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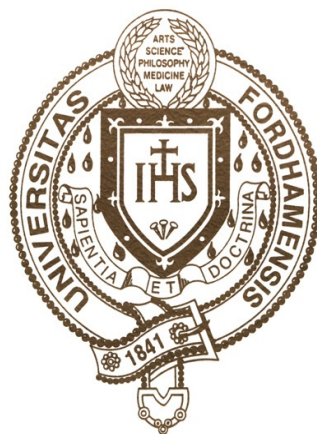
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Trademark Intersectionality

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TRADEMARK INTERSECTIONALITY

Sonia K. Katyal^{*}

Even though most scholars and judges treat intellectual property law as a predominantly content-neutral phenomenon, trademark law contains a statutory provision, section 2(a), that provides for the cancellation of marks that are “disparaging,” “immoral,” or “scandalous.” This provision has raised intrinsically powerful constitutional concerns, which invariably affect two central metaphors that are at war within trademark law: the marketplace of goods, which premises itself on the fixedness of intellectual properties, and the marketplace of ideas, which is premised on the very fluidity of language itself. Since the architecture of trademark law focuses only on how marks communicate information about a certain product or corporation within the marketplace of goods, it largely underestimates the more complex role that trademarks play within the marketplace of ideas. Conversely, by only taking into account a brand’s expressive implications, the provisions governing scandalous, disparaging, and immoral matter fail to substantively address the source-identifying functions that these marks often serve.

This Article starts from the premise that the best way to balance the tension between these two perspectives is to focus on the foundational role of the government in regulating the dual norms of both commerce and communication in trademark law. Borrowing insights from critical race theory and antidiscrimination law, I argue that we need to grapple with the creation of a new kind of intersectionality among cultural symbols—an intersectionality that stems from the interaction of a trademark’s

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economic, commercial, and cultural identities. This project requires us to reexamine the very nature of the trademark itself. While most scholars classify trademarks as private goods, I argue that they operate much more like public goods, a point that the laws of trademark often overlook, which sets the foundation for the constitutional difficulties that pervade trademark analysis. By studying how intersectionality might help to resolve the multifaceted role that trademarks inhabit, we also in turn refashion the notion of intersectionality itself, so that it takes a fuller account of the role of commodification in affecting the governance of identity within the commercial and expressive marketplaces of speech.

INTRODUCTION.....	1602
I. A POLITICAL ECONOMY OF TRADEMARKS: THREE BRAND EXTERNALITIES.....	1609
A. Private Goods and Commercial Externalities	1613
B. Public Goods and Moral Externalities	1621
C. Racial Branding and Cultural Externalities.....	1630
II. GOVERNMENT AS GUARANTOR IN THE MARKETPLACE OF GOODS.....	1638
A. Mediating the Marketplace.....	1642
B. Commerciality and Content.....	1647
C. Content and Captivity	1656
III. GOVERNMENT AS SPONSOR IN THE MARKETPLACE OF IDEAS	1662
A. Tolerating Offensive Symbols.....	1663
B. The Public Label and the (Non)Public Forum	1669
C. Application: The Case of Vanity Plates	1676
IV. RECONCILING TRADEMARK INTERSECTIONALITY	1682
A. Decommodification and Semiotic Democracy.....	1685
B. Recommodification and Dissent.....	1689
CONCLUSION	1698

INTRODUCTION

There is an unresolved conflict within intellectual property. Even though most scholars and judges treat intellectual property law as a predominantly content-neutral phenomenon, each area of law—patents, copyright, and trademarks—contains statutory and common law presumptions that are indelibly rooted in content-based considerations, and therefore intrinsically raise constitutional concerns.¹ In 1817, Justice Story wrote of the dangers of offering

1. See ALAN L. DURHAM, *PATENT LAW ESSENTIALS* 75 (3d ed. 2009) (discussing inventions denied on the basis of illegality or immorality); Margo Bagley, *Patent First, Ask Questions Later: Morality and Biotechnology in Patent Law*, 45 WM. & MARY L. REV. 469 (2003) (discussing the denial of biotechnology patents on moral grounds); Timothy R. Holbrook, *The Expressive Impact of Patents*, 84 WASH. U. L. REV. 573 (2006) (discussing the relationship between patents, sexuality, and social issues).

intellectual property protection to inventions used “to poison people, or to promote debauchery, or to facilitate private assassination”² Patent law historically banned immoral subject matter from protection, and, until recently, relied on this doctrine to ban patents on gambling devices and others used to propagate consumer fraud.³ Copyright law, too, has struggled with its own set of moral considerations: A host of cases have dealt with the intersection of obscenity regulation, artists’ moral rights, and the limits of fair use.⁴ And trademark law, too, has its own corresponding framework—section 2(a) of the Lanham Act includes a provision that provides for the cancellation of marks that are “disparaging,” “immoral,” or “scandalous.”⁵

Although patent and copyright law have, to some extent, self-consciously distanced themselves from the dangers of subjectivity within these considerations, trademark law’s content-based provisions have retained a unique vitality. Recent case law reveals two strands of cases, each of which indicates a growing conflict between two central metaphors that have historically animated the governance of expression—the marketplace of goods and the marketplace of ideas—and the underlying conflict between economic property and social meaning within each sphere.

Consider these examples. In 2003, Judge Kollar Kotelly overturned a ruling that cancelled the trademark in the term WASHINGTON REDSKINS, on the grounds that there was insufficient evidence to demonstrate that the term was disparaging to Native Americans. In the opinion, Kotelly observed, “[t]here is no evidence in the record that addresses whether the use of the term ‘redskin(s)’ in the context of a football team and related entertainment services would be

2. *Lowell v. Lewis*, 15 F. Cas. 1018, 1019 (C.C.D. Mass. 1817) (No. 8,568).

3. See, e.g., *Meyer v. Buckley Mfg. Co.*, 15 F. Supp. 640 (N.D. Ill. 1936) (patent denied to a vending machine that allowed a user to try to manipulate a miniature steam shovel to scoop up a toy); *Scott & Williams, Inc. v. Aristo Hosiery Co.*, 7 F.2d 1003 (2d Cir. 1925) (dealing with a patent that imitated a seamed stocking); *Nat’l Automatic Device Corp. v. Lloyd*, 40 F. 89 (N.D. Ill. 1889) (patent denied for a toy race course because it was used for betting).

4. See, e.g., *Jartech v. Clancy*, 666 F.2d 403 (9th Cir. 1982) (holding that a work is not excluded from copyright protection by reason of its obscene content); *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979) (same); *Wojnarowicz v. Am. Family Ass’n*, 745 F. Supp. 130 (S.D.N.Y. 1990) (dealing with moral rights and fair use). For further discussion, see Kurt L. Schmalz, *Problems in Giving Obscenity Copyright Protection: Did Jartech and Mitchell Brothers Go Too Far?*, 36 VAND. L. REV. 403 (1983); and Ann Bartow, *Fair Use and the Fairer Sex: Gender, Feminism and Copyright Law*, 14 AM. U. J. GENDER, SOCIAL POLICY AND LAW 551, 564 (2006).

5. Section 1052(a) provides that:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it (a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute

15 U.S.C. § 1052(a) (2006).

viewed by a substantial composite of Native Americans, in the relevant time frame, as disparaging.”⁶ The court reached these findings, despite the observations of one plaintiff who pointedly observed that the term “Redskins” is “the absolute, unquestionably worst term There is no context in which the term ‘Redskins’, is not offensive.”⁷

Just a few years later, the trademark office took a different view, and denied federal registration to a group that sought to trademark the term DYKES ON BIKES⁸ to mark the annual contingent that has historically led San Francisco’s Gay Pride Parade. In that case, the Patent and Trademark Office (PTO), on two separate occasions, initially rejected an application to register the mark on the grounds that the term dyke was vulgar, offensive, and scandalous—even though the participants themselves sought to label themselves with the term. Commenting on the PTO’s decision, a prominent historian, Joan Nestle, observed, “I cannot imagine a more ironic twist of thinking than to judge this reclaimed badge of honor as insulting to the very community who has created its power.”⁹

Both of these cases were eventually permitted to go forward—the *Redskins* case was reversed on other grounds, and the PTO decision in the *Dykes on Bikes* case was also eventually reversed. Yet both cases raise the potential conflict between the fluidity of language and the seemingly stabilizing force of property rights, demonstrating that intellectual property’s incomplete framework offers us little to address the complexities between culture, property, and speech. Why is it that trademark law permits one party to propertize terms like REDSKINS that may be perceived as outstandingly pejorative according to members of a targeted group, but, when the targeted group seeks to commodify a disparaging term, precisely to excise it of its disparaging impact, section 2(a) might prevent them from doing so? Can trademark law reconcile the protected

6. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 144 (D.D.C. 2003). The court clearly struggled with the empirical evidence that had been collected. See *infra* notes 162–163 and accompanying text. Since then, survey evidence has suggested a wide divergence of opinions on the question of disparagement, including some surveys that have suggested that Native Americans do not view the term Redskins as offensive. Of course, there are difficulties with empirical research in this area. See http://volokh.com/archives/archive_2009_05_10-2009_05_16.shtml#1242423155 (last visited July 15, 2010).

7. See Nancy Marie Mithlo, *Reappropriating Redskins*, 20 VISUAL ANTHROPOLOGY REV. 22, 22–35 (2005) (quoting Raymond Apodaca).

8. See Todd Anten, Note, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of Slurs Into Section 2(a) of the Lanham Act*, 106 COLUM. L. REV. 388 (2006) (discussing this case). See generally John W. Schouten & James H. McAlexander, *Subcultures of Consumption: An Ethnography of the New Bikers*, 22 J. CONSUMER RES. 43 (1995) (analyzing the social structure and values of Harley-Davidson enthusiasts—including the DYKES ON BIKES—as a consumption-based subculture).

9. See Joe Garofoli, *Attorneys Find Dykes on Bikes Patently Offensive, Reject Name*, S.F. CHRON., July 14, 2005, at A1.

appropriation of a third party (in this case, a sports team) with the unprotected appropriation of the very group that is targeted by the term?

In many ways, these cases point to a subtle paradox that operates throughout trademark law and its relationship to cultural products: Although culture is shifting, dynamic, and fluid, property rights are often considered to be just the opposite: fixed, static, and concrete.¹⁰ This tension invariably affects two central metaphors that are at war within trademark law: the marketplace of goods, which premises itself on the fixedness of intellectual properties; and the marketplace of ideas, which is premised on the very fluidity of language itself. The law governing trademarks presumes that a mark is a type of economic property—it has a fixed presumption of meaning as a brand, and as an identity, in the marketplace of goods. However, a variety of nonowners who are affected by a mark posit just the opposite view—that trademarks are far more expressive than economic in nature, and are thus inherently unstable because they can mean so many different things within the marketplace of ideas. The tension between these two positions often fractures trademarks into two different spheres—one sphere that premises its existence on a fixedness of proprietary meaning, and another sphere that posits that they are just the opposite—fluid and dynamic, like ideas themselves.

This Article starts from the premise that the best way to balance the tension between these two perspectives is to focus on the foundational role of the government in regulating the dual norms of both commerce and communication in trademark law and advertising, respectively.¹¹ Should the state play a role in subsidizing or penalizing certain types of marks when it registers them, or should it remain a body that preserves content- and viewpoint-neutrality in regulating trademarks in advertising? Within the law, almost overwhelmingly, an economic theory of trademark's utilitarian functions predominates. Yet as scholars like Barton Beebe have perceptively shown, the economic theory of trademarks has failed to capture—or even anticipate—the divergence between the economic and semiotic functions of trademarks, let alone provide a coherent normative approach.¹² While the law includes a provision that provides for the cancellation of marks that are disparaging, immoral, or scandalous, its incomplete framework offers us little else in addressing the complexity of group and individual claims over the impact of trade symbols themselves.

10. See ROSEMARY COOMBE, *THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES: AUTHORSHIP, APPROPRIATION AND THE LAW* (1998); Naomi Mezey, *The Paradoxes of Cultural Property*, 107 COLUM. L. REV. 2004, 2005 (2007).

11. See generally Ronald K.L. Collins & David M. Skover, *Essay, Commerce & Communication*, 71 TEX. L. REV. 697 (1993) (discussing the constitutional protection of commercial speech).

12. See Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621 (2004).

In other words, trademarks, owing to their expressive and economic dimensions, embody a particular kind of conflict that the government has failed to grapple with. Since trademarks inhabit a multiplicity of meanings, they can operate as devices of owned property, and at other times, they can also operate as devices of expression and culture. The tension between these facets produces a nearly irreconcilable incompatibility between the marketplaces of goods and of ideas. The *Redskins* and the *Dykes on Bikes* cases show how trademark law is often the terrain on which these conflicts unfold, leaving the optimal role of state regulation largely undertheorized.

Indeed, the legal standards for determining disparaging and scandalous content only serve to highlight, rather than resolve, these nearly irreconcilable intersections between social meaning and economic value in trademark law. The end result of this bipolarity also means that antidiscrimination concerns are usually invisibilized in favor of a resolution that favors either freedom of culture and speech, on one hand, or property, on the other. As a result, the law leaves us with a curious mismatch—though trademark law governs speech and expression, our case law and theory is correspondingly thin in providing us with guiding principles over how to reconcile these principles with the function of trademarks as property.

The purpose of this Article is to reconcile these polarities of economic value and social meaning within trademark law by considering the state's role in resolving these tensions. What we need is a theory that reconciles the interaction of trademark law's commercial functions with its expressive connotations, a way to embrace the state's role in preserving the economic value of brand equity while simultaneously recognizing the potential expressive externalities that may flow from commodifying certain marks. I argue that, unlike other areas of law, trademark law's section 2(a) provisions cannot be perfectly analogized to our case law on either First Amendment, antidiscrimination, or other areas of intellectual property: What it represents, I argue, is something wholly unique, and something far more instructive to these areas than the current literature suggests.

For the past twenty years, one of the crucial tools that we have used in grappling with the complexity of culture and discrimination has been the theory of intersectionality, which has provided us with a vantage point from which to theorize some responses.¹³ Intersectionality's main gift has been forcing the law to recognize the multiplicity of different identities that circulate within a particular embodiment, and to take into account the unique intersection of overlapping categories of identity. To date, however, we think of intersectionality in terms of categories of human identity along an axis of categories of

13. For more on the concept of intersectionality, see Part II, *infra*, and *infra* notes 175–182.

personhood, rather than property. While it has transformed many areas of law dealing with people (employment law, family law, and criminal law, to take just a few examples), it has only had a limited effect on areas of law dealing with property, and even less effect as applied to the realm of intellectual property.

This Article seeks to introduce some of the ways in which the concept of intersectionality, when fashioned to account for the shifting and fluid grounds of trademark law, emerges as a helpful vantage point from which to explore the dual pillars of commodification and content regulation. I argue that we need to grapple with the creation of a new kind of intersectionality among cultural symbols—an intersectionality that stems from the interaction of a trademark's economic, commercial, and cultural identities. Like traditional intersectionality theories, which criticize the presumption of singular categories of identity, trademark law, I argue, unwittingly falls into the same trap of exclusivity. Instead of recognizing the intersection of economic, cultural, and commercial aspects of a trademark, the law overwhelmingly focuses on one aspect to the exclusion of the others, generating a fragmented set of principles, rather than taking into account a more sophisticated and comprehensive approach.

Here, the theory of intersectionality—with its unique refusal to erase or minimize the interaction of identity-based categories—offers us a potentially helpful set of conceptual tools for addressing the expressive and economic facets of intellectual property. I argue that the genius of trademark law lies, curiously, in its own intersectionalities, in its unique nature as a vessel for a wide variety of irreconcilable differences. On one hand, it is both a commodity as well as a sign of speech and expressive significance. Trademarks also assimilate aspects of public goods as well as private ones. Because their nature stems from the nonrivalrous and nonexclusive character of expression and speech, they are more akin to public goods within the marketplace of ideas, but because they are protected through the law as intellectual property, they function, largely, as private properties in the marketplace of goods. This leads to a foundational tension between the role of trademarks in public discourse and the commercial marketplace, where they serve two different functions—one involving speech and expression, and another involving source identification.

The goal of this Article, therefore, is to analyze trademark law's fragmented incompatibilities by pointing to the varieties of intersectionalities that the law produces, both in terms of their economic and constitutional implications. This project, however, requires us to reexamine the very nature of the trademark itself. By studying how intersectionality might help to resolve the multifaceted role that trademarks inhabit, we also, in turn, refashion the notion of intersectionality itself, so that it takes fuller account of the role of commodification in affecting

antidiscrimination and the governance of identity within the commercial and political marketplaces of speech.

This Article is divided into four parts. In Part I, I introduce an ongoing debate among scholars regarding whether trademarks are properly classified as public or private goods. As I show, the economic theory of trademarks, with its classification of trademarks as private goods, has, at times, failed to take into account the social externalities that flow from trademark's expressive functions, an omission that resurfaces in the context of regulating scandalous and disparaging marks. Here, I argue that trademark law is defined by a central paradox: While the law constructs trademarks as private goods, they function in the marketplace as public goods like information. As a result, the law incorporates a disparate—and sometimes contradictory—host of considerations that are embodied in the Lanham Act's provisions surrounding scandalous, disparaging, and immoral marks, ranging from commercial harm to expressive harm.

Parts II and III focus on exploring the constitutional implications of this tension between trademark's public and private facets and provides an account of how the government role shifts in accordance with the status of the trademark in question. Generally, I argue that a trademark's constitutional status often falls within the interstitial spheres of both high-value and low-value speech, owing to its commercial connotations. As a result, the government is caught between two central roles, both of which are outlined, but never reconciled, within trademark law's architecture. One role, described in Part II, focuses on the role of branding and quality control, and involves envisioning the government as a guarantor of commercial quality within the marketplace of goods. But there is another role that the Lanham Act also personifies, one that is often overlooked in the literature. This role, described in Part III, and largely typified by the Lanham's Act's provisions on scandalous and disparaging marks, carves out a vision of the government as an expressive sponsor that selects certain types of brands and trademarks for recognition. Both roles for the government—guarantor and sponsor—raise constitutional concerns that surface within the case law on section 2(a), ranging from content- and viewpoint-based concerns to others involving unconstitutional conditions.

Part IV concludes by responding to the popular critiques of section 2(a). Unlike the dominant doctrinal perspective in the literature, which suggests that the Lanham Act provisions are unconstitutional, I focus on how trademark law might be uniquely poised to be more protective of First Amendment concerns than scholars suggest. Drawing upon the juridical and practical significance of trademark law's unique remedy of cancellation, I show how it is possible for the law to take into account the social externalities of harmful marks, and yet avoid

some of the classic burdens familiar to First Amendment lawyers. By focusing on the law's unique approaches to section 2(a), I show how trademark law's intersectionality may protect, rather than destroy, a fertile semiotic democracy in the process.¹⁴

I. A POLITICAL ECONOMY OF TRADEMARKS: THREE BRAND EXTERNALITIES

In 1888, Charles Underwood, a mill owner, and Chris Rutt, a local journalist, purchased a mill in Missouri called the Pearl Milling Company.¹⁵ They then undertook to develop a product that would become a staple item in every household. Ideally, they reasoned, the perfect product would require a substantial amount of flour in its preparation, but yet still comprise something novel and appropriate for wide consumption. After some consideration, they settled on the one thing that everyone enjoyed eating: pancakes. Pancakes, they believed, were the perfect mass commodity: Everyone ate them, everyone liked them, and they seemed to conjure up warm memories of childhood and the hospitality of home cooking. After some experimentation, they finally came up with a ready-made pancake mix that consistently retained its smooth, velvety character. For a short while, they packaged the mix in paper bags and sold it under the unassuming title "Self-Rising Pancake Flour."¹⁶ But they soon decided that they needed something else—a *hook*—something that would, in the words of advertising scholar Marilyn Kern-Foxworth, "make the product recognizable by all American housewives."¹⁷

A year later, their search ended in a vaudeville house in St. Joseph, Missouri. In an evening performance, Chris Rutt came upon a team of blackface minstrel comedians known as Baker and Farrell, who were performing one of the most popular songs of the day, a song titled "Old Aunt Jemima."¹⁸ Clad in aprons and red bandannas to conjure up the image of a Black, female, southern cook, and using a rollicking tone and rhythm, the performance enraptured white

14. See Sonia K. Katyal, *Semiotic Disobedience*, 84 WASH. U. L. REV. 489 (2006).

15. See MARILYN KERN-FOXWORTH, AUNT JEMIMA, UNCLE BEN, AND RASTUS: BLACKS IN ADVERTISING, YESTERDAY, TODAY, AND TOMORROW 63–64 (1994).

16. See *id.* at 64.

17. *Id.*

18. *Id.*

audiences throughout the country.¹⁹ Immediately, Rutt realized he had found the perfect hook:

Mesmerized, Rutt knew that the song and costume projected the image for which he had been searching. He decided to mimic it, using not only the name but the likeness of the Southern mammy. . . . thus beginning a new era in advertising. This would be the first time a living person would be used to personify a company's trademark.²⁰

At the time, few probably realized that the birth of AUNT JEMIMA as a trademark would herald a new era in advertising. But it marked a curious intersection between the commodification of racial minorities and the representation of intellectual properties within the marketplace of goods. The invention of AUNT JEMIMA as a trademark cemented a growing trend in American advertising—the use of ethnic minorities, particularly African and Native Americans—that relied upon stereotypical representations in order to sell products.²¹

One might argue that the creation of AUNT JEMIMA both capitalized upon, and facilitated, a perceived absence in the American purchasing public, in which racial minorities were cast not as consumers or citizens to be marketed *to*, but as a set of images and tools in the construction of a company brand—icons that forced a sort of perceptual segregation between the marketplace of goods and the marketplace of ideas.²² Minorities, under this approach, became transformed from a racial subject (a person) to a racial object (a trademark).²³

Indeed, just after the persona of Aunt Jemima was created, the company undertook a search for an actual person who could personify Aunt Jemima, a woman who could make their trademark into a household name.²⁴ Over the next hundred years, tens of women were hired to play Aunt Jemima, accompanied by legendary myths that were circulated by Quaker Oats about the pancakes' miraculous powers. In turning to the stereotypical image of the southern mammy to sell its products, and then hiring a woman to perform and personify this image, the corporation both relied upon and transformed a

19. See *id.* at 65.

20. *Id.*

21. See K.J. Greene, *Trademark Law and Racial Subordination: From Marketing of Stereotypes to Norms of Authorship*, 58 SYRACUSE L. REV. 431 (2008).

22. See Russell K. Robinson, *Perceptual Segregation*, 108 COLUM. L. REV. 1093 (2008) (discussing perceptual segregation with a focus on African Americans).

23. See Margaret Jane Radin & Madhavi Sunder, *Introduction to RETHINKING COMMODIFICATION* 8 (Martha M. Ertman & Joan C. Williams eds., 2005) (making similar observations).

24. See KERN-FOXWORTH, *supra* note 15, at 66. Their search ended when they found Nancy Green, a woman who was initially born a slave, but later was employed as a cook for a judge in Chicago, and who was actually renowned for her delicious pancakes. See *id.* at 66–67.

powerful irony: It created a fictional person in order to sell products, but then employed an actual person to embody the stereotype it had created.

Under the watchful eye of the company's creators, AUNT JEMIMA became not just a trade symbol, but an icon. She became a person who created, performed, indeed *personified* an icon in the everyday marketplace of goods.²⁵ The civil rights leader Eldridge Cleaver accused Aunt Jemima of acting as a traitor to black America, of "consorting with the enemy in the defeat of black America."²⁶ In response to the emerging chorus of criticism centering on Aunt Jemima, the company attempted to reform Aunt Jemima's image. Over the years, Aunt Jemima has undergone a variety of changes—more modern hair styles, updated clothing, and a more humanized appearance. All of this has been done to remedy—and to change—the social meaning of the AUNT JEMIMA trademark, which some consumers have associated with a historical symbol of slavery.²⁷

And yet, perhaps because of this iconic linkage between personhood and property, AUNT JEMIMA's success as a readily identifiable trademark is still unparalleled: At one point, she was listed as one of the two most trusted symbols by the American housewife.²⁸ Generations of kitchen items—pitchers, plates, cookie jars, salt-and-pepper shakers, and sugar bowls—have been sold across America, along with a ubiquitous series of dolls with her image emblazoned upon them. Even to this day, the icon of Aunt Jemima remains indelibly burned into our collective American memory—representing both the pervasiveness of racial stereotyping and its lingering effects on the expressive construction of American commodities.

Like Aunt Jemima herself, trademark law is dominated by a profound conflict between economic value and social meaning. Trademark law, like most

25. For a powerful treatment of the question of applying trademark protection to actual persons, see David Dante Troutt, *A Portrait of the Trademark as a Black Man: Intellectual Property, Commodification, and Redescription*, 38 U.C. DAVIS L. REV. 1141 (2005). In addition, other scholars have also studied the parallels between trademark law and racial classifications. See Alex M. Johnson, Jr., *Destabilizing Racial Classifications Based on Insights Gleaned From Trademark Law*, 84 CAL. L. REV. 887 (1996).

26. KERN-FOXWORTH, *supra* note 15, at 85. Others argued that in trademarking Aunt Jemima, the company was able to—literally—own both the person and the symbol, prompting one author to call her a "slave in a box." See M.M. MANRING, *SLAVE IN A BOX: THE STRANGE CAREER OF AUNT JEMIMA* 148 (1998).

27. Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement: How Politically Correct Must a Trademark Be?*, 22 PEPP. L. REV. 7, 10 (1994). One commentator observes in contemporary times that "[t]hrough her complexion had been presumably improved, her heart remained the same." KERN-FOXWORTH, *supra* note 15, at 91 (quoting James Anderson (reviewing EUGENE GENOVESE, *ROLL, JORDAN, ROLL* (1974))).

28. See *The Mammy Caricature*, Commercial Mammies, <http://www.ferris.edu/jimcrow/mammies> (last visited June 14, 2010) (citing STANLEY SACHAROW, *SYMBOLS OF TRADE: YOUR FAVORITE TRADEMARKS AND THE COMPANIES THEY REPRESENT* 62 (1982)).

of intellectual property law, is largely dominated by an economic perspective. Trademarks are owned properties, brand owners may argue, rather than simply ideas. Yet while trademarks are commodities in one sense, they are also expressions in another, to both the markholder that owns them and to the public that perceives them, and the law inherits the responsibility of navigating a trademark's potential contradiction between its status as corporate property and as cultural icon. The PTO is charged with the responsibility to cancel, or to refuse to register, the mark if it determines that the mark "comprises immoral, deceptive, or scandalous matter," or if it may disparage certain persons, institutions, beliefs, or national symbols.²⁹ Yet this position conflicts with the dominant economic approach to trademarks, which tends to situate trademarks within a private marketplace of goods, where symbols operate to sell, to inform, and to persuade the consumer.

Both views—trademark as commodity and trademark as social symbol—are deeply suffused with notions of culture and identity. But they focus on managing two different types of externalities—one that is largely economic, and another that is largely cultural or content-based. And yet the law seems unable to satisfactorily reconcile both types of externalities at the same time. Since the architecture of trademark law focuses only on how marks communicate information about a certain product or corporation within the marketplace of goods, it largely underestimates the more complex role that trademarks play within the marketplace of ideas.³⁰ Conversely, by only taking into account a brand's expressive implications, the provisions governing scandalous and immoral matter fail to address the source-identifying functions that these marks often serve. As a result, the economic perspective, as a general body of principles and precepts, seems wholly unable to account for the fluidity of language and the effects that those marks have on society. And, on the expressive side, the constantly shifting domain of language and meaning sits awkwardly beside the dominance of economic theory—coexisting, but never quite intersecting, with each other.

This Part argues that, just as intersectionality theory argues against the decoupling of identity-based categories like race and gender, trademark law, quite similarly, suffers from a parallel problem of essentialism regarding its public and private facets. While trademarks are owned properties, they are also suffused with expressive implications. Contrary to the law that treats trademarks like other types of private properties, this Part argues that trademarks often function like other public goods, and the law's failure to recognize this role accounts for some of its inherent tension between economic and expressive value.

29. 15 U.S.C. § 1052(a) (2006).

