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AN EXCLUSIVE RIGHT TO EVOKE

Stacey L. Dogan*

Abstract: Ten years ago, in *White v. Samsung Electronics America, Inc.*, the U.S. Court of Appeals for the Ninth Circuit held that a robot violated Vanna White's publicity rights. Since *White*, the tendency to equate evocation with infringement in trademark and right of publicity cases has only grown. In contrast to this expansionist trend in trademark and right of publicity law, however, courts in recent copyright cases have arguably backed away from a strong right to evoke. This Article identifies these trends and suggests some reasons for concern over an exclusive right to evoke. The author argues that if we wish to preserve a rich commons and avoid significantly chilling free expression, courts should at least cabin the right to evoke and ensure that, when utilized, it serves the law's normative goals.¹

Introduction

evoke \i-'vOk\ . . . **1:** to call forth or up: as . . . **c:** to bring to mind or recollection.....²

Ten years have passed since the U.S. Court of Appeals for the Ninth Circuit, in *White v. Samsung Electronics America, Inc.*,³ held that a robot violated Vanna White's publicity rights.⁴ In *White*, the court held

* Associate Professor, Northeastern University School of Law. This Article was presented at the Boston College Law School Symposium on Intellectual Property, E-Commerce and the Internet in October 2002. I appreciate helpful comments from the participants, particularly Fred Yen, Joe Liu, Ruth Okediji, and Tony Reese.

¹ As this Article was going to press, the United States Supreme Court decided *Moseley v. V Secret Catalogue, Inc.*, 123 S. Ct. 1115 (2003), rejecting a strong-form right to evoke under trademark law. See *infra* notes 135-150 and accompanying text.

² Merriam-Webster's Collegiate Dictionary 402 (10th ed. 1996).

³ 971 F.2d 1395 (9th Cir. 1992).

⁴ See *id.* at 1399. The court was actually reversing a grant of summary judgment for the defense, but it made its views of the merits clear. See *id.* Ultimately, a jury awarded White \$403,000 in damages. See *Vanna White Wins Suit*, Wall St. J., Jan. 24, 1994, at B2; see also *Wendt v. Host Int'l, Inc.*, Nos. 93-56318, 93-56510, 1995 WL 115571, at *1-2 (9th Cir. Mar. 16, 1995) (similarities between physical characteristics of robots and actors precluded summary judgment for defendants in right of publicity claim).

that the right of publicity extends beyond a celebrity's name or likeness to cover virtually any symbol that might "evoke" a celebrity's identity for commercial gain.⁵ Judge Kozinski argued in his dissent from a denial of rehearing en banc, "Instead of having an exclusive right in her name, likeness, signature or voice, every famous person now has an exclusive right to *anything that reminds the viewer of her*. After all, that's all Samsung did: It used an inanimate object to remind people of White, to 'evoke [her identity].'"⁶

Kozinski portrayed this so-called "right to evoke" as a radical departure from prior precedent,⁷ but in fact, intellectual property laws had been used for some time to prevent the use of non-proprietary symbols to evoke personal identities, trademarks, or creative works. The right of publicity law was applied to look-alikes,⁸ sound-alikes,⁹ and a racecar that made people think of its driver;¹⁰ state trademark

⁵ See *White*, 971 F.2d at 1399 (A broad right of publicity is necessary because "[t]he identities of the most popular celebrities are not only the most attractive for advertisers, but also the easiest to evoke without resorting to obvious means such as name, likeness, or voice.").

⁶ *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1515 (9th Cir. 1993) (Kozinski, J., dissenting) (denial of rehearing en banc).

⁷ See *id.* Kozinski had plenty of company in criticizing the outcome in *White*. See Arlen W. Langvardt, *The Troubling Implications of a Right of Publicity "Wheel" Spun Out of Control*, 45 U. Kan. L. Rev. 329, 399 (1997) (contending that the Ninth Circuit decision created "a property right of unprecedented and unwarranted scope"); David S. Welkowitz, *Catching Smoke, Nailing JELL-O to a Wall: The Vanna White Case and the Limits of Celebrity Rights*, 3 J. Intell. Prop. L. 67, 77-84 (1995); Linda J. Stack, Note, *White v. Samsung Electronics America, Inc.'s Expansion of the Right of Publicity: Enriching Celebrities at the Expense of Free Speech*, 89 Nw. U. L. Rev. 1189, 1194-97 (1995); Fred M. Weiler, Note, *The Right of Publicity Gone Wrong: A Case for Privileged Appropriation of Identity*, 13 Cardozo Arts & Ent. L.J. 223, 258 (1994) ("in ^anding misappropriation under these circumstances, a court is empowering White to enjoin an advertiser from depicting *anything* next to the 'Wheel of Fortune' game board").

⁸ See *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612, 624 (S.D.N.Y. 1985).

⁹ See *Lombardo v. Doyle, Dane & Bernbach*, 58 A.D.2d 620, 622 (N.Y. App. Div. 1977).

¹⁰ See *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 827 (9th Cir. 1974) (racecar driver has publicity claim against advertiser that used photo of car with unidentifiable man inside); see also *Carson v. Here's Johnny Portable Toilets*, 698 F.2d 831, 836 (6th Cir. 1983) ("Here's Johnny" mark found to violate Johnny Carson's right of publicity); *Allen*, 610 F. Supp. at 624.

[T]he question before the court is not whether some, or even most, people will be reminded of plaintiff when they see this advertisement. In order to ^and that the photograph contains plaintiff's 'portrait or picture,' the court would have to conclude that most persons who could identify an actual photograph

dilution laws had been invoked against marks that resembled other marks without causing confusion;¹¹ and copyright law had been interpreted to protect the “total concept and feel” of creative works.¹² Certainly, trademark and copyright law sometimes offered safe harbor if the evocation was designed to parody or criticize the intellectual property;¹³ but if the evocation was not so designed, courts frequently granted relief based on a party’s use of material that did not consist of, but somehow evoked, another’s original work, trademark, or celebrity image.¹⁴

After *White*, the tendency to equate evocation with infringement in trademark and right of publicity cases only grew. After the passage of the Federal Trademark Dilution Act of 1995 (“FTDA”), some courts concluded that an owner of a famous mark could prevent others from using marks that merely “conjure[d]” the famous mark,¹⁵ and actors extended the right of publicity to devices that evoked characters that

of plaintiff would be likely to think that this was actually his picture. This standard is necessary since we deal not with the question of whether an undisputed picture of plaintiff is recognizable to some, but whether an undisputed picture of defendant Boroff should be regarded, as a matter of law, to be a portrait or picture of plaintiff.

Allen, 610 F. Supp. at 624; see also *Lombardo*, 58 A.D.2d at 622 (Guy Lombardo sued claiming that singing of Auld Lang Syne appropriated his identity. The court upheld on the basis that people could be deceived into thinking he was in the commercial, even though the actor in the commercial did not resemble Lombardo.); Paul J. Heald, *Filling Two Gaps in the Restatement (Third) of Unfair Competition: Mixed-Use Trademarks and the Problem with Vanna*, 47 S.C. L. Rev. 783, 806 (1996) (contending that “Judge Kozinski’s dissent fails to garner a majority of the Ninth Circuit judges because his assertion that a reference is not an appropriation seems equally applicable to generally accepted precedent”).

¹¹ See *Toys “R” Us, Inc. v. Canarsie Kiddie Shop, Inc.*, 559 F. Supp. 1189, 1208 (E.D.N.Y. 1983) (allowing dilution claim against user of Kids “R” Us mark based on similarity to Toys “R” Us suf^ax).

¹² See *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1167 (9th Cir. 1977); *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1109–10 (9th Cir. 1970).

¹³ See *Fisher v. Dees*, 794 F.2d 432, 435 (9th Cir. 1986) (copyright); *Eveready Battery Co., Inc. v. Adolph Coors Co.*, 765 F. Supp. 440, 450 (N.D. Ill. 1991) (trademark parody).

¹⁴ See *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 218 (2d Cir. 1999); *Wendt v. Host Int’l, Inc.*, 125 F.3d 806, 810 (9th Cir. 1997).

¹⁵ See *V Secret Catalogue, Inc. v. Mosley*, 259 F.3d 464, 471 n.3 (6th Cir. 2001) (rejecting suggestion that marks must be “substantially similar” for dilution to occur, and requiring only that junior mark conjure senior mark), *rev’d*, 123 S. Ct. 1115; *Nabisco*, 191 F.3d at 218 (“The marks must be of suf^acient similarity so that, in the mind of the consumer, the junior mark will conjure an association with the senior.” (emphasis added)).

the actors played on television.¹⁶ Courts reached these decisions with little consideration of their impact on the cultural commons—i.e., on the pool of communicative resources available for use by the public.¹⁷

In contrast to this expansionist trend in trademark and right of publicity law, however, courts in recent copyright cases have arguably backed away from a strong right to evoke. For example, the “look and feel” doctrine, which initially threatened to fence off highly abstract features of copyrighted works, has matured into a fairly narrow theory of limited applicability.¹⁸ Just as significantly, courts in copyright cases have repeatedly invoked a series of limiting doctrines designed to preserve a rich public domain. The idea/expression dichotomy,¹⁹ the scenes-a-faire doctrine,²⁰ and the merger rule²¹ all enable courts to carve out dimensions of creative works that should not be owned. Fair use allows the copying of protected material if necessary to achieve a laudable goal.²² By applying a robust version of these doctrines in

¹⁶ See *Wendt*, 125 F.3d at 810 (The validity of statutory right of publicity claims is determined by “[t]he degree to which these robots resemble, caricature, or bear an impressionistic resemblance to” plaintiffs.).

¹⁷ See *id.* at 811 (The court refused to balance actors’ publicity rights against the interest of the copyright holder in a television program: “While it is true that appellants’ fame arose in large part through their participation in *Cheers*, an actor or actress does not lose the right to control the commercial exploitation of his or her likeness by portraying a ‘fictional character.’”); *White*, 971 F.2d at 1398 (limiting inquiry in right of publicity cases to whether defendant “appropriated” plaintiff’s identity by any means, including by evocation).

