bullying and Opportunism in Trademark and Right-of-Publicity Law

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BULLYING AND OPPORTUNISM IN TRADEMARK AND RIGHT-OF-PUBLICITY LAW

STACEY DOGAN*

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Lawyers,¹ scholars,² and even Congress³ have lately expressed concern about so-called “trademark bullies”—trademark holders that assert tenuous

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¹ See, e.g., Jason Vogel & Jeremy A. Schachter, *How Ethics Rules Can Be Used to Address Trademark Bullying*, 103 TRADEMARK REP. 503, 504 (2013) (expressing concern that “[current] mechanisms may not effectively deter [trademark] bullying at the pre-litigation stage”); *Category Archives: Trademark Bullying*, DUETSBLOG, <http://www.duetsblog.com/trademark-bullying/> [<https://perma.cc/5TQF-JF3A>] (archiving law firm blog entries discussing examples of alleged bullying by trademark holders); Roxana Sullivan & Luke Curran, *Trademark Bullying: Defending Your Brand or Vexatious Business Tactics?*, IPWATCHDOG (July 16, 2015), <http://www.ipwatchdog.com/2015/07/16/trademark-bullying-defending-your-brand-or-vexatious-business-tactics/id=59155/> [<https://perma.cc/MZA7-NR4X>] (defining trademark bullies as those who “aggressively assert rights beyond the scope of trademark protection afforded by the Lanham Act through the issuance of threatening cease-and-desist letters”).

² E.g., Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 WIS. L. REV. 625, 629 (“[B]ullying is a serious concern, as it has implications far beyond trademark law and impacts the U.S. economy and the freedom of cultural expression.”); Jessica M. Kiser, *To Bully or Not to Bully: Understanding the Role of Uncertainty in Trademark Enforcement Decisions*, 37 COLUM. J.L. & ARTS 211, 211 (2014) (“Trademark bullying harms competition and chills free speech interests of those seeking to use trademarks for criticism

legal claims against vulnerable defendants, who often capitulate rather than incurring the expense and uncertainty of litigation. At the same time, we've witnessed right-of-publicity claims for acts that never would have raised an eyebrow a few decades ago.⁴ Complaints about bullying and overreaching are largely anecdotal rather than empirical, so it's hard to gauge the extent of the behavior and to measure its costs. But the fact that it has attracted so much attention suggests a perception, at least, that some rights-holders are asserting unreasonable claims and chilling legitimate conduct.

This Essay contends that certain structural and doctrinal features of trademark and right-of-publicity law enable and, in some cases, reward aggressive claiming. Although the two areas of law have different roots and distinct doctrinal formulations, they share some common features that may fuel grabby behavior by rights-holders. Normatively, both areas of law have gravitated toward an unjust enrichment model, which gives trademark holders and celebrities support for a broad sense of entitlement to the economic value of their marks and identities.⁵ At the same time, rights and limiting doctrines can be vague and indistinct, making extravagant claims hard to reject out of hand. The law, in other words, has failed in its function of giving notice of where legal rights end and the public's right of access begins. Especially in

and parody as permitted by the fair use doctrine.”); Irina D. Manta, *Bearing Down on Trademark Bullies*, 22 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 853, 855 (2012) (expressing concern that “[t]rademark bullying engenders a number of costs for society”); Kenneth L. Port, *Trademark Extortion: The End of Trademark Law*, 65 WASH. & LEE L. REV. 585, 585 (2008) (explaining that “[t]rademark litigation in America today is undergoing a profound change” because of “the use of strike suits and the like to deter market entrants”); Jeremy N. Sheff, *Fear and Loathing in Trademark Enforcement*, 22 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 873, 873 (2012) (“Much academic commentary these days concludes that trademark enforcement has become overly aggressive.”).

³ Trademark Technical and Conforming Amendment Act of 2010, Pub. L. No. 111-146, § 4, 124 Stat. 66, 70 (instructing Secretary of Commerce to report and propose policy recommendations on “the extent to which small businesses may be harmed by litigation tactics by corporations attempting to enforce trademark rights beyond a reasonable interpretation of the scope of the rights granted to the trademark owner”).

⁴ *E.g.*, *Sarver v. Chartier*, Nos. 11–56986, 12–55429, 2016 WL 625362, at *10 (9th Cir. Feb. 17, 2016) (affirming grant of anti-SLAPP motion, in right-of-publicity suit filed by soldier allegedly depicted in fictional film about troops' experiences in Iraq); *Rosa & Raymond Parks Inst. for Self Dev. v. Target Corp.*, No. 15-10880, 2016 WL 25495, at *2 (11th Cir. Jan. 4, 2016) (ruling on a right of publicity claim based in part on Target's sale of biographical books and movie about Rosa Parks); *Marshall v. Nat'l Football League*, 787 F.3d 502, 506 (8th Cir. 2015) (“The class action complaint alleges that for many years NFL Films . . . has used the names, images, likenesses, and identities of former NFL players in its various videos to generate revenue and promote the NFL.”).

⁵ See generally Mark A. Lemley, *Faith-Based Intellectual Property*, 62 UCLA L. REV. 1328, 1338 (2015) (noting the common view among contemporary commentators “that IP is some kind of prepolitical right to which inventors and creators are entitled”).

trademark law, this doctrinal creep is exacerbated by other doctrines that encourage and reward broad claims of rights.

If vague boundaries and aggression-promoting doctrines have created the current problem, the solution would seem to lie with restoring clarity and eliminating rules that reward over-claiming. On both fronts, this is easier said than done. Although scholars have proposed threshold doctrines to make it harder to prove a *prima facie* case,⁶ courts appear disinclined to adopt them.⁷ With both trademarks and the right of publicity, judges seem to crave discretion to decide whether behavior violates the spirit of the law.⁸ And they manage this by making the letter of the law a set of flexible, fact-intensive doctrines that offer little in the way of notice or predictability.⁹ To make things worse, trademark law's rules rewarding boldness are deeply entrenched, and face little counterweight from ethical and legal rules against over-claiming.¹⁰

⁶ *E.g.*, Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669, 1682-85 (2007) (proposing "trademark use" requirement in infringement suits); Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 414-16 (2010) (advocating threshold materiality requirement); Rebecca Tushnet, *Running the Gamut from A to B: Federal Trademark and False Advertising Law*, 159 U. PA. L. REV. 1305, 1305 (2011) (proposing that courts reconcile trademark and false advertising law by, among other things, requiring materiality for both); *cf.* William McGeeveran, *The Trademark Use Reform Act*, 90 B.U. L. REV. 2267, 2268 (2010) (suggesting safe harbors to protect certain speech-related uses of trademarks).

⁷ *See, e.g.*, *Rescuecom Corp. v. Google Inc.*, 562 F.3d 123, 139-40 (2d Cir. 2009) (rejecting "trademark use" requirement in infringement suits); *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 485 (5th Cir. 2008) (rebuffing a call for materiality: "Whether or not a consumer *cares* about official sponsorship is a different question from whether that consumer would likely *believe* the product is officially sponsored.").

⁸ *See generally* Stacey L. Dogan, "We Know It When We See It": *Intermediary Trademark Liability and the Internet*, 2011 STAN. TECH. L. REV. 1, 1 ("The recent history of intermediary liability decisions in copyright and trademark law reflects a notable resistance to rules that might constrain judicial discretion to ferret out bad guys."); Stacey Dogan, *Principled Standards vs. Boundless Discretion: A Tale of Two Approaches to Intermediary Trademark Liability Online*, 37 COLUM. J.L. & ARTS 503, 503 (2014) (explaining that current doctrine "resembles a roving unfair completion law, leaving discretion with the fact finder to assess the intermediary's culpability in enabling confusion").

⁹ *See, e.g.*, *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 163 (3d Cir. 2013) (endorsing "transformative use test" in speech-related right-of-publicity in part "because it provides courts with a flexible—yet uniformly applicable—analytical framework"); *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1148 (9th Cir. 2011) (noting the need for "flexibility over rigidity" in likelihood of confusion analysis); *Brookfield Commc'ns v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1054 (9th Cir. 1999) ("We must be acutely aware of excessive rigidity when applying the law in the Internet context; emerging technologies require a flexible approach.").

¹⁰ *See infra* Section II.B. (discussing features of trademark law that encourage aggressive claiming).

Given these structural and doctrinal features, it's no wonder that rights-holders test the limits of their trademark and publicity rights in lawsuits, PTO practice, and cease-and-desist campaigns. Contrary to the oft-stated trope of trademark holders, they do not *have* to take aggressive positions against borderline conduct to avoid loss of their trademark rights.¹¹ But they can obtain benefits from taking forceful positions, both in the immediate dispute and more generally.¹² Whether we view them as bullies, opportunists, or rational profit-maximizers, rights-holders are responding to incentives and opportunities created by judges making substantive law.¹³

This is not to condone or excuse those who assert untenable claims. The reality, however, is that few of the claims that critics cite as trademark bullying are untenable, under today's permissive standards for infringement and dilution.¹⁴ And the same goes for right-of-publicity claims, even in the context

¹¹ See, e.g., *US Mark Owner Bows to Public Opinion in Monster Dispute*, WORLD TRADEMARK REV. (Jan. 12, 2009), <http://www.worldtrademarkreview.com/Blog/detail.aspx?g=956f08e4-f918-4db7-af2d-09957f7fd842> [<https://perma.cc/L8DU-2QJ3>] (quoting CEO of Monster Cable regarding his decision to drop trademark dispute against Monster Mini Golf: "This is a landmark kind of situation, as public opinion wins over what is the right thing to do for trademark protection of a famous mark. We have made the decision that public opinion, and that of our valued customers, is more important than the letter of the law that requires us to prevent the dilution of our mark or risk losing it."). See generally Kiser, *supra* note 2, at 224-32 ("[T]he actual risk of losing one's trademark rights due to a failure to police third party trademark use appears to be highly exaggerated.").

¹² Such strategies can backfire, of course; as Leah Chan Grinvald has pointed out, public shaming can sometimes offer a powerful rebuke to trademark bullies. See Grinvald, *supra* note 2, at 625 (examining the "use of shaming by small businesses and individuals to defend themselves against a trademark bully").

¹³ Cf. Kiser, *supra* note 2, at 218 ("Thus, trademark bullying can only rarely be described as meritless and is often better described as unnecessary, inefficient and economically irrational.").

¹⁴ Indeed, in one of the most commonly-cited examples of purported bullying, the US Patent and Trademark Office ("PTO") initially agreed with the alleged bully. The PTO at first rejected Bo Muller-Moore's application for EAT MORE KALE, on the basis that it was likely to be confused with Chick-fil-A's EAT MOR CHICKIN mark. See Letter from Andrew D. Lawrence, Managing Attorney, U.S. Patent and Trademark Office 108, to Daniel P. Richardson, Attorney for Applicant Robert Muller-Moore (Mar. 7, 2013), <http://tsdr.uspto.gov/documentviewer?caseId=sn85412053&docId=OOA20130307115404#docIndex=26&page=1> [<https://perma.cc/ES4R-536B>] ("Registration was refused as to the goods and services . . . because Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential customer would be confused, mistaken or deceived as to the source of the goods and/or services of the applicant and registrant."). It took three years of advocacy before the PTO changed its mind and allowed the registration. See Notice of Publication from Comm'r for Trademarks, to Robert Muller-Moore, applicant (Sept. 24, 2014), <http://tsdr.uspto.gov/documentviewer?caseId=sn85412053&docId=NOP20140924055805#docIndex=13&page=1> [<https://perma.cc/Q8W8-RCTL>].

of expressive works.¹⁵ While we might hope for voluntary restraint by rights-holders, the only way to ensure such restraint is to clarify boundaries and alter incentives. Commentators have suggested a variety of tools for shifting these incentives, and this Essay brainstorms about some more.