30. See Rochelle Dreyfuss, *Expressive Genericity*, 65 NOTRE DAME L. REV. 397 (1990).

Trademarks, here, have a special paradox from within, stemming from an inherent incompatibility regarding their status as both public and private goods. This intersectionality between private and public, in turn, informs trademark law's own ambivalence in facing the law's governance of three different types of externalities in trademark law—commercial, moral, and cultural.

A. Private Goods and Commercial Externalities

Trademarks are often the overlooked stepchild of the world of intellectual property goods. In general, economists characterize copyrighted and patented goods as public goods in the sense that they are, by nature, nonrivalrous and nonexclusive, so that consumption by one person does not reduce or eliminate another's access to the same good.³¹ The rationale for regulation is simple. Because information by nature tends to be nonrivalrous and nonexclusive, it is difficult to exclude third parties from free riding from its creation.³² For this reason, the law provides for a series of limited monopolies—intellectual property rights—in order to avoid the market failure that would develop in their absence, and to incentivize creativity and innovation. Thus, copyrighted and patented goods are both governed by Article I, Section 8 of the U.S. Constitution, which allows Congress to create limited property rights in information in order to ensure the progress of “[s]cience and the useful [a]rts.”³³ Because society benefits from a constant accumulation of more copyrighted and patented goods in the marketplace—artworks, writings, music, and inventions—Congress is empowered to enact limited property rights over these areas to protect an author or inventor, and to incentivize their continued production.

In contrast to copyrighted and patented goods, which are assertively treated by the law as public goods, trademarks are part of a separate framework that concentrates on commerce, rather than communication. Unlike patents and copyrights, which are governed by Article I, Section 8, and are concerned with preserving incentives to create, trademarks' intellectual origins lie mostly within the Commerce Clause, which grounds its purpose in facilitating the smooth

31. Pure public goods are generally defined in terms of two features: nonrivalry of consumption and nonexcludability of benefits. See Anne Fennell, *Beyond Exit and Voice: User Participation in the Production of Local Public Goods*, 80 TEX. L. REV. 1, 7 n.15 (2001) (citing RICHARD CORNES & TODD SANDLER, *THE THEORY OF EXTERNALITIES, PUBLIC GOODS AND CLUB GOODS* 6–7 (1986)); see also ROBERT D. COOTER, *THE STRATEGIC CONSTITUTION* 105 (2000) (defining public goods as nonrivalrous and nonexcludable); RUSSELL HARDIN, *COLLECTIVE ACTION* 17 (1982) (“Public goods are defined by two properties: *jointness of supply* and *impossibility of exclusion*.”).

32. See RICHARD A. POSNER, *ECONOMIC ANALYSIS OF LAW* 41 (6th ed. 2003) (defining a public good).

33. U.S. CONST. art. I, § 8, cl. 8.

functioning of the marketplace of goods.³⁴ In a case that established that trademarks were not part of Article I, Section 8, the Supreme Court observed that “[a]ny attempt . . . to identify the essential characteristics of a trade-mark with inventions and discoveries in the arts and sciences, or with the writings of authors, will show that the effort is surrounded with insurmountable difficulties.”³⁵ The Court continued:

The trade-mark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it But in neither case does it depend upon novelty, invention, discovery, or any work of the brain. It requires no fancy or imagination, no genius, no laborious thought.³⁶

Instead, the court reasoned that a trademark was wholly unrelated to invention or discovery because a mark’s protection was established by a period of use in commerce, “rather than a sudden invention.”³⁷

Even within the world of trademark theory, the dominant justification for trademark protection involves the stimulation of commerce, instead of creativity: Trademarks lower transaction and search costs because buyers and sellers can use trademarks as shorthand in communicating and digesting certain information regarding the products and services in question.³⁸ Thus, while the law of patents and copyright is largely concerned with incentivizing contributions to the marketplace of ideas, trademark law concerns itself exclusively with the marketplace of goods. As William Landes and Richard Posner have written:

A trademark conveys information that allows the consumer to say to himself, “I need not investigate the attributes of the brand I am about to purchase because the trademark is a shorthand way of telling me that the attributes are the same as that of the brand I enjoyed earlier.”³⁹

As one scholar concludes, “[w]ith products, as with people—if there were no trademarks by which to identify articles of merchandise, there would be no way to tell the good from the bad.”⁴⁰ Aside from this identification function,

34. See David W. Barnes, *A New Economics of Trademarks*, 5 NW. J. TECH. & INTELL. PROP. 22, 22–23 (2006).

35. See *Trade-Mark Cases*, 100 U.S. 82, 93–94 (1879).

36. *Id.* at 94.

37. *Id.*

38. See generally William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265 (1987) (discussing trademark law from an economic perspective).

39. *Id.* at 269.

40. Sidney Diamond, *The Historical Development of Trademarks*, 65 TRADEMARK REP. 265, 289 (1975).

trademarks also involve a guarantee function, which helps to ensure that goods bearing the same mark are of consistent quality to the consumer.⁴¹

Scholars have also offered the argument that trademarks are wholly separate from other types of public goods (like information or inventions, as in copyrighted or patented goods, respectively).⁴² In their foundational study of trademarks, Landes and Posner echo this view: “A proper trademark is not a public good; it has social value only when used to designate a single brand.”⁴³ Similarly, Mark Lemley has argued that within the realm of trademark, “there is no public goods problem for intellectual property to solve.”⁴⁴ He continues:

Unlike patents and copyrights, trademark law and the right of publicity do not exist to encourage the creation of new brand names, personal names, or likenesses. There is no affirmative social interest in encouraging their proliferation, and, in any event, the fixed costs invested in creating a new name are so minimal that it is hard to imagine that creating one would require incentives.⁴⁵

Lemley’s comments suggest that the classic public goods approach is inapposite in this context—since there is no market failure problem for trademarks to solve, there is no need to stimulate their production. Trademarks are thought to play no role in enriching the public domain, and thus there is less of a need for government intervention to mitigate the danger of underproduction.⁴⁶

As a result, both scholars and practitioners find it difficult to characterize the uniquely expressive and persuasive qualities that trademarks and brands possess, sometimes designating these qualities to be outside of trademark law’s governance unless they affect the value of its mark in some manner.⁴⁷ In the

41. *Id.*

42. See Barnes, *supra* note 34, at 23–24 (discussing scholars’ classification of trademarks as private goods).

43. William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267, 276 (1988); Stephen L. Carter, Comment, *The Trouble With Trademark*, 99 YALE L.J. 768 (1990) (noting that a trademark is not a public good).

44. Mark A. Lemley, *Ex Ante Versus Ex Post Justifications for Intellectual Property*, 71 U. CHI. L. REV. 129, 143 (2004).

45. *Id.* at 143 n.50.

46. See Barnes, *supra* note 34, at 23.

47. Some of these conflicts arise surrounding an interesting debate that has occurred in the trademark literature in the context of “trademark use,” a theory that concentrates on the threshold question of whether the defendant used a trademark “as a mark in commerce,” suggesting that nontrademark uses should be immune from liability. See, for example, the colloquy between Graeme B. Dinwoodie & Mark D. Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597 (2007) and Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669, 1670 (2007) (rejecting Dinwoodie and Janis’s view); also see Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777 (2004).

U.S. Supreme Court case of *Friedman v. Rogers*,⁴⁸ which involved a state statute that barred optometrists from practicing under a trade name, the Court found that trade names carried little or no informational content:

Here, we are concerned with a form of commercial speech that has no intrinsic meaning. A trade name conveys no information about the price and nature of the services offered by the optometrist until it acquires meaning over a period of time by associations formed in the minds of the public between the name and some standard of price or quality.⁴⁹

Following this view, scholars interpreted *Friedman* to suggest that trademarks have little expressive or informational value because they do not convey information intrinsically; it is only through secondary meaning that information becomes circulated, through “associations that grow up over time between the name and a certain level of price and quality of service.”⁵⁰

The *Friedman* view initially facilitated a very limited scope of trademark protection, whereby courts initially saw a trademark as “little more than a vehicle through which consumers could match products with their producers.”⁵¹ The central justification for trademark law, under this view, is that it is a property right that functions, essentially, just like any other kind of private property in this context. Trademark protection thus protects the mark’s source-identifying function by ensuring that one party—the mark’s source—enjoys exclusive rights in a single context. Without such protection, the law reasons, both consumers and producers suffer. Consumers would face higher search costs in locating authentic goods, endangering the qualitative associations the consumer makes with a certain good, and ultimately making it less and less desirable for companies to engage in trademarking behavior.⁵²

But there is a complexity that brands like AUNT JEMIMA plainly demonstrate. It is true that trademark law protects a brand’s proprietary, source-identifying function.⁵³ But trademarks do more than lower consumer search

48. 440 U.S. 1 (1979).

49. *Id.* at 12.

50. *Id.* at 16. For discussion of this point, see Jeffrey Lefstin, Note, *Does the First Amendment Bar Cancellation of REDSKINS?*, 52 STAN. L. REV. 665, 674–75 (2000).

51. Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1843 (2007) (arguing that early trademark law was largely concerned with unfair competition, and was strongly influenced by natural rights theories of property); Dreyfuss, *supra* note 30 (reaching similar conclusions about trademark’s narrow functions).

52. Trademark law protects against unauthorized proprietary uses in commerce, on the ground that classic forms of passing off (1) increase the costs of finding authentic goods in the marketplace; (2) misrepresent the quality and characteristics of the good; (3) fail to satisfy a customer who desires to purchase an authentic good; and (4) diminish the incentives to engage in further trademarking activity. See Barnes, *supra* note 34, at 23.

53. *See id.* at 28.

costs; they also serve a referential function that is deeply informative in nature, which makes it more difficult to separate them entirely from the world of other public goods like information.⁵⁴ These referential functions can comprise references to a mark by a competitor (for example, comparative advertising) or by a consumer (parody or commentary).⁵⁵ While source-identifying uses are supposed to be rivalrous, referential uses (by other competitors or consumers for the purposes of communicating information about a good) are nonrivalrous in nature.⁵⁶

Today, a trademark can serve commercial, expressive, and communicative functions for more than one party at the same time. Part of this shift is largely attributable to the changing role of trademarks in today's culture. Especially in the modern era, trademarks are complex symbols of both corporate identity and consumer identity.⁵⁷ Today's brands are not just about product differentiation; they are said to comprise "complete meaning systems" that enable the consumer, company, and company employee to "publicly enact a distinctive set of beliefs and values."⁵⁸

Consequently, the law now reflects, contrary to *Friedman*, a strong disposition towards viewing a trademark as a broad "repository for value and meaning," thereby enabling the perception that any form of consumer confusion is an evil in and of itself.⁵⁹ Yet the law's treatment of trademarks as exclusive properties, coupled with a trademark's inherent nature as more akin to a public good—explains in part why trademark law now reflects such a marked disarray of principles. While trademark law is designed to apply to trademark uses within the stream of commerce (in the marketplace of goods), it has slowly broadened to encompass other expressive uses within the marketplace of ideas. Today, consumers who refer to a mark in rejecting or comparing a product to other

54. See *id.* at 29.

55. See *id.* at 28.

56. See *id.* at 25 ("Simultaneous use of a trademark by consumers referring to a particular source of coffee is purely non-rivalrous and simultaneous use by competing coffee makers in the same geographic market is purely rivalrous.").

57. See Deven Desai, *A Brand Theory of Trademark Law* (draft on file with author); and Mark Bartholomew, *Advertising and Social Identity*, 59 *BUFF. L. REV.* (forthcoming 2010). As Tamara Piety has written, "Advertising is as much about creating perceptions as it is about conveying information. Indeed, with respect to the creation and maintenance of a brand, it is almost *entirely* about creating perceptions, perceptions that might not correspond to any 'real' difference beyond the brand identity itself." Tamara R. Piety, *Free Advertising: The Case for Public Relations as Commercial Speech*, 10 *LEWIS & CLARK L. REV.* 367, 386 (2006).

58. Piety, *supra* note 57, at 390 (quoting one marketing specialist).

59. McKenna, *supra* note 51, at 1843. See also Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 *STAN. L. REV.* 413 (2010); William McGeeveran, *Rethinking Trademark Fair Use*, 94 *IOWA L. REV.* 49, 57 (2008); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302 (9th Cir. 1992) (describing expressive uses of marks).

goods, or individuals who identify a mark for the purposes of comparison, parody, or commentary, can fall within the widening categories of trademark governance, depending on the use involved, and, at times, even when a referential use does not occur in a commercial context.⁶⁰ While trademark law aims to preserve some generic marks for the public domain⁶¹ and enables the protection of some referential uses through its fair and nominative use doctrines,⁶² the law's reliance on concepts of consumer confusion and dilution have, at times, enabled trademark protection to expand outward from the regulation of commerce and unfair competition into the regulation of communication instead.⁶³

Nevertheless, the expanding role of marks as expressions of communication, rather than pure expressions of commerce, means that trademarks take on characteristics that resemble both public and private goods. In a provocative series of papers, David Barnes has argued that the dominant analysis of trademarks as private goods is sorely misplaced: Instead, it is better to characterize trademarks as mixed public goods.⁶⁴ He reasons (along with Glynn Lunney) that in the absence of legal protection, which provides for some form of scarcity, trademarks retain many of the same qualities as most public goods.⁶⁵

In the past, trademark law tended to govern the horizontal relationships between competitors by serving to prohibit them from passing off each other's

60. See Barnes, *supra* note 34, at 26. For further discussion of this point, see also Margreth Barrett, *Internet Trademark Suits and the Demise of "Trademark Use"*, 39 U.C. DAVIS L. REV. 371 (2006); Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721, 796–816 (2004); Michael K. Cantwell, *Confusion, Dilution, and Speech: First Amendment Limitations on the Trademark Estate*, 87 TRADEMARK REP. 48, 55–76 (1997); Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397 (1990); Rochelle Cooper Dreyfuss, *Reconciling Trademark Rights and Expressive Values: How to Stop Worrying and Learn to Love Ambiguity*, in TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH 261, 261–67 (Graeme B. Dinwoodie & Mark D. Janis eds., 2008); Pratheepan Gulasekaram, *Policing the Border Between Trademarks and Free Speech*, 80 WASH. L. REV. 887 (2003); Arlen W. Langvardt, *Protected Marks and Protected Speech: Establishing the First Amendment Boundaries in Trademark Parody Cases*, 36 VILL. L. REV. 1, 60–102 (1991); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687 (1999); Jacqueline Lipton, *Commerce Versus Commentary: Gripe Sites, Parody, and the First Amendment in Cyberspace*, 84 WASH. U. L.R. 1327, 1331–32 (2006); Jessica Litman, *Breakfast With Batman: The Public Interest in the Advertising Age*, 108 YALE L.J. 1717 (1999); Robert J. Shaughnessy, Note, *Trademark Parody: A Fair Use and First Amendment Analysis*, 72 VA. L. REV. 1079, 1082–99, 1107–16 (1986); Hannibal Travis, *The Battle for Mindshare: The Emerging Consensus That the First Amendment Protects Corporate Criticism and Parody on the Internet*, 10 VA. J.L. & TECH. 3, 8–29 (2005).

61. See generally Deven R. Desai & Sandra L. Rierson, *Confronting the Genericism Conundrum*, 28 CARDOZO L. REV. 1789 (2007).

62. See *New Kids on the Block*, 971 F.2d 302.

63. See sources cited in note 60 for further exposition of this point.

64. See David W. Barnes, *Trademark Externalities*, 10 YALE J.L. & TECH. 1, 6 (2007).

65. See Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 463 (1999) (“Unlike a private good, where it is usually the case that one use of the good physically precludes another, for trademarks, it is physically possible for both uses to proceed.”).

goods as their own. Yet beginning with a case in 1917 that, ironically, prohibited another company's use of Aunt Jemima's name to sell pancake syrup, trademark law has slowly expanded outward, protecting against a steadily growing list of unauthorized uses, some of which take place in the marketplace of goods, and others that spill over into the marketplace of ideas.⁶⁶

Particularly in the twentieth century, trademark law has shifted from a focus on the competitor to the consumer, potentially introducing a much wider range of potential harm than unfair competition.⁶⁷ In the 1950s and 60s, trademark law was relatively simplistic, but as national brands began to emerge, especially those more focused on consumer experiences and lifestyle, scholars began to embrace a more Chicago-like view of brands as capable of "enhance[ing] consumer efficiency, facilitat[ing] a broader spectrum of goods, foster[ing] quality control, and facilitat[ing] entry."⁶⁸ As marketing practices grew more powerful and pervasive, they began to overtake even the original function that a trademark served—that is, denoting much more than just the product source.⁶⁹ In many cases, powerful brands like TIDE, GAIN, BOLD, and IVORY SNOW did not denote a particular source of the product (in this case, they all came from Proctor & Gamble), but rather denoted something entirely different, as Jerre Swann explains:

Tide is "so powerful, it cleans down to the fiber." Ivory Snow is "99 and 44/100 percent pure" and therefore mild for . . . baby clothes. Bold is the detergent with fabric softeners; it "cleans, softens, and controls static." . . . The product is as differentiated as the brand, and the brand generates expectations as to the product, not its producer. Source, for many experience goods, is not merely anonymous; it is irrelevant and can be counterproductive.

In other words, product and source have effectively been merged into a brand, rendering a focus on the source of a product as a matter of secondary importance.⁷⁰

Today, consumers make purchases to satisfy both physical and psychological needs, and as Jerre Swann has suggested, "they are often more concerned with

66. See *Aunt Jemima Mills Co. v. Rigney & Co.*, 247 F. 407, 408, 410 (2d Cir. 1917).

67. See Graeme W. Austin, *Trademarks and the Burdened Imagination*, 69 BROOK. L. REV. 827 (2004); Bartow, *supra* note 60.

68. Jerre B. Swann, David A. Aaker, & Matt Reback, *Trademarks and Marketing*, 91 TRADEMARK REP. 787, 790 (2001).

69. *Id.* at 792–93.

70. *Id.* at 793–94 ("ARM & HAMMER, an old source mark, now principally connotes 'freshness,' whether used on baking soda, deodorant, toothpaste or detergent. The 'lonely' MAYTAG repairman, for what are prototypical search goods, is more than a source symbol, he specifically connotes reliability, irrespective of the appliance responsible for his inactivity.").

identifying themselves than with identifying the source of the goods they buy.”⁷¹ Nowhere is this shift more apparent than in the ever-growing marketplace of sports merchandising. The most obvious example would be the NIKE “swoosh” sign, which as Mark Lemley has suggested, reverses the function of a trademark: “[r]ather than identifying the good with a particular manufacturer, and thereby guaranteeing its quality, the identifier is itself the product. . . . [T]he logo stands alone as a thing that customers value in and of itself.”⁷²

Again, the psychological importance of brands also underscores a further difference between copyright and trademark law: While copyright law is designed to incentivize additional layers of expression and commentary through fair use protections, trademark law limits the multivariate associations of a trademark to a single source through doctrines like secondary meaning and, in the case of famous marks, protection against dilution. Dilution, which protects against the blurring or tarnishing of a mark’s meaning and association, empowers a trademark owner to become concerned, not just with unfair forms of business competition, but also to control the multivariate references that the brand might conjure up.⁷³ As David Barnes has explained, dilution actions are partly aimed at preventing congestion among trademarks, the idea being that noncompeting trademark uses of the same mark (say a KODAK bicycle) are partially rivalrous because two or more uses of the same mark, even on different goods, might detract or gradually whittle away the mark’s strength.⁷⁴

71. Swann et al., *supra* note 68, at 796.

72. See Lemley, *supra* note 60, at 1706. As Lemley suggests, especially of sports team merchandising, contemporary trademark law suggests that anyone using a DALLAS COWBOYS logo on a hat (even with a disclaimer that clearly states that the hat is not officially sponsored or affiliated merchandise) would be prohibited from doing so, even though the DALLAS COWBOYS logo isn’t being used as a source (suggesting that the Dallas Cowboys actually manufactured the hat), but instead as a reference to the team, and even in the absence of any consumer confusion. Lemley continues, discussing this example:

The haberdasher is not using the “Cowboys” logo as a trademark; she is simply reproducing it. Consumers are not confused, at least assuming she uses an appropriate disclaimer and makes no false reference to an “official licensed NFL product.” Nor can the trademark owner make a plausible case that this competing sale will weaken the connection between the mark and the team. . . . The point of trademark law has never been to maximize profits for trademark owners at the expense of competitors and consumers. And the investment at issue in these cases is not investment in the quality of the underlying product (the team), but in merchandising the brand itself.

Id. at 1708. See also Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960 (1993) (reaching similar conclusions).

73. See Clarisa Long, *Dilution*, 106 COLUM. L. REV. 1029, 1059 (2006); see also *Moseley v. Victoria’s Secret Catalogue, Inc.*, 537 U.S. 418 (2003) (describing dilution); Beebe, *supra* note 12, at 684–702.

74. See Barnes, *supra* note 34, at 25.

Trademark law's transformation, from a horizontal relationship between corporations, to a vertical one involving corporations and their effects on consumers, has ushered trademark law into largely uncharted jurisprudence. Through doctrines that extended the boundaries of trademark goodwill, for example, companies have essentially invented new forms of consumer confusion.⁷⁵ But in making this shift, trademark law revealed a deep logical flaw: As Robert Bone writes, “[i]t supposed that the law protected goodwill because goodwill had value, but in fact the reverse was true: goodwill had value only because the law protected it.”⁷⁶

As Bone suggests, the convergence between the proprietary role of a mark in commerce and its communicative connotations is a fragile one because it is so circular. The convergence is only successful to the extent that it is self-referential—referencing a mark's economic value to its social meaning. However, in the case of marks like AUNT JEMIMA and others that rely on racial stereotypes or caricatures, the social and expressive value of these marks can create externalities that overstep the marketplace of goods, and instead spill over into the marketplace of ideas. Each of these marks, in their own way, challenges the classic characterization of trademarks as private goods, and instead suggests that they function more like other public goods, demonstrating an underlying incompatibility between trademarks as a form of private property and their broader, communicative functions.⁷⁷

B. Public Goods and Moral Externalities

While the dominant economic theory gives us some understanding of why trademarks are valuable (from the perspective of the corporation and the consumer), it gives us little insight into the central difference between private goods (which are rivalrous and cannot be consumed by more than one person at a time) and the nature of trademarks themselves (which deal with the constant fluidity of symbols and imagery, and which are, by nature, nonrivalrous forms of expression).

There is, however, an underlying paradox that emanates from trademark law involving brands, like AUNT JEMIMA, that have multivariate meanings.

75. See Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 603–04 (2006); Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413 (2010).

76. Bone, *supra* note 75, at 587 (citing Felix S. Cohen, *Transcendental Nonsense and the Functional Approach*, 35 COLUM. L. REV. 809, 815 (1935)).

77. See generally Chad J. Doellinger, *A New Theory of Trademarks*, 111 PENN. ST. L. REV. 823 (2007) (critiquing the economic approach to trademark law).

The law might treat such trademarks just as any other private property in the marketplace of goods, but the mark still functions as a public good in the marketplace of ideas. The paradoxical nature of a trademark—that it is caught between a private property and a public good—captures, in part, why both the law and economic theory miss many of the doctrinal complexities that stem from the variety of functions that trademarks serve in the common language of the marketplace of ideas.

The operative intuition, as I suggested, behind trademark protection is that it serves a purely source-identifying function. In the case of marks like AUNT JEMIMA, the registration of a trademark implicitly suggests that the source-identifying function of a brand eclipses its expressive connotations. When a mark like AUNT JEMIMA acquires secondary meaning, for example, trademark protection enables the owner to substitute its own meaning for the historical significance of the term, both capitalizing on and facilitating a kind of historical amnesia that becomes necessary to sell the product.⁷⁸ In other words, the “brand” of AUNT JEMIMA as a source-identifier overtakes the historical stereotype of Aunt Jemima herself.

But the eclipse is only a partial one; it appears somewhat incomplete because the law also refuses to register scandalous, immoral, and disparaging marks. Even though both patent and copyright law have long since abandoned moral prerequisites,⁷⁹ uniquely, trademark law contains one of the few content-based classifications in our legal system, retaining a careful commitment to its

78. See generally Lauren Berlant, *National Brands/National Bodies: Imitation of Life*, in *COMPARATIVE AMERICAN IDENTITIES: RACE, SEX, AND NATIONALITY IN THE MODERN TEXT* (Hortense Spillers ed., 1991).

79. As one commentator points out, “[p]ornographic art, literature, and photography are protected by copyright without regard to their moral or aesthetic quality.” Kurt M. Saunders & Leonard J. Rymysza, *The Scarlet Letter of Trademark Law: The Bar to Registration of Immoral and Scandalous Trademarks*, 14 S. L.J. 17, 27 (2004). Scholars of intellectual property law have long recognized the substantial morass that is created when law attempts a sort of moral or aesthetic intervention along similar lines. See, e.g., Christine Haight Farley, *Judging Art*, 79 TUL. L. REV. 805 (2005); Arnold H. Loewy, *Distinguishing Government Suppression of Speech From Government Support of Speech*, 6 FIRST AMEND. L. REV. 171 (2007); Alfred C. Yen, *Copyright Opinions and Aesthetic Theory*, 71 S. CAL. L. REV. 247 (1998); see also *Belcher v. Tarbox*, 486 F.2d 1087 (9th Cir. 1973) (“There is nothing in the Copyright Act to suggest that the courts are to pass upon the truth or falsity, the soundness or unsoundness, of the views embodied in a copyrighted work. The gravity and immensity of the problems, theological, philosophical, economic, and scientific, that would confront a court if this view were adopted are staggering to contemplate.”). Likewise, many inventions that have moral or immoral implications are patented without mention of the potential externalities that they may cause. See Holbrook, *supra* note 1, at 573; Shubha Ghosh, *Race Specific Patents, Commercialization, and Intellectual Property Policy* 13 (SMU Dedman Sch. of Law Legal Studies Research Paper No. 00-13, 2007), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1008338.

own continued purification.⁸⁰ Ever since 1905, when Congress enacted the first Trade-Mark statute, morality concerns have been present in the touchstone statutory words of “immoral” and “scandalous.”⁸¹ In 1947, Congress extended the statute to also ban the registration of trademarks that may “disparage” or bring persons, institutions, beliefs, or national symbols into contempt or disrepute.⁸² Although both areas—immoral and scandalous marks on one hand, disparaging marks on the other—have some overlap, the range of scandalous marks has appeared to be considerably broader, covering areas of “racial, profane, vulgar, sexual, innuendo, and illegal matter.”⁸³ Every state, including the federal government, now regulates the registration of scandalous, immoral, or disparaging trademarks.⁸⁴ More recently, the Federal Circuit has emphasized that, to be scandalous, the mark (1) must be considered as applied to only the goods or services in the application, and not on its own; and (2) must be viewed as scandalous to a substantial composite of the general public, as viewed from the context of contemporary attitudes.⁸⁵ The amount does not have to be a majority: It only has to be a “substantial composite” of the general public.⁸⁶

In early cases, government officials voiced not just a concern over the expressive content of the marks themselves, but also the nature of the business

80. There is, of course, a considerable array of scholarship on this topic. See generally Jasmine Abdel-Khalik, *To Live in In-“Fame”-y: Reconceiving Scandalous Marks as Analogous to Famous Marks*, 25 CARDOZO ARTS & ENT. L.J. 173 (2007); Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 664 (1993); Theodore H. Davis, Jr., *Registration of Scandalous, Immoral, and Disparaging Matter Under Section 2(A) of the Lanham Act: Can One Man’s Vulgarity Be Another’s Registered Trademark?*, 54 OHIO ST. L.J. 331 (1993); Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(A) Trademark Law After Lawrence v. Texas*, 2 MARQ. INTEL. PROP. L. REV. 187 (2005); Jeffrey M. Samuels & Linda B. Samuels, *Court Opinions Affecting PTO Trademark Practice: The Year in Review*, 89 J. PAT. & TRADEMARK OFF. SOC’Y 177 (2007); Cameron Smith, Note, *Squeezing the Juice® out of the Washington Redskins®: Intellectual Property Rights in “Scandalous” and “Disparaging” Trademarks After Harjo v. Pro-Football Inc.*, 77 WASH. L. REV. 1295 (2002) [hereinafter Smith, *Squeezing the Juice*]; Regan Smith, Note, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 HARV. C.R.-C.L. L. REV. 451 (2007) [hereinafter Smith, *Trademark Law*].