¹⁸ See, e.g., *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1443 (9th Cir. 1994) (establishing narrow scope of protection for cases relying exclusively on similarity in overall concept and feel); cf. *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822–25 (9th Cir. 2001) (holding that to bring a case to the fact-finder based on similarities in a work’s “total concept and feel,” a plaintiff must first establish substantial similarity in *protected* aspects of work under the Ninth Circuit’s so-called “extrinsic” test).

¹⁹ See *Williams v. Crichton*, 84 F.3d 581, 587–89 (2d Cir. 1996) (finding no infringement when the primary similarity between works lay in the same “idea” of a story set in a dinosaur theme park).

²⁰ See *id.* (The court found no substantial similarity between the settings of two works about dinosaur theme parks: although the two works “share a setting of a dinosaur zoo or adventure park, with electrified fences, automated tours, dinosaur nurseries, and uniformed workers, these settings are classic *scenes a faire* that flow from the uncopyrightable concept of a dinosaur zoo.”).

²¹ See *Yankee Candle Co., Inc. v. Bridgewater Candle Co.*, 259 F.3d 25, 36 (1st Cir. 2001) (applying merger doctrine to find no infringement unless candle labels are “nearly identical” with one another).

²² 17 U.S.C. § 107 (2000).

look-and-feel cases, most courts have resisted a strong right to evoke in copyright law.

The absence of such muscular limits in trademark and right of publicity law has fostered the growth of a right to evoke, to the clear detriment of the public. As intellectual property laws extend beyond the protection of particular, identifiable elements and into the more metaphysical realm, they threaten to overprotect in ways that stifle speech.²³ In addition, as parties succeed in enjoining behavior based on the use of non-proprietary signals that make people think of them, they risk chilling not only those who wish to appropriate their work or to trade on their reputation, but also those whose evocation is purely referential or even unknowing.²⁴ An exclusive right to evoke therefore should concern us.

This Article seeks to call attention to the right to evoke and to identify the costs associated with its expansion. "Right to evoke," as used in this Article, means a right to prevent others from calling to mind a particular piece of intellectual property even if they have not replicated the intellectual property or deceived the public in any way. The critique therefore targets evocation as a right in and of itself, and not as a piece of evidence to be considered in an infringement suit. Thus, one work's evocation of another is certainly relevant to proof of substantial similarity in a copyright case,²⁵ but it does not alone establish that a defendant has wrongfully appropriated copyrighted expression.²⁶ Likewise, to dilute a famous mark, a trademark should come closer than merely calling the mark to mind,²⁷ and evocation of a per-

²³ See generally Alfred C. Yen, *A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work's "Total Concept and Feel,"* 38 Emory L.J. 393, 426-27 (1989) (discussing risk of chill from look-and-feel doctrine).

²⁴ See *White*, 989 F.2d at 1513.

²⁵ See *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946) (articulating two-step test for infringement, requiring proof of copying and substantial similarity).

²⁶ See *id.* at 472-73 (discussing requirement to prove "illicit" or "improper" copying of copyrighted expression in infringement suit); see also *Warner Bros. Inc. v. Am. Broad. Cos.*, 720 F.2d 231, 242 (2d Cir. 1983) ("Stirring one's memory of a copyrighted character is not the same as appearing to be substantially similar to that character, and only the latter is infringement.").

²⁷ See *V Secret Catalogue*, 259 F.3d at 471 n.3, *rev'd*, 123 S. Ct. 1115.

son's identity should be a necessary, but not sufficient, prerequisite to a right of publicity claim.²⁸

To be sure, courts have recognized the public's affirmative right to evoke trademarks or personal identities in certain circumstances. So, for example, individuals may not only evoke, but also use trademarks for parody²⁹ or criticism;³⁰ parties may employ others' trademarks for comparative advertising or other "fair" uses;³¹ and reporters may evoke individuals' identities for news reporting without violating their right of publicity.³² Each of these cases, however, involves defendants who, for one reason or another, warrant special license to engage in behavior that would otherwise infringe. My point here is that by allowing evocation to serve as a proxy for infringement of trade-

²⁸ See *Carson*, 698 F.2d at 835 ("The right of publicity, as we have stated, is that a celebrity has a protected pecuniary interest in the commercial exploitation of his identity.").

²⁹ See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 907 (9th Cir. 2002), *cert. denied*, No. 02-633, 2003 WL 167680 (U.S. Jan. 27, 2003) (parody of a trademark falls within non-commercial use exemption); *Lucasfilm Ltd. v. Media Mkt. Group, Ltd.*, 182 F. Supp. 2d 897, 900 (N.D. Cal. 2002) ("[p]arody is a form of non-commercial, protected speech which is not affected by the Federal Trademark Dilution Act"). Some, but not all, jurisdictions have held that the First Amendment requires some protection for parody in right of publicity cases as well. *Compare* *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 973-76 (10th Cir. 1996) (parody trading cards protected under First Amendment against players' right of publicity claim), *and* *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 810 (Cal. 2001), *cert. denied*, 534 U.S. 1078 (2002) ("[W]hen 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 primarily from the celebrity's fame."), *with* *White*, 971 F.2d at 1401 (no parody defense to right of publicity claim when the "ad's spoof of Vanna White and Wheel of Fortune is subservient and only tangentially related to the ad's primary message: 'buy Samsung VCRs'").

³⁰ See 15 U.S.C. § 1125(a), (c) (2000) (unfair competition and dilution claims both require "commercial" use of trademark); *see also* *CPC Int'l, Inc. v. Skippy Inc.*, 214 F.3d 456, 462 (4th Cir. 2000) (undue expansion of trademark laws to control language would "diminish our ability to discuss the products or criticize the conduct of companies that may be of widespread public concern and importance") (citing Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 Yale L.J. 1687, 1710-11 (1999)).

³¹ See *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 307-08 (9th Cir. 1992) (establishing "nominative fair use" defense in trademark law); *SSP Agric. Equip., Inc. v. Orchard-Rite Ltd.*, 592 F.2d 1096, 1103 (9th Cir. 1979) ("use of competitor's trademark for purposes of comparative advertising is not trademark infringement 'so long as it does not contain misrepresentations or create a reasonable likelihood that purchasers will be confused . . .").

³² See *Montana v. San Jose Mercury News, Inc.*, 34 Cal. App. 4th 790, 794 (1995); *Stephano v. News Group Pubs., Inc.*, 485 N.Y.S.2d 220, 225-26 (1984).

mark and publicity rights, courts risk unduly broadening the kinds of behavior that one needs a license to commit.

Judging from a recent decision of the United States Supreme Court, the tide of trademark law may well be turning away from a strong-form right to evoke. As this Article was going to press, the Court, in *Moseley v. V Secret Catalogue, Inc.*, announced that “the mere fact that consumers mentally associate [a] junior user’s mark with a famous mark is not sufficient to establish actionable dilution.”³³ If lower courts follow the Supreme Court’s cue in *Moseley*, trademark law may follow copyright in limiting the legal consequences of evocation. Because *Moseley* rested on an interpretation of the FTDA, however, it reserved no affirmative evocation right to the public, and has no impact on state dilution law or the right of publicity.³⁴

Part I describes the evolution of the right to evoke in copyright, right of publicity, and trademark law.³⁵ It begins with copyright, in which courts initially flirted with a right to evoke, but later backed off by applying a series of doctrines designed to make copyright true to its normative goals.³⁶ After describing this progression, Part I turns to right of publicity and trademark, in which a right to evoke has been alive and growing.³⁷ Part II outlines the dangers of a right to evoke – including its overbreadth and the risk that it will chill legitimate behavior – and contends that the public has an affirmative interest in evoking cultural reference points in our society.³⁸ Part III suggests a number of vehicles through which courts might accommodate these interests in trademark and right of publicity cases.³⁹

Two caveats are in order here. First, this Article is preliminary and exploratory. I do not pretend to catalog every case recognizing a right to evoke, nor do I discuss all of the threats presented by such recognition. My goals are more modest – to raise consciousness of the existence of a trend and to warn of its dangers. Second, despite my concerns about a right to evoke, my opposition is not absolute; I can

³³ 123 S. Ct. at 1124.

³⁴ *See id.*

³⁵ *See infra* notes 40–150 and accompanying text.

³⁶ *See infra* notes 48–78 and accompanying text.

³⁷ *See infra* notes 79–150 and accompanying text.

³⁸ *See infra* notes 151–165 and accompanying text.

³⁹ *See infra* notes 165–171 and accompanying text.

imagine circumstances in which an evocation might offend the interests that our intellectual property laws are designed to promote. Such cases, however, will be rare, and courts must do a better job of guarding against the other, far more common, cases in which the public interest in evocation outweighs the interests of intellectual property holders in the protected aspects of their “property.”

I. Evocation as Right

“Right to evoke” is not a term used by courts in intellectual property cases. Instead, courts describe copyright infringement in terms of the rights granted by section 106 of the Copyright Act,⁴⁰ depict trademark entitlements as non-exclusive rights to prevent confusion and/or dilution of protected marks,⁴¹ and say that the state-law right of publicity applies only if a defendant has appropriated an individual’s identity for commercial gain.⁴²

Yet as intellectual property doctrine has evolved, courts have increasingly loosened the strictures of what it means to copy, to confuse, and to appropriate.⁴³ I am not the first to observe this phenomenon; countless scholars have traced the expansionist trends of copyright,⁴⁴ trademark,⁴⁵ and right of publicity⁴⁶ doctrine. This Part critiques a

⁴⁰ 17 U.S.C. § 106 (2000).

⁴¹ See 15 U.S.C. §§ 1114(1), 1125(a), (c) (2000).

⁴² See *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 967–68 (10th Cir. 1996). The specific elements of a right of publicity claim vary among jurisdictions, but most jurisdictions that recognize the right have adopted this standard. See *id.* “Most formulations of the right protect against the unauthorized use of certain features of a person’s identity—such as name, likeness, or voice—for commercial purposes.” *Id.* (citing J. Thomas McCarthy, *The Rights of Publicity and Privacy* §§ 4.9–.15 (1996)).