Part I discusses the notice failures in the normative, doctrinal, and enforcement-related features of trademark and right-of-publicity law. In particular, lack of clarity about the purpose and scope of these legal rights leads to uncertainty about when the use of a trademark or a celebrity reference requires permission. In trademark law, this uncertainty is exacerbated by enforcement mechanisms that lack transparency and yet contribute to the viability of bloated trademark claims. Part II explores the features of trademark law (and, to a lesser extent, the right of publicity) that specifically reward aggressive claiming. Especially in light of the substantive ambiguities discussed in Part I, trademark law enables and arguably encourages trademark holders to test the limits of their trademark rights. Part III explores the costs of this phenomenon, and considers some possible responses.

I. NOTICE FAILURE IN THE WHY, WHAT, AND HOW OF TRADEMARK AND PUBLICITY RIGHTS

As Bessen and Meurer observed in *Patent Failure*, notice about the existence and boundaries of legal rights is critical to any system of property.¹⁶ One need not accept trademarks or publicity rights as “property,” moreover, to recognize notice as essential to both areas of law.¹⁷ For trademark law, markets

¹⁵ The fact that the Ninth Circuit took over two-and-a-half years to decide a case involving a movie loosely based on a former soldier’s exploits demonstrates the breadth of the right of publicity and the uncertainty about First Amendment protection even for traditionally sacrosanct forms of speech. See generally Jennifer E. Rothman, *Sarver Tells Ninth Circuit—Hey, Don’t Forget About Me!*, ROTHMAN’S ROADMAP TO THE RIGHT OF PUBLICITY (Dec. 9, 2015, 2:45 PM), <http://www.rightofpublicityroadmap.com/news-commentary/sarver-tells-ninth-circuit-%E2%80%93hey-don%E2%80%99t-forget-about-me> [<https://perma.cc/X3HC-ATRV>] (“One of the reasons the Ninth Circuit delayed deciding this case [*Sarver v. Hurt Locker, LLC*] was that it was waiting to see if the Supreme Court granted certiorari in . . . the case involving right of publicity claims by former student-athletes on the basis of NCAA basketball and football videogames.”).

¹⁶ See JAMES BESSEN & MICHAEL J. MEURER, *PATENT FAILURE* 7 (2009) (“Property can fail when boundary information is not publicly accessible,” and “when the boundaries of the rights are not clear and predictable.”).

¹⁷ Of course, “notice” plays another, even more central function in trademark law: it explains and justifies why trademarks receive protection in the first place. See, e.g., *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995) (explaining that trademark law “quickly and easily assures a potential customer that *this* item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past”). The notice concerns addressed in this article are related, but distinct: they involve the adequacy of notice about the existence and nature of trademark rights, to speakers and sellers who might be accused of violating those rights.

could not function without some means for sellers to determine whether their marketing plans might infringe someone else's trademark. This requires the ability to identify protected marks and to have some confidence about the scope of their protection. For publicity rights, identifying the rights-holder poses less of a problem, because disputes almost always involve deliberate reference to, or depiction of, a known individual. But certainty about the scope of legal entitlements is equally important in the publicity-rights context. Fuzzy legal boundaries make it hard to assess risks associated with celebrity references, which can chill both creative expression and new product markets.¹⁸

If clarity of notice is the objective, both right-of-publicity and trademark law fall well short of the mark. In part, the problem is rooted in ambivalence and ambiguity about the laws' normative goals. That uncertainty, in turn, contributes to legal rights with indistinct boundaries. Finally, particularly with trademark law, vague legal standards interact with an informal, non-transparent enforcement regime that operates in the shadow of the law, yet (bizarrely) ends up feeding back to shape it. On every level—from the normative to the doctrinal to the mechanisms for enforcement—notice problems pervade these two regimes.

A. *Why: Ambivalence and Ambiguity about Normative Goals*

Admittedly, clarity about normative goals is one step removed from the sort of notice that Bessen and Meurer were concerned with—i.e., notice to affected parties about the existence and scope of legal rights.¹⁹ In the trademark and right-of-publicity context, however, ambivalence about the law's purpose has contributed to ambiguity about the contours of legal rights, which, in turn, has created uncertainty about whether and when permission is required for use of a trademark or evocation of identity. Normative ambiguity, moreover, makes it hard to predict how the law will evolve in response to new sets of facts, which reinforces the prevailing uncertainty.²⁰

¹⁸ Given the prevalence of risk aversion, uncertainty can also lead to unnecessary licensing, which can impede market competition and sometimes produce rights-enhancing feedback loops. See Stacey L. Dogan, Haelan Laboratories v. Topps Chewing Gum: *Publicity as a Legal Right*, in INTELLECTUAL PROPERTY AT THE EDGE: THE CONTESTED CONTOURS OF IP 17, 36 (Rochelle Cooper Dreyfuss & Jane C. Ginsburg eds., 2014) (“[T]he prevalence of licensing . . . can lead to a market dominated by a single firm.”); cf. James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 YALE L.J. 882, 882 (2007) (“Because liability is difficult to predict and the consequences of infringement are dire, risk-averse intellectual property users often seek a license when none is needed.”).

¹⁹ See generally BESSEN & MEURER, *supra* note 16.

²⁰ In some circumstances, flexible standards can do a better job of promoting the law's objectives than fixed rules. For this to happen, though, there must be agreement over the law's essential objective, so that decision-makers can apply the standard in a supple but

1. Trademark Law

Although trademark law theoretically follows a consistent normative model, in practice, the law has distorted and departed from that model in important ways. The dominant theoretical model views trademarks as a means for facilitating accurate information about products, with the ultimate goal of making markets more competitive.²¹ With competition as its baseline, the law should presume that all parties have equal access to product features and marketing tools; trademark law should not intervene unless the defendant's behavior causes relevant harm to consumers, the trademark holder, or both.²² This suggests, at a minimum, that actionable confusion or misinformation must be of the sort that could potentially affect purchasing decisions and/or the reputation of the trademark holder.

In practice, however, trademark law can diverge from this normative vision, in two distinct ways. First, as Mark Lemley and Mark McKenna point out, courts sometimes lose track of the reasons for blocking confusion, and appear to view confusion itself—of *any* sort—as an evil to be avoided.²³ Rather than serving as an intermediate step in facilitating competitive markets, avoidance of confusion can take on a life of its own, justifying intervention even when it affects neither consumer purchasing decisions nor the trademark holder's reputation. In the abstract, avoiding irrelevant confusion might itself sound harmless, but as the net of actionable “confusion” expands, a growing set of individuals has to make the tricky determination of whether their behavior might run afoul of the law.²⁴ When those individuals are causing no harm, it's

relatively predictable way. When normative goals are in doubt or in internal conflict, this becomes more challenging.

²¹ See, e.g., *Qualitex*, 514 U.S. at 163-64 (“In principle, trademark law, by preventing others from copying a source-identifying mark, ‘reduce[s] the customer’s costs of shopping and making purchasing decisions,’ for it quickly and easily assures a potential customer that *this* item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past.” (internal citation omitted)); *id.* at 164 (explaining that “trademark law . . . seeks to promote competition by protecting a firm’s reputation”).

²² Cf. *Wal-Mart Stores, Inc., v. Samara Bros., Inc.*, 529 U.S. 205, 213 (2000) (“Consumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves by a rule of law that facilitates plausible threats of suit against new entrants based on alleged inherent distinctiveness.”).

²³ Lemley & McKenna, *supra* note 6, at 414 (arguing that “trademark law needs to refocus on confusion that is actually relevant to purchasing decisions”).

²⁴ In the wake of *eBay Inc. v. MercExchange, LLC*, 547 U.S. 388 (2006), some courts have shown skepticism about granting injunctive relief in the absence of a likelihood of real injury from infringement. See, e.g., *Herb Reed Enters., LLC v. Fla. Ent. Mgmt., Inc.*, 736 F.3d 1239, 1249 (9th Cir. 2013) (“We now join other circuits in holding that the *eBay* principle—that a plaintiff must establish irreparable harm—applies to a preliminary injunction in a trademark infringement case.”); *N. Am. Med. Corp. v. Axiom Worldwide*,

hard to justify saddling them with the costs of assessing risk and avoiding their (harmless) behavior. Often, moreover, the individuals are engaged in behavior that has social value of its own, making legal intervention even more costly.²⁵

The expansion of actionable confusion has complemented a second, often implicit, normative trend toward an unjust-enrichment approach to trademark protection. In this view, trademark owners invest time and resources in developing their good will, and deserve protection against those who seek to exploit that good will without justification, even in the absence of harm.²⁶ This rationale relies on Lockean natural-rights reasoning—the notion that those who invest their labor in creating something of value deserve to capture that value, at least as long as they don’t leave others worse off.²⁷ Several modern

Inc., 522 F.3d 1211, 1228-29 (11th Cir. 2008) (applying irreparable harm standard in trademark case); *Williams v. Green Valley RV, Inc.*, No. 8:15-CV-01010-ODW-MR, 2015 WL 4694075, at *2-3 (C.D. Cal. Aug. 6, 2015) (applying irreparable harm standard in trademark case). It is unclear how widely courts will adopt the Ninth Circuit’s view that irreparable harm requires something more than a strong likelihood of confusion. *See Herb Reed*, 736 F.3d at 1250 (“Gone are the days when ‘[o]nce the plaintiff in an infringement action has established a likelihood of confusion, it is ordinarily presumed that the plaintiff will suffer irreparable harm if injunctive relief does not issue.’” (quoting *Rodeo Collection, Ltd. v. W. Seventh*, 812 F.2d 1215, 1220 (9th Cir.1987))). In any event, the prospect of damages makes the threat of an infringement suit costly, regardless of the likelihood of a permanent injunction.

²⁵ *See generally* William McGeeveran & Mark P. McKenna, *Confusion Isn’t Everything*, 89 NOTRE DAME L. REV. 253, 253-54 (2013) (“Some courts penalize socially valuable but unlicensed use of marks . . .”).

²⁶ Several modern trademark doctrines reflect this impulse, including, among others, the merchandising right, the federal anti-dilution statute, post-sale confusion, and initial interest confusion. *See generally* Stacey L. Dogan, Harms, Benefits, and Justifications in Trademark Law (unpublished manuscript) (on file with author).

²⁷ In an important article, Mark McKenna contends that natural-rights reasoning provided the primary foundations for early trademark law. *See* Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1841 (2007) (explaining that trademark law originally “sought to protect producers from illegitimate diversions of their trade by competitors”). In McKenna’s view, a natural-rights approach would limit trademark rights to situations in which direct competitors pass their products off as originating from the trademark holder. *See id.* at 1899 (“Traditional trademark protection . . . focused on producers’ attempts to steal away customers from them in close competition proximity.”). What McKenna overlooks, however, is that the natural rights philosophy contains no inherent, principled limit on the “fruits” of labor that the law can legitimately protect. Thus, while nineteenth century courts limited recovery to cases involving diverted trade, natural-rights reasoning could just as well support trademark holders’ claim to the value of their hard-earned reputation or “goodwill.” And as advertising and diversification led to commercial value that extended beyond trademark holders’ core markets, trademark holders indeed pushed for broader protection. *See generally* Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 548 (2006) (“Ever since the 1920s, and with greater frequency during the past two decades, courts have relied on the idea that trademark law protects against appropriation

trademark doctrines reflect this instinct to reward trademark holders for developing valuable brands, and to condemn those who seek to profit from the value of the trademark holder's reputation.²⁸ And courts shaping these doctrines routinely deride parties for riding on the coattails of someone else's success.²⁹ These courts seem to presume that one goal of trademark law is not to avoid harm, but to reserve to the trademark holder the fruits of its reputational investments. Absent some justification, in other words, parties have no right to obtain benefit from someone else's good name.