81. See Baird, *supra* note 80, at 666 (citing DAPHNE ROBERT, *THE NEW TRADE-MARK MANUAL* 272 (1947)). The Trade-Mark Acts of 1881 and 1882 did not ban immoral subject matter, although there was some interest in banning “scandalous” registrations as of 1892. Other countries had also banned registration for such marks as well. For an excellent historical summary, see Abdel-Khalik, *supra* note 80, at 183–86.

82. Baird, *supra* note 80, at 667.

83. *Id.* at 669.

84. See John V. Tait, Note, *Trademark Regulations and the Commercial Speech Doctrine: Focusing on the Regulatory Objective to Classify Speech for First Amendment Analysis*, 67 FORDHAM L. REV. 897, nn.82 & 94 (1998) (listing citations).

85. See Saunders & Rymsza, *supra* note 79, at 20 (citing *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994)); see also *Schlage Lock Co. v. Staiano*, 2005 T.T.A.B. LEXIS 543 at *22–23 (T.T.A.B., Dec. 12, 2005) (quoting *In re Blvd. Entm’t, Inc.*, 334 F.3d 1336, 1339 (Fed. Cir. 2003)).

86. *Mavety Media Group*, 33 F.3d at 1371.

the marks were connected to, citing specific concerns with obscene publications, acts of vice, and other illegal activities. In 1856, for example, one government official noted, in his assessment of trademarks, “[i]t is unquestionably the duty of courts to regard with disfavor every establishment having any tendency to corrupt the public morals”⁸⁷ Since then, courts have concerned themselves, largely, with three sets of marks—(1) marks that dealt with political or religious figures; (2) marks that touch on sexuality; and (3) forms of perceived vulgarity or illegality—often blending these content-based classifications.⁸⁸

Of course, defining scandalous or immoral is a notoriously subjective endeavor. As one commentator has argued, the definition often varies according to the identity, time, and place of the person that is asked.⁸⁹ Given the absence of legislative history defining the term, courts have turned to the mark’s “ordinary and common meaning,” but with little clarity.⁹⁰ The concern, it seems, involves “moral externalities” that might flow from subsidizing expressive behavior that the government considers undesirable, unwholesome, or—to put it more directly—scandalous.⁹¹ As a result, courts have regulated a wide range of subject matter that falls within these parameters, including marks that are indecent, vulgar, or obscene.⁹² Yet from almost any angle, the definition of scandalous matter is confusingly subjective—it has been defined as “vulgar,” “lacking in taste, indelicate, morally crude” as measured by contemporary public attitudes.⁹³ One of the more determinative legal standards has only offered this observation: “[T]he threshold for objectionable matter is lower for what can be

87. See Abdel-Khalik, *supra* note 80, at 187 (quoting *Christy v. Murphy*, 12 How. Pr. 77 (N.Y. Sup. Ct. 1856)). Early cases, for example, evinced a concern with the enforcement of marks related to “quack medicine.” See, e.g., *Comstock v. White*, 10 Abb. Pr. 264 (N.Y. Sup. Ct. 1860).

88. See Abdel-Khalik, *supra* note 80, at 200.

89. Baird, *supra* note 80, at 664–65.

90. See, e.g., *In re Riverbank*, 95 F.2d 327, 328 (C.C.P.A. 1938) (struggling with the common meaning—and thus propriety—of the term “Madonna”).

91. See, e.g., Martin Zelder, *Incompletely Reasoned Sex: A Review of Posner’s Somewhat Misleading Guide to the Economic Analysis of Sex and Family Law*, 91 MICH. L. REV. 1584, 1604 (1993) (reviewing RICHARD A. POSNER, *SEX AND REASON* (1992)) (defining “moral externalities”). For a great discussion of the concept of moral harm, see Andrew Koppelman, *Does Obscenity Cause Moral Harm?*, 105 COLUM. L. REV. 1635 (2005).

92. See, e.g., *In re Riverbank*, 95 F.2d 327.

93. Saunders & Rymza, *supra* note 79, at 26 (citing *In re Runsdorf*, 171 U.S.P.Q. 443, 444 (T.T.A.B. 1971)); see also *In re Riverbank*, 95 F.2d at 328 (defining scandalous as “shocking to the sense of truth, decency, or propriety; disgraceful, offensive; disreputable; . . . [g]iving offense to the conscience or moral feelings; . . . calling out condemnation”) (citations omitted); *In re Tinseltown*, 212 U.S.P.Q. 863, 864 (T.T.A.B. 1981) (defining scandalous as “profane”); *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. 176, 178 (T.T.A.B. 1978) (quoting WEBSTER’S NEW COLLEGIATE DICTIONARY (2d ed. 1949)) (defining scandalous as “that which offends established moral conception or disgraces all who are associated or involved” and to scandalize as “to horrify or shock the moral sense”).

described as ‘scandalous’ [under section 2(a)] than for what is considered ‘obscene.’”⁹⁴

In one of the earliest cases to address the definition of scandalous, a court, in 1938, defined it as “shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . [g]iving offense to the conscience or moral feelings . . . calling out condemnation”⁹⁵ In that case, the U.S. Court of Customs and Patent Appeals upheld a refusal to register the trademark MADONNA for a wine label, stating that it was obvious that “[e]veryone would concede that an application to register the name of the Supreme Being, as a trade mark would be properly rejected”⁹⁶ Even though the court observed that the meaning of the term MADONNA could also denote an Italian term for madame, it noted that that the nation had only recently decriminalized drinking, and that folks might associate drinking with the Virgin Mary (“it is a matter of common knowledge,” the court wrote, “that the United States is not a wine drinking country”), concluding that the mark was scandalous.⁹⁷

Another early case involved the refusal to register the term QUEEN MARY for a line of underwear for women, holding that the mark was “shocking to the sense of propriety” due to its association of the Queen of England with an intimate female garment.⁹⁸ This definition—“shocking to the sense of propriety”—however vague, remained the guiding standard until 1978, when the Trademark Trial and Appeal Board (TTAB) defined scandalous as “that which offends established moral conception or disgraces all who are associated or involved” and to scandalize as “to horrify or shock the moral sense.”⁹⁹

Though the statute suggests that immoral marks are distinct from scandalous marks, courts often conflate the two and permit morality considerations to creep into their analysis.¹⁰⁰ Courts repeatedly emphasize the importance of

94. *In re McGinley*, 660 F.2d 481, 485 n.9 (C.C.P.A. 1981).

95. *In re Riverbank*, 95 F.2d at 328.

96. *Id.*

97. *Id.* at 329.

98. *Ex Parte Martha Maid Mfg. Co.*, 37 U.S.P.Q. 156 (C.C.P.A. 1938).

99. See M. Christopher Bolen et al., *When Scandal Becomes Vogue: The Registrability of Sexual References in Trademarks and Protection of Trademarks From Tamishment in Sexual Contexts*, 39 IDEA 435, 437 (1999) (citing *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. 176, 178 (T.T.A.B. 1978)); see also *In re Runsdorf*, 171 U.S.P.Q. 443, 443–44 (T.T.A.B. 1971); *In re P.J. Valckenberg*, 122 U.S.P.Q. 334, 334 (T.T.A.B. 1959); *Parfum L’Orle, Inc.*, 93 U.S.P.Q. 481 (Patent & Trademark Office 1952).

100. Early on, for example, courts rejected terms that referred to revered religious and political figures in the context of products that raised moral considerations. See Justin G. Blankenship, Casenote, *The Cancellation of Redskins as a Disparaging Trademark: Is Federal Trademark Law an Appropriate Solution for Words That Offend?*, 72 U. COLO. L. REV. 415, 431–32 (2001) (citing *In re Reemtsma Cigarettenfabriken G.m.b.H.*, 122 U.S.P.Q. 339 (T.T.A.B. 1959)) (finding mark “SENUSSI” was scandalous because it was sought for placement on cigarettes, when the term referred to a Muslim sect that forbids its members from using tobacco). Compare *In re Reemtsma Cigarettenfabriken*, 122 U.S.P.Q.

considering “the moral values and conduct fashionable at the moment, rather than that of past decades.”¹⁰¹ Yet as courts began to consider marks with sexual connotations, the subjectivity of the governing standard began to unravel into significant inconsistency. Some marks that were initially deemed problematic due to sexual connotations later survived. For example, a trademark examiner rejected the term LIBIDO for perfume, on the grounds that it indicated sexual desire and was therefore immoral.¹⁰² That decision was overturned. In another case, however, a court allowed a mark for WEEK-END SEX on a magazine, finding it was not scandalous.¹⁰³ Yet in a third case, the Trademark Board refused to register the term “BUBBY TRAP” for brassiers, finding that it would be offensive to the public sense of propriety or morality.¹⁰⁴

Throughout case law, each approach has led to layers of difficulty: What does the mark actually mean? How much should context matter? Is there a difference between a general and specialized audience? In each layer, courts struggle to discern the difference between the private property of the mark and its significance as an expression with multivariate meanings. Throughout, the PTO has asserted that it studiously avoids assuming that it knows the views of a substantial composite of the public; instead, it prefers for marks to be published, and then for interested members of the public to file for cancellation or opposition of a mark afterward.¹⁰⁵

One general rule of thumb suggests that the more graphic or directly profane the depiction, the less likely it is that a mark will receive registration.¹⁰⁶

339, with *In re Waughtel*, 138 U.S.P.Q. 594 (T.T.A.B. 1963) (permitting the registration of cigars marked AMISH on account of the high percentage of Amish men who smoked).

101. *In re Madsen*, 180 U.S.P.Q. 334, 335 (T.T.A.B. 1973); see also *In re Thomas Labs., Inc.*, 189 U.S.P.Q. 50 (T.T.A.B. 1975) (approving a cartoon of a naked man staring at his own crotch in dismay as a visual mark for a penis lengthener, on the ground that the image was “[no] threat to present-day public morals”).

102. See *Parfum L’Orle*, 93 U.S.P.Q. 481 (reversing the trademark examiner’s decision).

103. *In re Madsen*, 180 U.S.P.Q. at 334.

104. *In re Runsdorf*, 171 U.S.P.Q. 443, 443 (T.T.A.B. 1971).

105. See *Ritchey v. Simpson*, 170 F.3d 1092, 1094 (Fed. Cir. 1999). The standard to establish standing for filing a cancellation claim is quite low. In one case, for example, a man who described himself as a “family man” who believed that the “sanctity of marriage requires a husband and wife who love and nurture one another” was permitted to argue for cancellation of marks relating to the alleged wife abuser O.J. Simpson on the grounds that the marks denigrated marriage and encouraged spousal abuse. *Id.* at 1097. In another case, two women successfully filed cancellation claims against one restaurant’s slogan that said, “only a breast in the mouth is better than a leg in the hand.” The women argued that the mark was “lewd, lascivious, indecent, obscene, worthless, depraved, chauvinistic, and degrading,” and that it disparaged women—in general—as a class. *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. 176 (T.T.A.B. 1978).

106. As a general rule, the clearer the vulgarity, the less likely the trademark will be protected. See *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981) (denying a photo of a nude man and woman embracing with male genitals showing); *In re Wilcher Corp.*, 40 U.S.P.Q.2d 1929, 1932–33 (T.T.A.B. 1996)

However, in the last two decades, the case law has revealed a substantial schism over whether courts should analyze the content of a mark by studying its contents alone, or whether to analyze it in conjunction with the surrounding context, including the specific goods related to the mark.¹⁰⁷ A case from the early 1980s, *In re McGinley*,¹⁰⁸ found that a photograph of a naked male and female was scandalous because it revealed the man's genitalia.¹⁰⁹ The court focused on whether or not the mark was scandalous on its face, irrespective of the goods upon which the mark is placed.¹¹⁰ This approach later became known as the *per se* test, because it focuses only on the offensive material itself, rather than on its surrounding context.¹¹¹

In contrast, another approach, known as the rule of association, declares that the scandalousness of a mark must be determined, not just by looking to the precise contours of the mark, but also by attending to the surrounding context by looking at its placement on the goods, services, and even time period in question.¹¹² Consider the case of a condom brand's logo, featuring an image of a condom that was designed to resemble a United States flag.¹¹³ In that case, the court was moved to observe, "[w]hat was considered scandalous as a trademark or service mark twenty, thirty, or fifty years ago may no longer be considered so, given the changes in societal attitudes. Marks once thought scandalous may now be thought merely humorous (or even quaint)"¹¹⁴

(rejecting a graphic caricature of DICK HEADS logo on the grounds of its "vulgar, anatomical significance").

107. See Blankenship, *supra* note 100, at 431–33.

108. 660 F.2d 481.

109. *Id.* at 481.

110. See *id.*; Blankenship, *supra* note 100, at 432–33.

111. See *In re Tinseltown, Inc.*, 212 U.S.P.Q. 863 (T.T.A.B. 1981) (finding mark BULLSHIT to be scandalous, despite its appearance on a series of fashion accessories); *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d 1635, 1639 (T.T.A.B. 1988) (finding an image of a defecating dog to be unregistrable); *Abdel-Khalik*, *supra* note 80, at 216–17 (noting that the *per se* test was used to bar registration for marks REALLY GOOD SHIT and THE BEARDED CLAM). *But see In re Thomas Labs., Inc.*, 189 U.S.P.Q. 50 (T.T.A.B. 1975) (allowing registration of a cartoon of a naked male staring down at his genitals).

112. Blankenship, *supra* note 100, at 431–32. For other examples of the rule of association approach, see *In re Runsdorf*, 171 U.S.P.Q. 443 (T.T.A.B. 1971) (refusing registration of mark BUBBY TRAP on grounds of association between the mark and the goods, brassieres); *Doughboy Indus., Inc. v. Reese Chem. Co.*, 88 U.S.P.Q. 227, 228 (T.T.A.B. 1951) (observing that a trademark "does not exist apart from the goods in connection with which it is used"). Determining scandal by context is quite tricky. See Ethan G. Zlotchew, "Scandalous" or "Disparaging"? *It Should Make a Difference in Opposition and Cancellations Actions: Views on the Lanham Act's Section 2(a) Prohibitions Using the Example of Native American Symbolism in Athletics*, 22 COLUM.-VLA J.L. & ARTS 217 (1998).

113. *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216 (T.T.A.B. 1993); Blankenship, *supra* note 100, at 432–33. The flag design was not applied to the condoms themselves. *In re Old Glory*, 26 U.S.P.Q.2d at 1217.

114. *In re Old Glory*, 26 U.S.P.Q.2d at 1219.

The Federal Circuit has adopted the rule of association approach, but its focus on context alone, as opposed to the singular meaning of the mark, results in a plethora of inconsistency,¹¹⁵ subjectivity, and vagueness.¹¹⁶ While courts insist that their duty is to only consider the marks themselves, and not pass judgment on the corresponding goods, it is often difficult for the courts to separate the two. Perhaps most directly, the issue of context becomes even more complicated when courts face the role of a specialized audience of a particular mark. In such cases, the specific meaning of a mark within a specialized audience may conflict with the general meaning associated with a mark. This generally occurs in two situations: (1) where an audience is less likely to be offended by a mark's connotations due to the nature of a particular business or transaction in question, or (2) when a mark carries a different and less scandalous meaning given the specialized community within which it is used.

Consider two examples. First, in a 2003 case in the Federal Circuit, the Trademark Office refused to register trademarks entitled "1-800-JACK-OFF" and "JACK OFF" for adult-oriented entertainment and telephone services.¹¹⁷ When faced with a variety of evidentiary sources from academics, business persons, and sexually oriented advertising that suggested that the term was not offensive to those seeking such services, the court rejected the evidence on the grounds that the views of a specialized audience did not demonstrate that the public at large would not consider the work to be vulgar.¹¹⁸ (Note, however, that the PTO has incomprehensibly allowed a mark entitled JACK OFF JILL to be registered for a musical).¹¹⁹

A second, and related, specialized audience issue involves the context of marks that have been referred to as self-disparaging, or marks that are used by members of a particular community to self-identify with a particular epithet or

115. See Saunders & Rymza, *supra* note 79, at 20 (citing *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994)).

116. Baird, *supra* note 80, at 670 (noting the Trademark Trial and Appeal Board has decided recently "to resolve doubts on the issue of whether a mark is scandalous or disparaging in favor of applicant and pass the mark for publication with the knowledge that if a group does find the mark to be scandalous or disparaging, an opposition proceeding can be brought and a more complete record can be established"). Consider a case involving the magazine BLACK TAIL, where the court found that use of the mark for a magazine that featured nude photos of African American women was not immoral or scandalous because the PTO had failed to prove that a substantial composite of the population would view the word "tail" as a vulgar term for a female sexual partner, rather than its nonvulgar meaning as an alternative term for rear end. The court noted that the "extreme changes in social mores over time" help to shed light on the inconsistency of its decisions. *In re Mavety Media*, 33 F.3d at 1371.

117. *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1341 (Fed. Cir. 2003) (relying on various dictionary determinations to show it was an offensive, scandalous, and vulgar reference).

118. *Id.* at 1341-42. See also Saunders & Rymza, *supra* note 79, at 23 (discussing *Boulevard*).

119. See *In re Boulevard*, 334 F.3d at 1343; Lilit Voskanyan, Comment, *The Trademark Principal Register as a Nonpublic Forum*, 75 U. CHI. L. REV. 1295, 1300 (2008) (citing *In re Boulevard*).

slur and thus excise the term from its disparaging context.¹²⁰ Here, too, the issue involves a specific context, rather than a general one. However, the fluidity of language often makes it difficult for a court to discern whether a term offends a target audience, particularly in light of the fact that many communities regain use of offensive language to reclaim, and thus excise, its derogatory power, thus blending the appreciable lines between meanings that are scandalous, disparaging, or liberatory.¹²¹ In some cases, while the general public might find a mark to be distasteful or disparaging, the specific context under which it is used might ameliorate some of these risks. The law, therefore, must navigate the difficulty between a general audience and a specific one, and the different interpretations of each.

In July 31, 2003, a contingent of lesbian motorcycle riders applied to register the mark DYKES ON BIKES for education and entertainment services. Initially, the PTO refused registration of the mark on the basis that the word dyke was disparaging to lesbians. The examiner stated:

Registration is refused because the proposed mark consists of or comprises matter which may disparage or bring into contempt or disrepute to the lesbian, bisexual and transgender communities. Consumers reasonably would understand that the term DYKES in the proposed mark refers to the disparaged party. A reasonable person of ordinary sensibilities would consider this reference offensive or objectionable because the term has been used as a derogatory or offensive term for lesbians.¹²²

Note, here, that the test viewed the mark from the perspective of the “reasonable person” as opposed to the targeted group.¹²³ This state of affairs, however, leads to unsettling inconsistencies when a specialized audience is present, particularly one that, as Todd Anten suggests, seeks to recode and thus reclaim the meaning of a particular term. Consider, for example, that the PTO has denied marks with the term DYKE, yet permitted some marks that include QUEER in the title (with one or two exceptions).¹²⁴ It has refused registration

120. See generally Anten, *supra* note 8.

121. As Todd Anten has explained, the reappropriation of terms like queer, fag, dyke, and a variety of ethnic and racial slurs demonstrate that some disparaged groups aim to “disarm the power of epithets by actively transforming slurs into sources of pride,” removing their harmful power through selective reappropriation of the term. See *id.* at 392.

122. San Francisco Women’s Motorcycle Contingent, Application No. 78/281746, Office Action Outgoing (P.T.O. Feb. 20, 2004).

123. This later changed after *Harjo* to view marks only from the perspective of the affected public.

124. Anten offers several examples of marks using the term dyke that were denied by the PTO. See Anten, *supra* note 8, at 391 (listing PTO denials for DYKESINTHECITY, DYKEDOLLS, VELVETPARK DYKE CULTURE IN BLOOM, DYKE TV, and DYKE DISH). However, the PTO allowed the registration of marks like QUEER DUCK and QUEER GEAR, yet, inexplicably, denied registration for terms like CLEARLY QUEER

for F*A*G* for the term FABULOUS AND GAY but allowed a trademark for QUEER EYE FOR THE STRAIGHT GUY and TECHNODYKE during the same period.¹²⁵ How can these outcomes be reconciled with one another?

Perhaps precisely because of the wide degree of variance that the PTO has demonstrated regarding marks affecting the LGBT community, the *Dykes on Bikes* case prompted a visible public outcry. The San Francisco Board of Supervisors even adopted a municipal resolution to convince the PTO to reverse its decision.¹²⁶ Eventually, the PTO reconsidered the case, reaching a different outcome after reviewing evidence showing that the term was no longer considered to be disparaging.¹²⁷ Central to the PTO's findings, most likely, were the hundreds of pages of academic and popular evidence that had been submitted to show the changing receipt and use of the term. One scholar, Carolyn Dever, an associate professor of English and Women's and Gender Studies at Vanderbilt University, argued:

“Dyke” has been claimed by lesbians as a term of pride and empowerment, as a sign of the refusal to be shamed or stigmatized by lesbian sexuality and social identity and as a symbol of unity within lesbian communities past, present and future.¹²⁸

Yet even after the mark was issued, a man emerged to argue that the term was offensive—not that it was disparaging to lesbians (as the PTO had once concluded), but rather, that the term DYKE was disparaging to him, personally, as a male.¹²⁹ The man lost on the grounds that he had failed to show a “reasonable” basis for his belief that he might be damaged by the mark's registration.¹³⁰

C. Racial Branding and Cultural Externalities

As the *Dykes on Bikes* case demonstrates, the law draws a distinction between the generalized harm that is presumably posed to the public by immoral or scandalous marks, and the specific harm that is addressed by disparaging marks towards a targeted group. This difference has meant that in the context of

(on the grounds that the term queer was derogatory to gays and lesbians). See *id.* (citing Gibbons, *supra* note 81, at 223–24).

125. Xenii Jardin, *USPTO Nixes Trademark App for “Dykes on Bikes,”* BOINGBOING, July 14, 2005, <http://www.boingboing.net/2005/07/14/uspto-nixes-trademar.html>. See Anten, *supra* note 8 (giving various examples).

126. Julian Guthrie, *Trademark Office OKs ‘Dykes on Bikes:’ Motorcycle Group’s Name on Its Way to Becoming Registered*, S.F. CHRON., Dec. 9, 2005, at A2.

127. See Anten, *supra* note 8, at 420.

128. Guthrie, *supra* note 126, at A2.

129. *McDermott v. San Francisco Women’s Motorcycle Contingent*, 81 U.S.P.Q.2d 1212, 1213 (T.T.A.B. 2006).

130. *Id.* at 1216.

immoral or scandalous marks, the Lanham Act is concerned with the moral externalities within the *general* views of the public; whereas, in the context of disparaging marks, the law has developed a test that, more recently, focuses only on the perspective of the *targeted* group instead.

This disjunction between the general and specific audience has led to a host of inconsistencies. Like the provisions regarding scandalous and immoral marks, the legislative history of the disparaging prong is sparse and fairly unenlightening as to Congress's original purpose. The legislative history of section 2(a) suggests that the law was curiously intended to preclude registration of marks that conflicted with another's right of privacy.¹³¹ Disparagement has been described as "the right to be 'let alone' from contempt or ridicule . . . the publication of a statement which the publisher intends to be understood, or which the recipient should understand, as tending 'to cast doubt upon the quality of another's land, chattels, or intangible things.'"¹³² It is important to note, however, among other differences, that while section 2(a) precludes the registration of matter that "is scandalous," it also precludes registration of matter that "*may be*" disparaging, suggesting a broader category for the latter.¹³³

The case law and legislative history surrounding disparagement are similarly unclear, sometimes due to a blurred line, as we saw in the *Dykes on Bikes* case, between what is scandalous and what is disparaging.¹³⁴ The provisions that cancelled disparaging marks, it seems, were enacted out of an earlier belief that "group libel" was an actionable harm, a suggestion that the Supreme Court defended in the 1952 case of *Beauharnais v. Illinois*.¹³⁵ There, the Court upheld an Illinois statute that declared it unlawful for any person to distribute publications that attributed "depravity, criminality, unchastity, or lack of virtue" to a class of citizens based on race, color, creed, or religion.¹³⁶ Later decisions, however, have

131. See *Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imps. Co. Inc.*, 703 F.2d 1372, 1376 (Fed. Cir. 1983) ("Although not articulated as such, it appears that the drafters sought by § 2(a) to embrace concepts of the right to privacy, an area of the law then in an embryonic state.").

132. See Robert H. Wright, *Today's Scandal Can Be Tomorrow's Vogue: Why Section 2(A) of the Lanham Act is Unconstitutionally Void for Vagueness*, 48 HOW. L.J. 659 (2005).

133. *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d 1705, 1738 (T.T.A.B. 1999) (emphasis in original).

134. See Blankenship, *supra* note 100, at 435 (citing Zlotchew, *supra* note 112, at 230); see also J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:77:25 (4th ed. 2009). In the context of marks directed towards the LGBT community, the PTO has, at times, used the terms scandalous and disparaging interchangeably. Anten, *supra* note 8, at 409–10; Zlotchew, *supra* note 112, at 230.

135. 343 U.S. 250 (1952).

136. *Id.* at 271 (Black, J., dissenting) ("The court condones this expansive state censorship by painstakingly analogizing it to the law of criminal libel. As a result of this refined analysis, the Illinois statute emerges labeled a 'group libel law.'). The Illinois statute at issue in *Beauharnais* was 38 ILL. REV. STAT. § 471 (1949). "Central to Justice Frankfurter's analysis was the conclusion that 'group libel,' as defined in the Illinois statute, is not 'within the area of constitutionally protected speech' and thus need

suggested that libelous statements should be afforded “low” First Amendment value only when they constitute false statements of fact, casting some doubt on *Beauharnais*.¹³⁷

Yet aside from measuring economic harm, trademark law has no way to measure the role of expressive harms to third parties. It may be said that stereotypical trademarks perpetuate a variant of what Lior Strahilivetz has called “misperception externalities”—unflattering stereotypes about a particular group.¹³⁸ Here, the social costs may take the form of emotional harm, reputational damage, or misinformation about a certain group or person. Early cases had considered the definition of disparagement of a commercial entity through the eyes of a reasonable person, ostensibly drawn from the general public.¹³⁹ More recently, however, courts have begun to focus more intensely on the point of view of the targeted group, noting that “only the perceptions of those referred to, identified, or implicated in some recognizable manner by the involved mark are relevant.”¹⁴⁰

While there are a few cases discussing disparagement in the context of section 2(a), the most prominent of these stems from a period in American advertising that relied heavily on the use of Native American images as trademarks in the commercial marketplace, particularly as team mascots.¹⁴¹ In the early 1930s, an American professional football team, the Boston Redskins,

not be tested by the clear and present danger standard. In justifying this conclusion, Justice Frankfurter relied primarily on *Chaplinsky's* characterization of ‘libelous’ utterances as ‘unprotected’ speech.” GEOFFREY R. STONE ET AL., *THE FIRST AMENDMENT* 250 (1999) (citing *Chaplinsky v. New Hampshire*, 315 U.S. 568 (1942)).

137. See *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964) (“[L]ibel can claim no talismanic immunity from constitutional limitations.”); *Phila. Newspapers, Inc. v. Hepps*, 475 U.S. 767 (1986) (same); *Hustler Magazine v. Falwell*, 485 U.S. 46 (1988) (same); *Collin v. Smith*, 578 F.2d 1197, 1204 (7th Cir. 1978) (expressing doubt as to whether *Beauharnais* is still good law); STONE, *supra* note 136, at 250 (citing *Milkovich v. Loraine Journal Co.*, 497 U.S. 1 (1990) (holding that only false statements of fact deserve a lower constitutional status)).

138. Lior Jacob Strahilivetz, *Information Asymmetries and the Rights to Exclude*, 104 MICH. L. REV. 185, 185–86 (2006).

139. See Jack Achiezer Guggenheim, *Renaming the Redskins (and the Florida State Seminoles?): The Trademark Registration Decision and Alternative Remedies*, 27 FLA. ST. U.L. REV. 287, 297 (1999) (citing *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1739–40 (T.T.A.B. 1999); *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d 1635 (T.T.A.B. 1988)).

140. *In re Hines*, 31 U.S.P.Q.2d 1685, 1688 (T.T.A.B. 1994).