⁴³ In many cases, the legislature has either led the way or has codified the expansion retroactively. The federal dilution right arose as a creature of statutory law. See 15 U.S.C. § 1125(c). Also, in the 1976 overhaul of the Copyright Act, Congress for the first time gave copyright holders a statutory exclusive right to make derivative works based on their copyrighted work. See 17 U.S.C. § 106(2).

⁴⁴ See Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 *Stan. L. Rev.* 1 (2001); Yen, *supra* note 23, at 393.

⁴⁵ Seminal examples include Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 *Notre Dame L. Rev.* 397 (1990); Lemley, *supra* note 30; and Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 *Emory L.J.* 367 (1999).

⁴⁶ E.g., Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 *Cal. L. Rev.* 125, 178–238 (1993) (critiquing each of the theoretical justifications offered for right of publicity law).

particular piece of that expansion: the use of evocation as a proxy for proof of violation of a right under copyright, right of publicity, or trademark law.⁴⁷

A. Copyright

Historically, copyright law did not support claims based on mere evocation.⁴⁸ The standard for infringement—which required both copying and substantial similarity—seemed to contemplate claims only against parties that replicated identifiable, tangible, and protectable features of copyrighted works.⁴⁹ Although the law protected against the copying of non-literal expression (such as characters and plot structures),⁵⁰ plaintiffs were required to identify with precision the high-level expression that the defendant appropriated.⁵¹ A plaintiff claiming substantial similarity in plot structure, for example, had to convince a factfinder that the defendant’s plot replicated the original components of the plaintiff’s own narrative.⁵²

Beginning in the late 1970s, however, a series of cases began eroding the traditional requirement of a particularized showing of similarities between works. In the first such case, the U.S. Court of Appeals for the Ninth Circuit, in *Sid & Marty Krofft Television Productions, Inc. v. McDonald’s Corp.*,⁵³ held that a plaintiff could prove infringement based solely on similarities in the “total concept and feel” of two works, even if the expressive details were quite different. *Krofft* itself involved a claim of infringement of the look and feel of a chil-

⁴⁷ See, e.g., Lunney, *supra* note 45, at 372 (describing “‘property mania’—the belief that expanded trademark protection was necessarily desirable so long as the result could be characterized as ‘property’”).

⁴⁸ See *Arnstein v. Porter*, 154 F.2d 464, 468–69 (2d Cir. 1946).

⁴⁹ See *id.*

⁵⁰ See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (“It is of course essential to any protection of literary property, whether at common-law or under the statute, that the right cannot be limited literally to the text, else a plagiarist would escape by immaterial variations.”).

⁵¹ See *id.* at 122–23. In *Nichols*, for example, the plaintiff claimed that the defendant had appropriated the characters and plot structure of her play. See *id.* at 120. Judge Hand found no infringement, however, because the similarities lay in stock characters and the highly general “ideas” underlying the play. See *id.* at 122–23.

⁵² See *id.*

⁵³ See generally 562 F.2d 1157 (9th Cir. 1977).

dren's television show.⁵⁴ The two-step test that the court adopted⁵⁵ virtually invited fact-^anders to ^and infringement based on evocation.⁵⁶

A decade later, the Ninth Circuit, in *Roth Greeting Cards v. United Card Co.*,⁵⁷ re-endorsed "total concept and feel" protection in a case involving the "mood" of a series of greeting cards.⁵⁸ The defendant in the case had used its own artwork on its cards, and had copied text too inconsequential to merit copyright protection.⁵⁹ All of the particularized expression in the two lines of cards was thus either unprotected or not copied.⁶⁰ The court nonetheless found infringement because "the characters depicted in the art work, the mood they portrayed, the combination of art work conveying a particular mood with a particular message, and the arrangement of the words on the greeting card are substantially the same" ⁶¹

Like *Krofft*, *Roth* essentially recognized an exclusive right to evoke in copyright law.⁶² Under the "total concept and feel" doctrine as originally conceived, a party could prevail in a copyright case without identifying any *protected* similarities between a copyrighted and an infringing work; a plaintiff only needed to convince a fact-^ander that the works exuded a similar mood.⁶³

⁵⁴ *Id.* at 1167.

⁵⁵ *See id.* In the ^arst, "extrinsic" step, the court required a plaintiff to prove similarities in the ideas of the two works; in the second, "intrinsic" step, the court asked whether the target audience would view the overall feel of the works as substantially similar. *See id.*; *see also* *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1987). *But see* Yen, *supra* note 23, at 410–11 (Yen criticizes *Roth* and *Krofft* for allowing abstract similarities between two works to support claim of copyright infringement: "*Roth* and *Krofft* strongly suggest that the very mood a work creates constitutes its protectable expression. If copyright claims can in fact be maintained at such a high level of abstraction, practically any similarity could conceivably support a ^anding of infringement.").

⁵⁶ This was especially true in *Krofft*, because the court made clear that the fact-^ander should attempt to anticipate the reaction of the target audience—young children. *See* 562 F.2d at 1166.

⁵⁷ 429 F.2d at 1106.

⁵⁸ *See id.* at 1110.

⁵⁹ *See id.* at 1109–10.

⁶⁰ *See id.*

⁶¹ *Id.* at 1110.

⁶² *See Roth*, 429 F.2d at 1110.

⁶³ *See id.*

To some extent, this exclusive right to evoke in copyright law arose because of the difficulty in articulating exactly what copyright law protected, and why. The United States Supreme Court has stated repeatedly that copyright in the United States exists for utilitarian purposes—“to stimulate artistic creativity for the general public good.”⁶⁴ Thus, copyright extends only to “intellectual conceptions of the author,”⁶⁵ and protects only against the copying of the author’s contributions.⁶⁶ Yet deciding what *kinds* of original contributions merit protection had long unumoxed the courts.⁶⁷ Learned Hand’s classic formulation of copyright’s scope—that it extends to expression, but not ideas⁶⁸—only begged the question of how to draw a dis-

⁶⁴ See *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975); see also *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 546 (1985) (“The rights conferred by copyright are designed to assure contributors to the store of knowledge a fair return for their labors.”); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) (Copyright “is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.”). The utilitarian framework derives ultimately from the Constitution. U.S. Const., art. I, § 8, cl. 8 (“The Congress shall have Power . . . to Promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”).

Scholars have asserted other philosophical defenses of copyright. 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, 1540–78 (1993) (suggesting a Lockean justification for copyright); Joseph P. Liu, *Owning Digital Copies: Copyright Law and the Incidents of Copy Ownership*, 42 Wm. & Mary L. Rev. 1245, 1296–1300 (2001) (discussing competing theories for copyright and concluding that “[i]n practice, courts draw upon an uneasy and sometimes conflicting mix of different theoretical frameworks”); Alfred C. Yen, *Restoring the Natural Law: Copyright as Labor and Possession*, 51 Ohio St. L.J. 517, 524–29 (1990) (identifying natural law origins in United States copyright law). The United States Supreme Court, however, has at least nominally adhered to the utilitarian or instrumentalist approach. See *Harper & Row*, 471 U.S. at 546; *Sony*, 464 U.S. at 429.

⁶⁵ *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884); cf. *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 347–48 (1991) (“even a directory that contains absolutely no protectible written expression, only facts, meets the constitutional minimum for copyright protection if it features an original selection or arrangement”).

⁶⁶ See *Feist*, 499 U.S. at 348 (“Originality remains the *sine qua non* of copyright; accordingly, copyright protection may extend only to those components of a work that are original to the author.”).

⁶⁷ See *Nichols*, 45 F.2d at 121.

⁶⁸ See *id.*

inction between the two.⁶⁹ In the absence of any clear guidance, the early look-and-feel courts concluded that the fairly abstract “feel” or “mood” of a work could constitute protected expression.⁷⁰

A number of recent developments, however, have suggested a greater willingness of courts to interpret “expression” more strictly and thereby to swing the pendulum away from a right to evoke in copyright law. Perhaps stimulated by the Supreme Court’s decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*,⁷¹ holding that actionable copying requires “copying of constituent elements of the work that are original,” lower courts have used greater rigor in evaluating look-and-feel infringement claims.⁷² The Ninth Circuit, in particular, has modified the intrinsic/extrinsic approach laid out in *Krofft* to require an initial showing of similarities between expressive elements of two works before a case can reach the jury.⁷³ In addition, if a plaintiff rests a claim *only* on similarities in the combination of otherwise unprotectable features, the Ninth Circuit has required “virtual identity”

⁶⁹ See *id.* Hand acknowledged the difficulty, stating, “Nobody has ever been able to fix that boundary, and nobody ever can.” *Id.* Many contemporary scholars have questioned the very pursuit of a dichotomy between idea and expression. See Yen, *supra* note 23, at 405 (“[T]he quest for separation of idea and expression” set forth in the seminal case to make the distinction is “based primarily on instinct, and not upon some principled distinction between the two categories . . . [T]he *Nichols* opinion never stated any principle which tells the court where to draw the line between idea and expression.”); see also *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (“Obviously, no principle can be stated as to when an imitator has gone beyond copying the ‘idea,’ and has borrowed its ‘expression,’” so the distinction must “inevitably be *ad hoc*.”).

⁷⁰ See *Roth*, 429 F.2d at 1110.

⁷¹ 499 U.S. at 340.

⁷² *Id.* at 361 (emphasis added).