While scholars quarrel over whether natural-rights reasoning or the obsession with confusion drove trademark law's twentieth century expansion,³⁰ it seems fair to conclude that the two trends collaborated in enabling trademark law's growth. More important, for current purposes, is the fact that both of these trends contribute to trademark holders' broad sense of entitlement to the economic value and meanings associated with their marks.

2. The Right of Publicity

If trademark's compass is occasionally askew, the right of publicity is lacking a compass altogether. Doctrinally, the modern right of publicity gives

of goodwill to justify some rather broad, and ultimately ill-advised, doctrinal expansions.”). The only limiting principle to the Lockean approach to property lies in the famous proviso: that laborers are entitled to the fruits of their labor as long as “enough, and as good” remains for others. JOHN LOCKE, *TWO TREATISES OF GOVERNMENT* § 27, at 19 (Hackett Publ'g Co. 1980) (1690). See Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 *YALE L.J.* 1533, 1538 (1993) (“It is because it limits the reach of the concept of property that the proviso serves as a central source of significant free speech protections.”).

²⁸ See, e.g., *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 384 (6th Cir. 2010) (“dilution by tarnishment”); *Au-Tomotive Gold Inc. v. Volkswagen of Am., Inc.*, 603 F.3d 1133, 1138 (9th Cir. 2010) (post-sale confusion); *Board of Supervisors for La. State Univ. Agric. and Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 484 (5th Cir. 2008) (sale of merchandise bearing mark); *Louis Vuitton Malletier, S.A. v. Hyundai Motor Am., No. 10 Civ. 1611-PKC*, 2012 WL 1022247, at *16 (S.D.N.Y. 2012) (“dilution by blurring”).

²⁹ See, e.g., *V Secret*, 605 F.3d at 389 (“The Moseleys do not have a right to use the word ‘secret’ in their mark. They use it only to make the association with the Victoria’s Secret mark.”); *Au-Tomotive Gold*, 603 F.3d at 1138 (“Post-purchase confusion creates a free-rider problem.”); *Smack Apparel*, 550 F.3d at 484 (“This creation of a link in the consumer’s mind between the t-shirts and the Universities and the intent to directly profit therefrom results in an ‘unmistakable aura of deception’ and likelihood of confusion.” (quoting *Boston Athletic Ass’n v. Sullivan*, 867 F.2d 22, 33 (1st Cir. 1989))); *Louis Vuitton*, 2012 WL 1022247, at *13 (finding likelihood of dilution by blurring when defendant “utilized the Louis Vuitton marks for its own branding goals” and “was definitely laddering and borrowing equity from Louis Vuitton” (citation omitted)).

³⁰ See generally Lemley & McKenna, *supra* note 6, at 414 (arguing that trademark law needs to refocus on confusion that is actually relevant); Mark P. McKenna, *supra* note 27 (arguing that natural-rights reasoning provided the primary foundations for early trademark law).

individuals the right to prevent commercial use of their names, likeness, or other identifying attributes.³¹ From its inception, the right of publicity has derived from an intuitive sense of fairness, rather than any measured analysis of why, and to what extent, individuals should have the right to control uses of their identities.³² In the opinion introducing the modern right, the Second Circuit Court of Appeals explained that the right was necessary because “many prominent persons . . . would feel sorely deprived” in its absence.³³ Subsequent courts have sometimes grappled more directly with normative questions, but they rarely settle on a single coherent justification. From natural rights³⁴ to utilitarianism³⁵ to unjust enrichment³⁶ to a commitment to individual dignity,³⁷ courts have offered a grab bag of alternative reasons for giving people the right

³¹ See Dogan, *supra* note 18, at 19 (“*Haelan* invited celebrities to complain any time that the use of their name, image, or other identifying attributes enhanced the appeal of a product sold to consumers.”).

³² See *id.* at 23 (“The court essentially validated celebrities’ sense of entitlement to any economic value that their celebrity status might confer to another party’s product or service.”); Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1162 (2006) (“In the absence of any clear theoretical foundation for the right of publicity, [its definition has] steadily swelled, to the point at which virtually any reference to an individual that brings financial benefit to someone else qualifies as a violation of the right of publicity.”); Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L. REV. 125 (1993) (critiquing the normative justifications for the right of publicity).

³³ *Haelan Labs. v. Topps Chewing Gum*, 202 F.2d 866, 868 (2d Cir. 1953). See generally Dogan, *supra* note 18, at 23 (“The court, in other words, recognized a right in celebrities in large part because celebrities expected the right and would feel ‘deprived’ by its absence.”).

³⁴ See, e.g., *White v. Samsung Elec. of Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992) (“Considerable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit. The law protects the celebrity’s sole right to exploit this value whether the celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof.”).

³⁵ See, e.g., *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 151 (3d Cir. 2013) (relying on both natural rights and utilitarian justifications: “As such, the goal of maintaining a right of publicity is to protect the property interest that an individual gains and enjoys in his identity through his labor and effort. Additionally, as with protections for intellectual property, the right of publicity is designed to encourage further development of this property interest.”).

³⁶ See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) (“The rationale for [protecting the right of publicity] is the straightforward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.”).

³⁷ See generally *Waits v. Frito-Lay Inc.*, 978 F.2d 1093, 1103 (9th Cir. 1992) (allowing claim for damages due to mental distress resulting from imitation of singer’s voice in advertisement). Cf. Mark P. McKenna, *The Right of Publicity and Autonomous Self-Definition*, 67 U. PITT. L. REV. 225 (2005) (advocating publicity right based on interest in “autonomous self-definition”).

to control the use of their identities. This normative pluralism makes it difficult both to define the right's contours and to balance it against competing considerations.

The result of this normative ambiguity is that people asserting right-of-publicity claims have a cornucopia of rationales from which to draw. Cumulatively, these rationales have led courts to describe publicity rights as a broad entitlement to the value of personal identity.³⁸ As a result, celebrities and other individuals have grown accustomed to the idea that they have an exclusive legal right to exploit their personal stories and/or their fame.³⁹

B. *What: The Malleability and Subjectivity of Rights-Defining Doctrines*

While these normative ambiguities can lead to uncertainty about *why* we protect trademarks and publicity rights, the more direct form of notice failure comes from the inability to identify rights-holders and to know how far their rights extend. Here, too, trademark and the right of publicity law fare poorly, albeit in somewhat different ways.

1. Trademark Law

Trademark risks can arise in a variety of different contexts. Sometimes, parties considering adopting a new mark or product feature must assess the risk that a trademark holder will try to block or challenge their use or registration.⁴⁰ At other times, a party knows that a mark is protected, but wants to use that mark in some way—to refer to the trademark holder, for example, or to call consumers' attention to competing or complementary products.⁴¹ Finally, because common English words can also serve as trademarks, parties

³⁸ See, e.g., *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 967 (10th Cir. 1996) (“Publicity rights, then, are a form of property protection that allows people to profit from the full commercial value of their identities.”); *State ex rel. Elvis Presley v. Crowell*, 733 S.W.2d 89, 97 (Tenn. Ct. App. 1987) (“In its broadest sense, property includes all rights that have value . . . Today there is little dispute that a celebrity's right of publicity has economic value.”).

³⁹ See, e.g., Appellant's Consolidated Open Brief on Appeal at 20, *Sarver v. Chartier*, No. 2:10-CV-09034 JHN-JC, 2016 WL 625362 (9th Cir. Feb. 17 2016), http://www-deadline-com.vimg.net/wp-content/uploads/2012/08/SARVER-BRIEF__120824163855.pdf [<https://perma.cc/4QJR-KJVG>] (brief in support of U.S. soldier Sarver's right of publicity claim, contending that “no social purpose is served by *denying Sarver compensation* for his right to his own persona” in film based on his experiences in Iraq (emphasis added) (quoting *Zacchini*, 433 U.S. at 576)).

⁴⁰ See Gibson, *supra* note 18, at 882 (explaining that “[trademark] liability is difficult to predict and the consequences for infringement are dire”).

⁴¹ See, e.g., *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137 (9th Cir. 2011) (deciding trademark infringement suit against company for advertising over search engine results for trademarked keyword of competitor).

considering using those words—even for their common English meaning—may face a charge of infringement.⁴²

The subjectivity of rules governing trademark eligibility, infringement, and privileged use can make it challenging to assess these risks with any certainty. Suppose, for example, that a manufacturer wants to copy a visually attractive feature of a product—say, a sleek design for a mobile phone. Even the threshold issue of whether the design is protectable involves thorny questions with unpredictable answers: Does the design have secondary meaning?⁴³ Does it perform a utilitarian function within the product, which would make it functional and thus ineligible for trademark protection?⁴⁴ If not, does it satisfy the hopelessly indeterminate standard for aesthetic functionality?⁴⁵ Messy questions of protectability, moreover, are not limited to trade dress; the lines between “inherently distinctive,” descriptive, and generic marks, for example, are notoriously vague,⁴⁶ and rights in unregistered marks—including, in some jurisdictions, foreign marks with a reputation in the United States—can be hard to appraise.⁴⁷

⁴² See, e.g., *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 98 (2d Cir. 1989) (deciding trademark infringement suit filed by Murphy Door Bed Company against competitor bed company for describing product as a “murphy bed”). This list does not exhaust the different contexts in which trademark risks arise, of course, but it captures many common scenarios.

⁴³ Trademark law allows protection of product design that has acquired secondary meaning, in the sense that consumers who encounter the design view it as an indication of source. See *Wal-Mart Stores, Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 216 (2000) (“[A] product’s design is distinctive, and therefore protectable, only upon a showing of secondary meaning.”).

⁴⁴ See *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 23 (2001) (“Because MDI’s dual-spring design is a functional feature for which there is no trade dress protection, MDI’s claim is barred.”).

⁴⁵ See, e.g., *Apple, Inc. v. Samsung Elecs. Co. Ltd.*, No. 11-CV-01846-LHK, 2012 WL 2571719, at *5 (N.D. Cal. 2012) (“[A]esthetic functionality is a limited doctrine that applies ‘[w]hen goods are bought largely for their aesthetic value,’ [and] ‘definitely contribute to that value and thus aid the performance of an object for which the goods are intended’” (emphasis added) (quoting *Auto-Motive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1068 (9th Cir. 2006))).

⁴⁶ See 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11.66 (4th ed.) (describing line between descriptive and suggestive marks as “hazy and only subjectively definable”); *id.* § 12:20 (“The line between highly descriptive terms and generic terms is as fuzzy and undefinable as the line between descriptive marks and suggestive marks.”).

⁴⁷ Compare, e.g., *Grupo Gigante SA De CV v. Dallo & Co., Inc.*, 391 F.3d 1088, 1098 (9th Cir. 2004) (recognizing protection for well-known foreign marks when mark owner demonstrates, “by a preponderance of the evidence, that a *substantial* percentage of consumers in the relevant American market is familiar with the foreign mark”), with *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 155-65 (2d Cir. 2007) (rejecting well-known marks doctrine and concluding that, under the longstanding territoriality principle, federal

The indeterminacy, moreover, does not end with evaluating a mark's eligibility for protection. Trademark law's standards for infringement and dilution are equally murky, leaving broad discretion with fact-finders to decide whether a contemplated mark treads too close to a protected one. Here, the compound visions of trademark law's purpose exacerbate the uncertainty. Doctrines such as post-sale confusion,⁴⁸ initial interest confusion,⁴⁹ the merchandising right,⁵⁰ and certain versions of affiliation confusion seem designed, at least in part, to prevent parties from evoking others' trademarks, without regard to confusion among customers about the source or provenance of products. The standards for dilution by blurring, moreover, target those who intentionally call to mind famous trademarks, apparently without regard to whether their evocation causes harm.⁵¹

trademark protection requires use in the United States). *See also* ITC Ltd. v. Punchgini, 9 N.Y.3d 467, 479 (2007) (“[W]hen a [foreign] business, through renown in New York, possesses goodwill constituting property or a commercial advantage in this state, that goodwill is protected from misappropriation under New York unfair competition law.”).