141. For more information on how the commercial marketplace has appropriated Native American images and culture, see ROBERT F. BERKHOFFER, JR., *THE WHITE MAN’S INDIAN: IMAGES OF THE AMERICAN INDIAN FROM COLUMBUS TO THE PRESENT* (1978); PHILIP DELORIA, *PLAYING INDIAN* (1999); *DRESSING IN FEATHERS: THE CONSTRUCTION OF THE INDIAN IN AMERICAN POPULAR CULTURE* (S. Elizabeth Bird ed., 1996); *SELLING THE INDIAN: COMMERCIALIZING & APPROPRIATING AMERICAN INDIAN CULTURES* (Carter Jones Meyer & Diana Royer eds., 2001); and Angela R. Riley, “*Straight Stealing*”: *Towards an Indigenous System of Cultural Property Protection*, 80 WASH. L. REV. 69, 80 (2005).

came into being.¹⁴² The historical origin of the term redskins is associated with the killing of Native Americans by settlers for bounty.¹⁴³ According to the team's history, the name was chosen to honor the coach of the team, William Lone Star Dietz, who was a half-German Sioux.¹⁴⁴ Four years after the team was established, it moved to the District of Columbia and became the WASHINGTON REDSKINS.¹⁴⁵ Suzan Harjo recounts how the team's fight song, *Hail to the Redskins*, exhorted their "braves on the warpath" to "scalp 'em," and their "warriors" to "fight for old DC."¹⁴⁶

Many decades later, in August, 2006, a small group of Native American youths filed a petition under section 2(a) for the cancellation of the trademark WASHINGTON REDSKINS.¹⁴⁷ Although all of them came from a variety of different tribes, geographies, and walks of life, they came together for a simple and pressing reason: to argue that the term redskin "was and is a pejorative, derogatory, denigrating, offensive, scandalous, contemptuous, disreputable, disparaging, and racist denigration for a Native American person."¹⁴⁸ Their petition was the latest in a now eighteen-year-old legal journey that stood alone in challenging trademark law's governance of the triangulated areas of legal history, intellectual property, and constitutional protection for freedom of expression.¹⁴⁹ In 1992, the same petition had been filed (by a different group of plaintiffs) to cancel the term on the grounds of disparagement.¹⁵⁰

142. For an excellent history of the case, see Suzan Shawn Harjo, *Fighting Name-Calling: Challenging "Redskins" in Court*, in *TEAM SPIRITS: THE NATIVE AMERICANS MASCOTS CONTROVERSY* 189 (C. Richard King & Charles Fruehling Springwood eds., 2001).

143. Rather than transporting the bodies of their Native American victims, the killers would instead simply scalp the heads of Native Americans, and thus the term redskins slowly emerged into being. *Id.* at 190–91.

144. Justin G. Blankenship, *The Cancellation of Redskins as a Disparaging Trademark: Is Federal Trademark Law an Appropriate Solution for Words That Offend?*, 72 U. COLO. L. REV. 415, 427 (2001).

145. Harjo, *supra* note 142, at 191.

146. *Id.* at 191.

147. Petition for Cancellation, *Blackhorse et al. v. Pro-Football, Inc.*, Pending Proceeding No. 92046185 (T.T.A.B. Aug. 11, 2006).

148. *Id.* ¶ 1.

149. In January, 1972, a coalition of Native American leaders wrote to the team owners' attorney, requesting him to "imagine a hypothetical National Football League, in which the other teams are known as the New York Kikes, the Chicago Polocks, the San Francisco Dagoes, the Detroit Niggers, the Los Angeles Spics, etc." See Harjo, *supra* note 142, at 193.

150. Since that filing in 1992, a slow chorus has emerged against the use of Native American mascots from federal, private, and municipal entities, culminating in the decision by the National Collegiate Athletic Association in 2005 to ban the use of racially hostile mascots at its tournaments. See Brief of the Social Justice Advocacy Group as Amici Curiae in Support of Petitioners, *Harjo v. Pro-Football, Inc.*, (No. 09-326), available at http://www.narf.org/sct/harjovpro-football/amicus_social_justice.pdf at 15. It is also interesting and instructive to note that other countries, specifically Canada, Australia, and New Zealand, have also struggled with the use of indigenous marks, reaching divergent conclusions. New Zealand has probably the strongest standard for indigenous marks, instituting an

In 1999, the original group won before the Trademark Board, which cancelled the mark on the grounds that the trademarks “may be disparaging of Native Americans” and “may bring Native Americans into contempt or disrepute.”¹⁵¹ In its opinion, the court cited the testimony of one expert who had argued that the term remains disparaging as “an artifact of an earlier period during which the public at large was taught to believe that American Indians were a backward and uncivilized people” and also cited a variety of dictionary definitions that noted the offensive or disparaging nature of the term.

Despite this history, the evidence also suggested an interesting wrinkle: Since the mid-1960s to the present, the term *redskin(s)* had largely disappeared from language, except to the extent that it was used to refer to the football team.¹⁵² Yet while the Trademark Trial and Appeal Board (TTAB) took the absence of the term after 1960 to be relevant to a finding of disparagement, the court on review criticized the TTAB’s finding, arguing that there was “no evidence” to support this conclusion.¹⁵³ Instead, for the district court, the absence of the term suggested something else: that the strong secondary meaning of the mark had largely eclipsed its previous connotations, permanently altering the meaning of the mark.¹⁵⁴ It thus only considered the time period during which the trademarks issued—roughly 1967 to 1990—and nothing more,¹⁵⁵ dismissing the views of the petitioners as only “a reflection of their individual viewpoints.”¹⁵⁶ Based largely on these divergent perceptions, the case was reversed on the grounds that the finding of disparagement was unsupported by substantial evidence.¹⁵⁷

advisory committee that studies whether a proposed mark might be derivative of a Maori sign, or otherwise offensive to the Maori people, and prohibiting their registration. See Peter J. Chalk & Alexander Dunlop, *Indigenous Trade Marks and Human Rights: An Australian and New Zealand Perspective*, 99 TRADEMARK REP. 956, 970–71 (2009).

151. *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1748 (T.T.A.B. 1999).

152. *Id.* at 1731, available at 1999 WL 375907 at *28. The evidence also suggested a change in the late 1950s and early 1960s, when the game programs switched from “caricature-like portrayals of Native Americans” to “realistic portraits of actual Native American individuals.” *Id.* at 1746, available at 1999 WL 375907 *45.

153. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 132 (D.D.C. 2003).

154. *Id.* at 132 n.31.

155. The court, for example, dismissed dictionary terms that mentioned that the term *redskins* was thought to be offensive on the grounds that it was “mere speculation” without an accompanying discussion of the purpose and methodology of usage labels. *Id.* at 130.

156. *Id.* at 135. The court also reached the same conclusion regarding contemporary resolutions against the use of the term passed by the National Congress of American Indians (NCAI) because they were not passed within the relevant time frame. *Id.*

157. See *id.* at 125–26 (“The Court concludes that the TTAB’s finding that the marks at issue ‘may disparage’ Native Americans is unsupported by substantial evidence, is logically flawed, and fails to apply the correct legal standard to its own findings of fact.”).

The difference between the two opinions was striking. Perhaps the most notable of the findings was the district court's adoption of an associational approach that focused on the context of the mark in relation to the goods and services of the team, instead of the *per se* meaning of the term itself in common parlance. The TTAB had performed an exhaustive historical review, and had found that the term *redskins* had remained a pejorative term to denote Native Americans throughout this century, from the 1960s to the present.¹⁵⁸ Yet the district court on appeal analyzed the mark in relation to the goods and services alone, in a test described later as the "*Harjo* test":¹⁵⁹

[O]ur analysis is essentially a two-step process in which we ask, first: What is the meaning of the matter in question, as it appears in the marks and as those marks are used in connection with the services identified in the registrations? Second, we ask: Is this meaning one that may disparage Native Americans? As previously stated, both questions are to be answered *as of the dates of registration of the marks herein*.¹⁶⁰

Although the district court agreed with the finding that the term *redskins* could refer to both the football team as well as to Native Americans during the relevant time period between 1967 and 1990, it still chose to overturn the TTAB's finding of disparagement because the pejorative use of the term had largely disappeared from common parlance.¹⁶¹ Central, also, to its conclusion was the district court's critique of a survey that had been performed among Native Americans that concluded that 36 percent had found the term *redskins* to be disparaging, as compared to 42 percent of the general public. The court found the survey to be unconvincing as a measure of a "substantial composite" of the view of the Native American population. Consider the colloquy that the court reproduced:

THE COURT: . . . I'm trying to figure out where you came from 36 percent out of the survey to 700 and 800,000. . . . [W]hat I'm saying is, aren't you—you're extrapolating that if 36 percent of the group of the survey felt this way, you then applied 36 percent to the whole population that are Native Americans. Is that accurate?

[EXPERT]: Yes.

THE COURT: And making an assumption, aren't you, then, that that is representative of what all the rest of them would feel?¹⁶²

158. *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d 1705, 1731–32, 1743–48 (T.T.A.B. 1999), available at 1999 WL 375907, at *28–29, *42–48.

159. *Pro-Football*, 284 F. Supp. 2d at 124.

160. *Id.* at 125.

161. *Id.* at 131–32.

162. *Id.* at 121.

Although recognizing that the survey was not perfect, the TTAB still recognized its conclusions as evidence of potential disparagement. In contrast, the district court dismissed the expert's findings as "plain arithmetic," disregarding the study because it failed to "test the participants' view of the term 'redskin(s)' in the context of Pro-Football's services" during the time period of 1967–1990, and refused to allow any extrapolation from the surveys performed.¹⁶³

In doing so, however, the district court's perspective may have obscured the statutory language. The petitioners, as the TTAB had recognized, only had to show that the term *may be* disparaging, not that the term actually was disparaging. Given the disagreement between the two perspectives—the historical term as a racial insult, and the current reference to the team—the TTAB had decided that it was unable to conclude—in a confusing use of double negatives—that the word *redskins* was "not considered offensive during the relevant time period."¹⁶⁴ In other words, it adopted a more flexible statutory standard that found that the absence of the term in common language suggested a possibility that the mark "may be" disparaging (which explains, in part, why it disappeared).

In contrast, the district court did just the opposite. Given its choice to only consider the mark in the context of the team and during a specific time period, the court did not consider the historical significance of the term in common language, focusing only on whether the trademark "may disparage Native Americans when used *in connection with* Pro-Football's services and during the relevant time frame."¹⁶⁵ It refused to consider the historical import of the term, deeming the voluminous writings, cartoons, and references to Native Americans as *redskins* as "plainly irrelevant to the legal question before the TTAB."¹⁶⁶ It continued:

There is no question that the history of the treatment of Native Americans in this country has been tragic. Nevertheless, the history of Native Americans has nothing to do with whether the trademarks at issue may disparage Native Americans in the context of Pro-Football's services and during the relevant time frame¹⁶⁷

163. *Id.* at 121, 127.

164. *Id.* at 130 (quoting *Harjo*, 50 U.S.P.Q.2d at 1744 n.114).

165. *Id.* at 131 (emphasis added).

166. *Id.* at 132 n.29. Although the district court still cited—and then dismissed—the media portrayal of Native Americans as "aggressive savages or buffoons," the court, on appeal, found such evidence to be plainly "irrelevant" to determining whether the marks were disparaging, observing, "at best, this evidence demonstrates that Pro-Football's fans and the media continue to equate the Washington Redskins with Native Americans and not always in a respectful manner," but refused to concede that these portrayals suggested that the term *redskins* is derogatory. *Id.* at 134.

167. *Id.* at 132 n.29.

In drawing this line, the court narrowed the focus of the inquiry by excluding the historical meaning of the term, and then also, simultaneously, expanded its focus to overemphasize the secondary meaning of the term in relation to the goods themselves.¹⁶⁸ Unlike the TTAB, the district court did not find the disappearance of the term from common language to be causally related to the term's disparaging character. Instead, the court concluded that its disappearance from the vernacular language—coupled with the strong secondary meaning of the term—had largely eclipsed any potential for disparagement. In other words, the court drew a circuitous connection between the *absence* of a racial epithet in common language and the *presence* of a trademark with the same name and evidence of strong secondary meaning, causally connecting the former to the latter, ultimately overlooking its responsibility to determine only whether the term had the potential to be disparaging. As a parting observation, the court found, in the alternative, that the case was barred due to laches, a finding that prompted the filing of an entirely new petition, eighteen years after the first one was filed, in a case that continues even today.¹⁶⁹

Much can be said about the import of *Harjo* on the future of section 2(a). The case typifies so many of the evidentiary difficulties of proving disparagement—how much empirical and historical evidence is enough, and even relevant—in light of the long shadow of a brand with strong secondary meaning? Even aside from the evidentiary difficulties lies a deeper question: How should section 2(a) balance the economic meaning of a mark as a brand with its potential social meaning as a racial or ethnic epithet? On these questions, there is some evidence to suggest that the TTAB has been able to utilize the *Harjo* test to perform a more precise examination of a mark in relation to its goods and services by also considering evidence of the mark's ordinary and common meaning in an *ex parte* (as opposed to a cancellation) proceeding.¹⁷⁰ In a case involving the resort Squaw Valley, which tried to register the marks SQUAW and SQUAW ONE for clothing, ski equipment, and other resort services (in the form of sporting goods, equipment, and apparel), the TTAB applied the *Harjo*

168. *Id.* at 132–33 (suggesting that the TTAB failed to show “how the use of the trademarks in connection with Pro-Football’s services disparages Native Americans”).

169. *Id.* at 139–44. On appeal, the court of appeals eventually, and just recently, upheld the laches findings. See *Pro-Football, Inc. v. Harjo*, 565 F.3d 880 (D.C. Cir. 2009).

170. *Pro-Football*, 284 F. Supp. 2d at 124. For examples of more recent cases, see *Order Sons of Italy in Am. v. Memphis Mafia, Inc.*, 52 U.S. P.Q.2d (BNA) 1364 (T.T.A.B. 1999) (determining that use of the word “mafia” in the context of Elvis Presley merchandise did not disparage Italian Americans); *In re Mothers & Fathers Italian Ass’n*, No. 75/197,967, 2000 TTAB LEXIS 52, at *1 (Feb. 11, 2000) (finding that the term mafia did not disparage Italian Americans).

test, agreeing that the term had to be analyzed using the rule of association test in connection with the goods and services in question.¹⁷¹

It concluded, however, after considering a lengthy summary of evidence on the term *squaw*, that the mark owner had not successfully rebutted the PTO's prima facie case of disparagement in the context of clothing and resort services.¹⁷² Using the slightly broader standard of proof appropriate for an *ex parte* proceeding, the TTAB introduced evidence from a variety of sources—news clippings discussing the offensive nature of the term from the perspective of many Native Americans; evidence that a variety of legislatures had acted to rename or ban geographic sites from having the same name; and dictionary definitions—all of which established that the term was used as an offensive name for a Native American woman. Though the resort owner attempted to dismiss such anecdotal evidence as representing the agenda of “activist groups,” the TTAB concluded that the argument was insufficient to dismiss their perspectives, arguing that the applicant had failed to offer any evidence to show that a substantial composite of Native Americans would *not* share their view.¹⁷³ Here, despite the import of the district court's opinion in *Harjo*, which suggested a categorical unwillingness to extrapolate the possibility of disparagement from an array of historical evidence, it appears that the TTAB has adopted a more flexible standard that takes into account both the historical import of the trademark, as well as the decisions of various private and government organizations to retire the mark, in addition to its appearance on the goods and services in question.

II. GOVERNMENT AS GUARANTOR IN THE MARKETPLACE OF GOODS

As I have suggested, there is an underlying irony within trademarks: They function within the marketplace of goods and services as private goods, but they function within the marketplace of ideas as public goods, with a multiplicity of social meanings. Because trademark law was initially animated by a concern for a smooth functioning of the marketplace of goods, it appears that the overall scope of trademark regulation has become formally divorced from trademark law's effect on the marketplace of ideas, except where section 2(a) is

171. *In re Squaw Valley Dev. Bd.*, Serial Nos. 76511144 and 76511145, May 23, 2006 at 12–13.

172. See Farella, Braun & Martel LLP, Trademark Office Denies “Disparaging” Mark (June 19, 2006) http://iplaw.blogs.com/content/2006/06/trademark_offic.html.

173. *In re Squaw Valley* at 32–33. The case, however, was not a total loss for Squaw Valley; the TTAB found that the use of the term *SQUAW* and *SQUAW ONE* on ski equipment in particular were allowable because each would bring to mind the resort, rather than the reference to a Native American woman. *Id.* at 50–51.

concerned. The result is a limiting theory of trademark law that inadequately takes into account the role of commodification in the construction of trademark law, First Amendment law, and antidiscrimination theory.

The most complicated consideration regards the extent to which the government is involved in supporting content or viewpoint discrimination, and the constitutional status of these Lanham Act regulations. The broader question implicated by this issue, however, involves the familiar question of paternalism: Should the government serve as a protector of its citizens from stereotypical, scandalous, or disparaging brands, or should it favor the liberal notion that consumers in a free market are able to make their own decisions free from intervention in the marketplace of goods, just as in the marketplace of ideas?¹⁷⁴

One way to answer this question is to look directly at theories of antidiscrimination, which have long considered this question in different contexts. Here, the notion of intersectionality may provide some fruitful lines of analysis.¹⁷⁵ The basic idea of intersectionality is that it forces us to avoid asking the dichotomous question of whether categories of identity should be separated; instead, intersectionality constructs these categories as “neither additive nor dichotomous.”¹⁷⁶ While the concept of intersectionality gained perhaps its most direct strength in forcing the law to grapple with the question of whether discrimination was caused by intra-group or inter-group discrimination in the

174. See J. Bartlett Johnson, *Constitutional Law Survey*, 71 DENV. U. L. REV. 887, 892 (1994) (raising this question).

175. It is important to note that there is not a single kind of intersectionality. When most scholars write about intersectionality, they usually focus on the interrelatedness of the dynamics of identity categories—race, class, gender, sexuality, disability, and so on. Some focus on their symbiotic nature; others, their multidimensional nature. See Nancy Ehrenreich, *Subordination and Symbiosis: Mechanisms of Mutual Support Between Subordinating Systems*, 71 UMKC L. REV. 251 (2002) (symbiosis); Darren Lenard Hutchinson, *Critical Race Histories: In and Out*, 53 AM. U. L. REV. 1187 (2004) (multidimensional); Peter Kwan, *Jeffrey Dahmer and the Cosynthesis of Categories*, 48 HASTINGS L.J. 1257, 1264 (1997) (cosynthesis); Darren Rosenblum, *Queer Intersectionality and the Failure of Lesbian and Gay ‘Victories,’* 4 LAW & SEXUALITY 83 (1994) (multidimensional). For more discussions of intersectionality, see Leslie McCall, *The Complexity of Intersectionality*, 30 SIGNS 3 (2005); Robert S. Chang & Jerome McChristal Culp, Jr., *After Intersectionality*, 71 UMKC L. REV. 485 (2002); Kevin R. Johnson, *Racial Restrictions on Naturalization: The Recurring Intersection of Race and Gender in Immigration and Citizenship Law*, 11 BERKELEY WOMEN’S L.J. 142, 143–45 (1996) (reviewing IAN HANEY LÓPEZ, *WHITE BY LAW: THE LEGAL CONSTRUCTION OF RACE* (1996)) (discussing the effects of naturalization laws on race and gender relations in United States).

176. Keisha Lindsey, *Reading Crisis Narrative Texts: Intersectionality in the Discourse on Marginalized Black Men*, Paper Presented at Political Theory Workshop, at 4 (Univ. of Chicago 2005) (quoting Crenshaw); see also Kimberlé Crenshaw, *Mapping the Margins: Intersectionality, Identity Politics, and Violence against Women of Color*, 43 STAN. L. REV. 1241 (1991).

workplace,¹⁷⁷ the power of intersectionality retains a solid and pervasive potential for many areas of law, including intellectual property.

In her foundational piece, for example, Kimberlé Crenshaw writes eloquently of the existence of a tripartite structure of intersectionality: (1) structural intersectionality, which is linked to the social and economic status of women of color;¹⁷⁸ (2) political intersectionality, which is linked to the potentially divergent goals of various social groups characterized by race and gender;¹⁷⁹ and (3) representational intersectionality, which is linked to the ways in which our popular culture depicts and regulates intersections of race and gender.¹⁸⁰ In Crenshaw's formulation, the concept of representational intersectionality would not only focus on the production of images that involve race and gender, but it would also encourage us to explore how intersectional narratives—for example, the narratives of women of color (who occupy both race and gender minority classifications)—can be marginalized within contemporary critiques.¹⁸¹ In Crenshaw's eyes, then, a choice to enforce regulation regarding gender alone (like an obscenity case), carries race-related implications, and a choice to enforce regulations regarding race representation has gender-related implications as well.

Taking intersectionality at face value—as a theory with its focus on gender and racial identity, among other categories of personhood—would initially suggest little relevance to a world of brands and trademarks in the marketplace of goods. After all, brands—even if they are the composites of racial and gender identity—are not persons, and their complexity is much more textured in relation to commerce, rather than identity. Yet Crenshaw's insight, I would suggest, can be fruitfully extended in three primary ways to the trademark context: First, by directing us to consider how the layering of commodification onto expressive marks (such as AUNT JEMIMA) alters and affects their representational intersectionality in the marketplace of goods, rather than just ideas. Does the potential for expressive harm change, in some way, due to the status of a mark like AUNT JEMIMA as a brand, and as a property, instead of as a figure of speech? Put another way, does a stereotype or caricature change its form when it is used as a trademark or trade symbol in the marketplace of goods?

177. See, e.g., Laura Morgan Roberts & Darryl D. Roberts, *Testing the Limits of Antidiscrimination Law: The Business, Legal, and Ethical Ramifications of Cultural Profiling at Work*, 14 DUKE J. GENDER L. & POL'Y 369, 392–93 (2007).

178. See Crenshaw, *supra* note 176, at 1245–46.

179. *Id.* at 1251–52.

180. *Id.* at 1282–83.

181. To bolster her account, Crenshaw discusses a famous obscenity case at the Supreme Court involving *2 Live Crew*. By focusing only on obscenity and its effect on women, for example, Crenshaw valuably argues that the case also obscured the race-related aspects raised by the case. *Id.* at 1283–90.

Or, does it function in precisely the same fashion as other types of potentially harmful speech that are unconnected to commodities?

Taking Crenshaw's theory of intersectionality one step further, we might explore how the public good/private property status of trademarks affects not just the narratives that brands propagate within the marketplace of goods, but also how these narratives affect the construction of images within the marketplace of ideas. The concept of representational intersectionality, for example, has great potential for a study of the expressive role of trademarks, which often reflect a contradictory and somewhat fractured hybridity between commercial and expressive interests—inasmuch as they are meant to be used in the commercial marketplace of goods, they have powerful implications for how we conceive of the marketplace of ideas, and who gets included—and excluded—from both realms. Indeed, the cases above force us to situate trademarks in a more public marketplace—the marketplace of ideas—where expression operates to sell, but also to communicate particular ideas about various social groups and the stereotypes that may or may not follow from them.

Second, rather than dividing the analytical flashpoints of section 2(a) into discrete dyads—property and speech, public and private, or commercial and political speech, respectively—intersectionality suggests placing a primary emphasis on the power of the meeting point *between* these categories in navigating the complexity of identity.¹⁸² In Part I, I suggested that trademark law is characterized by a sort of intersectionality between public and private goods, where trademarks are classified as private goods, but they behave more like public ones. An intersectional analysis recognizes that trademarks are not completely private properties, nor are they public goods—instead, they occupy the intersection between the two. In this Part, I suggest that a second type of intersectionality characterizes the constitutional status of trademarks under section 2(a). Trademarks are usually classified as commercial speech, but, in the context of section 2(a), they behave much more like expressive or political speech because of the multivariate associations that flow from them. As I argue, they are neither completely commercial, nor completely expressive; like the intersectionality of race and gender, I argue that trademarks occupy the intersectionality of both commercial and expressive spheres, with significant implications for their First Amendment status. Therein lies a trademark's constitutional intersectionality, caught between its commercial status and its

182. *Id.*; Kimberlé Crenshaw, *Demarginalizing the Intersection of Race and Sex: A Black Feminist Critique of Antidiscrimination Doctrine, Feminist Theory, and Antiracist Politics*, 1989 U. CHI. LEGAL F. 139, 149 (“Discrimination, like traffic through an intersection, may flow in one direction, and it may flow in another.”).

political ramifications—irreconcilable, nonrivalrous, and yet contradictorily self-referential.

A third extension of Crenshaw's work is more analytically normative, as opposed to descriptive. The concept of intersectionality might help us in exploring the ideal role for the government to play in regulating the hybrid character of trademarks as mixed public and private goods, and as mixed commercial and expressive speech. Just as the law's regulation of race affects its intersection with gender, the law's regulation of the realm of private goods—the commercial realm of trademarks—affects its intersection with the realm of public goods like information. How should the government navigate the world of the commercial marketplace, as distinct from the marketplace of ideas? Should trademarks be regulated by the same standard in both contexts, or by a standard that recognizes how trademarks occupy the intersection of both marketplaces? Should it aim to be viewpoint-neutral, as in the context of noncommercial speech, or content-sensitive, as in the trademark context? Just as Crenshaw valuably exhorted scholars to take into account how each category affected the other (how the regulation of race affects gender, and vice versa), this Part argues that the law must also take into account the intersection of a trademark's commercial and expressive facets, how each impacts the other, and how the law's governance alters the interaction between a trademark's economic value and social meaning in the marketplace.

A. Mediating the Marketplace

The marketplace of ideas and the marketplace of goods are both founded on the simple principle that they are inherently truth-seeking institutions.¹⁸³ Yet the question of whether the marketplace—of goods or of ideas—actually leads to truth or to distortion has led to multiple opposing viewpoints, often leaving the proper role of government an open-ended question.¹⁸⁴ Writing in 1974, Ronald Coase mused that if the government favored noninterference in the marketplace of ideas, then why not take the same approach in the marketplace of goods?¹⁸⁵ For Coase, the government's inconsistent approach suggested, at the very least,

183. See *Abrams v. United States*, 250 U.S. 616, 630 (1919) (Holmes, J., dissenting) (“[T]he best test of truth is the power of the thought to get itself accepted in the competition of the market . . .”).

184. For a few of these perspectives, see C. Edwin Baker, *Scope of the First Amendment Freedom of Speech*, 25 UCLA L. REV. 964, 974–81 (1978); Kent Greenawalt, *Free Speech Justifications*, 89 COLUM. L. REV. 119, 135–38 (1989); Stanley Ingber, *The Marketplace of Ideas: A Legitimizing Myth*, 1984 DUKE L.J. 1, 1–6.