⁷³ See *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822–23 (9th Cir. 2002) (“when applying the extrinsic test, a court must filter out and disregard the non-protectible elements in making its substantial similarity determination”); see also *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1443 (9th Cir. 1994) (“Because only those elements of a work that are protectable and used without the author’s permission can be compared when it comes to the ultimate question of illicit copying, we use analytic dissection to determine the scope of copyright protection before works are considered ‘as a whole.’”); *Shaw v. Lindheim*, 919 F.2d 1353, 1361 (9th Cir. 1990) (“If a district court concludes, after analyzing the objective criteria under the extrinsic test, that reasonable minds might differ as to whether there is substantial similarity between the *protected expression* of ideas in two literary works, and the record supports the district court’s conclusion, there is a triable issue of fact that precludes summary judgment.”) (emphasis added).

in selection and arrangement.⁷⁴ Other jurisdictions have similarly insisted that plaintiffs identify with particularity similarities in the original and allegedly infringing works, even in cases involving look-and-feel claims.⁷⁵

Complementing this stricter conception of “expression,” courts have relied upon copyright’s limiting doctrines to narrow the scope of look-and-feel claims. They have used merger,⁷⁶ scenes-a-faire,⁷⁷ and the originality requirement⁷⁸ to “filter out unprotected aspects of works in look-and-feel cases. The cumulative effect of these doctrines is that a plaintiff in a copyright case must persuade a court not merely that the defendant has done something to remind the public of the plaintiff’s work, but that the defendant has actually copied an identifiable component of the plaintiff’s original expression.

⁷⁴ *Apple*, 35 F.3d at 1446; see also *Feist*, 499 U.S. at 349 (describing copyright in factual compilations as “thin”).

⁷⁵ See *Williams v. Chrichton*, 84 F.3d 581, 588 (2d Cir. 1996). “When we determine that a work contains both protectible and unprotectible elements, we must take care to inquire only whether ‘the protectible elements, standing alone, are substantially similar.’” (quoting *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1002 (2d Cir. 1995)); see also *Le Moine v. Combined Communications Corp.*, No. 95C5881, 1996 WL 332688, at *6 (N.D. Ill. June 13, 1996) (“finding no infringement when, “although the two works may appear to have a similar total concept and feel when viewed superficially, the similar appearance of the two works stems only from the [unprotected] individual elements they share, not from a substantially similar total concept and feel arising from the creative arrangement and interaction of common elements.”); cf. *Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1297–99 (D.C. Cir. 2002) (“finding, after detailed comparison of two architectural works, including particular combinations of unprotected elements, enough evidence of similarity in “look and feel” to survive summary judgment).

⁷⁶ The merger doctrine denies copyright protection to expression that constitutes one of a few ways of describing an unprotected idea. See *Yankee Candle Co., Inc. v. Bridgewater Candle Co.*, 259 F.3d 25, 35 (1st Cir. 2001) (applying merger doctrine to deny protection to candle labels and therefore to reject look-and-feel claim).

⁷⁷ See *Williams*, 84 F.3d at 588.

⁷⁸ E.g., *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 237 F. Supp. 2d 376, 386–89 (S.D.N.Y. 2002).

B. *Right of Publicity*

The right of publicity⁷⁹ is, at core, a business right to control use of one's identity in commerce.⁸⁰ Although courts and commentators have offered various rationales for the right, most modern cases defend it on some combination of incentive, just deserts, and unjust enrichment grounds: celebrities should have an incentive to develop valuable public personas, their efforts should be rewarded, and others deriving financial benefits from those valuable identities should pay.⁸¹ Publicity claims arise most often in celebrity endorsement cases, but the right extends to any use of a celebrity image calling attention to commercial interests or products.⁸² The publicity right originally applied only to the use of a celebrity's name or photograph; over time, however, courts extended it to the use of a celebrity's "identity,"⁸³ reasoning that to limit the right to the use of particular features of the celebrity would defeat the objective of giving celebrities "a protected

⁷⁹ Not all states have endorsed a right of publicity, and those that have vary somewhat in form and substance. See McCarthy, *supra* note 42, §§ 1.1-.11 (discussing the development of right of publicity laws and noting slow and inconsistent change); see also Michael J. Albano, Note, *Nothing to "Cheer" About: A Call for Reform of the Right of Publicity in Audiovisual Characters*, 90 Geo. L.J. 253, 265-86 (2001) (summarizing differences among state laws).

⁸⁰ See McCarthy, *supra* note 42, §§ 6.3, 6.5-.6. The right emanated originally from the common-law right to privacy. See Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 Harv. L. Rev. 193, 213-20 (1890). In the middle of the last century, however, courts decided that the general right of individuals to be left alone was not well suited to remedying uses of celebrity identities (because the celebrities had deliberately cast themselves into the limelight) and accordingly developed the modern right of publicity. See *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953) (holding that "in addition to and independent of . . . right of privacy . . . , a man has a right in the publicity value of his photograph"); see also Melville Nimmer, *The Right of Publicity*, 19 Law & Contemp. Probs. 203, 215-23 (1954) (advocating publicity rights).

⁸¹ See Madow, *supra* note 46, at 178-238 (explaining various theoretical justifications for right of publicity).

⁸² See *Cardtoons*, 95 F.3d at 968 (Under Oklahoma law, the right of publicity "requires proof of three elements: (1) knowing use of [the celebrity's] name[] or likeness[] (2) on products, merchandise, or goods (3) without [the celebrity's] prior consent."); *McFarland v. Miller*, 14 F.3d 912, 919 (3d Cir. 1994) ("A famous individual's name, likeness, and endorsement carry value and an unauthorized use harms the person both by diluting the value of the name and depriving that individual of compensation.").

⁸³ See *Landham v. Lewis Galoob Toys Inc.*, 227 F.3d 619, 624-25 (6th Cir. 2000).

pecuniary interest in the commercial exploitation of [their] identit[ies].”⁸⁴

Even before *White v. Samsung Electronics America, Inc.*, courts found that use of symbols, phrases, look-alikes, or other devices to evoke the image of a celebrity in advertisements violated the right of publicity. *Motschenbacher v. R.J. Reynolds Tobacco Co.*,⁸⁵ for example, involved a claim by a racecar driver who objected to an advertisement that featured a car with markings similar to his, along with an indistinct image of a driver.⁸⁶ The Ninth Circuit in *Motschenbacher* held that, even though “the ‘likeness’ of plaintiff is itself unrecognizable,” a publicity claim could proceed because the car’s “markings were not only peculiar to the plaintiff’s cars but they caused some persons to think the car in question was plaintiff’s and to infer that the person driving the car was the plaintiff.”⁸⁷ The U.S. Court of Appeals for the Sixth Circuit, in *Carson v. Here’s Johnny Portable Toilets, Inc.*,⁸⁸ found Johnny Carson’s right of publicity violated by a portable-toilet company operating under the name “Here’s Johnny.”⁸⁹ And the New York Appellate Court, in *Lombardo v. Doyle, Dane & Bernbach, Inc.*,⁹⁰ held that a “combination of New Year’s Eve, balloons, party hats, and ‘Auld Lang Syne’ . . . might amount to an appropriation of [Guy Lombardo’s] carefully and painstakingly built personality.”⁹¹ Over time, the courts appeared

⁸⁴ *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983) (“If the celebrity’s identity is commercially exploited, there has been an invasion of his right whether or not his ‘name or likeness’ is used.”).

⁸⁵ 498 F.2d 821 (9th Cir. 1974).

⁸⁶ *See id.* at 822.

⁸⁷ *Id.* at 827.

⁸⁸ 698 F.2d at 831.

⁸⁹ *Id.* at 836. The dissent, like Judge Kozinski’s in *White v. Samsung Electronics America*, contended that First Amendment principles should limit the scope of the publicity right. *Id.* at 840 (Kennedy, J., dissenting).

⁹⁰ 58 A.D.2d 620 (N.Y. App. Div. 1977).

⁹¹ *Id.* at 622; *see also* *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1101-02 (9th Cir. 1992) (sound-alike of Tom Waits in Frito-Lay commercial violated Waits’s right of publicity); *Midler v. Ford Motor Co.*, 849 F.2d 460, 463-64 (9th Cir. 1988) (sound-alike commercial violated Bette Midler’s right of publicity); *Lombardo*, 58 A.D.2d at 623 (Titonne, J., dissenting) (contending that Lombardo also stated a cause of action for invasion of privacy under New York law, based on use in advertising of band and conductor using “the same gestures, musical beat and choice of music (i.e., ‘Auld Lang Syne’) with which plaintiff had been associated in the public’s mind for more than a decade”).

to be converging on a simple rule: if a commercial actor ran an advertisement that obtained value by referencing a celebrity, that commercial actor should pay.⁹²

White, therefore, involved not so much a departure as a fortification and detailed articulation of a trend that had begun twenty years before. The facts of the case are well known. Samsung, the electronics manufacturer, had run a series of futuristic ads intended to show how its products would fare over time in comparison to various pop culture references.⁹³ One of the ads, for Samsung VCRs, showed a robot, “dressed in a wig, gown, and jewelry,” standing “next to a game board which is instantly recognizable as the Wheel of Fortune game show set, in a stance for which Vanna White is famous.”⁹⁴ A caption read, “Longest-running game show. 2012 A.D.”⁹⁵ Vanna White sued, claiming that the ad violated her publicity rights.⁹⁶ The district court granted summary judgment for Samsung, but the Ninth Circuit reversed.

The Ninth Circuit agreed that Samsung did not make use of White’s name or likeness, but it nonetheless held that White had alleged facts sufficient to support a publicity claim.⁹⁷ True, the robot

⁹² See Kristine M. Boylan, *The Corporate Right of Publicity in Federal Dilution Legislation, Part II*, 82 J. Pat. & Trademark Soc. 5, 27-32 (2000) (identifying sweat equity justifications for right of publicity law, and contending that similar arguments support a dilution cause of action); Harry Kalven, Jr., *Privacy In Tort Law – Were Warren and Brandeis Wrong?*, 31 Law & Contemp. Probs. 326, 331 (1966) (“No social purpose is served by having the defendant get for free some aspect of the plaintiff that would have market value and for which he would normally pay.”).

⁹³ See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1396 (9th Cir. 1992). One ad showed a juicy steak with the caption, “Revealed to be health food, 2010 A.D.,” and another showed Morton Downey, Jr. as a presidential candidate in 2008. *Id.*

⁹⁴ *Id.*

⁹⁵ *Id.*

⁹⁶ *Id.* at 1397. White’s claim under the federal Lanham Act was also reinstated by the Ninth Circuit. *Id.* at 1399-1400.