⁴⁸ *E.g.*, Au-Tomotive Gold Inc. v. Volkswagen of Am., Inc., 457 F.3d 1062, 1077-78 (9th Cir. 2006) (“Shorn of their disclaimer-covered packaging, Auto Gold’s products display no indication visible to the general public that the items are not associated with Audi or Volkswagen. The disclaimers do nothing to dispel post-purchase confusion.”).

⁴⁹ *See, e.g.*, Playboy Enters., Inc. v. Netscape Commc’n. Corp., 354 F.3d 1020, 1025 (9th Cir. 2004) (recognizing initial interest confusion doctrine: “Although dispelled before an actual sale occurs, initial interest confusion impermissibly capitalizes on the goodwill associated with a mark and is therefore actionable trademark infringement.”). *Compare* Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP, 423 F.3d 539, 551-52 (6th Cir. 2005) (refusing to recognize initial interest confusion for product-design trade dress), *with id.* at 555 (Kennedy, J., dissenting in part) (proposing initial interest confusion standard that would turn, in part, on “whether a product shape identifies its source when viewed from the point where the confusion is alleged to have occurred”).

⁵⁰ *See, e.g.*, Board of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co., 550 F.3d 465, 484 (5th Cir. 2008) (“Th[e] creation of a link in the consumer’s mind between the t-shirts and the Universities and the intent to directly profit therefrom results in an ‘unmistakable aura of deception’ and likelihood of confusion.” (citation omitted)).

⁵¹ *See* 15 U.S.C. § 1125(c) (2012) (“[T]he owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who . . . commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, *regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.*” (emphasis added)). The preamble to the blurring definition mentions harm. *See id.* § 1125(c)(2)(B) (“[D]ilution by blurring’ is association arising from the similarity between a mark or trade name and a famous mark *that impairs the distinctiveness of the famous mark.*” (emphasis added)). But the factors themselves appear designed to gauge whether the defendant’s use called to mind the famous mark. *See id.* § 1125(c)(2)(B)(i)-(vi) (listing factors the court may consider when deciding a dilution or blurring claim).

Finally, although courts have added some welcome clarity to trademark defenses in recent years, the standards for nominative fair use and descriptive fair use continue, in most jurisdictions, to turn at least part on subjective inquiries about the risk of confusion.⁵² For some uses—most notably, the use of trademarks in expressive works—the law appears to be converging on a standard that will lead to greater predictability.⁵³ Elsewhere, the question of whether a defendant may refer to a trademark holder by its name can turn on contextual questions that are hard to assess *ex ante*.⁵⁴

I don't mean to suggest that trademark law is hopelessly off course or producing systematic errors. Most judges deciding trademark cases employ measured analysis, and may well reach the right result most of the time.⁵⁵ My point is simply that, given the multiple layers of ambiguity in trademark law's doctrinal standards for eligibility, infringement, and protected use, a wide variety of questionable trademark claims can pass the straight-face test. Viewed differently, the law offers poor notice about whether and when the sale of imitative products, or adoption of marks that resemble existing ones, might trigger a cease-and-desist letter or complaint.

2. *Right of Publicity*

In one sense, the right of publicity features less doctrinal ambiguity than trademark law, because the identity of the rights-holder is rarely at issue, and the right's broad definition sweeps in virtually all profit-oriented uses of an

⁵² See, e.g., *Toyota Motor Sales, USA, Inc. v. Tabari*, 610 F.3d 1171, 1177 (9th Cir. 2010) (“The nominative fair use doctrine allows such truthful use of a mark, even if the speaker fails to expressly disavow association with the trademark holder, *so long as it's unlikely to cause confusion as to sponsorship or endorsement.*” (emphasis added)); *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 231 (3d Cir. 2005) (in nominative fair use defense, calling for consideration of “the precise way in which what the defendant said, or did not say, other than the mere presence of the mark on the website, may have inaccurately implied endorsement or sponsorship”); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596, 609 (9th Cir. 2005) (denying summary judgment on classic fair use defense in part because of genuine issue of fact as to “the degree of confusion”).

⁵³ In particular, we have seen widespread adoption of the *Rogers v. Grimaldi* standard, which allows the use of a trademark in an expressive work as long as it is “(1) ‘artistically relevant’ to the work and (2) not ‘explicitly misleading’ as to the source or content of the work.” *Fortres Grand Corp. v. Warner Bros. Entm't Inc.*, 947 F. Supp. 2d 922, 931 (N.D. Ind. 2013) (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 1000 (2d Cir. 1989), and discussing its acceptance across various circuits).

⁵⁴ See generally *McGeveran & McKenna*, *supra* note 25, at 292 (noting courts' tendency to use limiting doctrines “that insist on lack of confusion as a condition of the limitation, or they otherwise let their concerns about confusion infect their analysis”).

⁵⁵ *Cf. id.* at 294 (“A doctrine that often reaches correct results, but only by imposing high litigation costs, offers cold comfort to most would-be competitors or commentators.”).

individual's name, likeness, or identity.⁵⁶ Most states, moreover, have specific carve-outs for news reporting and other informational uses.⁵⁷ For many affected parties, then, the rules are fairly clear: use of celebrity name or likeness in advertisements and merchandise is almost always a violation,⁵⁸ and use in news reporting and other explicit commentary is almost always exempt.⁵⁹

In between these two extremes, however, lies a murky middle ground of behavior whose risk is much harder to gauge. Courts have especially struggled with products that incorporate celebrity names or images into expressive visual works, such as prints,⁶⁰ t-shirts,⁶¹ comic strips,⁶² and video games.⁶³ Because

⁵⁶ See *White v. Samsung Elec. Am., Inc.*, 971 F.2d 1395, 1397 (9th Cir. 1992) (stating that California common-law right of publicity “may be pleaded by alleging (1) the defendant’s use of the plaintiff’s identity; (2) the appropriation of plaintiff’s name or likeness to defendant’s advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury” (quoting *Eastwood v. Superior Court*, 149 Cal. App. 3d 409, 417 (1983))).

⁵⁷ *E.g.*, Fla. Stat. § 540.08(4)(a) (2015) (providing a carve-out for “the publication, printing, display or use of the name of any person in any . . . news medium or publication”).

⁵⁸ See Dogan, *supra* note 18, at 29 (“[P]roducts viewed as pure ‘celebrity merchandise’—posters, trinkets, and other standalone products featuring the celebrity’s unaltered likeness . . . are consistently found to violate the right of publicity.”). Compare the situation in Britain, Australia, and New Zealand, where use in advertisements can constitute passing off, but celebrity merchandise does not require permission. See generally Stacey L. Dogan, *The Right of Publicity: A Cautionary Tale from the United States*, in *THE INTERNET AND THE EMERGING IMPORTANCE OF NEW FORMS OF INTELLECTUAL PROPERTY* (Susy Frankel & Daniel Gervais, eds., forthcoming 2016).

⁵⁹ Dogan, *supra* note 18, at 28 (“At one end of the spectrum lie traditional expressive products such as newspapers, books, and movies that offer information, criticism, or commentary about the celebrity. These overtly expressive products reliably defeat right-of-publicity claims.”).

⁶⁰ *E.g.*, *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 918 (6th Cir. 2003) (deciding a suit by Tiger Woods against seller of limited edition prints entitled “The Masters of Augusta” and featuring Woods and other former tournament winners).

⁶¹ See *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 800 (Cal. 2001) (ruling on a claim against seller of t-shirts featuring charcoal drawing of Three Stooges).

⁶² See, *e.g.*, *Winter v. DC Comics*, 69 P.3d 473, 746 (Cal. 2003) (considering claims by musicians against publisher of comic book that depicted two “villainous half-worm, half-human offspring” whose name and features resembled them); *Doe v. TCI Cablevision*, 110 S.W.3d 363, 365 (Mo. 2003) (en banc) (allowing claims by hockey player known as Tony Twist against publisher of comic book featuring “a villainous character sharing his name”). See generally Rebecca Tushnet, *A Mask That Eats into the Face: Images and the Right of Publicity*, 38 COLUM. J.L. & ARTS 157 (2015).

⁶³ See, *e.g.*, *In re NCAA Student-Athlete Name & Likeness Licensing Litig. (Keller)*, 724 F.3d 1268, 1279 n.10 (9th Cir. 2013) (attempting to distinguish between works with a “primary emphasis on reproducing reality” and “other kinds of expressive works” that might enjoy first amendment protection); *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 145 (3d Cir. 2013) (Ambro, J., dissenting) (“I agree with my colleagues that the Transformative Use Test is the

these products derive value from their use of a person's identity, they meet the elements for a presumptive right-of-publicity violation in most states.⁶⁴ At the same time, they contain additional expression that qualifies them for some level of protection under the First Amendment.⁶⁵ As a result, courts have had to balance the state right-of-publicity interest against constitutional speech interests in these cases.⁶⁶ It's here that notice problems have arisen, because of the nebulous tools that courts have crafted for balancing speech and celebrity concerns. A variety of legal standards have emerged, but in the end, outcomes seem to turn largely on judges' intuitive, case-by-case feelings about the line between expression and exploitation.⁶⁷

Take the "transformative test," which the California Supreme Court adopted in *Comedy III Productions v. Gary Saderup, Inc.*,⁶⁸ a case involving t-shirts depicting the Three Stooges.⁶⁹ In the words of the court:

In sum, when an artist is faced with a right of publicity challenge to his or her work, he or she may raise as affirmative defense that the work is protected by the First Amendment inasmuch as it contains significant transformative elements or that the value of the work does not derive

preferred approach for balancing these [right of publicity and speech] interests, but we part ways on its interpretation and application. The result is that they side with Hart, and I with EA."); *No Doubt v. Activision Publ'g, Inc.*, 122 Cal. Rptr. 3d 397, 400 (Cal. Ct. App. 2011) (allowing claims by band No Doubt against makers of "videogame featuring computer-generated images of the members of No Doubt"); *Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 608 (Cal. Ct. App. 2006) (rejecting a celebrity suit against distributors of video game that presented a distorted version of her persona). *See generally* Tushnet, *supra* note 62.

⁶⁴ *See, e.g.*, *Cardtoons, L.C. v. Major League Players Ass'n*, 95 F.3d 959, 968 (10th Cir. 1996) (explaining that any "(1) knowing use of . . . name or likeness (2) on products, merchandise, or goods (3) without . . . prior consent" violates right of publicity in the absence of a "valid defense"); *White v. Samsung Elec. Am.*, 971 F.2d 1395, 1397-99 (9th Cir. 1992) (discussing White's common law right of publicity claim).

⁶⁵ *See ETW Corp.*, 332 F.3d at 924 ("Cases involving Lanham Act false endorsement claims and state law claims of the right of publicity have considered the impact of the First Amendment on those types of claims.").

⁶⁶ *See id.* (discussing "how First Amendment rights have been balanced against intellectual property rights in cases involving the Lanham Act and the state law rights of publicity").

⁶⁷ *See, e.g.*, *Keller*, 724 F.3d at 1279 n.10 (defining test as "whether a likely purchaser's primary motivation is to buy a reproduction of the celebrity, or to buy the expressive work of that artist"); *Comedy III Prods. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001) (explaining that the key question is "whether the celebrity likeness is one of the 'raw materials' from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question").

⁶⁸ 21 P.3d 797 (Cal. 2001).