185. See R.H. Coase, *The Market for Goods and the Market for Ideas*, 64 AM. ECON. REV. 384 (1974); see also Tamara R. Piety, *Market Failure in the Marketplace of Ideas: Commercial Speech and the Problem That Won't Go Away*, 41 LOY. L.A. L. REV. 181 (2007).

an underlying paradox between the government's regulation of the norms of commerce and the norms of communication, suggesting, perhaps, the need for greater parity between the two approaches.¹⁸⁶ But the larger question Coase raised—the question of whether the regulation of ideas can be analogized to the regulation of goods—is perhaps the defining issue that faces the next generation of First Amendment cases.¹⁸⁷

Just two years after Coase posed his question, however, the Court offered one answer by assertively crafting a different standard for regulating commercial and noncommercial speech in *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.*¹⁸⁸ In that case, the Court held that the First Amendment protects commercial speech, defining it as “speech which does ‘no more than propose a commercial transaction.’”¹⁸⁹ Yet the Court was careful to note that the government plays a different role in regulating commercial speech (as opposed to noncommercial speech). In the marketplace of ideas, for example, its task is governed by the First Amendment's expressive commitment to noninterference, allowing free speech to foster a healthy degree of debate and dissent in the marketplace of ideas. On the other hand, within the marketplace of goods, the government's role is premised, largely, on ensuring commercial honesty in advertising. Its job, therefore, is not to preserve an unfettered exchange of ideas, but to preserve the smooth functioning of commerce, and to guarantee that producers are marketing their goods honestly. Towards this end, the Federal

186. Coase, *supra* note 185, at 384–85.

187. For a discussion of the impact of commercial speech classifications on trademark law, see Mark P. McKenna, *The Rehnquist Court and the Groundwork for Greater First Amendment Scrutiny of Intellectual Property*, 21 WASH. U. J.L. & POL'Y 11, 26–28 (2006). For some perspectives on the classification of commercial speech, see C. Edwin Baker, *Commercial Speech: A Problem in the Theory of Freedom*, 62 IOWA L. REV. 1, 3 (1976); Vincent Blasi, *The Pathological Perspective and the First Amendment*, 85 COLUM. L. REV. 449, 484–95 (1985); Ronald K.L. Collins & David M. Skover, *Commerce and Communication*, 71 TEX. L. REV. 697, 736–39 (1993); Deborah J. La Fetra, *Kick It Up a Notch: First Amendment Protection for Commercial Speech*, 54 CASE W. RES. L. REV. 1205 (2004); Thomas H. Jackson & John Calvin Jeffries, Jr., *Commercial Speech: Economic Due Process and the First Amendment*, 65 VA. L. REV. 1 (1979); Charles Gardner Geyh, *The Regulation of Speech Incident to the Sale or Promotion of Goods and Services: A Multifactor Approach*, 52 U. PITT. L. REV. 1, 71–73 (1990); Burt Neuborne, *A Rationale for Protecting and Regulating Commercial Speech*, 46 BROOK. L. REV. 437, 440 (1980); Daniel Hays Lowenstein, *“Too Much Puff”: Persuasion, Paternalism, and Commercial Speech*, 56 U. CIN. L. REV. 1205, 1247–49 (1988); Michael J. Perry, *Freedom of Expression: An Essay on Theory and Doctrine*, 78 NW. U. L. REV. 1137, 1171–75 (1983); Robert Post, *The Constitutional Status of Commercial Speech*, 48 UCLA L. REV. 1 (2000) [hereinafter Post, *Constitutional Status*]; Robert C. Post, *Subsidized Speech*, 106 YALE L.J. 151 (1996) [hereinafter Post, *Subsidized Speech*]; Martin H. Redish, *The Value of Free Speech*, 130 U. PA. L. REV. 591, 630–35 (1982); Steven Shiffrin, *The First Amendment and Economic Regulation: Away From a General Theory of the First Amendment*, 78 NW. U. L. REV. 1212 (1983); Nat Stern, *In Defense of the Imprecise Definition of Commercial Speech*, 58 MD. L. REV. 55 (1999).

188. 425 U.S. 748 (1976).

189. *Id.* at 762 (quoting *Pittsburgh Press Co. v. Pittsburgh Comm'n on Human Relations*, 413 U.S. 376, 385 (1973)).

Trade Commission is afforded broad authority to stop “deceptive” and “unfair” advertisements, and has defined “unfair” to include ads that “‘cause[] or [are] likely to cause substantial injury to consumers which is not reasonably avoidable by consumers themselves and not outweighed by countervailing benefits to consumers or to competition.’”¹⁹⁰

This view portends a deep divide between the marketplace of goods and the marketplace of ideas: While the political marketplace of ideas is designed to foster and encourage dissent and debate, the commercial marketplace is premised largely on persuasion; it is not designed to permit a reciprocal exchange of information between seller and consumer.¹⁹¹ A trademark’s dual strands—its expressive and commercial facets in the marketplace of goods—thus translates into two potential lines of analysis regarding the proper degree of constitutional scrutiny that should be afforded to section 2(a). One intuition, which this Part explores, wholly characterizes trademarks as commercial speech, and little else. Yet another view, quite reasonably, might posit that while a trademark is certainly used for commercial purposes, it is also used for expressive purposes as well. These dichotomous uses bring up a fundamental question about the level of constitutional scrutiny that should be afforded to these marks. While advertisements generally (and trademarks specifically) are considered to be well within the purview of commercial speech, immoral, scandalous, or disparaging marks might also be compared to the same host of issues that animated related controversies surrounding other categories of low-value speech, like obscene or indecent speech, as well as hate speech.

Like other forms of low-value speech, certain types of commercial speech receive less protection under the First Amendment. Commercial speech, because of its singular focus on economic profit, is thought to make a qualitatively different contribution to the marketplace of ideas.¹⁹² The Court has reasoned that regulating false or misleading speech in the commercial context is more justified because it “lacks the value that sometimes inheres in false or misleading political speech,”¹⁹³ and because consumers are less likely to have the acumen or information to question an advertiser’s claims. Moreover, the government has opted to regulate such speech on the grounds that commercial

190. Patricia A. Davidson & Christopher N. Banthin, *Untangling the Web: Legal and Policy Tools to Restrict Online Cigar Advertisements*, 35 U.S.F. L. REV. 1 (2001) (citing 15 U.S.C. § 45(n) (1994)); see also 15 U.S.C. § 45(n) (2006).

191. See Helen McGee Konrad, Note, *Eliminating Distinctions Between Commercial and Political Speech: Replacing Regulation With Government Counterspeech*, 47 WASH. & LEE L. REV. 1129, 1136 (1990) (citing *Va. State Bd.*, 425 U.S. at 765).

192. See *U.S. Healthcare, Inc. v. Blue Cross of Greater Phila.*, 898 F.2d 914, 933–34 (3d Cir. 1990).

193. *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 496 (1995) (Stevens, J., concurring).

speech is inherently more durable than other types of speech, and therefore less likely to be chilled from government oversight.¹⁹⁴

Yet the Court has offered us little guidance in governing the difference between commercial and noncommercial speech, a distinction that further complicates the constitutional status of scandalous and disparaging marks, particularly those that fall outside of the boundaries of factually false or misleading representations.¹⁹⁵ Most commercial speech is given a lower standard of protection because it contains only factual or product information, and thus does not offer the political, artistic, or scientific value that classic First Amendment speech does.¹⁹⁶ The problem, however, is that disparaging and scandalous trademarks do signify some expressive meaning beyond simply the commercial, and that is why they may necessitate more scrutiny. A trademark owner, as we saw in the *Redskins* case, may emphasize the mark's commercial significance in the marketplace of goods, seeking to obliterate its formerly disparaging connotations, but the very content of the meaning of the mark—its disparaging character—puts it in an expressive context that may justify differential treatment under the First Amendment. The question is whether these special considerations merit more or less protection under the Constitution.¹⁹⁷

To some extent, the tensions that have surfaced regarding these polarities force us to grapple with the need for a more textured role for the state. On one hand, our First Amendment jurisprudence establishes that the government must not outlaw speech it deems offensive. The touchstone case of *Cohen v. California*,¹⁹⁸ with its stalwart defense of the seminal jacket reading “FUCK THE DRAFT,” gives us marked pause.¹⁹⁹ Like the profane language in *Cohen*, most trademarks that fall within the Lanham Act's provisions against scandalous or disparaging content are not quite obscene or meant to provoke a violent reaction, but they may fall within a vein of speech that some deem offensive, distasteful, and undesirable. This presents us with a problem. While the government can act to prevent the intrusion of undesirable speech into the privacy

194. See *U.S. Healthcare*, 898 F.2d at 934 (citing *Va. State Bd.*, 425 U.S. at 772 n.24).

195. See *Bolger v. Young's Drug Prods. Corp.* 463 U.S. 60, 81 (1983) (Stevens, J., concurring in the judgment) (“[T]he commercial element does not necessarily provide a valid basis for noncommercial censorship.”).

196. See Reza R. Dibaaj, *The Political Economy of Commercial Speech*, 58 S.C. L. REV. 913, 917 (2007); see also Lillian R. DeVier, *A Comment on Professor Wolfson's "The First Amendment and the SEC"*, 29 CONN. L. REV. 325, 327 (1988).

197. For an interesting application of trademark principles to constitutional law, see Pamela S. Karlan, *Constitutional Law as Trademark*, 43 U.C. DAVIS L. REV. 385 (2009).

198. 403 U.S. 15 (1971).

199. *Id.* at 16, 26.

of the home,²⁰⁰ it cannot “shut off discourse solely to prevent others from hearing it” in public space.²⁰¹ The fact that “the air may at times seem filled with verbal cacophony” is not a “sign of weakness, but of strength” for the Court due to its constitutional commitment to freedom of expression.²⁰²

Thus, a threshold application of *Cohen* to section 2(a) might suggest to a First Amendment absolutist that the Lanham Act’s provisions fall within the threshold of unconstitutional regulation. If the First Amendment must protect the wearing of a shirt that says, explicitly, “FUCK THE DRAFT,” then surely, the reasoning goes, *Cohen* must protect the very commodification (or federal registration) of the phrase as a trademark. But are the situations truly analogous? The phrase in *Cohen* involved pure expression in the marketplace of ideas, whereas the same phrase in the Lanham Act context involves the federal registration of a commodity as a brand in the marketplace of goods.

A second major consideration, again differing from *Cohen*, involves the question of whether the government’s refusal to register a mark can be analogized to *Cohen*’s criminal prohibition on certain types of speech. The dispute here centers on the analytical and juridical significance one attaches to the commodification and commercialization of trademarks, rather than the criminalization of certain types of speech. This difference is important because it marks a substantial nexus between the role of the state in supporting (or propertizing) such expression, and whether the state can refuse to register offensive language. While a refusal to register clearly affects the intellectual property rights (and enforcement) that accompany a protected mark, it does not actually *prohibit* the use or expression of such marks, raising the question of whether section 2(a) counts as a substantial abridgement of speech or a simple denial of a subsidy.

These considerations, while complex, must also be situated within a broader landscape that explores the appropriate trajectory that the government should take in regulating trademarks. Yet the overall question remains: Is the government a guarantor of certain qualities of commercial speech in the marketplace of goods, thus necessitating greater scrutiny over content-based regulations, or is it a sponsor of certain types of speech in the marketplace, thus deserving of less scrutiny? The choice between them may indeed shed dispositive light on the constitutionality of section 2(a), as the Subparts below suggest.

200. *Id.* at 21 (citing *Rowan v. U.S. Post Office Dep’t*, 397 U.S. 728 (1970)); *Erzoznik v. Jacksonville*, 422 U.S. 205, 209 (1975) (citing *Rowan*, 397 U.S. 728).

201. *Cohen*, 403 U.S. at 21.

202. *Id.* at 25. See also STONE, *supra* note 136, at 262–72.

B. Commerciality and Content

Registration and regulation of trademarks has traditionally been the government's responsibility. The rationale for government regulation is that trademark protection, like other types of property rights, benefits the public—and both encourages and maintains quality through the protection of brand goodwill and its reputational benefits, fostering fair competition and protecting the consumer at the same time.²⁰³ Yet trademarks also raise an underlying constitutional conflict regarding speech that contains both commercial and noncommercial elements. Questions of classification directly parallel the question of whether trademarks or trade names serve purely informational functions in the marketplace of goods, as *Friedman* suggests, or whether as *Redskins* and other cases suggest, they serve broader functions in the marketplace of ideas, thus raising the question of whether these marks may be classified as speech deserving of a higher degree of constitutional protection.²⁰⁴

The Court has never directly confronted the question of the constitutionality of the section 2(a) provisions (after all, the Lanham Act was passed well before the commercial speech doctrine even existed). Yet the breadth and amorphous nature of the boundaries of commercial speech conflict with its prior case law in the area of trademarks, for which it has carved out a much narrower role.²⁰⁵ The implications of each approach are significant. Crafting an overbroad classification for commercial speech enables some expressive marks within section 2(a) to receive less protection, but crafting a classification that is too narrow risks rendering section 2(a) meaningless. In addition, courts have largely failed to uniformly execute an approach for how to govern intersectional or hybrid speech, that is, speech that is inextricably entwined with elements of both commercial and noncommercial content in the trademark context.²⁰⁶

203. See S. REP. NO. 79-1333, at 4 (1946), reprinted in 1946 U.S.C.C.A.N. 1274, 1275.

204. Compare *Friedman v. Rogers*, 440 U.S. 1, 12–15 (1979), with *Metromedia, Inc. v. City of San Diego*, 453 U.S. 490 (1981) (expressing a distinction between commercial speech and ideological speech). See also Mark Bartholomew, *Advertising in the Garden of Eden*, 55 BUFF. L. REV. 737, 751, 761 (2007); Bruce Ledewitz, *Corporate Advertising's Democracy*, 12 B.U. PUB. INT. L.J. 389 (2003).

205. *Friedman*, for example, claimed that trade names lack informational content, whereas other cases have maintained exactly the opposite. 440 U.S. at 12; see *Zauderer v. Office of Disciplinary Counsel*, 471 U.S. 626, 647, 651 (1985) (suggesting that illustrations in commercial speech “serve[] important communicative functions: it attracts the attention of the audience to the advertiser’s message, and it may also serve to impart information directly”); *Bad Frog Brewery, Inc. v. N.Y. State Liquor Auth.*, 134 F.3d 87, 96 (2d Cir. 1998), (quoting *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council*, 425 U.S. 748, 765 (1976)) (observing that advertising, “however tasteless,” operates to disseminate information regarding “who is producing and selling what product”).

206. See Lisa A. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 S.M.U. L. REV. 381, 397–98 (2008) (citing *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905–07 (9th Cir. 2002)); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 672 (5th Cir. 2000); *Dr. Seuss Enters., L.P.*

Ironically, as of 1942, the Constitution did not extend protection to commercial advertising at all.²⁰⁷ But twenty-two years later, the Court extended some protection for political advertising in the famed *New York Times Co. v. Sullivan*²⁰⁸ case, where it distinguished a set of submarine tour ads in *Valentine v. Chrestensen*,²⁰⁹ a prior case, from the politically-oriented advertisement for the Committee to Defend Martin Luther King.²¹⁰ By making this distinction between editorial advertisements and other types of advertisements, the Court suggested that purely commercial advertising was not deserving of full First Amendment protection when it “did no more than propose a commercial transaction.”²¹¹ In 1975, in the case of *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.*,²¹² the Court consecrated this view, holding that some forms of commercial speech are deserving of First Amendment protections, albeit to a different degree than other types of speech.²¹³ The “consumer’s interest in the free flow of commercial information . . . may be as keen, if not keener by far, than his interest in the day’s most urgent political debate,” the Court concluded.²¹⁴

As Jeff Lefstin wrote, in that case, the Court identified the “free flow of market information as a key First Amendment interest,” rejecting the implied paternalism that animated the state’s initial choice to bar citizens’ access to the information.²¹⁵ There, the Court offered the view that keeping open the channels of communication in the marketplace of ideas was the best route to protect consumer decisions, but still preserved some boundaries for the government to regulate false or misleading advertising and the time, place, or

v. Penguin Books USA, Inc., 109 F.3d 1394, 1403–06 (9th Cir. 1997); *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 500–01 (2d Cir. 1996); *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 772–73, 778 (8th Cir. 1994); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 32–33 (1st Cir. 1987); *Lucasfilm Ltd. v. Media Mkt. Group, Ltd.*, 182 F. Supp. 2d 897, 900–01 (N.D. Cal. 2002); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 735 (D. Minn. 1998)).

207. See *Valentine v. Chrestensen*, 316 U.S. 52, 54 (1942); C. Edwin Baker, *The First Amendment and Commercial Speech*, 84 IND. L.J. 981, 981–82 (2009).

208. 376 U.S. 254 (1964).

209. 316 U.S. 52 (1942).

210. See *Sullivan*, 376 U.S. at 257, 265–66 (1964) (“[The advertisement] communicated information, expressed opinion, recited grievances, protested claimed abuses, and sought financial support on behalf of a movement whose existence and objectives are matters of the highest public interest and concern.”).

211. *Pittsburgh Press Co. v. Pittsburgh Comm’n on Human Relations*, 413 U.S. 376, 385 (1973). See also *Bigelow v. Virginia*, 421 U.S. 809, 822 (1975) (suggesting that an advertisement that “did more than simply propose a commercial transaction”—as in the case of an advertisement of out-of-state abortion services—might warrant heightened protection).

212. 425 U.S. 748 (1976).

213. *Id.* at 762–65.

214. *Id.* at 763.

215. See Lefstin, *supra* note 50, at 672.

manner of commercial speech.²¹⁶ It also offered a singular, simple definition of commercial speech: “speech which does no more than propose a commercial transaction.”²¹⁷

A few years later, the Court refined its treatment of commercial speech in *Central Hudson Gas & Electric Corp. v. Public Service Commission*,²¹⁸ which set forth the principle of applying intermediate scrutiny to evaluate the content of commercial speech. Although *Central Hudson* attempted to traverse these boundaries by differentiating between commercial and noncommercial speech, it observed:

[T]he First Amendment’s concern for commercial speech is based on the informational function of advertising. Consequently, there can be no constitutional objection to the suppression of commercial messages that do not accurately inform the public about lawful activity. The government may ban forms of communication more likely to deceive the public than to inform it²¹⁹

Thus, as long as the commercial speech addresses a lawful activity, and is not misleading, it is entitled to protection.²²⁰ The court will ask whether the asserted government interest is substantial, and whether the regulation directly advances the government interest. And finally, the court will inquire whether the governmental interest could be served by a more limited restriction on commercial speech. If so, *Central Hudson* dictates that the excessive restrictions will not survive.²²¹

Although *Central Hudson* purported to add some clarity to the Court’s treatment of commercial speech, it offered a test that has been referred to as “notoriously indeterminate,”²²² prompting a barrage of criticism from scholars on the right and left of the political spectrum.²²³ At the debate’s center is the issue that frames the degree of scrutiny the Lanham Act provisions should receive: the question of how to define commercial speech. The touchstone case of *Bolger v. Youngs Drug Products Corp.*²²⁴ provides the most visible—and confusing—definition. In that case, the Court held that the circulation of two pamphlets

216. See *Va. State Bd.*, 425 U.S. at 763–65, 770–72.

217. *Id.* at 762 (quoting *Pittsburgh Press Co.*, 413 U.S. at 385).

218. 447 U.S. 557 (1980).

219. *Id.* at 563 (citations omitted).

220. *Id.* at 564.

221. *Id.*

222. Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After Eldred*, 44 *Liquormart*, and Bartnicki, 40 *HOUS. L. REV.* 697, 733 (2003).

223. See, e.g., Alex Kozinski & Stuart Banner, *Who’s Afraid of Commercial Speech?*, 76 *VA. L. REV.* 627 (1990); Post, *Constitutional Status*, *supra* note 187.

224. 463 U.S. 60 (1983).

(one that described the use of condoms and contained manufacturer's information, and a second entitled, "Plain Talk about Venereal Disease," which simply discussed the use of condoms) comprised commercial speech on the grounds that they were (1) advertisements; (2) that referred to a specific product; and (3) had a commercial motivation.²²⁵

The Court curiously reached this observation despite its recognition that the advertisement included discussions that involved far more information than a simple proposal to engage in a commercial transaction. Since *Bolger*, courts have looked to these three elements—an advertisement, reference to a specific product, coupled with evidence of an economic or promotional intent—in classifying commercial speech. Elsewhere, however, the Court has stated that if commercial speech and fully protected speech are "inextricably intertwined," it will treat the entire expression as fully protected, noncommercial speech.²²⁶

Based on these observations, most courts consider logos, labels, and trademarks to enjoy some First Amendment protection, although the level of protection they enjoy is tethered to the reduced protections enjoyed by commercial speech.²²⁷ When a word or symbol is used as a trademark to identify and distinguish the source of a commercial good or service, the expression may be classified as commercial speech.²²⁸ Lower courts, for example, have relied on *Bolger*, noting that common sense dictates that uses of logos should not receive the highest protection afforded by the First Amendment, given that regulations on commercial speech are often related to legitimate government objectives.²²⁹ Yet this broad view has meant, at times, that noncommercial expression in both the narrow category of trademarks, and the broader field of advertising generally, gets cast as commercial speech, even when the speech plays a multivariate

225. *Id.* at 66–68.

226. *Riley v. Nat'l Fed'n of the Blind, Inc.*, 487 U.S. 781, 796 (1988). Yet the court has abstained from applying this rule to situations where noncommercial speech is added on to commercial speech, observing that "advertising which 'links a product to a current public debate' is not afforded the high degree of protection that noncommercial speech enjoys." *Bd. of Trs. of the State Univ. of N.Y. v. Fox*, 492 U.S. 469, 475 (1989) (quoting *Bolger*, 463 U.S. at 67–68 (quoting *Cent. Hudson Gas Elec. v. Pub. Serv. Comm'n*, 447 U.S. 557, 563 n.5 (1980))). Elsewhere, the Court has refused to allow states to treat noncommercial speech as less valuable than commercial speech. See *Metromedia, Inc. v. City of San Diego*, 453 U.S. 490 (1981); *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 424 (1993) (rejecting a ban on commercial newsracks on the grounds that the distinction between commercial and noncommercial speech bears no relationship to the city's interests).

227. See *Bad Frog Brewery, Inc. v. N.Y. State Liquor Auth.*, 134 F.3d 87, 94 (2d Cir. 1998).

228. See *Ramsey*, *supra* note 206, at 396 ("Like the use of a trade name, these source-identifying uses of a trade-mark are pure commercial speech because the 'purpose is strictly business' and they 'are used as part of a proposal of a commercial transaction.'" (citing *Friedman v. Rogers*, 440 U.S. 1, 11 (1979))).

229. See *Transp. Alternatives, Inc. v. City of New York*, 218 F. Supp. 2d 423, 437–38 (S.D.N.Y. 2002) (linking aesthetics and traffic safety as legitimate regulations of commercial signage).

combination of roles in both the marketplace of goods and ideas.²³⁰ This view has also led to a discordant swath of content being characterized as commercial—a pro-life clinic’s advertising, despite its content addressing issues of public concern;²³¹ an article in a trade journal that favorably compared a sponsored product to a competitor’s;²³² a distributor’s observations that a competitor was linked to the Church of Satan;²³³ even a mention of a trade name on a disgruntled customer’s website that steered visitors to competitors.²³⁴ Many of these cases run afoul of the view that commercial speech and noncommercial speech, when intertwined, deserve more protection.²³⁵

More recently, however, the Court has taken a more critical view of the power of government regulation, and, in doing so, quietly diverged from cases like *Friedman* by asserting some substantial informational value for commercial speech, labels, and advertising.²³⁶ At the same time, however, although the Court has tended towards invalidating government regulations against commercial speech, it hasn’t expressly overruled *Central Hudson*.²³⁷ Yet it has emphasized that courts should not “place too much importance on the distinction between commercial and noncommercial speech,”²³⁸ and both Justices Stevens and Thomas have separately observed the artificiality and difficulty of drawing a distinction between them.²³⁹ For example, in one case, *44 Liquormart, Inc. v. Rhode Island*,²⁴⁰ the Court confronted state prohibitions on the advertising

230. See Ramsey, *supra* note 206, at 385 (citing *World Wrestling Fed’n Entm’t v. Bozell*, 142 F. Supp. 2d 514, 525–26 (S.D.N.Y. 2001); *People for the Ethical Treatment of Animals, Inc. v. Doughney*, 113 F. Supp. 2d 915, 919 (E.D. Va. 2000), *aff’d* on other grounds, 263 F.3d 359 (4th Cir. 2001); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 735 (D. Minn. 1998) (all characterizing noncommercial speech as commercial)).

231. *Fargo Women’s Health Org., Inc. v. Larson*, 381 N.W.2d 176 (N.D. 1986).

232. *Semco, Inc. v. Amcast, Inc.*, 52 F.3d 108 (6th Cir. 1995).

233. *Proctor & Gamble Co. v. Amway Corp.*, 242 F.3d 539, 552 (5th Cir. 2001).

234. *Bihari v. Gross*, 119 F. Supp. 2d 309 (S.D.N.Y. 2000).

235. See Volokh, *supra* note 222, at 734–35.

236. See Rebecca Tushnet, *Trademark Law as Commercial Speech Regulation*, 58 S.C.L. REV. 737, 747 (2007) (making this observation). The Court has struck down regulations prohibiting the reporting of alcohol content on beer labels, for example, assuming, without deciding, that the informational content on the label, coupled with the use of a label, constituted commercial speech. See *Rubin v. Coors*, 514 U.S. 476 (1995).

237. See *Thompson v. W. States Med. Ctr.*, 535 U.S. 357 (2002) (invalidating an FDA provision banning a pharmacy’s advertising a special service that enabled tailor-made medications at a physician’s request); *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525 (2001) (striking down advertising restrictions on cigars and tobacco due to a lack of fit between goals and ban); *Greater New Orleans Broad. Ass’n v. United States*, 527 U.S. 173 (1999) (striking down a ban on casino broadcasting ads).

238. See Ramsey, *supra* note 206, at 393 (citing *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 424 (1993)).

239. See *id.*; *Rubin*, 514 U.S. at 494 (Stevens, J., concurring); *Lorillard*, 533 U.S. at 575 (Thomas, J., concurring)).

240. 517 U.S. 484 (1996).

of liquor prices, and held that government actors enjoy “less regulatory authority when . . . commercial speech restrictions strike at ‘the substance of the information communicated.’”²⁴¹ This principle suggests that the state objectives must aim at controlling secondary effects from the content of advertising, rather than the content of the advertising itself.

The indeterminacy of line-drawing between commercial and noncommercial speech has understandably led to a chorus of suggestions to abandon the distinction entirely.²⁴² In 2004, both critics and advocates for the commercial speech doctrine were disappointed when the Supreme Court, after first agreeing to hear the landmark constitutional case of *Nike v. Kasky*,²⁴³ decided to dismiss the petition as improvidently granted.²⁴⁴ The case turned on the question of whether factual representations Nike made on its website regarding its treatment of workers could be cast as commercial speech, and subject to regulation under a California False Advertising statute, or whether it received full constitutional protection. The California Supreme Court held that Nike’s language, despite addressing matters of public concern, still qualified as commercial speech, and held that the First Amendment did not protect Nike’s statements to the extent that they were false and misleading.²⁴⁵ The outcome of the case meant that the issue of mixed speech would be left for another day of decision, likely warranting the treatment of trademarks as simple commercial speech.

Despite these divergences, the operative case law suggests a high degree of scrutiny for section 2(a) on the grounds that scandalous and disparaging marks are targeted by the Lanham Act for their content, even though the marks also qualify as commercial speech. But even this suggestion, upon further study, reveals deep inconsistencies. On one hand, the Court has held, in cases like *Cohen* and *Bolger*, that the offensive nature of certain content is not a sufficient justification for the government to suppress it on its own.²⁴⁶ It has extended

241. *Id.* at 499 (quoting *Linmark Assocs., Inc. v. Twp. of Willingboro*, 431 U.S. 85, 96 (1977)).

242. See Kozinski & Banner, *supra* note 223, at 628–29; Post, *Constitutional Status*, *supra* note 187, at 5.

243. 539 U.S. 654 (2003).

244. *Id.* (per curiam). See also Erwin Chemerinsky & Catherine Fisk, *What Is Commercial Speech? The Issue Not Decided in Nike v. Kasky*, 54 CASE W. RES. L. REV. 1143 (2004).

245. See *Kasky v. Nike, Inc.*, 45 P.3d 243, 247 (Cal. 2002), *cert. denied*, 539 U.S. 677 (2003). United States Supreme Court Justices Breyer and O’Connor felt differently, dissenting from the dismissal of the petition, and arguing that the statements were inextricably intertwined with noncommercial speech, thus meriting heightened scrutiny. See *Nike*, 539 U.S. at 677 (Breyer & O’Connor, JJ., dissenting).

246. See *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 72 (1983) (rejecting a rule that prohibited the mailing of contraceptive advertising on the grounds that the rule was designed “to protect those individuals who might potentially be offended”). The Court has extended this view to an unruly class of contexts, culminating in *Erznoznik v. Jacksonville*, where it struck down a city law that prohibited nudity in drive-in theatres when the screen was visible to the public on the grounds that the screen was not sufficiently obtrusive. 422 U.S. 205, 212 (1975).

this view in commercial speech cases like *Lorillard Tobacco Co. v. Reilly*,²⁴⁷ which overturned regulations prohibiting tobacco advertising under the First Amendment according to *Central Hudson*.²⁴⁸ In that case, the Court also cited an internet free speech case, *Reno v. American Civil Liberties Union*,²⁴⁹ for the proposition that “the governmental interest in protecting children from harmful materials . . . does not justify an unnecessarily broad suppression of speech addressed to adults.”²⁵⁰ Similarly, outside of the commercial speech context, in *Erznoznik v. City of Jacksonville*,²⁵¹ the Court overturned a law that made it a public nuisance and punishable offense for drive-in movies to show films that depicted nudity on the grounds that it was overbroad.²⁵² These cases suggest that offensive expression cannot be prohibited or regulated merely on the basis of its content alone.