⁹⁷ See *id.* at 1397. This finding disposed of White’s statutory right of publicity claim, which required proof of knowing use of her name or likeness for advertising or selling purposes. See *id.* Citing California case law, Samsung argued that the common-law right of publicity contained a similar requirement, but the Ninth Circuit disagreed. Because the case cited by Samsung had involved use of actual photographs of the celebrity at issue, the court reasoned, it

had no occasion to consider the extent beyond the use of name or likeness to which the right of publicity reaches. The court held only that the right of

did not replicate any of White's features or use her name or voice; nonetheless, the court announced, "[t]he right of publicity does not require that appropriations of identity be accomplished through particular means to be actionable."⁹⁸ Indeed, by limiting the right to particular types of appropriation, "we would not only weaken the right but effectively eviscerate it" because "[t]he identities of the most popular celebrities are not only the most attractive for advertisers, but also *the easiest to evoke* without resorting to obvious means such as name, likeness, or voice."⁹⁹ By evoking White's image, the court held, Samsung had exploited the value of White's celebrity, and therefore it should pay.¹⁰⁰

Despite two hefty dissents¹⁰¹ and rancorous scholarly criticism,¹⁰² *White* remains the law, at least in the Ninth Circuit. Although other courts have discredited or distinguished certain aspects of the Ninth Circuit's reasoning in *White*,¹⁰³ none has entirely abandoned the notion that a celebrity has a claim whenever an advertiser gets commercial value from evoking the celebrity's persona. For example, the U.S. Court of Appeals for the Sixth Circuit, in *Landham v. Lewis Galoob Toys, Inc.*,¹⁰⁴ considered a movie actor's claim that a toy based on his movie character violated his right of publicity.¹⁰⁵ The court announced that the right of publicity "is now generally understood to cover anything

publicity cause of action 'may be' pleaded by alleging, *inter alia*, appropriation of name or likeness, not that the action may be pleaded in *only* those terms.

Id.

⁹⁸ *White*, 971 F.2d at 1398.

⁹⁹ *Id.* at 1399 (emphasis added).

¹⁰⁰ *See id.*

¹⁰¹ *See id.* at 1402 (Alarcon, J., dissenting) (Judge Alarcon dissented to most of the original opinion); *see also* *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1521 (9th Cir. 1993) (Kozinski, J., with O'Scannlain, J. and Kleinfeld, J., dissenting) (denial of rehearing en banc).

¹⁰² *See* Heald, *supra* note 10, at 804-07; Langvardt, *supra* note 7, at 399; Welkowitz, *supra* note 7, at 77-84; Stack, *supra* note 7, at 1194-97; Weiler, *supra* note 7, at 258; Peter K. Yu, Note, *Fictional Persona Test: Copyright Preemption in Human Audiovisual Characters*, 20 *Cardozo L. Rev.* 355, 359-67 (1998).

¹⁰³ *See* *Cardtoons*, 95 F.3d at 970 (rejecting the majority's conclusion in *White* that the First Amendment cannot insulate a celebrity parody against a right of publicity claim); *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir. 2000) (criticizing broadest interpretation of *White*).

¹⁰⁴ 227 F.3d at 619.

¹⁰⁵ *See id.* at 624.

that suggests the plaintiff's personal identity,"¹⁰⁶ but held that in that case the actor's identity was not suggested because the public did not associate him with his character.¹⁰⁷ Had the public made such an association, the plaintiff would presumably have had a publicity claim.¹⁰⁸

As it stands, then, the right of publicity extends to any commercial, unauthorized use of a device or symbol—including but not limited to the individual's name, likeness, or voice—that brings to mind a celebrity.¹⁰⁹ Although theoretically the use must also commercially benefit the defendant, courts generally assume that if the celebrity link is made, such a benefit exists.¹¹⁰ The defendant need not use any particular attribute of the celebrity or deceive the public into thinking that it has.¹¹¹ Evocation, alone, is enough.¹¹²

¹⁰⁶ *Id.*

¹⁰⁷ *See id.* at 626 ("we share . . . Judge Kozinski's unwillingness to give every individual who appears before a television or movie camera, by occupation or happenstance, the right as a matter of law to compensation for every subtle nuance that may be taken by someone as invoking his identity without first being required to prove significant commercial value and identifiability").

¹⁰⁸ *See* *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997). In *Wendt*, two of the actors in the television program *Cheers* sued to prevent licensed, *Cheers* look-alike bars from using barstool-sitting robots that allegedly resembled them. The district court granted summary judgment because the robots bore no resemblance to the actors "except that one of the robots, like one of the plaintiffs, is heavier than the other." *Id.* at 809 (quoting district court). The Ninth Circuit reversed summary judgment for defendants, holding that a jury could conclude that the robots constituted likenesses of the actors that would justify a right of publicity claim. *See id.* at 810–11. The court also found the claims not preempted by copyright law. *See id.* at 809.

¹⁰⁹ *See* *McCarthy*, *supra* note 42, § 3.2.

¹¹⁰ In *White*, for example, the Ninth Circuit simply assumed that Samsung was using White's identity to its commercial advantage. *See* 971 F.2d at 1399. Paul Heald has suggested the commercial benefit requirement as one way to distinguish *White* from earlier precedent and to support the argument that it represents a break from prior law:

The invocation of Vanna was not made to convince Vanna fans to buy the product, but rather to convey in especially vivid fashion the abstract concept of durability. This use of the celebrity persona to convey a concept is significantly different from those presented in *Midler* and *Motschenbacher*, where the advertisers were attempting to capitalize on the intrinsic attractiveness of the unique attributes of a particular celebrity.

Heald, *supra* note 10, at 807. Heald proposes, "Only 'if the name or likeness is used [primarily] to attract attention to a work [or product]' should liability follow." *Id.* at 809 (quoting Restatement (Third) of Unfair Competition § 47 cmt. c (1993) (alteration in original)).

¹¹¹ *Cf. Midler*, 849 F.2d at 463–64 (voice imitation violated right of publicity).

C. Trademark

For most of its history, federal trademark law protected only against misleading or deceptive uses of confusingly similar marks.¹¹³ It was well accepted that a trademark holder had no rights against parties whose marks merely evoked the protected mark.¹¹⁴ Indeed, at least with respect to trade dress, some courts viewed it as desirable to allow competitors to use enough of the trade dress to evoke a competing product, as long as the overall appearance of the product did not create confusion.¹¹⁵

The FTDA shifted this landscape. Intended to protect “famous marks” against loss of their distinctiveness,¹¹⁶ the FTDA created a new cause of action that no longer depends upon the risk of customer deception. The FTDA protects famous, distinctive marks against com-

¹¹² See McCarthy, *supra* note 42, § 3.2.

¹¹³ See S. Rep. No. 79-1333 (1946), reprinted in 1946 U.S.C.A.N. 1274, 1275 (discussing the purposes of the Lanham Act). “A trade-mark only gives the right to prohibit the use of it so far as to protect the owner’s good will against the sale of another’s product as his.” *Id.* (quoting *Prestonettes v. Coty*, 264 U.S. 359, 368 (1924)).

¹¹⁴ See *In re Ferrero*, 479 F.2d 1395, 1397 (C.C.P.A. 1973) (“The very fact that one mark may bring another mark to mind does not itself establish likelihood of confusion as to [the] source [of the product].”).

¹¹⁵ See *Am. Home Prods. Corp. v. Barr Labs., Inc.*, 656 F. Supp. 1058, 1068 (D.N.J.), *aff’d*, 834 F.2d 368 (3d Cir. 1987). In *American Home Products*, the district court held that a generic pharmaceutical seller did not infringe the Advil trade dress by selling pills with a similar brown color. See *id.* at 1068–69. The court pointed out that trade dress that evokes, but does not confuse, can serve a valuable function:

The resemblance between two products can alert consumers to the functional or utilitarian equivalence between them, to the fact that one product may be substituted for the other in the ultimate uses for which the products are intended. The free flow of information regarding the substitutability of products is valuable to individual consumers and to society collectively, and by providing it a supplier engages in fair competition based on those aspects—for example, price—in which the products differ.

Id. at 1068. The court further noted: “The fact that one mark may bring another mark to mind does not in itself establish likelihood of confusion as to source.” *Id.* at 1070; see also *Conopco, Inc. v. May Dept. Stores Co.*, 46 F.3d 1556, 1565 (Fed. Cir. 1994) (“finding no infringement when private label retailer “packages its product in a manner to make it clear to the consumer that the product is similar to the national brand, and is intended for the same purposes”).

¹¹⁶ See 15 U.S.C. § 1127 (2000) (“The term ‘dilution’ means the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of—(1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception.”).

mercial uses of other marks that “lessen[]” the famous mark’s capacity “to identify and distinguish goods or services, regardless of the presence or absence” of competition among the parties or any confusion as to source.¹¹⁷ The House report offered several examples of uses that could, over time, reduce a mark’s uniqueness—“the use of DUPONT shoes, BUICK aspirin, and KODAK pianos would be actionable under this legislation.”¹¹⁸

In the eight years since the FTDA’s passage, the courts of appeals have had differing views on everything from the degree of distinctiveness required for dilution protection¹¹⁹ to the requisite level of fame¹²⁰ to the question of whether the statute applies to claims be-

¹¹⁷ *Id.* § 1125(c).

¹¹⁸ H.R. Rep. No. 104-374, at 3 (1995), *reprinted in* 1995 U.S.C.C.A.N. 1029, 1030.