⁶⁹ *Id.* at 800.

primarily from the celebrity's fame.⁷⁰

This sounds simple enough, offering refuge to right-of-publicity defendants who can prove *either* that their work contained significant transformative elements, *or* that it does not owe its value primarily to the celebrity's fame. In practice, however, the standard raises more questions than it answers. What kind of "transformative elements" can count in defendants' favor? Must the defendant somehow transform the name or image itself, or is it sufficient to incorporate them into a broader expressive work?⁷¹ How do we decide whether a work's value derives principally from the defendant's contributions, or instead from the celebrity's fame? The long opinion repeatedly invokes its "transformative" test without answering these questions. Indeed, the court's multiple iterations of its standard offer something for everyone.⁷² In the end, the opinion leaves no clear roadmap, instead leaving it to judges to apply their subjective intuition about whether the defendant is engaged in protected speech or commercial exploitation.

Admittedly, the *Saderup* transformative test offers clarity for creators of certain types of expressive works. Parodists and critics, for example, know that they cannot face right-of-publicity claims from the target of their reproach.⁷³ Other visual manipulations or critical uses, including distortions and "heavy-handed lampooning," are equally protected.⁷⁴ Yet beyond cases of direct and obvious criticism, commentary, or visual manipulation, the court's standard offers less guidance, and seems to collapse into a subjective inquiry into

⁷⁰ *Id.* at 810.

⁷¹ At least implicitly, the court suggests the latter, because it offers factual account reporting as an example of a class of works that enjoy First Amendment protection. *Id.* at 809. But the opinion never explicitly defines the kind of expressive contributions that can make a work transformative under its standard.

⁷² *See, e.g., id.* at 808 (identifying the relevant question as whether a work "contains significant transformative elements"); *id.* at 808 & n.10 (framing the inquiry as whether "a work is worthy of First Amendment protection because added creative elements significantly *transform the celebrity depiction*" (emphasis added)); *id.* at 809 (including "factual reporting, . . . fictionalized portrayal . . . , heavy-handed lampooning . . . [and] subtle social criticism" as among types of uses protected by the First Amendment); *id.* ("Another way of stating the inquiry is whether the celebrity likeness is one of the 'raw materials' from which an original work is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of the work in question."); *id.* ("We ask, in other words, whether a product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness. And when we use the word 'expression,' we mean expression of something other than the likeness of the celebrity.").

⁷³ *Id.* at 808 ("[W]orks of parody or other distortions of the celebrity figure are not, from the celebrity fan's viewpoint, good substitutes for conventional depictions of the celebrity and therefore do not generally threaten markets for celebrity memorabilia that the right of publicity is designed to protect.").

⁷⁴ *Id.* at 809.

whether the work was unduly exploitative of the celebrity's fame.⁷⁵ Indeed, it's not clear how some classic sorts of protected use would be analyzed under a transformative standard. Take "factual reports"—a category of expression that the court assumes would qualify for First Amendment protection under its standard, and that has always been presumed to lie beyond the reach of the publicity right.⁷⁶ Yet the court never elaborates on why factual accounts so clearly meet its transformative standard—and one could argue that many of them would fail. Suppose, for example, that the "factual report" comes in a gossip article in a tabloid magazine, accompanied by an attention-grabbing front-page photo of the celebrity. With respect to the photo, at least, couldn't the celebrity argue that the celebrity likeness is the "sum and substance" of the work, and that the cover derives most of its value from the celebrity's fame?

The *Saderup* court clearly did not intend to reach tabloids or other "news"-oriented uses of celebrity identities. Yet the example illustrates the indeterminacy of the transformative test. In the absence of objective tools for distinguishing between protected and unprotected uses, the transformative test relies on subjective, historically contingent instincts about the line between speech and exploitation. The problem with such a subjective inquiry, of course, is that exploitation lies in the eye of the beholder. The test has proven especially problematic for parties that incorporate visual depictions of celebrities into expressive products outside the traditional realm of books and news reports. In these cases, courts have increasingly gravitated toward the view that, absent some parody or visual distortion, products bearing celebrity likenesses violate the right of publicity.⁷⁷ So far, this trend has mainly limited itself to video games and comic books. Based on the success of these suits, however, plaintiffs have begun to test the waters with more traditional media, including historical and biographical books,⁷⁸ sports broadcasts,⁷⁹ and

⁷⁵ Indeed, with respect to one of its examples of works that likely satisfy the "transformative" test, the opinion reflects some internal uncertainty. At one point in the opinion, the court mentions Andy Warhol paintings as "subtle social criticism" that would likely pass muster. *Id.* Later, the court returns to the paintings and indicates that, in light of their subtle social commentary, the paintings "may well be entitled to First Amendment protection." *Id.* at 811 (emphasis added).

⁷⁶ *Id.* at 809 ("We emphasize that the transformative elements or creative contributions that require First Amendment protection are not confined to parody and can take many forms, [including] factual reporting.").

⁷⁷ See generally Tushnet, *supra* note 62.

⁷⁸ *E.g.*, *Rosa & Raymond Parks Inst. for Self Dev. v. Target Corp.*, No. 15-10880, 2016 WL 25495, at *5 (11th Cir. Jan. 4, 2016) (affirming summary judgment against the Parks Institute in its lawsuit claiming "unlawful commercial exploitation of a celebrity" based on use of Rosa Parks's name and likeness in biographical books and movie).

⁷⁹ See, e.g., *Marshall v. ESPN*, 111 F. Supp. 3d 815, 383 (M.D. Tenn. 2015) (dismissing right-of-publicity claims by college athletes against ESPN, based on use of their images in sports broadcasts).

fictional⁸⁰ and non-fictional films.⁸¹ These suits have largely failed, but the fact that they were filed at all suggests an increasing uncertainty about the outer limits of right-of-publicity claims.

California's "transformative" test is not the only one used to balance right-of-publicity interests against the First Amendment. Other jurisdictions have applied a variety of other tests that differ from one another both substantively and on the extent to which they offer notice of the limits of right-of-publicity claims. The "predominate use" test—like some of the language in *Saderup*⁸²—asks whether the value of the work derives predominantly from the artist's contributions or from the draw of the celebrity's fame.⁸³ The direct First Amendment balancing test purports to ask—directly—whether the speech interests of the defendant outweigh the celebrity's interest in exploiting her fame.⁸⁴ While they may give different weight to speech and celebrity interests, both of these tests ultimately come down to the same subjective inquiry as the transformative standard—does the defendant's behavior have enough social value to override the celebrity's interest in controlling the value of her fame? The one test that provides greater structure and certainty—the deferential standard of *Rogers v. Grimaldi*⁸⁵—has been largely rejected in the right-of-publicity context.⁸⁶ Thus, in the one area in which trademark law has moved

⁸⁰ *E.g.*, *Sarver v. Hurt Locker LLC*, No. 2:10-cv-09034-JHN-JC, 2011 WL 11574477, at *1-2 (C.D. Cal. 2011) (rejecting claims by former soldier based on the unauthorized use of his experiences and personal characteristic in fictionalized movie).

⁸¹ So far, courts have been unsympathetic to right-of-publicity claims by athletes depicted in sports broadcasts and related compilations. *See, e.g.*, *Marshall*, 11 F. Supp. 3d at 830 (dismissing student-athletes' right of publicity claim against sports broadcaster, on the ground that sports broadcasts are exempt from Tennessee's right of publicity); *Gionfriddo v. Major League Baseball*, 114 Cal. Rptr. 2d 307, 318 (Cal. Ct. App. 2001) ("Balancing plaintiffs' negligible economic interests against the public's enduring fascination with baseball's past, we conclude that the public interest favoring the free dissemination of information regarding baseball's history far outweighs any proprietary interests at stake.").

⁸² *See, e.g.*, *Comedy III Prods. v. Gary Saderup, Inc.*, 21 P.3d 797, 809 (Cal. 2001) ("The inquiry is in a sense more quantitative than qualitative, asking whether the literal and imitative or the creative elements predominate in the work.").

⁸³ *E.g.*, *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (en banc) ("[T]he use and identity of Twist's name has become predominantly a ploy to sell comic books and related products rather than an artistic or literary expression, and under these circumstances, free speech must give way to the right of publicity.").

⁸⁴ *E.g.*, *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 976 (10th Cir. 1996) ("The law attempts to . . . [strike] a proper balance between the right of a creator to the fruits of his labor and the right of future creators to free expression.").

⁸⁵ 875 F.2d 994 (2d Cir. 1989); *see supra* note 53 and accompanying text (discussing the *Rogers* standard).

⁸⁶ *See, e.g.*, *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 163 (3d Cir. 2013) ("[T]herein lies the weakness of comparing the right of publicity to trademark protections: the right of publicity is broader and, by extension, protects a greater swath of property interests. Thus, it would be

from vagueness to relative clarity, the right of publicity has muddled on in ambiguity.

This diverse doctrinal menu, when combined with the subjectivity of the standards as applied, reinforces the impression that most cases turn less on doctrine than on judges' personal views about the line between legitimate use and exploitation.⁸⁷ Some courts show skepticism about publicity rights and weigh them lightly against speech interests,⁸⁸ while others view the use of name or likeness to enhance the value of a product as inherently suspect.⁸⁹ As a result, beyond the conventional worlds of advertising (at one end) and news accounts (at the other), the law offers inadequate notice of when the use of a celebrity name or likeness supports a right-of-publicity claim.

C. *How: Notice Failure In Enforcement Practice*

So far, this Part has demonstrated that both trademark and right-of-publicity law offer inadequate notice about the existence and scope of legal entitlements. As a result, parties considering adopting trademarks, or incorporating individuals' identities into their expressive works, often cannot predict, with confidence, whether they will run afoul of someone else's legal rights.

Particularly in trademark law, this substantive notice failure is compounded by a lack of transparency in the mechanisms for enforcing trademark rights. While statistics are hard to come by, commentators agree that the vast majority

unwise for us to adopt a test [from *Rogers*] that hews so closely to traditional trademark principles." (citing *Rogers*, 875 F.2d at 1004)).

⁸⁷ Compare, for example, the sports video game cases with *Noriega*. Compare, e.g., *Hart*, 717 F.3d at 154 ("Appellant's claims stemmed from Appellee's alleged use of his likeness and biographical information in its NCAA Football series of videogames."), with *Noriega v. Activision/Blizzard, Inc.*, No. BC-551747, 2014 WL 5930149 at *1 (Cal. Super. 2014) ("The complaint . . . contends that defendants: (1) designed, created, advertised and sold the popular video game 'Call of Duty: Black Ops II;' . . . [and] 'engaged in the blatant misuse, unlawful exploitation and misappropriation of plaintiff's image and likeness for economic gain.'"). Both cases involved very similar likenesses of the depicted parties, but the college football players tended to win, while *Noriega* lost, based on the same "transformative" test. Compare, e.g., *Hart*, 717 F.3d at 168 ("[W]e consider whether the type and extent of [video game player] interactivity permitted is sufficient to transform the Appellant's likeness into the Appellee's own expression. *We hold that it does not.*" (emphasis added)), with *Noriega*, 2014 WL 5930149, at *4 ("[E]vidence compels the conclusion that defendants' use of *Noriega's* likeness was transformative. . . . [T]he marketability and economic value of the challenged work in this case comes not from *Noriega*, but from the creativity, skill and reputation of defendants.").

⁸⁸ E.g., *Cardtoons*, 95 F.3d at 972 ("Cardtoons' interest in publishing its parody trading cards implicates some of the core concerns of the First Amendment.").