Yet on the other hand, the Court has crafted a narrow band of consideration for the “captive audience,”²⁵³ enabling the regulation of advertising, and has, at other times, evinced some concern for keeping a home safe from the intrusion of indecent content.²⁵⁴ Just a year after *Erznoznik*, for example, in a case of an indecent broadcast involving George Carlin’s “dirty words” monologue, the Court upheld restrictions when they were sufficiently narrow.²⁵⁵ In that case, *FCC v. Pacifica Foundation*,²⁵⁶ the Court stridently upheld the

247. 533 U.S. 525 (2001).

248. *Id.* In fact, in *Lorillard*, one of the strongest proponents of erasing the distinction between commercial and noncommercial speech, Justice Thomas, observed that “when the government seeks to restrict truthful speech in order to suppress the ideas it conveys, strict scrutiny is appropriate, whether or not the speech in question may be characterized as ‘commercial.’” *Id.* at 572 (Thomas, J., concurring in part and concurring in the judgment). Thomas continued by observing that there was “no ‘philosophical or historical basis for asserting that ‘commercial’ speech is of ‘lower value’ than ‘noncommercial’ speech.” *Id.* at 575 (quoting 44 *Liquormart v. Rhode Island*, 517 U.S. 484, 522 (1996) (Thomas, J., concurring in part and concurring in judgment)).

249. 521 U.S. 844 (1992).

250. See *Lorillard*, 533 U.S. at 564 (citing *Reno v. Am. Civil Liberties Union (ACLU)*, 521 U.S. 844, 875 (1997)).

251. 422 U.S. 205 (1975).

252. *Id.* at 213 (noting “[c]learly all nudity cannot be deemed obscene even as to minors” and citing examples of visual expression, like a baby’s buttocks, that would be otherwise unproblematic except if depicted onscreen).

253. See *Lehman v. City of Shaker Heights*, 418 U.S. 298 (1974) (allowing regulation of advertising on municipal transportation). *But see Sable Commc’ns of Cal., Inc. v. FCC*, 492 U.S. 115, 131 (1989) (striking down a law criminalizing “obscene or indecent communication for commercial purposes” on the grounds that the prohibition went too far in blocking access for adults).

254. See *Rowan v. U.S. Post Office Dep’t*, 397 U.S. 728 (1970) (enabling addressees to give notice that they no longer want further mailings); *Fla. Bar v. Went For It, Inc.*, 515 U.S. 618 (1995) (upholding a moratorium on mail solicitation of accident victims given that the restriction permitted alternative means).

255. The most recent of these cases, *Reno v. ACLU*, held that the government could regulate speech to protect children, but could not undertake an “unnecessarily broad suppression of speech addressed to adults.” 521 U.S. 844, 875 (1997).

256. 438 U.S. 726 (1978).

regulation of content that was indisputably vulgar, offensive, and indecent, even though it was not obscene, based on the view that privacy considerations and captivity weighed in favor of such regulations.²⁵⁷ This view was later extended in a case that upheld the rights of private cable operators to prohibit indecent content, which it defined as programming that depicted “sexual activities . . . or organs in a patently offensive manner,” on the grounds that it did not impose an unnecessarily broad restriction on speech.²⁵⁸ Tellingly, the Court found that the statute—despite its regulation of “offensive” speech—was viewpoint neutral, suggesting that the Lanham Act’s provisions might face the same characterization.²⁵⁹

These cases suggest that the constitutionality of section 2(a) turns, in part, on whether the government interest will be classified as “substantial” (if the mark is classified as commercial speech) or “compelling” (if classified as noncommercial speech).²⁶⁰ Given the context of trademark uses normally categorized as commercial speech, the “substantial” prong is more likely to be employed. This suggests, following *Central Hudson*, that if the speech is not misleading and concerns a lawful activity, the regulation will violate the First Amendment unless there is a showing of a substantial government interest, the regulation directly advances that interest, and the regulation is not more extensive than necessary to serve that interest.²⁶¹

Should the Court jettison *Central Hudson*’s intermediate scrutiny test, however, thereby removing the distinction between commercial and noncommercial speech, the constitutionality of section 2(a) will likely turn on whether or not the regulation is viewed as content-based or content-neutral. In the context of trademark law generally, a variety of scholars have argued, contrary to

257. *Id.*; see also Tim Searcy, *Do Not Call: Abdicating and Ignoring Responsibility*, 10 RICH. J.L. & TECH. 28, 45 (2004).

258. *Denver Area Educ. Telecomm. Consortium, Inc. v. FCC*, 518 U.S. 727, 732 (1996) (citation omitted).

259. *Id.* at 747 (construing “offensive” as viewpoint-neutral).

260. See Ramsey, *supra* note 206, at 424. She observes:

A broad trademark goal, such as protecting consumers from harm, is more likely to be found substantial or compelling, but this particular trademark law must be sufficiently narrowly tailored to prevent the suppression or chill of protected expression. If the goals of trademark law are defined more narrowly, such as preventing confusion about sponsorship or approval of use of a mark in artistic or literary works, some may question whether the alleged harm to consumers is real and sufficiently material to justify restricting this expression.

261. *Id.* at 425 (citing *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557, 566 (1980)). If the regulation is viewed as content-based, which is the most likely outcome, the regulation will receive strict scrutiny, and most cases have tended towards finding such restrictions unconstitutional. See *id.* at 427 (noting that a content-based speech regulation survives strict scrutiny if it is narrowly tailored and the least restrictive means to promote a compelling government interest, whereas a content-neutral regulation is subjected to intermediate scrutiny).

some courts, that the Lanham Act is content-based.²⁶² According to scholars Mark Lemley and Eugene Volokh, two of the strongest proponents of this view,²⁶³ such courts often confuse viewpoint-neutrality with content-neutrality.²⁶⁴ In a longer exposition of this view, Eugene Volokh argues forcefully that the context of trademark and copyright law contains undesirable content-based analysis, pointing out:

[T]hese classifications require[] judges and juries to make further content-based decisions of their own: whether speech is “newsworth[y],” whether it’s “outrageous,” whether it “tarnish[es]” a trademark by “us[ing it] in an unwholesome context,” whether it uses a trademark or a name in a way that has “artistic relevance” to its message, whether it copies more than it really needs to copy, whether it is parody that mocks the original rather than satire that mocks society, and so on. These decisions often leave factfinders with considerable discretion in judging speech based on what it says, and it’s easy for the factfinders to exercise that discretion in ways that are viewpoint-based or subject-matter-based.²⁶⁵

Indeed, Volokh perfectly captures the precise concern with section 2(a): that its focus on immoral, scandalous, and disparaging content opens the door for a host of subjective and discretionary decisions. In fact, there is some evidence that courts are becoming sympathetic to this view: Lisa Ramsey offers the example of an injunction that barred “disparaging remarks or negative commentary” that the Ninth Circuit classified as a content-based restriction.²⁶⁶ Further, she argues that by restricting word choice, trademark law forecloses the possibility of “‘alternative avenues’ for using the exact same words.”²⁶⁷ “Because the choice of words can be critical to the message—some firms spend large sums of money to select the perfect brand name—any restriction on use of a trademark may have a significant effect on the content of speech,”²⁶⁸ Ramsey concludes.

262. For discussion of this point, see *id.* at 431 (citing *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979) (classifying regulations in the Lanham Act as content-neutral)); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1403 n.11 (9th Cir. 1997) (agreeing with this view).

263. Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 221 (1998); Volokh, *supra* note 222, at 707–13.

264. Lemley & Volokh, *supra* note 263, at 218.

265. Volokh, *supra* note 222, at 709–10.

266. See Ramsey, *supra* note 206, at 431 (citing *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1016 (9th Cir. 2004)).

267. *Id.* at 437.

268. *Id.*

C. Content and Captivity

The prior issues raise an unanswered question: Should a scandalous or disparaging label be viewed as purely commercial, or should it receive full constitutional protection because, even though it might fall within a general definition of commercial speech, it lacks the potential to be, factually speaking, false and misleading?²⁶⁹ Or is there a third alternative under *Central Hudson*? If commercial speech is speech that does “no more” than propose a commercial transaction, then it is extremely difficult to tell how trademarks fare against this definition. Does a logo, on a piece of merchandise, propose a commercial transaction, or do something more expressive? Statutes and case law often fail to analyze these questions, particularly when a trademark functions as a persuasive instrument within an advertisement, but in ordinary common discourse, conveys something else. In such situations, the expressive connotations of a trademark layer onto the commercial considerations, thus raising the question the court entertained in the *Redskins* case: whether the marks can be separated on their own under a per se approach—or whether the context in which they are raised should serve some role in classifying them.

The Lanham Act was enacted in 1946, long before the advent of the commercial speech doctrine.²⁷⁰ Fifteen years ago, in the only case to address the issue, the Supreme Court consecrated the significance of the dichotomy between commercial and noncommercial speech for trademark law—specifically—in *San Francisco Arts & Athletics v. United States Olympic Committee (USOC)*,²⁷¹ when it proscribed a California corporation from naming their sports competition the GAY OLYMPIC GAMES. In that case (*Gay Olympics*), applying a weakened form of intermediate scrutiny under the First Amendment, the Court cast the name as classic commercial speech²⁷² and stated:

The [defendant’s] expressive use of the word [Olympic] cannot be divorced from the value the [plaintiff’s] efforts have given to it. The mere fact that the [defendant] claims an expressive, as opposed to a purely commercial, purpose does not give it a First Amendment right to “appropriat[e] to itself the harvest of those who have sown.” The [plaintiff’s] right to prohibit use

269. See *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 436 (1993) (Blackmun, J., concurring) (“[T]ruthful, noncoercive commercial speech concerning lawful activities is entitled to full First Amendment protection.”); *Bad Frog Brewery, Inc. v. N.Y. State Liquor Auth.*, 134 F.3d 87, 96–97 & n.4 (2d Cir. 1998) (citing *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 491 (1995) (Stevens, J., concurring)).

270. *Smith, Squeezing the Juice*, *supra* note 80, at 1309.

271. 483 U.S. 522 (1987).

272. See *Ramsey*, *supra* note 206, at 413.

of the word “Olympic” in the promotion of athletic events is at the core of its legitimate property right.²⁷³

In making this observation, the Supreme Court clarified a number of points regarding the relationship between property and speech. First, the Court suggested that the presence of a commercial component to the GAY OLYMPIC GAMES proscribed appropriation of a trademark, even for expressive purposes.²⁷⁴ Despite quoting *Cohen* for the proposition that “words are not always fungible, and that the suppression of particular words ‘run[s] a substantial risk of suppressing ideas in the process,’”²⁷⁵ the Court concluded that the term Olympic was not generic because the word had acquired value as the result of the official Olympics organization’s expenditure of labor, skill, and money²⁷⁶ in the hundred or so years it had been used. The Court continued:

One reason for Congress to grant the [United States Olympic Committee] exclusive control of the word “Olympic,” as with other trademarks, is to ensure that the USOC receives the benefit of its own efforts so that the USOC will have an incentive to continue to produce a “quality product,” that, in turn, benefits the public. But in the special circumstance of the USOC, Congress has a broader public interest in promoting, through the activities of the USOC, the participation of amateur athletes from the United States in the “great four-yearly sport festival, the Olympic Games.”²⁷⁷

Given these goals, the Court wrote that Congress might have reasonably concluded that most commercial uses of the term Olympic might be confusing, and that any unauthorized use of the term might harm the USOC by diluting the distinctiveness and commercial value of the mark.²⁷⁸

The Court further concluded that the USOC’s restrictions on prohibiting the use of the word Olympic by the gay organization were merely “incidental to the primary congressional purpose of encouraging and rewarding the USOC’s activities.”²⁷⁹ In other words, the expressive recoding of the term by a gay organization did not immunize the appropriation; nor did it ensure that the speech receives greater protection under the First Amendment. Much like the *Redskins* case, the Court overstated the trademark function of the term, separating its

273. S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm. (Gay Olympics), 483 U.S. at 540–41 (citation omitted).

274. *Id.* at 535 (“To the extent that Section 110 applies to uses for the purpose of trade [or] to induce the sale of any goods or services . . . its application is to commercial speech.”).

275. *See id.* at 532 (quoting *Cohen v. California*, 403 U.S. 15, 26 (1971)).

276. *Id.* at 533.

277. *Id.* at 537 (citation omitted).

278. *Id.* at 539.

279. *Id.* at 537.

economic value from its social meaning. It recognized, for example, that the use of the term Olympic had both promotional and political importance, and thus transcended the “strictly business” context of ordinary types of commercial speech.²⁸⁰ But its decision to prevent a gay organization from using the mark, the Court assured itself, had little to do with prohibiting its expressive message, noting that it was only prohibiting the use of “one word for particular purposes,” and that this restriction on expressive speech was “incidental” to the primary purpose of encouraging and rewarding USOC’s activities. In the Court’s view, the speech restriction was not content-based, but only restricted the “manner” in which the game was identified.²⁸¹ “The appropriate inquiry,” the Court noted, citing *United States v. O’Brien*,²⁸² “is thus whether the incidental restrictions on First Amendment freedoms are greater than necessary to further a substantial governmental interest.”²⁸³

On this point, the Court assertively conflated both *O’Brien* and *Central Hudson*, and noted that USOC’s exclusive use of the term was necessary to incentivize USOC “to continue to produce a ‘quality product,’ that in turn, benefits the public” and also furthers the goals of understanding, athleticism, and friendship between nations.²⁸⁴ Here, the Court espoused an absolutist view of property—permitting the trademark owner a nearly unlimited right to exclude others from using the trademark, and flowing from this point, defending the constitutionality of the statute in the process. “[O]n its face,” the Court explained, “[the law] applies primarily to commercial speech There is no basis in the record to believe that the Act will be interpreted or applied to infringe significantly on noncommercial speech rights.”²⁸⁵

The *Gay Olympics* case has faced mixed criticism, stemming from its professed distinction between commercial and noncommercial speech. The Court suggested that by labeling certain types of speech as commercial, the government

280. *Id.* at 535 (citing *Friedman v. Rogers*, 440 U.S. 1, 11 (1979)).

281. See *Ramsey*, *supra* note 206, at 432 (discussing this point).

282. 391 U.S. 367 (1968).

283. *Gay Olympics*, 483 U.S. at 536–37 (citing *O’Brien*, 391 U.S. at 377).

284. *Id.* at 537. Given these goals, the Court reasoned, the potential for confusion with the title GAY OLYMPIC GAMES would create sponsorship confusion and thus lessen the distinctive quality of the term. Although it noted that the USOC’s rights were broader than those of a traditional trademark owner, the Court concluded that the restriction on the use of the term GAY OLYMPIC GAMES was no broader than necessary to further the goals and interests of Congress in protecting the Olympic Games. *Id.* at 539–40. As such, the Court observed that the property interests in USOC’s trademark overrode the expressive interests of others, noting that “the SFAA’s expressive use of the word cannot be divorced from the value the USOC’s efforts have given to it.” *Id.* at 541. For discussion of this case, see Robert N. Kravitz, *Trademarks, Speech, and the Gay Olympics Case*, 69 B.U. L. REV. 131 (1989); Volokh, *supra* note 222, at 737.

285. *Gay Olympics*, 483 U.S. at 536 n.15.

may be able to evade or lessen its First Amendment obligations and censor various speakers like the Gay Olympics organization, even in the absence of source confusion, and even in the presence of expressive considerations.²⁸⁶ For some prominent trademark scholars, Rebecca Tushnet among them, the Supreme Court's property argument highlights the risk of using property concepts to fend off First Amendment challenges.²⁸⁷ The case has enabled courts to construe commercial speech overinclusively, thereby enjoining expression, like parody, even when the protections afforded to noncommercial and/or expressive speech should rightly apply.²⁸⁸

Since the *Gay Olympics* case, only a few cases have addressed the intersection between commercial speech classifications and trademark issues regarding offensive content, and each has reached highly instructive conclusions. The first of these cases involved a dispute concerning a restaurant named "Sambo's Restaurant."²⁸⁹ The mayor and city council members of Ann Arbor objected to the use of the name, and convinced the owners to change the name to "Jolly Tiger."²⁹⁰ The owners of the restaurant encountered significant losses under the new name, and eventually decided to bring back the old "Sambo's" moniker. The city later revoked their requests for sign permits on the grounds that they violated the previous agreement to give up use of the name.²⁹¹

In response, the restaurant owner decided to file suit on the grounds that the city unlawfully conditioned its permit on the relinquishment of its First Amendment rights. In its opinion, the Sixth Circuit mounted a stalwart defense of the restaurant owner's First Amendment rights, even though it characterized the sign as classic commercial speech. Although the court plainly recognized

286. See *supra* note 81; John V. Tait, Note, *Trademark Regulations and the Commercial Speech Doctrine: Focusing on the Regulatory Objective to Classify Speech for First Amendment Analysis*, 67 *FORDHAM L. REV.* 897, 898 (1998).

287. See Tushnet, *supra* note 236, at 746.

288. For greater discussion of parody cases and other examples of noncommercial speech, see *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359 (4th Cir. 2001); Kravitz, *supra* note 284. Other courts have carved out some areas of protection for parody and consumer commentary. See, e.g., *Lamparello v. Falwell*, 420 F.3d 309, 313 (4th Cir. 2005); *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 671 (9th Cir. 2005); *Taubman Co. v. Webfeats*, 319 F.3d 770, 775 (6th Cir. 2003). While I focus primarily on those cases involving disparagement and related issues below, there is a vast amount of literature on this problem in the context of parody, consumer commentary, and other noncommercial uses. See, e.g., Richard B. Biagi, *The Intersection of First Amendment Commercial Speech Analysis and the Federal Trademark Dilution Act: A Jurisprudential Roadmap*, 91 *TRADEMARK REP.* 867 (2001); Patrick D. Curran, Note, *Diluting the Commercial Speech Doctrine: "Noncommercial Use" and the Federal Trademark Dilution Act*, 71 *U. CHI. L. REV.* 1077 (2004); Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 *NOTRE DAME L. REV.* 397 (1990); Lemley & Volokh, *supra* note 263, at 220.

289. *Sambo's Rests., Inc. v. City of Ann Arbor*, 663 F.2d 686 (6th Cir. 1981).

290. *Id.* at 688.

291. *Id.* at 689.

that the term “Sambo’s” is “no more than a form of latent vilification,” it declined to categorize the speech as a “fighting word,” citing *Chaplinsky* for the proposition that the term did not tend to “incite an immediate breach of the peace.”²⁹² Nor, the court observed, did it constitute a form of “group libel,” noting that the constitutionality of group libel laws has been brought into question. Instead, the court noted that “[a]t least where obscenity is not involved, we have consistently held that the fact that protected speech may be offensive to some does not justify its suppression.”²⁹³ The court continued:

Ann Arbor contends that the use of the name “Sambo’s” to advertise a restaurant offends certain citizens and frustrates the City’s policy of racial harmony and equality. Plainly, racial harmony and equality is a substantial state interest. Significantly, however, the City has produced no evidence to demonstrate that the actual operation of the restaurant under the name “Sambo’s” has retarded or impeded achievement or furtherance of its goal or racial equality.²⁹⁴

In the end, the court sided with the restaurant owners, and issued an injunction preventing the City from revoking its sign permits. It decided that “even though exposure to the ‘Sambo’s’ signs may offend some citizens, the ability of the City ‘to shut off discourse solely to protect others from hearing it is dependent upon a showing that substantial privacy interests are being invaded in an essentially intolerable manner.’”²⁹⁵

Sambo’s is particularly instructive in helping the law set a baseline standard for its own involvement in the selection and protection of trademarks under federal law. It suggests, for example, that goals of “racial harmony and equality” may be powerful interests, and that a potential challenge to a particular trademark needs to make a stronger showing than simply that a sign might be offensive to some citizens. But it also suggests the need for a close nexus between the law and the asserted interest. Here, the absence of a linkage between the government decision to deny the sign permits, and the maintenance of racial harmony, informed the court’s decision to overturn the City. It also suggests that a lower standard of scrutiny does not apply when the regulation is “directed not at any commercial aspect of the prohibited advertising but at the ideas conveyed and form of expression—the core of First Amendment values,” suggesting the need for a higher degree of constitutional scrutiny.²⁹⁶

292. *Id.* at 694.

293. *Id.* at 695 (quoting *Carey v. Population Serv. Int’l*, 431 U.S. 678, 701 (1977)).

294. *Id.* (citing *Linmark Assoc., Inc v. Willingboro*, 431 U.S. 85, 94–95 (1977)).

295. *Id.* (quoting *Cohen v. California*, 403 U.S. 15, 21 (1971)).

296. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557, 578 (1980) (quoting *Carey v. Population Servs. Int’l*, 431 U.S. 678, 701 n.28 (1977)).

Other cases have adopted this view and similarly overturned classifications of commercial speech when they raise expressive concerns. Consider a famous case that considered the constitutionality of a federal law that banned alcohol labels from using the name CRAZY HORSE out of respect for the iconic Native American leader who had actually opposed the consumption of alcohol throughout his life.²⁹⁷ In that case, a district court adopted the finding of a magistrate judge who declared the statute to comprise an unconstitutional content-based regulation.²⁹⁸ The court characterized the CRAZY HORSE label as “indisputably commercial speech,” which meant that the government, in order to justify its legislation, would have to satisfy the *Central Hudson* test.²⁹⁹ Although the court found that the expression was protected by the First Amendment’s standards of commercial speech, the court held that the purpose of “protecting Native Americans from the offensive exploitation of a former Sioux leader’s name”³⁰⁰ was not a substantial interest, noting also that “the desire to protect society or certain numbers of society from the purported offensiveness of particular speech is not a substantial interest which justifies its prohibition.”³⁰¹

In support of its position, the court cited *Sambo’s*, finding that the government “did not have a substantial interest in prohibiting use of the name merely because it was offensive to some.”³⁰² While the use of the name might offend some citizens, the court noted, there was no tangible evidence to suggest that the sign would “sufficiently impede racial harmony or equality to justify suppression of protected commercial speech.”³⁰³ “If the only interest asserted by the government were its desire to abate or avert the perceived offensiveness of the Crazy Horse name, it would not constitute a substantial interest Indeed that is precisely the type of objective that is prohibited by the First

297. *Hornell Brewing Co. Inc. v. Brady*, 819 F. Supp. 1227 (E.D.N.Y. 1993). In 1992, Hornell Brewing Company introduced “The Original Crazy Horse Malt Liquor,” claiming that it was to be the inaugural product in a line of beverages that “celebrated” the American West. At the time, South Dakota Senator Larry Pressler asked for the company to either change its name or donate its proceeds to the Native American community on the grounds that “defamation of this hero is an insult to Indian culture.” *Id.* at 1230 (internal citation omitted). After negotiations between the company and Sioux leaders failed, however, Congress eventually enacted a statute that required the Bureau of Alcohol, Tobacco and Firearms to deny registration to any alcoholic beverage that bore the name Crazy Horse. *Id.* at 1229–31. See also Nell Jessup Newton, *Memory and Misrepresentation: Representing Crazy Horse*, 27 CONN. L. REV. 1003 (1995).

298. See *Hornell Brewing Co.*, 819 F. Supp. at 1228–29.

299. *Id.* at 1233 (citing the *Central Hudson* test).

300. *Id.* at 1234 (internal quotation marks omitted).

301. *Id.* (citing *Texas v. Johnson*, 491 U.S. 397, 399 (1989)).

302. *Id.* (citing *Sambo’s of Ohio, Inc. v. City Council of Toledo*, 466 F. Supp. 177, 180 (N.D. Ohio 1979)).

303. *Id.* (citing *Sambo’s Rests., Inc. v. City of Ann Arbor*, 663 F.2d 686, 695 (6th Cir. 1981)).

Amendment”³⁰⁴ The court then concluded that the statute was overbroad because it did not directly advance the goal of preventing alcohol consumption in the Native American community.³⁰⁵

A final case, not involving racial brands but rather indecent ones, explored the constitutionality of a beer label application that depicted a frog with four fingers, the middle one extending upwards.³⁰⁶ The New York State Liquor Authority rejected the application, and was affirmed by a lower court, which found a reasonable link between the decision and the state’s interest in protecting children from vulgar speech.³⁰⁷ Yet on appeal, the Second Circuit held that the decision was not meant to protect against commercial harms, but rather to censor a “sexually provocative confrontational gesture,” thus making the ban of such speech unconstitutional.³⁰⁸ Although it classified the speech as commercial,³⁰⁹ the Second Circuit found that the state’s prohibition of the label failed the third prong of *Central Hudson* (the need to advance a state interest) because the prohibition did little to insulate children from vulgar speech, observing that given “the wide currency of vulgar displays throughout contemporary society, . . . barring such displays from labels for alcoholic beverages cannot realistically be expected to reduce children’s exposure to such displays to any significant degree.”³¹⁰ The court observed, tellingly, that “a state must demonstrate that its commercial speech limitation is part of a substantial effort to advance a valid state interest, not merely the removal of a few grains of offensive sand from a beach of vulgarity.”³¹¹

III. GOVERNMENT AS SPONSOR IN THE MARKETPLACE OF IDEAS

Reading the prior Part, one might reach the seemingly inescapable conclusion that a scandalous or disparaging trademark must be classified as indisputably commercial speech, and any trademark restrictions against the content of a label, such as the ones detailed in this Article, might well follow in the direction of cases like *Bad Frog Brewery* (frog beer label), *Sambo’s Restaurant*, and *Hornell Brewing* (CRAZY HORSE beer label). These cases brazenly suggest precisely what

304. *Id.* at 1235.

305. *Id.* at 1236–37.

306. *Bad Frog Brewery, Inc. v. N.Y. State Liquor Auth.*, 134 F.3d 87, 90–91 (2d Cir. 1998); *see also* *Bad Frog Brewery, Inc. v. N.Y. State Liquor Auth.*, 973 F. Supp. 280, 281–82 (N.D.N.Y. 1997).

307. *Bad Frog Brewery*, 134 F.3d at 91–92.

308. *Id.* at 101.

309. *Id.* at 97 (“[T]he labels are a form of advertising, identify a specific product, and serve the economic interest of the speaker.”).

310. *Id.* at 98–100.

311. *Id.* at 100.

the REDSKINS logo, or AUNT JEMIMA long illustrated—that marks that seemingly originate from the marketplace of goods are often deeply evocative of the marketplace of ideas, and vice versa. Following Coase, if the government is proscribed from interfering with one, it must also be proscribed from interfering with the other. Under this view, and following from Nike’s position in *Kasky*, commercial speech is no less important than other types of speech; as Robert Post has eloquently observed, commercial advertisements deeply influence public discourse and often enable contentious articulations of collective identity.³¹² Thus, any abridgement of commercial speech risks chilling such discourse, and the community that may be affected by it.

Yet to reach such a conclusion, while certainly defensible, might be premature. As this Article has suggested, a trademark constitutes something more complicated than just a hybrid of commercial and expressive speech—it represents the intersection between them, which suggests that it can mean different things, depending upon the context in which it is perceived. Just as the law’s choice to regulate one affects the other, the law’s designation of commercial speech affects the marketplace of ideas, and, in turn, a designation of expressive speech affects the marketplace of goods. And while the prior Part articulated a Coasean view premised on noninterference, this Part argues that more recent jurisprudence from the Supreme Court suggests a more robust role for the state in regulating speech, through public subsidies. Along these lines, it is necessary for us to consider the observation—long overlooked by many scholars—that trademark registration on the Federal Register does not qualify as classic public fora, but rather constitutes nonpublic fora that allows for a greater degree of government regulation and intervention. Both the case law on speech subsidies and on nonpublic fora afford the government a wider degree of elasticity in regulating speech than most scholarship on trademarks has previously demonstrated. The final difference between the classic offensive speech cases and the trademark context, as I discuss further in Part IV, is that the remedy of cancellation does not prohibit *use* of the mark; it precludes federal registration and enforcement of trademark protection. Each of these elements suggests that a rush to a judgment of unconstitutionality would be an unduly simplistic move.