¹¹⁹ The federal courts of appeals are divided as to whether inherent distinctiveness is a separate requirement of the FTDA. *Compare* TCPIP Holding Co., Inc. v. Haar Communications, Inc., 244 F.3d 88, 98 (2d Cir. 2001) (“weak, non-distinctive, descriptive marks do not qualify for the [FTDA]’s protection, even if famous”), *and* Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208, 216 (2d Cir. 1999) (“It is quite clear that the statute intends distinctiveness, in addition to fame as an essential element.”), *with* Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C., 212 F.3d 157, 166–67 (3d Cir. 2000) (“we are not persuaded that a mark be subject to separate tests for fame and distinctiveness”). Interestingly, *Nabisco* would have to be decided differently if the Second Circuit applied its own stated legal standards after the United States Supreme Court, in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.* ruled that product design cannot be inherently distinctive. 529 U.S. 205, 215–16 (2000); *see also* Deere & Co. v. MTD Prods., Inc., No. 00 CIV. 5936(LMM), 2002 WL 1837402, at *2 (S.D.N.Y. Aug. 12, 2002) (“finding no protection under the FTDA because “use of color alone cannot be inherently distinctive.”) (citing *Wal-Mart*, 529 U.S. at 211; *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162–63 (1995); *TCPIP*, 244 F.3d at 98)). *See generally* Toro Co. v. ToroHead, Inc., Opposition No. 114,061, 2001 WL 1734485, at *14 (Trademark Trial & Appeal Bd. Dec. 12, 2001) (“To be vulnerable to dilution, a mark must be not only famous, but also so distinctive that the public would associate the term with the owner of the famous mark even when it encounters the term apart from the owner’s goods or services, i.e., devoid of its trademark context.”).

¹²⁰ *Compare* *TCPIP*, 244 F.3d at 99 (suggesting that plaintiff must show some evidence of public recognition—consumer surveys, press accounts, or other evidence that its advertising was effective and stating that “we think Congress envisioned that marks would qualify as ‘famous’ only if they carried a substantial degree of fame”), *and* I.P. Lund Trading ApS & Kroin, Inc. v. Kohler Co., 163 F.3d 27, 47 (1st Cir. 1998) (“the standard for fame . . . required to obtain anti-dilution protection is more rigorous than that required to seek infringement protection”), *with* Advantage Rent-A-Car, Inc. v. Enter. Rent-A-Car, Inc., 238 F.3d 378, 380 (5th Cir. 2001) (party need not show that fame extends beyond its market when both parties are operating in same market). *I.P. Lund* involved product design, and it quoted a provision in the *Restatement* that suggests an exacting standard for fame in product design context: “A mark that evokes an association with a specific source only when used in connection with the particular goods or services that it identifies is ordinarily not

tween competitors.¹²¹ The courts of appeals have not yet resolved whether the statute protects trade dress,¹²² and despite a recent United States Supreme Court decision, the standard for proving dilution remains elusive.¹²³ Any resolution of the scope of protection against dilution thus appears quite a ways off.

Nonetheless, at least in some early interpretations, the FTDA appeared to give trademark holders a broad right to obtain an injunction merely by showing that someone else's mark brought their mark to mind.¹²⁴ A number of appellate decisions suggested that *any* symbol that reminded the public of a trademark posed a threat to that mark's distinctiveness.¹²⁵ The U.S. Court of Appeals for the Second Circuit, for example, stated that to dilute, a mark "must be of sufficient similarity so that, in the mind of the consumer, the junior mark will *conjure an association with the senior.*"¹²⁶ Although the court considered other

sufficiently distinctive to be protected against dilution." See *I.P. Lund*, 163 F.3d at 46-47 (quoting Restatement (Third) of Unfair Competition § 25 cmt. e (1995)). Generally, the courts seem to view fame in a niche market as sufficient if both parties are operating in the same niche market. See *Advantage Rent-A-Car*, 238 F.3d at 380; *Times Mirror Magazines*, 212 F.3d at 164 ("We are persuaded that a mark not famous to the general public is nevertheless entitled to protection from dilution where both the plaintiff and defendant are operating in the same or related markets, so long as the plaintiff's mark possesses a high degree of fame in its niche market."); *Syndicate Sales, Inc. v. Hampshire Paper Corp.*, 192 F.3d 633, 640 (7th Cir. 1999) (summarizing authorities).

¹²¹ See, e.g., *YKK Corp. v. Jungwoo Zipper Co.*, 213 F. Supp. 2d 1195, 1207-08 (C.D. Cal. 2002).

¹²² See *Syndicate Sales*, 192 F.3d at 639 (finding not "insubstantial" the argument that dilution protection for trade dress would be unconstitutional, but refusing to consider challenge that was not raised before the trial court); *I.P. Lund*, 163 F.3d at 45 (assuming that statute applies to trade dress, but suggesting that dilution will be rare in product configuration cases that do not also involve confusion); *Armament Sys. & Procedures, Inc. v. Lansky*, No. 00 C 6317, 2002 WL 726801, at *2-4 (N.D. Ill. Apr. 24, 2002) (refusing to grant summary judgment against dilution claim based on use of trade dress consisting of "distinctive black frame housing with flat side colored panels, its push button activator, its blue LED light and its retention clip," though noting that "it is not at all clear" that the plaintiff will succeed in proving fame and other elements of dilution claim).

¹²³ See *Moseley v. V Secret Catalogue, Inc.*, 123 S. Ct. 1115, 1123-25 (2003).

¹²⁴ See *V Secret Catalogue v. Moseley*, 259 F.3d 464, 475 (6th Cir. 2001), *rev'd*, 123 S. Ct. 1115; *Nabisco*, 191 F.3d at 223-24.

¹²⁵ See *Nabisco*, 191 F.3d at 223.

¹²⁶ See *id.* at 218 (emphasis added); see also *V Secret Catalogue*, 259 F.3d at 475 (adopting Second Circuit "conjure an association" standard), *rev'd*, 123 S. Ct. 1115; *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 467-69 (7th Cir. 2000) (finding "Herbozac" dilutive of "Prozac" based solely on Prozac's degree of renown and the similarity between the marks, based on Second Circuit's "conjure an association" standard).

factors in evaluating the evidence of dilution, the focus of the inquiry remained whether the junior use would “remind” the public of the senior mark.¹²⁷ At the other extreme, the U.S. Court of Appeals of the Fourth Circuit refused to find dilution unless a plaintiff showed an actual, consummated adverse impact on its mark’s selling power as a result of the junior use.¹²⁸

These two divergent interpretations of the dilution standard reflected radically different conceptions of Congress’s goals in enacting the FTDA. On the one hand, a standard requiring proof of actual, consummated injury views the dilution statute as targeting only cases in which loss of selling power has already occurred, and imposes a virtually insurmountable hurdle of proof: even holders of distinctive, famous marks would have to wait for evidence of loss of brand recognition before bringing an injunction against use of the same mark by another party.¹²⁹ On the other hand, a standard of dilution based solely on a mark conjuring another reflects a view that a famous mark has a singular association in people’s minds and is entitled to protection against any background noise that might interfere with the purity of that association.¹³⁰ The upshot is that the owner of a famous mark

¹²⁷ See *Nabisco*, 191 F.3d at 219. In explaining the relevance of distinctiveness and the channels of commerce, for example, the court explained:

It is easy to imagine instances where because of the low level of distinctiveness of the senior mark, or insufficient similarity between the two, the use of the junior mark in a remote area of commerce would have little tendency to *remind consumers* of the senior mark and *thus little capacity to dilute its effectiveness*, but where use of the same junior mark in a closely related area would bring about the harm the statute was designed to avoid.

Id. (emphasis added).

Other courts imposed a more stringent similarity requirement for dilution than for likelihood of confusion. See, e.g., *Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 425 (6th Cir. 1999) (upholding requirement that marks be “the same or very similar” to support a dilution claim because “Jet’s theory would permit it to enjoin the use of a vast number of registered trademarks containing the word ‘jet’ and used in unrelated industries”).

¹²⁸ *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev.*, 170 F.3d 449, 453 (4th Cir. 1999); see also *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 670 (5th Cir. 2000) (adopting the Fourth Circuit’s actual-harm standard).

¹²⁹ See *Nabisco*, 191 F.3d at 223–24. Even the classic examples — “DuPont” shoes, “Buick” aspirin, and “Kodak” pianos — would require proof of actual harm before an injunction could enter. See H.R. Rep. No. 104-374, at 3 (1995), reprinted in 1995 U.S.C.C.A.N. 1029, 1030.

¹³⁰ See Jerre B. Swann, Sr., *Dilution Redeemed for the Year 2002*, 92 Trademark Rep. 585, 613 (2002). Under this view, the use of words that evoke the mark do not destroy, but

would have in gross property rights, not only in the mark itself but in a broad penumbra of associated words.¹³¹ The loose dilution standard, in other words, represents a strong right to evoke.

In contrast to these extreme interpretations of the FTDA, some courts of appeals adopted a more nuanced view of the FTDA's objectives. The U.S. Court of Appeals for the Third Circuit, for example, described the overall objective of dilution analysis as protecting not against attenuated weakening of brand value but against the *loss* of the singularity of a famous mark: "Blurring occurs when the defendant's use of its mark causes the public to no longer associate the plaintiff's famous mark with its goods or services; the public instead begins associating both the plaintiff and the defendant with the famous mark."¹³² In this view, a trademark holder—of even a famous mark—is not entitled to absolutely pure, interference-free connections; although trademark holders may prevent use by others that will eventually make their marks lose their singularity, the circle should not be drawn beyond users of the mark itself and others that the public views as the same.¹³³

weaken the singular mental association between a mark and its owner: "When, therefore, two brands are associated, there may be a 'fan effect': by the process of spreading activation, discrete and (usually) consistent propositions linked to each symbol become part of a larger, divergent array, with adverse memory consequences for both the brand concepts and each of their separate links." *Id.* Advocates of this position also contend that allowing parties to evoke others' brands—along with their positive associations—would unjustly enrich evokers because blurring and tarnishment are both "examples of the exploitation of the memorability of a brand." *See id.* at 622. Like the related right of publicity, it reflects a notion that trademark holders should have the right to capture—or, in this case, to enjoin—all of the positive associations related to their intellectual property. *See id.* at 623–24.

¹³¹ *Cf.* Lunney, *supra* note 45, at 372 (In the wake of recent expansions in trademark law, "trademarks become property not merely in the formal, legal sense of a right assigned to an entity reasonably well-placed to protect and vindicate the mark's information function, but in the more ordinary, more substantive, and ultimately more absolute sense of a thing belonging fully and completely to its owner.").