⁸⁹ E.g., *White v. Samsung Elec. of Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992) ("Considerable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit. The law protects the celebrity's sole right to exploit this value . . .").

of trademark enforcement happens through cease-and-desist letters sent to parties that have used marks or applied to register them.⁹⁰ By all accounts, many recipients of these letters back down without regard to the merits of the claim against them. William Gallagher, Irina Manta, Leah Chan Grinvald, Kenneth Port, and others have explored the structural reasons for this widespread capitulation, which often boil down to an unwillingness to endure the expense and uncertainty of prolonged litigation brought by deep-pocketed plaintiffs.⁹¹ The notice failures identified above play a critical role in recipients' unwillingness to fight: given the vagaries of trademark rules, many businesses would rather change their marketing plans *ex ante* than engage in protracted battle with uncertain outcomes.⁹²

This shadowy, pervasive cease-and-desist practice is not only enabled by trademark law's notice failures, but it also exacerbates them, by creating an impression of broader rights than the law provides. Cease-and-desist letters routinely include lists of other parties that have surrendered to the trademark holder's demands to abandon their marks.⁹³ Such lists can leave the impression that the trademark holder had the legal right to force each of these surrenders, even though most of them resulted, not from any judicial decision, but from a blend of legal ambiguity and risk aversion.⁹⁴ Part II, below, discusses the ways in which successful cease-and-desist practice can actually expand the

⁹⁰ William Gallagher's qualitative empirical study, based on interviews with intellectual property lawyers, supports the notion that most trademark disputes are resolved through cease-and-desist letters followed by private negotiation. See William T. Gallagher, *Trademark and Copyright Enforcement in the Shadow of IP Law*, 28 SANTA CLARA COMPUTER & HIGH TECH. L.J. 453, 453 (2012) ("Cease and desist" letters, phone calls, and negotiations with alleged infringers constitute the bulk of IP enforcement efforts in trademark and copyright practice."); see also Leah Chan Grinvald, *Policing the Cease-and-Desist Letter*, 49 U.S.F. L. REV. 411, 411 (2015) ("Statistics show that approximately only three percent of all legal disputes are brought to the judicial system." (citation omitted)).

⁹¹ See generally *supra* notes 2, 90; see also Gibson, *supra* note 18.

⁹² This is especially true for parties that have filed an intent-to-use application to register a mark that they have not yet adopted. The cost of selecting and adopting a different trademark may pale in comparison to the cost of re-branding in the event of an injunction or ultimate PTO rejection. And while PTO proceedings move more quickly than federal court litigation, final resolution can take years—too long to put branding and marketing plans on hold. Cf. *Classic Liquor Imps., Ltd. v. Spirits Int'l B.V.*, No. 15 Civ. 6503 JSR, 2015 WL 9487886, at *5, *7 (S.D.N.Y. Dec. 29, 2015) (referencing efforts by established firm to disrupt upstart competitor's adoption of trademark, and allowing declaratory judgment action to resolve parties' relative rights).

⁹³ E.g., Letter from Auma N. Reggy, Attorney for Chick-fil-A, to Daniel P. Richardson, Attorney for Bo Muller-Moore 3 (Oct. 4, 2011), <http://www.scribd.com/doc/74942618/Chick-fil-A-2011-C-D-Letter-Over-Eat-More-Kale#download> [<https://perma.cc/7HG9-6K9V>] (listing thirty marks "in which the owners/users . . . agreed to cease and desist their use," including EAT MORE VEGETABLES and EAT MORE BEER).

⁹⁴ See generally Gibson, *supra* note 18, at 901 ("Even when the argument for liability is weak, the letter's recipient knows that he or she can no longer hope to proceed unnoticed.").

substantive scope of trademark rights. Even apart from that effect, however, the track record of success can appear, to recipients, like a common-law record of outcomes in conflicts involving the mark. When this happens, the cease-and-desist letter has a multiplier effect: not only has it convinced the current target to back down from its use, but it also fortifies the mark-holder's credibility with future targets. The non-transparency of trademark law's cease-and-desist tradition, in other words, can magnify the effects of uncertainty and risk aversion, making it even more difficult for users of trademarks to assess the legitimacy and legality of their use.

II. EXACERBATING DOCTRINES AND OTHER CIRCUMSTANCES

Given the combination of substantive and procedural features discussed above, trademark and right of publicity law arguably give insufficient guidance about when the use of a trademark, or depiction of a person, requires permission (or should simply be avoided). Rights-holders have a broad zone of plausibility for their trademark and right-of-publicity claims; especially in trademark law, the ratcheting effect of cease-and-desist practice can create the illusion of even more elastic limits.

This Part contends that a combination of rhetoric, economics and legal rules creates incentives for right-holders to test the outer limits of their legal rights—and indeed, that aggression can pay by expanding the legal entitlement. In the right-of-publicity context, the explanation is straightforward: individuals have a direct economic interest—sometimes complemented by dignity or moral concerns—in exploiting their identity to the greatest extent possible, and right-of-publicity rhetoric gives them a sense of entitlement to the value of their fame. Trademark law shares these economic incentives, but adds two twists: a misunderstanding of policing obligations among trademark holders, combined with rules that effectively enlarge the legal interests of parties that stake broad claims. Given that, it is unsurprising that trademark holders assert claims against a wide range of uses, even in the absence of harm.

A. *Right-of-Publicity Incentives*

As discussed above, the rhetoric of right-of-publicity law starts with a presumption that celebrities own the economic value associated with their fame. While speech interests can sometimes overcome that presumption, courts evaluate them on a case-by-case basis, under subjective and indeterminate standards that make outcomes hard to predict. The same uncertainties that make it hard for creators to gauge the risks associated with expressive works offer at least a prospect of success for depicted parties to block or profit from the challenged use of their identity. For a variety of reasons, this prospect may be sufficient to trigger claims that test the limits of legal doctrine, even when the stakes of a particular lawsuit appear small.

First, for some “franchise” plaintiffs whose identity has broad appeal to consumers across a range of different products, a successful right-of-publicity action may solidify licensing markets that extend well beyond that case. Take

the recent lawsuit by the Rosa & Raymond Parks Institute against Target, based on the sale of books, movies, and plaques bearing Rosa Parks's name and likeness.⁹⁵ Parks's foundation claimed that Target's sale of these products—and its use of her name and image in advertising those products—violated her right of publicity.⁹⁶ Both the trial court and the Eleventh Circuit rejected the claims, invoking a “qualified privilege to report on matters in the public interest . . . deeply rooted in Michigan jurisprudence.”⁹⁷ Had the claims succeeded, however, the Parks foundation would have been entitled to licensing fees from a vast array of civil-rights-related expressive works and merchandise sold by Target and other vendors. Even with a low likelihood of success, then, the expected gains from the lawsuit may have exceeded the costs of bringing it, which could explain this otherwise perplexing litigation.

The interest in protecting broad licensing markets also undoubtedly explains *Comedy III v. Saderup*, a lawsuit against an artist who sold silkscreen t-shirts with images of the Three Stooges.⁹⁸ C3 Entertainment, Inc., the assignee of the Three Stooges' publicity rights, has a robust licensing program “with many diverse licensees offering thousands of different products and services all over the world . . .”⁹⁹ The California Supreme Court's decision in *Saderup*—that a t-shirt made from a charcoal drawing of the Three Stooges violated their right of publicity¹⁰⁰—gave C3 a sturdy foundation for its active (and, presumably, profitable) licensing campaign.

A second factor that may explain some recent right-of-publicity gambles is their suitability for class-action status. Many mass-produced expressive works, especially in the sports context, involve numerous, similarly situated parties whose claims can be resolved as a class.¹⁰¹ While each class member may have an insignificant expected recovery,¹⁰² the aggregate damages from a successful

⁹⁵ *Rosa & Raymond Parks Inst. for Self Dev. v. Target Corp.*, No. 15-10880, 2016 WL 25495, at *2 (11th Cir. Jan. 4, 2016).

⁹⁶ *Id.* at *2. The lawsuit also included claims of unfair competition and unjust enrichment. *Id.*

⁹⁷ *Id.* at *4 (quoting *Rouch v. Enquirer & News of Battle Creek*, 398 N.W.2d 245, 253 (Mich. 1986)); *Rosa & Raymond Parks Inst. for Self Dev. v. Target Corp.*, 90 F. Supp. 3d 1256, 1264-65 (M.D. Ala. 2015) (“Michigan courts . . . have applied the legitimate public interest privilege to instances where the misappropriation occurred for the purposes of making a profit.”), *aff'd*, No. 15-10880, 2016 WL 25495 (11th Cir. Jan. 4, 2016).

⁹⁸ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797 (Cal. 2001).

⁹⁹ *Licensing*, C3 ENTERTAINMENT, INC., <http://www.threestooges.com/licensing/> [<https://perma.cc/QNF9-XXZ3>].

¹⁰⁰ *Saderup*, 21 P.3d at 811.

¹⁰¹ *E.g.*, *Marshall v. Nat'l. Football League*, 787 F.3d 502, 505-06 (8th Cir. 2015) (deciding suit filed by a class of former NFL players alleging that the League violated their publicity rights by selling films with game footage).

¹⁰² Individual student-athletes have earned fairly small recoveries in their right-of-publicity suit against video game manufacturers. *See* Jon Solomon, *Current NCAA Players Could Benefit from Video Game Settlement*, CBS SPORTS (May 31, 2014),

action would be substantial, making them attractive candidates for class-action plaintiffs' lawyers.

Finally, factors other than economics clearly play a role in some right-of-publicity suits. For college athletes who feel exploited by video games that bring revenues to the NCAA but not to them, lawsuits offer the opportunity to vindicate their frustration with the NCAA's amateurism rules.¹⁰³ And for plaintiffs like Jeffrey Sarver, a lawsuit offers the opportunity to object to a fictionalized account that allegedly portrayed him (or, more accurately, a character based on him) as a "mad, foolish, crazy, wild, mentally ill man, who will recklessly risk his and others' lives because of an addiction / fascination with death."¹⁰⁴

B. *Trademark Doctrine and the Benefits of Sharp Elbows*

The vagueness of trademark law's boundaries helps to explain why even questionable trademark claims have a veneer of plausibility, giving accused parties little certainty about legal risks associated with their use of a mark. Trademark holders, of course, have plenty of financial incentive to assert many of these claims, particularly through cheap and easy cease-and-desist letters. Sometimes, the claims are an attempt to avoid competition, or to maximize licensing revenues associated with their marks. The National Football League, for example, is notorious for objecting to any mention of the Super Bowl in non-officially-licensed advertising.¹⁰⁵ Although the nominative fair use doctrine would protect many Super Bowl references in ads, the League has succeeded in intimidating advertisers into compliance, presumably in the hope of enhancing the value to "official sponsors" of the right to mention the Big Game.¹⁰⁶ Similar economic motivations explain efforts by universities and

<http://www.cbssports.com/collegefootball/writer/jon-solomon/24577543/current-ncaa-players-could-benefit-from-video-game-settlement> [https://perma.cc/R58J-YJB8] (mentioning recoveries ranging from \$48 for players featured on game roster to \$15,000 for named plaintiffs).

¹⁰³ See, e.g., *Keller*, 724 F.3d 1268, 1289 (9th Cir. 2013) (explaining that "even if an athlete wished to license his image to EA, the athlete could not do so without destroying amateur status").

¹⁰⁴ Plaintiff's Complaint and Demand for Jury Trial at 15, *Sarver v. Hurt Locker, LLC*, No. 2:10-cv-09034-JHN-JC, (C.D. Cal. Mar. 2, 2010).

¹⁰⁵ See Steve Baird, *The NFL's Super Bowl Trademark Nonsense*, DUETS BLOG (Jan. 27, 2015), <http://www.duetsblog.com/2015/01/articles/trademarks/the-nfls-super-bowl-trademark-nonsense/> [https://perma.cc/HWK4-QCAQ] ("Advertisers—fearful of NFL legal action—strain and contort to avoid the two words that could make out a nominative fair use of the Super Bowl trademark, opting instead for pairs of other code words like 'Super Sunday,' the 'Big Game,' 'Super Party,' or 'Superb Owl' coverage.").