A. Tolerating Offensive Symbols

Traditional analyses from a First Amendment absolutist perspective might argue that the law must offer the same protection to disparaging and scandalous

312. See Post, *Constitutional Status*, *supra* note 187, at 11.

trademarks as all other expressions in order to avoid the spectre of content and viewpoint discrimination. The First Amendment requires neutrality, and therefore would proscribe the government from making determinations based on the perceived harm to either the general public or a particular segment of the public that is targeted or referenced by the mark. Under this traditional view, the “[g]overnment cannot, consistent with free speech, craft a policy of granting or withholding subsidies which is primarily ‘aimed at the suppression of dangerous ideas.’”³¹³ Within the marketplace of ideas, it is axiomatic that the government must tolerate even “offensive” or “outrageous” speech—that “the government cannot police the private speech market to ensure that expression is in good taste, decent, or not upsetting.”³¹⁴ The intended purpose of protecting the public from offensive speech also raises the risk of viewpoint discrimination.³¹⁵ As Leslie Jacobs explains:

[The State] cannot “forbid particular words” in public speech to “protect the sensitive” from a “distasteful mode of expression,” or even prohibit hate-motivated speech that may cause listeners extreme emotional distress. Because such “public sensitivity” standards would homogenize what should be a diverse offering of expression, the Constitution places the burden on those who dislike the speech to avoid it. That the government acts in response to the complaints of offended constituents—even a large number of them—does not justify restricting the unpopular speech.³¹⁶

These observations can also extend to commercial speech as well. In *Carey v. Population Services International*,³¹⁷ the Court held that if a regulation is “directed not at any commercial aspect of the prohibited advertising but at the ideas conveyed and form of expression,” a heightened standard of scrutiny may very well be applicable.³¹⁸ In other words, if the content is targeted for noncommercial reasons, it should still receive full First Amendment protection.

Carey’s intuition squarely conflicts with the *Gay Olympics* case, which wholly dismissed any concerns of censorship in the trademark context. Further, both cases are balanced by another cornerstone First Amendment principle regarding state subsidization. While the Court has long held that the government may not condition the receipt of a benefit on the surrender of free speech rights, it has also refused to force the government “to subsidize all forms

313. Alan Gutmacher *Inst. v. McPherson*, 616 F. Supp. 195, 205 (S.D.N.Y. 1985) (quoting *Cammarano v. United States*, 358 U.S. 498, 513 (1959)).

314. Leslie Gielow Jacobs, *The Public Sensibilities Forum*, 95 NW. U.L. REV. 1357, 1357 (2001).

315. *See id.* at 1385–87.

316. *Id.* at 1357–58 (footnotes omitted).

317. 431 U.S. 678 (1977).

318. *Id.* at 701 n.28.

of speech equally.”³¹⁹ The conflict between these two principles thus produces a point of constitutional ambiguity. Scandalous and disparaging marks, one might argue, occupy almost precisely the intersection between these two constitutional policies—one, illustrated by *Carey*, which favors a high degree of scrutiny for the high-value content within commercial speech, and another principle, represented by the *Gay Olympics* case, that empowers the government to regulate other types of lower value speech, like false or misleading commercial speech, or even some forms of indecent speech in advertising.

For some First Amendment scholars, section 2(a) echoes similar tensions surrounding an earlier debate over the proper role of the government in regulating campus speech codes. The governing jurisprudence on hate speech seemingly compels the conclusion that the Lanham Act provisions rest on shaky distinctions, long repudiated by a variety of federal courts, regarding both content and viewpoint. In *Doe v. University of Michigan*,³²⁰ for example, a federal district court rejected a campus hate speech code (which proscribed behavior and speech based on a variety of protected characteristics, including race), on grounds of overbreadth and vagueness.³²¹ In that case, the court observed that “the mere dissemination of ideas—no matter how offensive to good taste—on a state university campus may not be shut off in the name alone of conventions of decency.”³²² The federal court overturned the speech code on the grounds that its terms “elude[d] precise definition[s]” and failed to satisfactorily distinguish protected from unprotected speech, thus risking penalizing the former along with the latter.³²³

Following these cases, one might argue that the very same logic operates in the Lanham Act context of section 2(a). According to this view, the Lanham Act’s provisions fail to avoid the dangers of vagueness and overbreadth. In *R.A.V. v. City of St. Paul*,³²⁴ perhaps the culmination of this viewpoint, the Supreme Court rejected the constitutionality of a state statute that prohibited the display of a burning cross, swastika, or other symbol that one knows (or has reason to know) “arouses anger, alarm, or resentment in others” on the basis of race, color, creed, religion, or gender.³²⁵ In a stridently written opinion, the

319. *Alan Guttmacher Inst. v. McPherson*, 805 F.2d 1088 (2d Cir. 1986).

320. 721 F. Supp. 852 (E.D. Mich. 1989).

321. *Id.* (proscribing behavior that stigmatized or victimized an individual on the basis of race, ethnicity, religion, sex, or sexual orientation).

322. *Id.* at 864 (quoting *Papish v. Bd. of Curators of the Univ. of Mo.*, 410 U.S. 667, 670 (1973)) (internal quotation marks omitted).

323. *Id.* at 687. A similar fate befell other campus speech codes. See, e.g., *UWM Post, Inc. v. Bd. of Regents of the Univ. of Wis. Sys.*, 774 F. Supp. 1163 (E.D. Wis. 1991).

324. 505 U.S. 377 (1992).

325. See *id.*

Court rejected the proposition that the legislature could single out a subset of low-value speech for additional penalization. For example, “the government may proscribe libel,” the Court wrote, “but it may not make the further content discrimination of proscribing only libel critical of the government,” suggesting that statutes that draw distinctions on the basis of content and subject matter enjoy First Amendment protection from speech-related limitations.³²⁶

On the other hand, however, the *R.A.V.* Court recognized some areas where line-drawing is permitted on the basis of content. “When the basis for the content discrimination consists entirely of the very reason the entire class of speech at issue is proscribable,” the Court explained, “no significant danger of idea or viewpoint discrimination exists.”³²⁷ Thus, if the reason for the content discrimination is neutral enough to support exclusion of the entire class of speech, then the Court deemed that the same reason must also be “neutral enough to form the basis of distinction within the class.”³²⁸ This means, for example, that the legislature could prohibit obscenity that “involves the most lascivious displays of sexual activity” because the motivation for the content discrimination stems from the same reason for its regulation to begin with—namely, its prurient character.³²⁹ On the other hand, even if the speech is commercial, and therefore low-value speech, “a State may not prohibit only that commercial advertising that depicts men in a demeaning fashion.”³³⁰ The operable concern here, the Court suggested, is the carving out of an additional penalty for a specific viewpoint that is based on gender, rather than the focus on the commercial content generally. “The point of the First Amendment,” the Court wrote, “is that majority preferences must be expressed in some fashion other than silencing speech on the basis of content.”³³¹ After *R.A.V.*, in another cross-burning case, the Court allowed Virginia to outlaw cross burnings done with the intent to intimidate, on the grounds that cross burning is “a particularly virulent form of intimidation.”³³² The Court reasoned that *R.A.V.* held that “content discrimination does not violate the First Amendment when the basis for it consists entirely of the very reason its entire class of speech is proscribable,”³³³ suggesting that the intimidating nature of cross burning fell within an acceptable breadth of prohibition.

326. *Id.* at 384.

327. *Id.* at 388.

328. *Id.*

329. *Id.*

330. *Id.* at 389.

331. *Id.* at 392.

332. *Virginia v. Black*, 538 U.S. 343, 363 (2003).

333. *Id.* at 344–45.

Taken at face value, *R.A.V.* might suggest that section 2(a)'s speech abridgements illegitimately target a subset of a category of commercial speech on the basis of its offensive, scandalous, or disparaging content. At least one circuit court has reached a similar conclusion in the context of a case involving the constitutionality of antiharassment guidelines at a public school.³³⁴ In that case, written by Judge (now Justice) Alito, the court found that the guidelines were unconstitutionally overbroad because they proscribed—simply—harassment, defining it to include both conduct and pure expression (words and images). Although he noted that the Supreme Court has never directly addressed the question of whether pure expression constituting harassment can be constitutionally regulated,³³⁵ Alito observed that the Court has never allowed the government to ban offensive speech based solely on its emotive impact without some showing of other types of secondary effects, noting “[t]here is no categorical ‘harassment exception’ to the First Amendment’s free speech clause.”³³⁶ Comparing the school’s guidelines to the statute at issue in *R.A.V.*, the court concluded that “[l]oosely worded anti-harassment laws may pose some of the same problems” of impermissibly regulating deeply offensive and disruptive categories of speech based on subject matter and viewpoint.³³⁷ Recognizing that the Supreme Court has not dealt yet with whether harassing (yet purely expressive content) can be regulated under the First Amendment, Alito cited, approvingly, a Fifth Circuit case that observed: “‘Where pure expression is involved,’ anti-discrimination law ‘steers into the territory of the First Amendment.’”³³⁸

The Third Circuit case thus clearly suggests an array of challenges for section 2(a) on the grounds of content discrimination, viewpoint discrimination, and overbreadth. The argument is disarmingly simple: Both regulations of scandalous and disparaging trademarks target speech based on content, as well as viewpoint, and thus cannot survive First Amendment scrutiny. Yet if we look closer, there are a number of crucial differences that must be drawn among hate speech, fighting words, and trademarks. First, hate speech and fighting words involve purely private speech, whereas trademarks also involve some

334. See *Saxe v. State Coll. Area Sch. Dist.*, 240 F.3d 200 (3d Cir. 2001).

335. *Id.* at 207 (citing *Weller v. Citation Oil & Gas Corp.*, 84 F.3d 191, 195 n.6 (5th Cir. 1996) (noting that the Court has “provid[ed] little guidance [concerning] whether conduct targeted for its expressive content . . . may be regulated under Title VII”).

336. *Id.* at 209 (quoting *Boos v. Barry*, 485 U.S. 312, 321 (1988) (“The emotive impact of speech on its audience is not a ‘secondary effect’ [deserving of regulation].”).

337. *Id.* at 207.

338. *Id.* at 206 (quoting *DeAngelis v. El Paso Mun. Police Officers Ass’n*, 51 F.3d 591, 596 (5th Cir. 1995)) (noting that when antidiscrimination laws are applied to harassment based purely on verbal insults, pictorial, or literary matter, they impose content- and viewpoint-based discrimination).

commercial speech, which is suffused with greater government regulation and oversight. This characteristic offers a greater role for the state in regulating speech in the marketplace of goods. In the context of commercial speech, for example, prior restraints are allowed, and rules on vagueness and overbreadth have less salience, as a formal matter.³³⁹

Second, it is important to note another key difference from *R.A.V.*: The use of the term disparaging (or even scandalous) in trademarks is not tethered to the context of specific categories like race, gender, religion, or sexual orientation. One widely respected First Amendment scholar, Elena Kagan, has suggested that hate speech regulations that fail to single out a particular group for protected status may survive the reach of *R.A.V.*³⁴⁰ In fact, at least one circuit court has reached this view. In a case that involved state advertising guidelines that prohibited demeaning or disparaging ads (when it had previously singled out specific groups for protection), the First Circuit found that the classifications survived First Amendment scrutiny.³⁴¹ The *R.A.V.* problem, the court said, exists “where the individual or group that is prevented from speaking is not itself an object of protection under the classifications given in a statute or regulation.”³⁴² Here, even though “[s]ome kinds of content (demeaning and disparaging remarks) are being disfavored,” the court explained, “no viewpoint is being preferred over another.”³⁴³ Since the state was “not attempting to give one group an advantage over another in the marketplace of ideas,” the court found no evidence of viewpoint discrimination.³⁴⁴ In this sense, the court insisted that it was not tilting the playing field in favor of one party over another, recalling the Supreme Court’s observation in *R.A.V.* that a city could not “license one side of a debate to fight freestyle, while requiring the other to follow Marquis of Queensberry rules.”³⁴⁵

339. See DANIEL A. FARBER, *THE FIRST AMENDMENT* 160 (2d ed. 2003).

340. See Elena Kagan, *Regulation of Hate Speech and Pornography after R.A.V.*, 60 U. CHI. L. REV. 873, 877, 889 (1993).

341. See *Ridley v. Mass. Bay Transp. Auth.*, 390 F.3d 65, 91 (1st Cir. 2004). After *R.A.V.*, the Massachusetts Bay Transit Authority (MBTA) rewrote those guidelines to prohibit the placement of advertising that is “demeaning or disparaging,” using the standard of “whether a reasonably prudent person . . . would believe that the advertisement contains material that ridicules or mocks, is abusive or hostile to, or debases the dignity or stature of, an individual or group of individuals.” *Id.* at 75 (quoting the MBTA’s 2003 advertising guidelines).

342. *Id.* at 91 n.11.

343. *Id.* at 91.

344. *Id.* (citing Kagan, *supra* note 340, at 889).

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

B. The Public Label and the (Non)Public Forum

The differences between the marketplaces of goods and of ideas can be summed up by focusing on the role of the government: In the former context, consumers readily expect—and deserve—a higher degree of regulation; and in the latter context, they demand precisely the opposite. Yet trademarks, again, fall uncomfortably between these two polarities because they constitute the private expression of a corporation but in a context that is conspicuously subject to a higher degree of intervention because of its commercial nature. As a result, there is a deep underlying conflict between how to classify trademarks, and whether they constitute entirely private speech, government-sponsored speech, or something in between. While trademarks, brands, and advertising represent privately owned commodities, it is also clear that the government acts to subsidize this form of private speech, just as it does with other public goods, in some manner through federal registration.³⁴⁶ This tension—between purely private speech and government-supported speech—also informs the degree of constitutional scrutiny that trademarks face in governing the expressive functions of trademarks in the public sphere. It is important to recognize that, to some extent, it is often hard to tell whether speech is purely private or purely governmental—in most cases, such speech exists along a sort of indeterminate continuum that results in significant constitutional confusion.³⁴⁷

The question over whether section 2(a) can survive either strict or intermediate scrutiny animates a central, preexisting divide between private and government speech. The *Sambo's* view would classify trademarks as private speech—private properties that constitute the expression of corporations, and which should be protected from aggressive constitutional intervention or oversight except when necessary to protect the consumer from false or misleading information. As Robert Post has reminded us, when the state tries to restrict private citizens' contributions to public discourse, even if they are subsidized, the First Amendment's prohibitions against content and viewpoint discrimination will apply.³⁴⁸ Given this context, the government “can not [sic] place conditions on its granting of public benefits or subsidies that cause the recipient to surrender

346. See Jacobs, *supra* note 314, at 1367.

347. See Caroline Mala Corbin, *Mixed Speech: When Speech Is Both Private and Governmental*, 83 N.Y.U. L. REV. 605, 607 (2008).

348. See Post, *Subsidized Speech*, *supra* note 187, at 155; see also Kathleen M. Sullivan, *Unconstitutional Conditions*, 102 HARV. L. REV. 1413, 1499–1500 (1989).

vital constitutional rights, even if the government has no obligation to provide the benefit and thus could withhold it altogether.”³⁴⁹

In the case of *Perry v. Sindermann*,³⁵⁰ an unconstitutional conditions case involving the firing of a public schoolteacher due to his outspoken criticism, the Court held that even though a person has no right to a valuable government benefit, the state cannot “deny a benefit to a person on a basis that infringes his constitutionally protected interests—especially, his interest in freedom of speech.”³⁵¹ *Perry* led to the observation that a court cannot produce a result, indirectly, that it could not command directly.³⁵² The question had historically focused on whether or not the government policy was related to the suppression of dangerous ideas—the closer the nexus, the more likely the Court has found the policy to be unconstitutional. In other cases, applying this view in other contexts of political speech, the Court has overturned FCC conditions against editorializing in providing grants because the limitation seemed motivated in part by a desire to “limit discussion of controversial topics” and to “shape the agenda for public debate.”³⁵³

These cases suggest a high degree of scrutiny for regulations that impinge on classic political or expressive speech. In 1991, extending this trend, the Supreme Court, in a unanimous opinion, handed down a case involving a state statute called a “Son of Sam” law that required that income derived from an accused criminal’s description of the event be deposited in an escrow account.³⁵⁴ The proceeds were then turned over to the victims of crime and the criminal’s other creditors. The Court overturned the statute under the First Amendment, holding that statutes that imposed a financial, content-based burden on

349. *Alliance for Open Soc’y Int’l v. USAID*, 430 F. Supp. 2d 222, 252 (S.D.N.Y. 2006). The central case, *Speiser v. Randall*, 357 U.S. 513 (1958), concerned a case that invalidated a tax exemption for veterans because it conditioned the exemption on the requirement that they agree to never advocate against the government during wartime. *But see* *Regan v. Taxation With Representation of Wash.*, 461 U.S. 540, 549 (1983) (“[A] legislature’s decision not to subsidize the exercise of a fundamental right does not infringe the right, and thus is not subject to strict scrutiny.”).

350. 408 U.S. 593 (1972).

351. *Id.* at 597. Elsewhere, the Court has observed that “[u]nder some circumstances, indirect ‘discouragements’ undoubtedly have the same coercive effect upon the exercise of First Amendment rights as imprisonment, fines, injunctions or taxes.” *Am. Commc’ns Ass’n v. Douds*, 339 U.S. 382, 402 (1950); *see also Perry*, 408 U.S. at 597; MELVILLE B. NIMMER, NIMMER ON FREEDOM OF SPEECH §§ 4.07–4.08 (1984) (arguing that abridgements, discouragements, or even the removal of a “basic incentive” to engage in speech is invalid under unconstitutional conditions doctrine) (quoting *Williams v. Rhodes*, 393 U.S. 23, 41 (1968) (Harlan, J., concurring)).

352. *Perry*, 408 U.S. at 597 (quoting *Speiser*, 357 U.S. at 527).

353. *See FCC v. League of Women Voters of Cal.*, 468 U.S. 364, 366, 384 (1984) (rejecting FCC’s conditioning of federal grants on the grounds that grantees agree not to “engage in editorializing”) (quoting 47 U.S.C. § 399 (1981)).

354. *See Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105, 108 (1991).

speakers were “presumptively inconsistent with the First Amendment.”³⁵⁵ It likened the statute to a previous case involving a content-based magazine tax, noting that the government’s ability to impose financial regulation could “effectively drive certain ideas or viewpoints from the marketplace.”³⁵⁶ It made no difference to the Court that the financial regulations were indirect, instead of direct: “While the Son of Sam law escrows all of the speaker’s speech-derived income . . . rather than taxing a percentage of it outright, this difference can hardly serve as the basis for disparate treatment under the First Amendment,” the Court concluded, noting that both forms of regulation operated as financial disincentives to speak.³⁵⁷ While the Court concluded that the state had a compelling interest in compensating victims from the fruits of criminal activity, it had little interest in limiting the compensation only to the proceeds of the accused criminal’s speech about the crime.³⁵⁸ It then concluded that the regulation was not narrowly tailored to achieve the former interest, and overturned the law under the First Amendment.³⁵⁹

Applying the Son of Sam case to section 2(a), Jeffrey Lefstin concluded that like the Son of Sam law, section 2(a)’s prohibition on registration imposes a similarly improper financial disincentive to the use of such marks in commercial communication.³⁶⁰ Lefstin explains that the difference between the statutes is not significant for First Amendment purposes, even though section 2(a) of the Lanham Act denies the mark holder the government-protected right to enjoy exclusive use of the mark in commerce (as opposed to the Son of Sam law’s denial of the right to profit from authorial activity). Lefstin continues:

In practice, a criminal’s right to royalties generated by his or her memoirs arises only by virtue of another exclusive right granted by the government: the copyright. . . . It seems highly unlikely that the Simon & Schuster court would have upheld a statute that denied copyright to works of criminals, or assigned the copyright in such works to their victims: Such laws would impose the same financial disincentive based on content that the “Son of Sam” law did. Since denial of federal registration reduces the economic value of a trademark, just as denial of copyright would reduce the economic value of a lurid crime memoir, section 2(a) places a financial burden on scandalous and disparaging trademarks on the basis of their content.³⁶¹

355. *Id.* at 115.

356. *Id.* at 115–16.

357. *Id.* at 116–17.

358. *Id.* at 120–21.

359. *Id.* at 121–23.

360. See Lefstin, *supra* note 50, at 678–79.

361. *Id.*

Lefstin's argument is certainly compelling. But the analogy to copyright protection seems to overlook the very different character and purpose of trademark regulation and registration, which involves the smooth functioning of commerce, rather than a stimulation of creativity and commentary. In the context of section 2(a), the Court is addressing a body of commercial speech, not political speech, and thus the government's interests may differ. In the trademark context, the government's protection of the mark serves a variety of interests that stem from commercial regulation, which traditionally has afforded the government a much wider berth of interests in crafting its own associations.³⁶² Even aside from the distinction between commercial and noncommercial speech, one might plausibly argue that the motive for the "Son of Sam" law was to impose a financial burden on authors; whereas the motive for section 2(a), as the Federal Circuit has suggested, is that Congress has deemed such marks undeserving of the time, services, and funds of the federal government.³⁶³

More recently, the Supreme Court has offered some support for this view by enlarging the concept of government speech in extending a wide elasticity for the state in crafting expressive subsidies. The Supreme Court has plainly observed that when the state is speaking, it may make content-based choices, even if it enlists private entities to convey its message.³⁶⁴ The touchstone case of *Rust v. Sullivan*³⁶⁵ involved the prohibition of family planning funds to entities that provided abortion counseling. As controversial as the outcome has been, the holding strongly reaffirmed the concept that the government is not engaging in viewpoint discrimination when it decides how to spend its money, or when it "use[s] private speakers to transmit specific information pertaining to its own program."³⁶⁶ *Rust*, the Court said, did not involve the "singling out [of] a disfavored group on the basis of speech content, but [constituted instead] a case

362. See, e.g., Lanham Act § 45, 15 U.S.C. § 1127 (2006):

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

See also Ramsey, *supra* note 206, at 422–23 (discussing articulated reasons for trademark regulation).

363. *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994).

364. See *Rosenberger v. Rector & Visitors of the Univ. of Va.*, 515 U.S. 819, 833 (1995).

365. 500 U.S. 173 (1991).

366. *Rosenberger*, 515 U.S. at 833; see also *Legal Servs. v. Velazquez*, 531 U.S. 533, 541 (2001); *Rust*, 500 U.S. at 178–81.

of the Government refusing to fund activities, including speech, which are specifically excluded from the scope of the project funded.”³⁶⁷

One might argue, therefore, that the enlargement of the contours of government speech has radically shrunk the boundaries of the unconstitutional conditions doctrine, with significant results for the constitutionality of section 2(a). When the government speaks on its own, the reasoning suggests, the law has afforded the government a very broad degree of discretion in deciding what it wants to say. It can craft public sensibilities, favor different types of speech—“it can discriminate in its own speech against unpopular ideas or modes of expression that are constitutionally protected when privately uttered.”³⁶⁸ This is, in part, why the Court upheld a variety of antiabortion speech restrictions that flowed from family planning subsidies in *Rust* and defended filtering restrictions regarding its funding for public libraries.³⁶⁹ The case law continues to grow.³⁷⁰ Of course, the most distinctive case illustrating this view is the notorious *National Endowments for the Arts v. Finley*³⁷¹ case, which upheld a “decency and respect” clause in the context of arts funding.³⁷²

These cases suggest an overlooked vantage point, again flowing from the intersection of government and private speech, that sheds important light on how one might potentially resituate section 2(a) within the context of government-sponsored subsidies in different fora, such as the marketplace of goods, rather than just the marketplace of ideas. Conventional wisdom among legal

367. *Rust*, 500 U.S. at 194–95. The Court offered a further nuance to its view of government speech in a later case, *Rosenberger*, that observed that when the government is speaking or subsidizing a particular message, as it had in *Rust*, it can engage in content and viewpoint discrimination—but if the government is offering funds to “encourage a diversity of views from private speakers,” it could not discriminate based on viewpoint. See Harold B. Walther, Note, *National Endowment for the Arts v. Finley: Sinking Deeper Into the Abyss of the Supreme Court’s Unintelligible Modern Unconstitutional Conditions Doctrine*, 59 MD. L. REV. 225, 236–37 (2000) (discussing and quoting *Rosenberger*).

368. Jacobs, *supra* note 314, at 1358.

369. *United States v. Am. Library Ass’n Inc.*, 539 U.S. 194 (2003).

370. See Randall P. Bezanson, *The Manner of Government Speech*, 87 DENV. U. L. REV. (forthcoming 2010), available at <http://papers.ssrn.com/sol3/papers.cfm?abstractid=1555042##>; MALLA POLLACK, *Governmental Marks: What Souvenirs Say About Speech and Sovereignty*, SELECTED WORKS OF MALLA POLLACK 11 n.38 (Dec. 14, 2009), http://works.bepress.com/malla_pollack/44. Along similar lines, as Leslie Jacobs has pointed out, the Supreme Court has classified a broad range of activities as government speech: (a) when the government finances private speakers as its agents pursuant to a chosen public policy; (b) where it acts as an editor in selecting private speech for a publication; (c) where it decides to fund projects according to government-designed standards of excellence; or, (d) perhaps most prominently, when it opted to institute a provision in the National Endowment for the Arts funding clause instructing it to consider whether the art is “decen[t]” and “respect[s] [the] values of the American public.” Jacobs, *supra* note 314, at 1359 (quoting *Nat’l Endowment for the Arts v. Finley*, 524 U.S. 569, 576 (1998)). See generally Erwin Chemerinsky, *The First Amendment: When the Government Must Make Content-Based Choices*, 42 CLEV. ST. L. REV. 199 (1994).

371. 524 U.S. 569.

372. *Id.* at 580–88.

scholars tends to frame section 2(a) as a matter of government encroachment into the private domain of intellectual property rights.³⁷³ Yet the boundaries of *Rust* and *Finley* suggest that rather than classifying section 2(a) as a purely private matter, it might be more prudent to consider, not just the private property in question, but the role of the federal government, and its concomitant interest, in registering trademarks. The result of situating section 2(a) in this context, in short, changes the nature of the inquiry, suggesting that trademarks constitute something more prone to regulation than other types of private properties, but something that constitutes less than pure government speech. Again, rather than occupying one of the two categories of government and private speech, trademarks inhabit the intersection between them.

Constitutional law, of course, has already recognized this possibility by crafting a special classification for increased speech regulation in the form of a nonpublic forum.³⁷⁴ This category of speech may be distinguished from two other categories (public forum and designated public forum) and enable a greater degree of breadth for government regulation of speech.³⁷⁵ The third option, the nonpublic forum, involves situations where the government permits—and selects—some forms of speech on government property. In a nonpublic forum, the government *creates* a private speech forum, enabling it to have slightly more leeway to discriminate against certain types of speech (so long as the regulations are reasonable and viewpoint-neutral), more so than it would if it were regulating purely private speech.³⁷⁶ In these situations, the government can exclude speakers on the basis of their subject matter, so long as the distinctions drawn are viewpoint-neutral and reasonable in light of the purpose served by the forum. According to one expert:

In a wide range of situations that do not constitute government speech, governments have created opportunities for private speakers to gain access to public property or funds and have conditioned access on standards such as the speech being in good taste, decent, not controversial, or not

373. See generally Lefstin, *supra* note 50.

374. First Amendment law recognizes three types of fora: (1) the traditional public forum; (2) the public forum created by government designation; and (3) the nonpublic forum. *Cornelius v. NAACP Legal Def. & Educ. Fund*, 473 U.S. 788, 802 (1985). Further, the Court recently noted that in a nonpublic forum, the government may exclude speakers so long as the restriction is viewpoint-neutral and reasonable. *Davenport v. Wash. Educ. Ass'n*, 551 U.S. 177, 189 (2007).

375. Purely public fora, for example, constitute areas like public streets and parks, and are traditionally devoted to assembly and debate. A second category, called a designated public forum, is defined as “public property which the State has opened for use by the public as a place for expressive activity”—in other words, inviting some diversity of viewpoints and expression, and thereby triggering strict scrutiny of any restrictions on speech. *Perry Educ. Ass'n v. Perry Local Educators Ass'n*, 460 U.S. 37, 45 (1983).