¹³² *Times Mirror Magazines*, 212 F.3d at 168; *see also* Hasbro, Inc. v. Clue Computing, Inc., 66 F. Supp. 2d 117, 134 (D. Mass. 1999) ("The basic idea of blurring is that the defendant's use of the plaintiff's mark causes the public no longer to think only of plaintiff's product upon seeing the famous mark, but rather to associate both the plaintiff and the defendant with the mark."); 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 24:68 (4th ed. 2002).

¹³³ *See* McCarthy, *supra* note 132, § 24:90.2. In Professor McCarthy's view, for dilution to apply, the marks have to be effectively the same—"the marks must be similar enough that a significant segment of the target group sees the two marks as essentially the same." *Id.* He describes blurring not as an abstract loss of purity in association between mark and product, but as one mark seen by customers as now identifying two sources. *See id.* In an

The United States Supreme Court, in *Moseley v. V Secret Catalogue, Inc.*, adopted a version of this intermediate view of the FTDA. Although the Court agreed doctrinally with the Fourth Circuit that the FTDA requires “actual” rather than “likelihood of” dilution, for practical purposes the decision forged a middle ground between the two standards.¹³⁴ In *Moseley*, the owners of the “Victoria’s Secret” mark sued a party that adopted “Victor’s Little Secret” as the name of an adult gift store in Kentucky. The plaintiffs claimed that defendants’ use of “Victor’s Little Secret” both blurred and tarnished the “Victoria’s Secret” mark.¹³⁵ The Sixth Circuit had ruled in favor of the plaintiffs, finding that consumers hearing the name of the gift store were “likely automatically to think of the more famous store and to link” the two.¹³⁶ Finding such linking “a classic instance of dilution by tarnishing (associating the Victoria’s Secret name with sex toys and lewd coffee mugs) and by blurring (linking the chain with a single, unauthorized establishment),” the Sixth Circuit upheld summary judgment for the plaintiffs.¹³⁷ In reaching this conclusion, the court rejected the Fourth Circuit’s requirement that plaintiffs prove consummated loss of selling power to prevail in an FTDA claim.¹³⁸

The Supreme Court granted certiorari to resolve the circuit split over the “actual harm” standard.¹³⁹ Noting that the FTDA applies to uses that “‘cause[] dilution of the distinctive quality’ of the famous mark,” the Court held that the statute “unambiguously requires a showing of actual dilution, rather than a likelihood of dilution.”¹⁴⁰ A plaintiff, in other words, must show that a defendant’s use in fact di-

attempt to reflect this view, the district court in *Hasbro* required a trademark holder to prove “that consumers associate the two different products with the mark even if they are not confused as to the different origins of these products.” 66 F. Supp. 2d at 136. The Second Circuit has also recently shown some interest in this approach. See *Hormel Foods Corp. v. Jim Henson Prod., Inc.*, 73 F.3d 497, 506 (2d Cir. 1996) (noting that dilution by blurring occurs when consumers “‘see the plaintiff’s mark used on a plethora of different goods and services . . . raising the possibility that the mark will lose its ability to serve as a unique identifier of the plaintiff’s product.’” (quoting *Deere & Co.*, 41 F.3d at 43)).

¹³⁴ See 123 S. Ct. at 1124.

¹³⁵ *Id.* at 1119.

¹³⁶ *V Secret Catalogue*, 259 F.3d 464, 477 (2001), *rev’d*, 123 S. Ct. 1115.

¹³⁷ *Id.*

¹³⁸ See *id.* at 466.

¹³⁹ *Moseley*, 123 S. Ct. at 1121–22.

¹⁴⁰ *Id.* at 1124.

lutes its mark, rather than merely that some future dilution is likely.¹⁴¹ Although the Court offered little guidance on how one might prove “actual dilution,” it made clear that “the mere fact that consumers mentally associate the junior user’s mark with a famous mark is not sufficient.”¹⁴² According to the Court, “[S]uch mental association will not necessarily reduce the capacity of the famous mark to identify the goods of its owner, the statutory requirement for dilution under the FTDA.”¹⁴³

While nominally adopting an actual dilution standard, however, the Court liberally constructed the meaning of “actual dilution.”¹⁴⁴ The Court not only rejected the Fourth Circuit’s requirement that parties prove loss of sales or profits, it also suggested that dilution did not depend on survey or other evidence of the actual effect of a challenged use in the marketplace.¹⁴⁵ Instead, the Court indicated that “actual dilution can reliably be proven through circumstantial evidence – the obvious case is one where the junior and senior marks are identical.”¹⁴⁶

By suggesting that circumstantial evidence can be used to prove actual dilution – and by specifically stating that surveys proving loss of distinctiveness are unnecessary – the Court fell short of requiring proof of consummated dilution.¹⁴⁷ In other words, if a plaintiff need not introduce evidence that a famous mark has suffered an actual loss of distinctiveness in consumers’ minds, or a loss of value associated with such loss of distinctiveness, then the plaintiff can prevail in a FTDA claim without direct proof of actual dilution.¹⁴⁸ On the other hand, the plaintiff must show that the challenged use, either by its

¹⁴¹ *See id.*

¹⁴² *Id.*

¹⁴³ *Id.* At the same time, the Court appeared to reject the Fourth Circuit’s strict “consummated injury” standard: “Of course, [requiring actual dilution] does not mean that the consequences of dilution, such as an actual loss of sales or profits, must also be proved.” *Id.*

¹⁴⁴ *See Moseley*, 123 S. Ct. at 1124.

¹⁴⁵ *See id.* (stating that the actual dilution requirement “does not mean that the consequences of dilution, such as an actual loss of sales or profits, must also be proved,” and disagreeing with the Fourth Circuit’s contrary suggestion).

¹⁴⁶ *Id.* at 1125.

¹⁴⁷ *See id.* at 1124–25.

¹⁴⁸ *See id.*

nature or through its actual effect, causes a loss of the famous mark's singularity.¹⁴⁹

Thus, under the Court's suggested approach, proof of dilution requires either that a defendant's use *by its very nature* reduces the singularity of the famous mark (as when the defendant uses an identical mark) or that a defendant's use actually reduces the singularity of the famous mark (by, for example, reducing its selling power, as proven through surveys or direct financial evidence).¹⁵⁰ The Court in *Moseley* has therefore left the FTDA intact, but deliberately rejected a strong right to evoke.

II. The Public's Interest in Evocation

The above analysis explores some of the ways in which the law empowers people to prevent others from evoking their protected intellectual property. Assuming the case has been made, however, why should we care?

A rich body of scholarship points out many of the positive reasons that speakers need an ability to evoke cultural associations to make effective speech. Rochelle Dreyfuss, for example, has made a strong case for using trademarks themselves to evoke particular images,¹⁵¹ and even the U.S. Court of Appeals for the Ninth Circuit recently held that it was fair game to make fun of Barbie.¹⁵² Numerous scholars—and many courts—have emphasized the importance of a rich public domain filled with the tools for future authorship.¹⁵³ Our culture would suffer if we were prevented not only from using these images, but from reminding people of them.

¹⁴⁹ See *Moseley*, 123 S. Ct. at 1124–25.

¹⁵⁰ See *id.*

¹⁵¹ See generally Dreyfuss, *supra* note 45, at 397.

¹⁵² See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002), *cert. denied*, No. 02-633, 2003 WL 167680 (U.S. Jan. 27, 2003).

¹⁵³ See Gordon, *supra* note 64, at 1563–64 (1993) (contending that “creators should have property in their original works, only provided that such grant of property does no harm to other persons’ equal abilities to create or to draw upon the preexisting cultural matrix and scientific heritage”); Jessica Litman, *The Public Domain*, 39 *Emory L.J.* 965, 968 (1990) (“The public domain should be understood not as the realm of material that is undeserving of protection, but as a device that permits the rest of the system to work by leaving the raw material of authorship available for authors to use.”).

There are other good reasons to avoid an abstract right to evoke, even if we accept existing limitations on the public's right to use identifiable, tangible features of existing intellectual property. First, as rights extend from the tangible to the ethereal, speakers will have a more difficult time evaluating whether their contemplated speech violates someone's rights. The resulting uncertainty will undoubtedly chill speech.¹⁵⁴ Second, as the scope of rights increases beyond features identified solely with the intellectual property at issue, we run the risk of generating conflicting claims among multiple stakeholders.¹⁵⁵ We are already experiencing a conflict of interests between copyright holders and actors who play roles in their copyrighted works.¹⁵⁶ Those conflicts could potentially multiply if certain words, marks, or symbols remind the public of multiple parties. Finally, particularly in the trademark realm, the public frequently benefits when a new market entrant uses product trade dress to evoke the strong trade dress of an entrenched market participant.¹⁵⁷ So long as there is

¹⁵⁴ See Netanel, *supra* note 44, at 19 ("At the very least, the idea/expression dichotomy's very vagueness induces considerable speaker self-censorship.").

¹⁵⁵ See *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1517 (9th Cir. 1993) (Kozinski, J., dissenting) (denial of rehearing en banc).

¹⁵⁶ See *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 809 (9th Cir. 1997). In *Wendt*, for example, the producers of *Cheers* had authorized the replica bars with all their related paraphernalia. See *id.* at 811. When the actors brought a right of publicity claim, the licensee defended on the ground that its license authorized use of the characters and that, because its right to the material sounded in copyright, it preempted the actors' state right of publicity claim. See *id.* Like most courts considering such conflicts, however, the Ninth Circuit held the claims not preempted. See *id.* at 809; see also *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 624–25 (6th Cir. 2000).