¹⁰⁶ Indeed, the NFL tried to register The Big Game to prevent even this reference to its winter sporting event. See Peter Lattman, *The NFL Punts on Trademarking "The Big Game"*, WALL STREET J.: L. BLOG (May 25, 2007, 9:17 AM), <http://blogs.wsj.com/law/2007/05/25/the-nfl-punts-on-trademarking-the-big-game/> [https://perma.cc/U963-SVW8]. It

other entities to clamp down on sale of merchandise bearing any relationship to their logos or colors.¹⁰⁷ Encouraged by the normative trend toward an unjust enrichment approach to trademark law, brand owners have vigorously pursued licensing markets to optimize the profits they can earn from their marks.¹⁰⁸ As a result, they often object to any perceived threat to those markets, even by parties engaged in expressive or nominative use.

In other contexts, mark owners appear motivated by a desire to squelch commentary or to control the mental associations that consumers have regarding their marks. The National Association for the Advancement of Colored People (“NAACP”), for example, threatened an anti-abortion group that used its trademark in an online article criticizing its position on abortion.¹⁰⁹ The state of Louisiana sued MoveOn.org for creating billboards that used the state’s tourism logo to parody Governor Jindal’s position on abortion.¹¹⁰ The U.S. Chamber of Commerce sued a comedy duo for staging a fake press conference announcing a change in the Chamber’s position on climate change.¹¹¹

If courts are concerned about trademark holders abusing their rights in an effort to prevent nominative or expressive uses, they should firm up these limiting doctrines to eliminate the plausibility of some of these questionable claims. The law has arguably improved with regard to expressive uses; courts could further improve matters by not letting confusion in through the back door with respect to nominative fair use. Only after achieving greater doctrinal

failed, of course, because that term has long been used in connection with an annual football game between University of California, Berkeley, and Stanford. *Id.* The International Olympic Committee has taken similar actions with respect to use of the OLYMPIC name or logo, going so far as to persuade host countries to pass legislation prohibiting even non-confusing uses of Olympic-related names and symbols. See Susan Corbett & Alexandra Sims, *Sui Generis Protection for Sporting Emblems and Words: A Triumph of Pragmatism Over Principle*, in *THE INTERNET AND THE EMERGING IMPORTANCE OF NEW FORMS OF INTELLECTUAL PROPERTY* (Susy Frankel & Daniel Gervais eds., forthcoming 2016); Jeré Longman, *Where Even Sausage Rings Are Put on the Chopping Block*, N.Y. TIMES (July 24, 2012), <http://nyti.ms/1Tuh9Op> [<https://perma.cc/VX39-Z3D2>] (discussing how a butcher was told to remove the Olympic rings he had placed on a sign outside of his shop).

¹⁰⁷ See *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 485 (5th Cir. 2008) (granting summary judgment in favor of university on its claims that defendant infringed by selling t-shirts featuring school colors and other trademarks).

¹⁰⁸ See Pete Canalichio, *Brand Licensing Provides More Outlets for Profit and Exposure*, ENTREPRENEUR (May 23, 2014), <http://www.entrepreneur.com/article/234163> [<https://perma.cc/8MPC-9KB7>] (discussing the benefits of licensing a brand).

¹⁰⁹ *Radiance Found., Inc. v. NAACP*, 786 F.3d 316 (4th Cir. 2015).

¹¹⁰ *Dardenne v. MoveOn.org*, No. 14-00150-SDD-SCR, 2014 WL 1364854, at *4 (M.D. La. Apr. 7, 2014).

¹¹¹ See Bill Donahue, *Six Ways IP Has Been Used to Attack Critics*, LAW360 (June 3, 2015), <http://www.law360.com/articles/663167/print?section=media> [<https://perma.cc/3QPJ-MZAL>].

clarity can courts take the next step of imposing sanctions or other costs against parties that assert abusive or overreaching claims.¹¹²

Clarifying these doctrines can address many examples of trademark-holder overreaching—cases in which the defendant has some legitimate interest in referencing the trademark holder either directly or through evocation. A whole other species of purported bullying, however, involves improbable claims of infringement against parties whose marks happen to resemble a protected one. Take Monster Mini Golf, for example, facing a charge of infringement by Monster Cable.¹¹³ Or the claim that EAT MORE KALE t-shirts infringe rights on a fast food chain's EAT MOR CHIKIN mark.¹¹⁴ Here, too, ambiguities in trademark doctrine make the claims difficult to disregard, but it's hard to imagine that the trademark holder is harmed—or even that it loses a licensing opportunity—as a result of the use. It might appear, then, that trademark holders act irrationally when they object to such uses. But the doctrine actually encourages them to do so, in two distinct ways.

The first way in which the doctrine encourages aggressive behavior is through the oft-repeated trope that trademark holders must police their marks. In reality, trademark holders' obligation to police is more limited than some trademark holders appear to believe; they cannot lose their rights, for example, by failing to object to uses that do not rise to the level of infringement.¹¹⁵ But the law does require trademark holders to take certain enforcement steps in order to preserve their rights, and the very ambiguities that create notice problems for putative defendants may well encourage trademark holders to take an “object first, analyze later” approach to enforcement. And in some circumstances, at least—particularly the context of genericide—the doctrine

¹¹² See, e.g., Manta, *supra* note 2, at 863 (“An excessively blurry line between forceful but legitimate enforcement and bullying is bound to render judicial sanctions ineffective.”). See generally Grinvald, *supra* note 90.

¹¹³ Steve Stecklow, *The Scariest Monster of All Sues for Trademark Infringement*, WALL STREET J. (Apr. 4, 2009), <http://www.wsj.com/articles/SB123869022704882969> [<https://perma.cc/8A5E-4GD3>] (exploring the claims against Monster Mini Golf and explaining that “[o]ver the years, [Monster Cable] has gone after purveyors of monster-branded auto transmissions, slot machines, glue, carpet-cleaning machines and an energy drink, as well as a woman who sells ‘Junk Food Monster’ kids’ T-shirts that promote good eating habits”).

¹¹⁴ See *supra* note 14 and accompanying text.

¹¹⁵ E.g., ProFitness Physical Therapy Ctr. v. Pro-Fit Orthopedic & Sports Physical Therapy P.C., 314 F.3d 62, 70 (2d Cir. 2002) (“[A] plaintiff should not be obligated to sue until its right to protection has ripened such that plaintiff knew or should have known . . . that [plaintiff] had a provable infringement claim . . .”). See generally Sheff, *supra* note 2, at 883 (“But the duty to police is not absolute—not every forbearance from enforcement will negatively affect a mark owner’s legal rights—and clients should know about that as well.”); Adidas Am., Inc. v. Payless Shoesource, Inc., 529 F. Supp. 2d 1215, 1259 (D. Or. 2007) (rejecting argument that failure to object to third-party use of related but distinct marks could constitute abandonment of asserted trademark).

does effectively require trademark holders to pay attention to third-party use of their mark, lest they lose rights in the mark.¹¹⁶ Sandy Rierson and Deven Desai have suggested adjustments that would reduce the burden on trademark holders to police non-branding use of terms that have both trademark and generic significance.¹¹⁷ More generally, trademark law would benefit from greater clarity about the duty to police.

Misconceptions of the duty to police, however, may play a smaller role in encouraging trademark aggression than another, far more intractable, feature of trademark law: the notion that “stronger” trademarks get more robust legal rights than “weaker” ones. Several rules of trademark law offer broader legal protection to parties that have succeeded in creating space between their marks and others—even when those others sell products that bear no relation to the trademark holder’s. These doctrines arguably encourage trademark holders to object to others’ trademarks, without regard to whether those parties are threatening confusion or causing other harm. Indeed, one could argue that, in light of these doctrines, many cases of purported bullying involve trademark holders making rational attempts to maximize the value of their assets—not because they risk *losing* their marks if they fail to object, but because their rights will be more valuable if their objection succeeds.¹¹⁸

The most obvious of these doctrines is anti-dilution law, which gives owners of “famous” marks the right to prevent the “dilution” of their marks through tarnishment or blurring.¹¹⁹ Critics have questioned the basis for these laws, contending, among other things, that the strongest marks may be the *least* likely to suffer loss of distinctiveness from other parties’ use of similar

¹¹⁶ See Grinvald, *supra* note 2, at 640 (“Since the expanded scope of trademark protection is afforded to stronger trademarks, trademark owners have a burden of either increasing the strength of their trademark, or ensuring that their strong trademark does not lose its strength.”); cf. Kiser, *supra* note 2, at 229-32 (discussing how the actual risk of losing a trademark due to failure to police is “highly exaggerated”). Sandra Rierson and Deven Desai have taken issue with this aspect of genericism doctrine, and have advocated a more nuanced approach that would preserve trademark protection for marks that have trademark significance, even if they also have a generic meaning. See generally Deven R. Desai & Sandra L. Rierson, *Confronting the Genericism Conundrum*, 28 CARDOZO L. REV. 1789 (2007).

¹¹⁷ Desai & Rierson, *supra* note 116, at 1792 (“[W]e contend that the genericism doctrine should be re-anchored to focus on the mark’s ability to act as a source identifier for the consumer in commercial contexts.”).

¹¹⁸ See generally MCCARTHY, *supra* note 46, § 11.91 (“[T]he corporate owners of trademarks have a duty to protect and preserve the corporation’s trademark assets through vigilant policing and appropriate acts of enforcement. Inaction will inevitably lead to erosion of those key corporate assets: the marks that identify and distinguish the corporation’s goods and services.”).

¹¹⁹ See 15 U.S.C. § 1125(c) (2012).

signs.¹²⁰ Yet the law provides this powerful form of protection to famous marks based on the assumption that use of similar marks by unauthorized parties may whittle away the famous mark's distinctiveness. And in deciding whether such whittling away is likely to occur, courts are instructed to consider, among other things, "the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark."¹²¹ Mark owners aspiring to attain "famous mark" status thus have an incentive to object to third-party use of their mark, even on different products and when confusion is unlikely.

The bias in favor of "strong" marks extends beyond dilution laws. In infringement analysis, strong marks get a thumb on the scale in proving likelihood of confusion.¹²² Strength, moreover, turns in part on distance between the claimed mark and others in the marketplace.¹²³ In gauging that distance, courts don't always limit themselves to marks that are close enough—in nature and in connection with their goods—to justify a claim of infringement. Some courts also take into account whether marks sharing

¹²⁰ See, e.g., Barton Beebe, *A Defense of the New Federal Trademark Antidilution Law*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1143, 1149-50 (2006) ("While two identical marks coexisting in the same marketplace will by definition negate each other's uniqueness, they need not blur each other, i.e., they need not increase consumer search costs or otherwise require consumers to 'think for a moment' before recognizing the respective sources of the marks. This is especially the case when one of the marks is very strong."); Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507, 542-44 (2008) ("Instead of a tree of associations, a better metaphor for mental models of strong brands might be a city with numerous one-way streets."); cf. Maureen Morrin & Jacob Jacoby, *Trademark Dilution: Empirical Measures for an Elusive Concept*, 19 J. PUB. POL'Y & MARKETING 265, 272 (2000) ("[S]ome brands, such as Continental Airlines, are so familiar to consumers . . . that recall of their original product category is largely immune to trademark dilution."); Tushnet, *supra*, at 541 n.170 (discussing the continued strength of the Hyatt and Lexis brands despite exposure to trademark-dilution).

¹²¹ 15 U.S.C. § 1125(c)(2)(B).