¹⁵⁷ See *Am. Home Prods. Corp. v. Barr Labs., Inc.*, 834 F.2d 368, 371 (3d Cir. 1987) ("A response that one 'associates' a given product with the name of a competitive product may simply reflect the recognition that the two products are competitive and serve the same purpose."); *Fla. Breckenridge, Inc. v. Solvay, No. 97-8417-Civ-RYSKAMP*, 1997 WL 695413, at *9 (S.D. Fla. July 18, 1997) (difference in shape of generic pill would adequately distinguish it from brand-name product in a consumer's mind, and "given the similarity in colors, she would probably know that she had been given the generic version ... and not the wrong prescription altogether"); *Hutchinson v. Essence Communications, Inc.*, 769 F. Supp. 541, 556 (S.D.N.Y. 1991) (holding that the fact that a defendant's use of a mark makes consumers "think about" plaintiff's product "is not compelling evidence of actual confusion"); cf. *In re Ferrero*, 479 F.2d 1395, 1397 (C.C.P.A. 1973) ("The very fact of calling to mind may indicate that the mind is distinguishing, rather than being confused by, two marks."). But see *McNeil-PPC, Inc. v. Granutec, Inc.*, 919 F. Supp. 198, 203 (E.D.N.C. 1995) (distinguishing *American Home* and finding likelihood of success in trademark claim by Tylenol, when "shape and texture as well as the color of [defendant's] product is remarkably similar to the Tylenol gelcap").

no confusion, however, the evocation serves an important public policy goal of market competition. With dilution protection for trade dress, some of this desirable activity might subside.¹⁵⁸

In contrast with its negative effect on public discourse, an unencumbered right to evoke may not promote the core philosophical objectives of trademark or right of publicity laws. Take the right of publicity: under a utilitarian theory, celebrities should have an incentive to develop personae pleasing to the public.¹⁵⁹ As scholars have pointed out, however, celebrities arguably have such an incentive anyway, without *any* right of publicity.¹⁶⁰ In any event, it is at best questionable whether a right to profit from evocations would add measurably to whatever incentive the right of publicity already provides. The other theoretical justifications for the right—natural rights theory and unjust enrichment—should involve some consciousness of whether the alleged violator has taken something of value that the celebrity was responsible for creating. In many (though not all) cases, others are primarily responsible for the value of symbols or other reference points that happen to evoke celebrities.¹⁶¹ In light of these competing concerns, as well as the speech interests of the public outlined above, courts considering publicity claims based on mere evoca-

¹⁵⁸ Theoretically, the FTDA might protect this kind of behavior as comparative advertising, but it does not fit neatly within the comparative advertising mold. See 15 U.S.C. § 1125(c)(4) (2000) (allowing “[f]air use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark”).

¹⁵⁹ See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) (right of publicity “provides an economic incentive for [performers] to make the investment required to produce a performance of interest to the public”).

¹⁶⁰ See Madow, *supra* note 46, at 203–04 (“Even in a world without publicity rights, celebrities would still be able to derive substantial income from their publicity values, to say nothing of the income they would continue to derive from the activities to which they owe their fame.”); Rochelle Cooper Dreyfuss, *We Are Symbols and Inhabit Symbols, So Why Should We Be Paying Rent?*, 20 Colum.-VLA J.L. & Arts 123, 144–45 (1996) (“[T]he right of publicity does not fit the utilitarian mold because the cost of creating a persona are recaptured through the activity with which the purveyor is primarily associated Furthermore, the marginal increase in incentives that this right provides is not likely to produce any significant increase in the amount of creative material produced.”).

¹⁶¹ See *White*, 989 F.2d at 1517 (Kozinski, J., dissenting) (denial of rehearing en banc). In the context of most television programs, for example, the shows’ creators have arguably had more of a hand in building the value of the set and other features that might be argued to evoke one of the characters. See *id.*; Dreyfuss, *supra* note 160, at 144–45.

tion should at least engage in some balancing to determine whether the right of publicity should prevail in a particular case.¹⁶²

Similar considerations apply to dilution. To the extent that dilution law seeks to prevent junior users from commandeering famous marks such that consumers no longer can identify their source,¹⁶³ that problem can be adequately addressed by applying dilution law only against marks that are identical or legally equivalent to a famous mark.¹⁶⁴ The FTDA, after all, was intended to protect not only owners of famous trademarks, but also the public.¹⁶⁵ Extending dilution rights to all marks bearing any associational relationship to famous ones exceeds the narrow objectives of the statute, at a significant societal cost. To be sure, such an interpretation arguably protects the purity of the famous mark's recall with consumers; but the existence and exclusivity of the recall is not threatened. In comparison with the public interests outlined above, the added value of a right to evoke seems insignificant.

III. Some Proposals

Constraining the right to evoke requires neither legislative action nor radical judicial re-interpretation of existing law. To the contrary, as in the copyright context, courts could easily cabin the expansion of an evocation right merely by giving force to the limits inherent in trademark and right of publicity doctrines. The following are some possible vehicles to move in that direction.

Two generalities apply to both trademark and right of publicity cases. First, courts should resist the temptation to equate evocation

¹⁶² See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 969-76 (10th Cir. 1996) (balancing of free speech interests with intellectual property rights in case involving appropriation of name and likeness of major league baseball players); see also *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 810 (Cal. 2001), *cert. denied*, 534 U.S. 1078 (2002) (suggesting that a First Amendment defense may protect against a right of publicity claim when defendant has introduced "significant transformative elements" or when "the value of the work does not derive primarily from the celebrity's fame").

¹⁶³ H.R. Rep. No. 104-374, at 3 (1995), *reprinted in* 1995 U.S.C.C.A.N. 1029, 1030 (listing "DuPont" shoes, "Buick" aspirin, and "Kodak" pianos as examples of dilutive uses of famous marks).

¹⁶⁴ Cf. *Moseley*, 123 S. Ct. at 1124 ("at least where the marks are not identical, the mere fact that consumers mentally associate the junior's mark with a famous mark is not sufficient to establish actionable dilution").

¹⁶⁵ See H.R. Rep. No. 104-374, at 4 (1995), *reprinted in* 1995 U.S.C.C.A.N. 1029, 1031.

with infringement, absent some rationale to do so in a particular case.¹⁶⁶ Second, even if such a rationale exists in a particular case, courts should not accept it blindly, but should consider whether the public's interest in evocation outweighs the intellectual property holder's concern in that case.

My specific doctrinal suggestions are somewhat more guarded. Courts might consider, in right of publicity cases, limiting an evocation right to cases involving likelihood of confusion as to endorsement. In other words, if a commercial actor does not use a name or likeness but merely *evokes* a celebrity's identity, the publicity right should apply only if the public is likely to believe that the celebrity endorsed the advertisement or product at issue.

In the dilution context, *Moseley v. V Secret Catalogue, Inc.*¹⁶⁷ has arguably begun a move away from a right to evoke, but more remains to be done. For one thing, *Moseley* only applies to the FTDA, and many state dilution laws have been invoked in cases involving mere evocation.¹⁶⁸ Even in federal cases, however, *Moseley's* lack of clarity leaves some open questions. For one, the meaning of "dilution" remains unclear. In light of the legislative history of the FTDA, it appears that courts should seek to distinguish between diluting loss of singularity, on the one hand, and mere background noise, on the other.¹⁶⁹ By articulating dilution's objective as the preservation of singularity of famous marks, courts would not only avoid unjustified intrusions into the public domain, but would arguably limit dilution claims to those that Congress appears to have contemplated in passing the FTDA.¹⁷⁰ One effect of this approach might be to require near identity between marks before allowing a dilution claim. In cases involving non-identical marks, *Moseley* appropriately suggests a need for proof of actual, consummated dilution because of the risk of unduly restricting the public domain under any approach that allows a presumption of actual dilution.¹⁷¹ Even with identical marks, this approach would

¹⁶⁶ See *Moseley v. V Secret Catalogue, Inc.*, 123 S. Ct. 1115, 1124-25 (2003).

¹⁶⁷ *Id.*

¹⁶⁸ See, e.g., *Deere & Co. v. MTD Prods., Inc.*, No. 94 CIV. 2322(DLC), 1995 WL 81299, at *3 (S.D.N.Y. Feb. 28, 1995).

¹⁶⁹ See H.R. Rep. No. 104-374, at 3 (1995), reprinted in 1995 U.S.C.C.A.N. 1029, 1030.

¹⁷⁰ See *id.* at 4.

¹⁷¹ See *Moseley*, 123 S. Ct. at 1123-24.

counsel in favor of a broad version of the “nominative fair use” doctrine, to make clear that uses *referring to* the trademark holder itself do not reduce the singularity of the mark because they reinforce, rather than weaken, association between a mark and its source.¹⁷²

Beyond clarifying the objective of the dilution inquiry, courts should be mindful of the positive reasons for allowing parties to evoke others’ products or services in pro-competitive ways. They might also weigh the public’s interest in such evocation in certain cases or with respect to certain types of marks. With trade dress, for example, it seems likely that the positive benefits of evocation outweigh the interest in protecting against dilution.¹⁷³ For that reason, courts should not presume that Congress intended to extend dilution protection to trade dress.

Conclusion

We should be concerned about the trend toward allowing intellectual property holders to prevent others from using non-proprietary words, expression, or symbols to evoke their intellectual property. This Article identifies the trend and suggests some of the reasons for concern. It establishes that a right to evoke is not a notion limited to a rogue opinion of the U.S. Court of Appeals for the Ninth Circuit or to right of publicity law. If we wish to preserve a rich commons and avoid significantly chilling free expression, courts should at least cabin the right to evoke and ensure that, when utilized, it serves the law’s normative goals.

¹⁷² See, e.g., *EMI Catalogue Partnership v. Hill, Holliday, Connors, Cosmopolos Inc.*, 228 F.3d 56, 64 (2d Cir. 2000) (“The fair use doctrine permits use of a protected mark by others to describe certain aspects of the user’s own goods.”); *United States Shoe Corp. v. Brown Group, Inc.*, 740 F. Supp. 196, 199–200 (S.D.N.Y. 1990) (fair use doctrine protects use of words “in good faith for descriptive purposes pertinent to their products,” even when use might remind the public of a protected trademark).

¹⁷³ Trademark holders who suffered from confusing use of trade dress, of course, would have a traditional likelihood of confusion claim. See 15 U.S.C. § 1125(a) (2000).