¹²² See, e.g., *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002) ("Fame of an opposer's mark or marks, if it exists, plays a 'dominant role in the process of balancing the *DuPont* factors."); *Kenner Parker Toys, Inc. v. Rose Art Indus.*, 963 F.2d 350, 353 (Fed. Cir. 1992) ("A strong mark . . . casts a long shadow which competitors must avoid."); *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 U.S.P.Q.2d 1816, 1822 (T.T.A.B. 2015) (finding WINEBUD as a mark for wine-related products confusingly similar to BUD as a mark for beer and noting that "[a]lthough fame is 'insufficient, standing alone, to establish likelihood of confusion,' . . . a finding of fame puts a heavy thumb on Opposer's side of the scale" (citations omitted)). See generally Barton Beebe, *An Empirical Study of the Multi-Factor Test for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1589 (2006) (describing strength of the mark as one of the four factors most likely to determine outcomes in likelihood-of-confusion analyses).

¹²³ See Beebe, *supra* note 122, at 1599 (describing how most Circuits view the strength of a mark and the proximity of the goods as the strongest factors).

similar features appear in fields “at least broadly . . . related to [the trademark holder’s] business.”¹²⁴ As a result, the existence of somewhat similar marks, on somewhat similar products, can count against a trademark holder in *any* infringement suit involving its mark.¹²⁵ Given this, it’s unsurprising that trademark holders object when they perceive any encroachment into the space surrounding their mark. The encroachment may not confuse consumers, and trademark holders’ failure to object to it may not result in loss of rights in their mark; but it can affect the value of their trademarks and the scope of their legal rights going forward. For this reason, Professor McCarthy warns that “[t]he only way a trademark owner can prevent the market from being crowded with similar marks is to undertake an assertive program of policing adjacent ‘territory’ and suing those who edge too close.”¹²⁶ And given the inherent fuzziness of trademark’s boundaries, judging what comes “too close” can, itself, be daunting.

I don’t mean to serve as an apologist for overreaching trademark holders. I have written elsewhere about the costs of expanding trademark rights without regard to confusion, and I believe that as the effective scope of trademark rights broadens, both competitors and consumers can suffer. My point here is that the law has not only failed in its function of delineating clear boundaries of trademark holder rights; it has arguably made things worse, by defining trademarks’ value, at least in part, by reference to uses that fall outside any reasonable definition of those boundaries. Recognizing this reality can help to put some cases of purported bullying into a different perspective. When a lawyer for Monster Energy Drinks recommended that the company object to a

¹²⁴ *PostX Corp. v. docSpace Co.*, 80 F. Supp. 2d 1056, 1061 (N.D. Cal. 1999) (concluding that marks that “clearly use, to varying degrees, elements of plaintiff’s mark’s design” by businesses that are “part of a field which at least broadly would include or be related to plaintiff’s business” weaken plaintiff’s mark); *see also One Indus., LLC, v. Jim O’Neal Distrib., Inc.*, 578 F.3d 1154, 1164-65 (9th Cir. 2009) (“The record, however, contains several examples of similar O marks used by different companies, including Oakley, OGIO, and Alloy MX. Such use of other ‘O’ symbols weakens the Rounded O’ mark.”); *Estee Lauder, Inc. v. Gap, Inc.*, 108 F.3d 1503, 1511 (2d Cir. 1997) (finding weakness of mark demonstrated by evidence that, when applicant sought to register mark, “there were more than 70 trademark registrations, pending applications for registration or renewal, or publications-for-opposition that incorporated the term ‘100%,’ and . . . *some* of those marks were for cosmetic products” (emphasis added)); *Sun Banks of Fla., Inc. v. Sun Fed. Sav. & Loan Ass’n*, 651 F.2d 311, 316 (5th Cir. 1981) (finding that evidence “abundantly established existing third-party use of the name ‘Sun,’ both within and without the financial community”); *JL Beverage Co., v. Beam, Inc.*, 899 F. Supp. 2d 991, 1000 (D. Nev. 2012) (“When considering whether the senior mark is weakened by its presence in a ‘crowded field’ of similar marks, the relevant field is ‘a field which at least broadly would include or be related to [the] plaintiff’s business.’”).

¹²⁵ Not all courts follow this rule. The Ninth Circuit, for example, has held that use of similar marks in unrelated markets is “irrelevant” to infringement analysis. *See Eclipse Assocs. Ltd. v. Data Gen. Corp.*, 894 F.2d 1114, 1119 (9th Cir. 1990).

¹²⁶ MCCARTHY, *supra* note 46, § 11.91.

brewery's sale of Vermonster beer,¹²⁷ she probably did not perceive any real risk of confusion or dilution of the Monster Energy marks. But she may well have concluded that objecting to any drink-related use of monster would help to preserve the strength of her client's mark, in general, in future cases.¹²⁸ This doesn't mean that the world is better off as a result of that action; but it does mean that the accused bully had a plausible reason for its aggression. If we want to curb that aggression, we should modify trademark law's incentives.

III. WHAT'S TO BE DONE?

This Essay has contended that three factors—vague legal boundaries, non-transparent enforcement mechanisms, and doctrines that reward aggression—may be fueling aggressive behavior by trademark and right-of-publicity claimants. It makes no empirical claim about the existence or frequency of such overreaching, but in light of these factors, it would come as no surprise if it turned out to be quite common.

If these three features combine to create an environment conducive to overreaching, the tweaking any one of them could help, at least around the edges. In the right-of-publicity context, industries built upon referential expressive works are virtually crying out for clearer notice about the balance between publicity rights and creative expression. The prevailing ad hoc approach for distinguishing between speech and exploitation leaves too much uncertainty about when the use of individuals' name, likeness, or identifying characteristics requires permission. Of course, if certainty alone is the goal, courts could resolve the situation in either direction, by adopting bright-line rules that favor either side. A rule that *every* profit-oriented use of celebrity identity requires permission, for example, would provide clear notice, though it would arguably trample time-honored values of free expression. At the other end, courts could bring greater certainty by adopting a test like *Rogers v. Grimaldi*, which involves less subjective balancing and more reliance on objective questions about the relationship between the individual's identity and the expressive work.¹²⁹

¹²⁷ Meg Marco, *Brewer Sued By Monster Energy Drink Asks America For Help*, CONSUMERIST (Oct. 14, 2009), <http://consumerist.com/2009/10/14/brewer-sued-by-monster-energy-drink-asks-america-for-help/> [<https://perma.cc/4BGE-VDYB>] (describing how a small Vermont brewer was sued by the maker of the Monster Energy drink for trademark infringement for the brewer's 'Vermonster' beer).

¹²⁸ Indeed, in at least one case, the Ninth Circuit concluded that a successful trademark enforcement strategy could make a "crowded field" less crowded. *See* *Abercrombie & Fitch Co. v. Moose Creek, Inc.*, 486 F.3d 629, 634 (9th Cir. 2007) ("Abercrombie presented evidence that its trademark enforcement had resulted in several competitors abandoning their use of moose images. It was not clearly inconsistent for Abercrombie to assert that the field is now less crowded.").

¹²⁹ *See supra* note 53 and accompanying text (discussing the *Rogers* standard).

In the trademark context, there is room for adjustment to all three of the levers that may contribute to overreaching. First and foremost, courts could reduce trademark law's notice failures by clarifying the boundaries of trademark rights. A variety of tools could achieve this purpose, alone or in combination. A robust trademark use doctrine, for example, would add doctrinal clarity by distinguishing between direct and contributory infringement claims. Furthermore, a materiality requirement would discourage legal claims for harmless infringement, by discouraging lawsuits over attenuated risks of confusion over association. Most promisingly, courts could add rigor and clarity to trademark law's defenses, carving out categories of protected use that fall safely beyond trademark holders' reach. Any level of increased doctrinal clarity would not only help with the resolution of individual cases, but it could enable "best practices" initiatives and other efforts that could empower targets to assess the credibility of cease-and-desist letters and other legal threats.

Beyond addressing these substantive notice failures, courts, legislatures, professional organizations, and members of the public can help to influence the role that cease-and-desist practice plays in contributing to trademark holder overreaching. Leah Chan Grinvald has demonstrated that public shaming can play a powerful role in dampening trademark holders' aggression; in her most recent article, she has proposed some initiatives designed to curb outrageous cease-and-desist letters.¹³⁰ Irina Manta and others have suggested alternatives.¹³¹ To the extent that these efforts can reduce the expected benefit to trademark holders from sending letters that reflect unreasonable interpretations of their rights, they can at least partially address the self-reinforcing, ratcheting-up effect of trademark law's non-transparent enforcement scheme. And in the registration context, the PTO could consider adopting policies that discourage unreasonable oppositions—a practice that is likely to grow in importance in the wake of *B&B Hardware, Inc. v. Hargis Industries Inc.*¹³²

Finally, courts should reconsider the doctrines that effectively encourage trademark holders to reach as broadly as possible in building fences around their marks. To some extent, these doctrines are intuitive and inevitable. It makes sense, for example, to allow only weak protection to marks in a very "crowded field," because none of the marks is likely to have much source-identifying meaning to consumers. But the converse does not necessarily hold—i.e., that especially strong marks are uniquely vulnerable to confusion or

¹³⁰ See generally Grinvald, *supra* note 90.

¹³¹ See Manta, *supra* note 2, at 853 (suggesting that the Patent & Trademark Office make "preliminary determinations about the validity of infringement claims" so that "trademark owners could record evidence of policing while being discouraged from making frivolous claims.").

¹³² 135 S. Ct. 1293, 1310 (2015) (holding that administrative decisions by the Trademark Trial and Appeal Board may have preclusive effect in civil litigation).

dilution, such that they need an extra-broad scope of protection. It may be, in fact, that the strongest marks are the least vulnerable to confusion or dilution, because consumers will continue to recognize them, regardless of whether other parties adopt somewhat similar terms.¹³³ In light of the negative effect that the “strong marks” preference appears to have on trademark enforcement, it is worth at least considering whether it is serving a legitimate function.

One recent development might prove important in shifting enforcement incentives in trademark law. In the wake of *eBay Inc. v. MercExchange, LLC*,¹³⁴ some courts have begun to soften the presumption of irreparable harm in trademark suits, instead requiring trademark holders to demonstrate a real threat of injury.¹³⁵ If this trend continues, the expected reward from bringing trademark claims will diminish, because courts may find that minor confusion rarely threatens meaningful harm.¹³⁶ If trademark holders are denied injunctive relief in these cases, they will have less power to influence the use of marks by third parties that may make consumers think of them, but that do them no harm. Indeed, we might all be better off in a world in which strong trademarks had more and better company.

¹³³ Tushnet, *supra* note 120, at 541-42 (“[I]n the dilution experiments, certain-well known brands [such as Lexis and Hyatt] resist dilution even without reminder ads.”).

¹³⁴ 547 U.S. 399 (2005) (holding that the traditional four-factor equitable test applies when determining whether to award permanent injunctive relief, which includes demonstrating the suffering of “irreparable harm”).

¹³⁵ *Ferring Pharm., Inc. v. Watson Pharm., Inc.*, 765 F.3d 205, 206 (3d Cir. 2014) (holding that in light of *eBay*, “a party bringing a claim under the Lanham Act is not entitled to a presumption of irreparable harm when seeking a preliminary injunction and must demonstrate that irreparable harm is likely”); *Herb Reed Enters. v. Fla. Entm’t Mgmt.*, 736 F.3d 1239, 1249 (9th Cir. 2013) (“We now join other circuits in holding that the *eBay* principle—that a plaintiff must establish irreparable harm—applies to a preliminary injunction in a trademark infringement case.”).

¹³⁶ Indeed, at least in the Ninth Circuit, even a showing of actual consumer confusion may not be enough to demonstrate irreparable harm. *See Williams v. Green Valley RV, Inc.*, No. 8:15-CV-01010-ODW-MRW, 2015 WL 4694075, at *3 (C.D. Cal. Aug. 6, 2015).