376. See Jacobs, *supra* note 314, at 1359–60.

offensive. Often the standards forbid specific types of speech, such as those which pertains [sic] to sexual conduct, are derogatory to particular groups, disparage a deity, or relate to an intoxicating substance.³⁷⁷

In these situations, “the government opens a speech opportunity to applicants without intending to send a message of its own. Instead, the intent and appearance of the speech opportunity is as a ‘forum’ where private speakers, not the government, are accountable for the content of the expression.”³⁷⁸

In fact, in a related issue involving regulation of advertising, the Supreme Court has offered a stalwart defense of content-based regulations in municipal property in the 1974 case of *Lehman v. City of Shaker Heights*.³⁷⁹ The city proscribed ads on its transportation that were “false, misleading, deceptive and/or offensive to the moral standards of the community, or contrary to good taste,” and certain types of political advertisements.³⁸⁰ The Court stalwartly defended the right of a city transit system to opt against political advertising, arguing that a city had the right to make reasonable choices concerning the type of advertising it chose to display, largely due to concerns of audience captivity, so long as its choices were not “arbitrary, capricious or invidious.”³⁸¹ The Court explained the city’s choices in terms of “managerial discretion,” arguing that the decision to limit space to “innocuous and less controversial commercial and service oriented advertising does not rise to the dignity of a First Amendment violation.”³⁸² In a memorable line, the Court wrote, “[w]ere we to hold to the contrary, display cases in public hospitals, libraries, office buildings, military compounds, and other public facilities would immediately become Hyde Parks open to every would-be pamphleteer and politician.”³⁸³

The facts in *Lehman* suggest that if the state is acting as proprietor, it has the right to engage in certain types of content discrimination. Other courts have reached similar conclusions, noting that concerns for a “captive audience”

377. *Id.* at 1360–61 (internal footnotes omitted).

378. *Id.* at 1376. In these cases, sometimes arising in the Establishment Clause context, the courts focus largely on the question of the degree of government involvement in crafting the message. See Abner S. Greene, *The Political Balance of the Religion Clauses*, 102 YALE L.J. 1611 (1993). Concerns have also been articulated to embrace “the degree of government “entanglement” in the message; whether it is “lending support” to the message at issue; and the degree to which a “reasonable observer” might attribute the message, despite the speaker’s identity, to the government. See Andy G. Olree, *Identifying Government Speech*, 42 CONN. L. REV. 365, 378 (2009). These determinations suggest, at the very least, that the binary between public and private speech can become so blurred, particularly in the trademark context, that a nonpublic regime between public and private becomes necessary.

379. 418 U.S. 298 (1974).

380. *Id.* at 300 n.1 (quoting Metromedia’s Metro Transit Advertising Copy Policy).

381. *Id.* at 303.

382. *Id.* at 304.

383. *Id.*

have legitimated advertising considerations involving good taste, decency, and community standards,³⁸⁴ and upholding prohibitions on advertising that may be demeaning or disparaging, among other categories against profane, obscene, or infringing content.³⁸⁵ In these cases, the finding that the advertising space constitutes a nonpublic forum is essential to the defense of such content-based regulations.³⁸⁶ Because the government is acting in a proprietary capacity, courts have afforded the government much more leeway in a nonpublic forum, but at times have required greater consistency in the application of these directives.³⁸⁷

C. Application: The Case of Vanity Plates

The nonpublic fora analysis suggests some pause in resituating section 2(a), not as a purely illegal encroachment on speech, but instead as part and parcel of a range of situations where the government has expressed reservations about subsidizing harmful, disparaging, or scandalous speech in similar contexts. The above cases suggest that if the trademark register is classified as a nonpublic forum, then the applicable standard for judging section 2(a) involves one of reasonableness and viewpoint-neutrality.³⁸⁸ In such circumstances, courts have readily upheld the government's ability to restrict certain forms of speech based on content. To determine whether a nonpublic fora has been created, courts turn to a variety of considerations, including (1) the government's standards for inclusion and exclusion in the forum, and their accompanying policies, both in

384. See *Children of the Rosary v. City of Phoenix*, 154 F.3d 972, 976 (9th Cir. 1998) (noting that the city did not open a public forum for advertising on its buses); *Lehman*, 418 U.S. at 302 (citing cases); Jacobs, *supra* note 314, at 1381–82 (citing cases).

385. See *Ridley v. Mass. Bay Transp. Auth.*, 390 F.3d 65, 75 n.2 (1st Cir. 2004); *Children of the Rosary*, 154 F.3d at 976, 982 (finding a city's advertising to be a nonpublic forum and upholding restrictions on political and religious advertising); see also *Johanns v. Livestock Mktg. Ass'n*, 544 U.S. 550, 562 (2005) (classifying the beef industry's promotional messages as government speech even though nongovernmental agencies were involved); *Pittsburgh League of Young Voters Educ. Fund*, No 2:06-cv-1064, 2008 WL 4965855 at *8 (W.D. Pa. Aug. 14, 2008).

386. *Ridley*, 390 F.3d at 82.

387. Jacobs, *supra* note 314, at 1383–84. At times, a showing of inconsistency in applying content-based regulations has transformed the forum from a “limited public forum,” requiring only a showing of reasonableness, to a “designated public forum,” which is subject to strict scrutiny. See *Hopper v. City of Pasco*, 241 F.3d 1067, 1079–81 (9th Cir. 2001) (holding that the exclusion of an artist under a regulation against “controversial” displays rendered City Hall a “designated public forum” rather than a “limited public forum” due to inconsistent application); see also *AIDS Action Comm. of Mass., Inc. v. Mass. Bay Transp. Auth.*, 42 F.3d 1, 12 (1st Cir. 1994) (requiring a transit authority to accept condom awareness advertisements despite its prohibition against “sexually explicit” or “patently offensive” material, on the grounds of inconsistency); *Christ's Bride Ministries, Inc. v. Se. Pa. Transp. Auth.*, 148 F.3d 242 (3d Cir. 1998) (noting that a rule against “controversial” advertising was trumped by inconsistency, creating a designated public forum); *Planned Parenthood Ass'n/Chi. Area v. Chi. Transit Auth.*, 767 F.2d 1225 (7th Cir. 1985) (finding the same, despite regulations against “vulgar,” “immoral” advertising).

388. See *Perry v. McDonald*, 280 F.3d 159, 167 (2d Cir. 2001).

writing and in practice; (2) the definiteness of those standards, and whether they are objective; (3) the risk of arbitrariness in their application; (4) the degree of selectivity, as applied, regarding access or admission to the forum; and (5) the principal function of the forum itself.³⁸⁹

Even outside of the situation in *Lehman*, however, where the city acts in its proprietary capacity, the nonpublic forum doctrine has also extended beyond into other forms of private speech when they are suffused with the government's role as regulator or licensor. Consider, for example, the special case of vanity license plate programs, which often raise similar considerations to those surrounding section 2(a) about viewpoint discrimination in the public-private forum context.³⁹⁰ Unlike the standard-issue license plate, which is generally considered to be government speech because it is used primarily for identification purposes,³⁹¹ a vanity plate allows a person, for an extra fee, to choose a particular configuration of letters and numerals, subject to a typical state standard that prohibits plates "that may carry connotations offensive to good taste and decency, or which could be misleading."³⁹² Other state restrictions proscribe "vulgar," "profane," "obscene," "repulsive," "misleading," "ethnically degrading," "offensive messages," or those that have "a negative connotation to a specific group."³⁹³ Conflicts are usually referred to a panel of administrators, or the DMV may have a list of previously proscribed examples to aid in its determination.³⁹⁴ Even after the plates are issued, however, citizens may complain and compel the DMV to decide whether or not to recall the plates, giving rise to some risk of a "heckler's veto."³⁹⁵

Cases on vanity plates—and this is particularly instructive for the trademark context—lean heavily in favor of considering vanity license plates

389. See *Hopper*, 241 F.3d at 1077–78 (outlining these factors).

390. See Corbin, *supra* note 347, at 607; Leslie Jacobs, *Free Speech and the Limits of Legislative Discretion*, 53 FLA. L. REV. 419, 424–41 (2001); Jacobs, *supra* note 314, at 1377; Amy Riley Lucas, *Specialty License Plates: The First Amendment and the Intersection of Government Speech and Public Forum Doctrines*, 55 UCLA L. REV. 1971, 2007–19 (2008). Note that here my analysis concentrates mostly on vanity plate programs, which involve an individual person's message, rather than other types of license plate programs, such as specialty plates (which tend to raise a greater degree of government activity due to the role of the legislature in selecting organizations) or non-vanity plates (which also tend to suggest standard government speech since the government selects the actual plate).

391. See Jeremy T. Berry, *Licensing a Choice: "Choose Life" Specialty License Plates and Their Constitutional Implications*, 51 EMORY L.J. 1605, 1623 (2002).

392. Jacobs, *supra* note 314, at 1377 (citing CAL. VEH. CODE § 5105 (West 1987)).

393. See *Dimmick v. Quigley*, No. C 96-3987 SL, 1998 WL 34077216, at *4 (N.D. Cal. July 13, 1998) (citing CAL. CODE REGS. Tit. 19, § 170 (1997)) (barring plates on these grounds).

394. Jacobs, *supra* note 314, at 1377–78.

395. *Id.* at 1377, 1424.

a nonpublic fora.³⁹⁶ The Second Circuit, for example, upheld speech-based restrictions in a vanity license plate case that bore the letters “SHTHPNS,” which suggested a profane observation.³⁹⁷ The restriction empowered the DMV to refuse plates “that might be offensive or confusing to the general public.”³⁹⁸ There, the court categorized the vanity license plate system as a nonpublic forum, pointing out the wide range of expressive restrictions on license plates, and drawing parallels to government-instituted editorial restrictions on the speech of federal employees.³⁹⁹ It chose, therefore, to examine the constitutionality of the restriction on the grounds of reasonableness and viewpoint neutrality, noting that the interests—(1) protecting the public from offensive and indecent speech, and (2) not associating the state with such speech—satisfied the test of reasonableness.⁴⁰⁰ The court continued:

Vermont’s restriction on scatological terms—what the Vermont statute describes as “offensive”—reasonably serves legitimate governmental interests. Automobile license plates are governmental property . . . and inevitably they will be associated with the state that issues them. Although the owner of a vehicle chooses the characters that appear on a vanity plate, the Vermont DMV must approve of a vanity plate before issuing it. The state has a legitimate interest in not communicating the message that it approves of the public display of offensive scatological terms on state license plates.⁴⁰¹

The court concluded by observing that the state has an interest in avoiding the display of offensive terms on state license plates.⁴⁰² Since the driver was free to use a bumper sticker saying the same thing, the court concluded that “[the] policy is . . . reasonably ‘directed not to suppressing, but to *disassociating* the [state] from, [plaintiff’s] speech.’”⁴⁰³ On the issue of viewpoint neutrality, the court

396. See Berry, *supra* note 391, at 1628 n.172 (citing *Perry v. McDonald*, 280 F.3d 159, 168 (2d Cir. 2001)) (classifying a vanity plate as a nonpublic forum, but noting that they “are a highly limited and extremely constrained means of expression” due to state involvement); *Pruitt v. Wilder*, 840 F. Supp. 414, 417 n.2 (E.D. Va. 1994) (same); *Kahn v. Dep’t of Motor Vehicles*, 20 Cal. Rptr. 2d 6, 10 (Ct. App. 1993) (same); *Higgins v. Driver & Motor Vehicle Servs. Branch*, 13 P.3d 531, 537 (Or. Ct. App. 2000) (en banc) (same). *But see* *Lewis v. Wilson*, 253 F.3d 1077, 1079 (8th Cir. 2001) (expressing doubt about categorizing a vanity license plate as a nonpublic forum because of its similarity to a bumper sticker with a political message).

397. *Perry*, 280 F.3d at 163; *see also Higgins*, 13 P.3d at 537–38 (adopting similar analysis).

398. *Perry*, 280 F.3d at 164 (quoting VT. STAT. ANN. Tit. 23, § 304(d) (2000) (amended 2004)).

399. *Id.* at 167–69 (citing *Cornelius v. NAACP Legal Def. & Educ. Fund*, 473 U.S. 788, 804–05 (1985)).

400. *Id.* at 169–70.

401. *Id.* at 169.

402. *Id.* at 172–73.

403. *Id.* at 170 (quoting *General Media Commc’ns, Inc. v. Cohen*, 131 F.3d 273, 281 n.10 (2d Cir. 1997)) (emphasis added) (second alteration in original).

emphatically rejected the proposition that the regulation was directed at the plaintiff's philosophical views—noting that the use of the term “offensive” did not bar a particular viewpoint.⁴⁰⁴ Other cases have agreed with this view, noting that a vanity plate's restrictions “do not involve a fundamental right or suspect classification, [and therefore] equal protection analysis affords government bodies broad discretion in pursuing legitimate governmental interests,” enabling the state to reject messages that may be offensive or carry sexual connotations.⁴⁰⁵

There are several marked similarities between vanity plates and trademarks. Like the trademark context, which closely associates a logo with its private source, it would be unusual for someone to seriously associate the speech on a personalized vanity plate with the government's own voice. Here, the expression, like a logo or mark, is directly attributable to the private party, but, like the vanity license plate, the speech is still registered or regulated, in some part, by the government. Like a trademark, a vanity plate serves both source-identifying and expressive functions, because the plate can constitute the personalized and private expression of an individual, even though the medium may be government-issued. The Principal Register, then, like a state license plate registry, is more like a federal forum or property that entrusts the PTO with the gatekeeping responsibility to manage access to the system of state-enforced trademark protection.⁴⁰⁶

Second, the government's role in these areas is also analogous in some respects. Registration in both the trademark and license plate contexts is typically regulated by the government, whether it involves the trademarking of particular goods in commerce, or automobile transportation, thus suggesting a greater degree of expressive association between the activity and the government's regulation. Indeed, in one of the few cases to address the issue, *In re McGinley*,⁴⁰⁷ the Court of Customs and Claims Appeals held that section 2(a)'s

404. *Id.*

405. Jacobs, *supra* note 314, at 1380 (quoting *McMahon v. Iowa Dep't of Transp.*, 522 N.W.2d 51, 56 (Iowa 1994)). Case law reveals a wide array of examples that go far beyond First Amendment classifications. Examples of previously recalled plates include “JAZZME” (a plate owned by a jazz historian, but recalled in response to a complaint that alleged that the slogan had a sexual connotation); “4 JIHAD” (in response to complaints that the slogan could be “misconstrued as a declaration of support for Iraqi President Saddam Hussein's call for jihad”); “GOVT SUX” (construed as “vulgar, obscene language”); along with a variety of ethnic slurs, including “DAGO” and “WOP” (in response to a complaint by the Sons of Italy). *Id.* at 1377–78.

406. Further, the requirements suggest a certain degree of selectivity; although the Lanham Act suggests that “[n]o trademark . . . shall be refused registration,” it limits registration to marks that do not consist of scandalous or disparaging matter. Lilit Voskanyan, Comment, *The Trademark Principal Register as a Nonpublic Forum*, 75 U. CHI. L. REV. 1295, 1317 (2008) (quoting Lanham Act, 15 U.S.C. § 1052 (2006)).

407. 660 F.2d 481 (C.C.P.A. 1981).

prohibitions were a legitimate decision by the government to decide which programs should “occupy the time, services, and use of funds of the federal government.”⁴⁰⁸ At the time, its decision was bolstered by the fact that the costs of trademark registration were underwritten by public funds.⁴⁰⁹ The fact that the system has shifted, however, since *McGinley*, to a “user-funded” system that is supported entirely by fees from the applicants rather than government funding, changes the equation somewhat.⁴¹⁰ As one scholar has pointed out, “it is the PTO’s opposition to a mark, rather than its approval, that is more likely to cause the expenditure of federal funds . . .”⁴¹¹ However, the source of the funding today is, it seems, even more like the license plate context, where the applicant pays for the cost of the license plate, just as in the trademark context where the applicant pays for the registration. In both contexts, the similarity of process suggests that the government isn’t acting as a patron as in *Finley*, but rather acts potentially as a proprietor, sponsor, and as a regulator.⁴¹²

Of course, no analogy is perfect, and even in this context there are certainly significant differences between the tangible world of government-issued license plates and trademark regulation, the most significant being that the license plates are considered to be governmental, rather than private property.⁴¹³ Nevertheless, the analogy here is useful because it demonstrates that the government *has* regulated arguably private content for its offensive character, contrary to *Cohen*, and that some of those circumstances may shed light on a different vantage point, and suggest potentially useful ways to resituate section 2(a).⁴¹⁴ In both circumstances, as the Second Circuit observes in the Vermont case, the government attempts to “disassociate itself,” rather than actively suppress, certain types of symbols based on content.⁴¹⁵ While the government, in both

408. *Id.* at 486.

409. *Davis*, *supra* note 80, at 366.

410. *Id.* at 367 (noting that not only are public funds no longer being used to finance the registration process, but the system has generated such a large surplus that the PTO has considered lowering fees).

411. *Id.*

412. Voskanyan, *supra* note 406, at 1313.

413. Helen Norton, *The Measure of Government Speech*, 88 B.U. L. REV. 587, 620 (2008) (noting that license plates are “generally owned by the government”).

414. See Corbin, *supra* note 347, at 675. Writing in the *NYU Law Review*, for example, just last year, after an exhaustive account of license plate controversies, Professor Caroline Mala Corbin favored a “rigorous intermediate scrutiny” approach that enables the government to impose speech restrictions on plates only if (1) it has a closely tailored, substantial interest that is clearly and publicly articulated; (2) it has no alternate means of accomplishing the same goal; and (3) private speakers have alternate means of communicating to the same audience. *Id.* at 675. Applying her test, Corbin does carve out some space for upholding regulations against hate speech and religious endorsements and sexually provocative messages. *Id.* at 685–91.

415. Concerns for viewpoint discrimination in the context of a government subsidy might be even stronger in the specialty plate context, which enables a person to choose from a menu of unique designs

circumstances, excludes a small number of brands or license plates based on content, erring on the side of inclusion, its regulation still demonstrates a level of editorial selectivity that bears more similarities to a nonpublic fora than a public one.⁴¹⁶

Normatively speaking, however, First Amendment absolutists have mixed views of the nonpublic fora category, and understandably so. This category seems to embody all of the discomfort that surrounds the recent erosion of the unconstitutional conditions doctrine, because it suggests that the government can openly discriminate against speech it doesn't support. Not only are the forum categories amorphous and prone to uncertainty in making content-based determinations, but they raise serious questions about the risk of government intervention into private expression. Here, like the municipal space on which brands are placed within city space in *Lehman*, the government, in regulating the trademark register, acts as a proprietor, host, gatekeeper, and licensor in regulating access to the space.

While the normative significance of this role is open to debate, the parallel remains instructive because it suggests that the government may have more leeway to regulate than critics of section 2(a) might presume. Consider an illustrative example. In the license plate context, the term *redskin* has warranted deregistration on the grounds that the term was "offensive to a reasonable person." In *McBride v. Motor Vehicle Division of Utah State Tax Commission*,⁴¹⁷ three Washington Redskins fans ordered and displayed plates that read, "REDSKIN," "REDSKNS" and "RDSKIN." The governing state standard

selected by the state (sometimes the legislature) that are often attributed to a particular organization. In most of these cases, courts consider a number of different factors in assessing the boundaries of the speech, and whether it is private or government speech. Among the factors are:

- The central purpose of the program in which the speech in question occurs and whether it is designed to promote private views;
- The degree of editorial control exercised by the government or private entities over the content of the speech;
- The identity of the literal speaker; and
- Whether the government or the private entity bears the ultimate responsibility for the content of the speech.

Olree, *supra* note 378, at 3, and Corbin, *supra* note 347, at 627 (collecting cases). See also *Ariz. Life Coal. v. Stanton*, 515 F.3d 956, 964–65 (9th Cir. 2008); *Choose Life Ill. v. White*, 547 F.3d 853, 860–64 (7th Cir. 2008) (considering these factors); *Planned Parenthood of S.C., Inc. v. Rose*, 361 F.3d 786, 792–93 (4th Cir. 2004); *Wells v. City & County of Denver*, 257 F.3d 1132, 1141 (10th Cir. 2001); *Knights of the Ku Klux Klan v. Curators of the Univ. of Mo.*, 203 F.3d 1085, 1093–94 (8th Cir. 2000); *Downs v. Los Angeles Unified Sch. Dist.*, 228 F.3d 1003, 1011–12 (9th Cir. 2000). Courts have considered a variety of complex institutional roles; for example, whether a state authorizes a plate, versus the method by which the legislature chooses a message for a plate. Compare *Sons of Confederate Veterans, Inc. v. Comm'r of Va. Dep't of Motor Vehicles*, 288 F.3d 610, 623–26 (4th Cir. 2002), with *Planned Parenthood of S.C.*, 361 F.3d at 792.

416. See Voskanyan, *supra* note 406, at 1313.

417. 977 P.2d 467 (Utah 1999).

proscribed plates in its administrative guidelines that were “vulgar, derogatory, profane, or obscene . . . [or plates that] express contempt, ridicule, or superiority of a race, religion, deity, ethnic heritage, gender, or political affiliation.”⁴¹⁸ In its decision, the Utah Supreme Court held that the terms may be too offensive to appear on vanity license plates.⁴¹⁹ The vanity plate owners argued that “they harbored no ill-will” towards Native Americans, but only wanted to commemorate their affection for the team.⁴²⁰ Nevertheless, they lost on largely the same grounds as the TTAB regarding the team’s trademark, which found that the general public could reasonably consider the term to be offensive, suggesting, at the very least, a significant degree of disagreement with the *Redskins* case.

IV. RECONCILING TRADEMARK INTERSECTIONALITY

“Selective memories cannot be avoided, but they can be counteracted.”⁴²¹

“In the search for ‘truth,’” First Amendment scholar Geoffrey Stone suggests, “we are more likely to succeed in the long run if we rely, not upon the dictate of a government censor but rather, upon ‘the power of the thought to get itself accepted in the competition of the market.’”⁴²² The traditional lore in First Amendment jurisprudence is that the remedy to harmful speech is simply more speech. Suppression, it is thought, drives harmful speech underground, where it can cause even more problematic results.⁴²³ Concerns about both speech and trademark paternalism understandably flow throughout similar critiques of section 2(a)—if large numbers of consumers find certain marks like REDSKINS or DYKES ON BIKES offensive, the argument suggests, they should simply decide to purchase goods from another source, and slowly, the trademark owner will react

418. *Id.* at 468 (quoting UTAH ADMIN. CODE r. 873-22M-34 (1999)).

419. *Id.* at 470–71 (remanding to the Commission); André Douglas Pond Cummings, “*Lions and Tigers and Bears, Oh My*” or “*Redskins and Braves and Indians, Oh Why*”: Ruminations on *McBride v. Utah State Tax Commission, Political Correctness and the Reasonable Person*, 36 CAL. W. L. REV. 11, 11–12 (1999). In its decision, the court used this standard: “whether an objective, reasonable person would conclude that the term ‘redskin’ contains any vulgar, derogatory, profane, or obscene connotation, or express contempt, ridicule, or superiority of race or ethnic heritage.” *McBride*, 977 P.2d at 471.

420. Cummings, *supra* note 419, at 13 (quoting *McBride*, 977 P.2d at 468).

421. Henrietta Lidchi, *The Poetics and the Politics of Exhibiting Other Cultures*, in REPRESENTATION: CULTURAL REPRESENTATIONS AND SIGNIFYING PRACTICES 151, 204 (Stuart Hall ed., 1997) (quoting Norman Davies, *The Misunderstood Victory in Europe*, N.Y. REV. OF BOOKS, May 25, 1995, at 7, 11).

422. Geoffrey R. Stone, *Restriction of Speech Because of Its Content: The Peculiar Case of Subject-Matter Restrictions*, 46 U. CHI. L. REV. 81, 103 (1978) (quoting *Abrams v. United States*, 250 U.S. 616, 630 (1919) (Holmes, J., dissenting)).

423. See Richard Delgado & Jean Stefancic, *Images of the Outsider in American Law and Culture: Can Free Expression Remedy Systemic Social Ills?*, 77 CORNELL L. REV. 1258, 1277 (1992) (discussing the reaction of “free speech absolutists and many campus administrators” to proposed campus hate-speech bans).

to the loss of market share by selecting another mark instead. Under this view, there is no need for the government to facilitate what the marketplace already promises to do on its own.

However, another view—as Edwin Baker has suggested—posits that time and again, the same infirmities that show up in the marketplace of goods often resurface in the marketplace of ideas.⁴²⁴ As Baker has explained, “the marketplace of ideas is improperly biased in favor of presently dominant groups”⁴²⁵—and this can be equally true in the marketplace of goods. For some scholars, then, the idea of the marketplace of ideas is actually a “pure legal fiction,” suggesting that such metaphors, in their ceaseless quest to draw upon free market parallels, tend to overlook the particular effect that certain types of offensive speech may have on a smooth functioning marketplace.⁴²⁶ Precisely because the marketplace of ideas is an unregulated private market, as Mari Matsuda has suggested, the First Amendment does little to protect against harmful or disparaging content, whether based on race or some other factor.⁴²⁷

The normative question, therefore, is whether the government should utilize section 2(a) to address this disparity. The Supreme Court, for example, has evinced some consideration of the goal of eradicating stereotypes in the contexts of education and employment,⁴²⁸ and of regulating certain types of low-value speech, like indecent or obscene speech. However, in the trademark context, we are faced with not just disputes about pure speech, but the complex layering of potential state sponsorship and regulation *onto* the intersecting and overlapping facets of private property and social expression. These complex layers require us to not only contemplate the value of speech as a cultural phenomenon, but to also consider how commodification—coupled with government registration—might play a role in the construction of representation. And finally, they also require us to contemplate the role of a trademark in facilitating a conversation between a speaker and an audience’s response.

424. See Baker, *supra* note 184, at 974–78.

425. *Id.* at 978.

426. See Brian J. Bilford, Note, *Harper’s Bazaar: The Marketplace of Ideas and Hate Speech in Schools*, 4 STAN. J. C.R. & C.L. 447, 450 (2008).

427. See Mari J. Matsuda, *Public Response to Racist Speech: Considering the Victim’s Story*, 87 MICH. L. REV. 2320, 2357 (1989).

428. Ross D. Petty et. al., *Regulating Target Marketing and Other Race-Based Advertising Practices*, 8 MICH. J. RACE & L. 335, 363 (2003). Since *Brown v. Board of Education*, 347 U.S. 483 (1954), the Supreme Court has paid marked observation to the need to eradicate the use of stereotypes. See *Bush v. Vera*, 517 U.S. 952, 985 (1996) (“Our Fourteenth Amendment jurisprudence evinces a commitment to eliminate unnecessary and excessive governmental use and reinforcement of racial stereotypes.”); *Edmonson v. Leesville Concrete Co.*, 500 U.S. 614, 630–31 (1991) (“If our society is to continue to progress as a multiracial democracy, it must recognize that the automatic invocation of race stereotype retards that progress and causes continued hurt and injury.”).

As this Article has suggested, trademarks vacillate between the captive attention of three spheres: the sphere of the potential consumer, the corporate producer, and the larger audience that is seated within a larger cultural landscape. As a result, the intersectionality of a trademark, both as a commodified property, one seemingly fixed and alienable, and as a cultural symbol, dynamic, shifting, and fluid, helps to explain their legal complexity with respect to the audience that interprets them.

The goal of this Article is largely descriptive, but the normative aspects of section 2(a) call out for a fuller analysis in the future. Again, like traditional antidiscrimination theories, which criticize the presumption of singular categories of human identity, I have argued that in section 2(a) cases, trademark law is disabled by its own fragmentation. Instead of recognizing the unique intersection of its political, cultural, and commercial aspects, trademark law overwhelmingly focuses on one aspect to the exclusion of others, thereby missing an opportunity to develop a more comprehensive account of trademark law and antisubordination. And intersectionality, as a theory—while it descriptively captures the overlapping relationship between commodification and culture in the marketplace of goods—fails to offer us a standardized way of distilling the ideal approach between the values of commerciality and communication.

However, by challenging the law's tendency to privilege a unitary approach, intersectionality might enable us to come to a greater understanding of the myriad of political and commercial facets that might be brought to bear on a particular matter.⁴²⁹ In other words, by embracing, rather than overlooking, the contradictory dimensions of a trademark, we see its malleable character as both a vessel for First Amendment protection, as well as a series of legal protections for proprietary ownership, and this unique posture provides us with a key model for reconciling our divisive portrayals of the conflict between property and speech.

In this Part, I suggest reframing section 2(a) to consider the secondary effects it facilitates as a potential benefit, rather than a cost, to our system of trademark registration. In other words, trademark law's cacophony of opposites—property vs. culture, private property vs. public good, noncommercial vs. commercial speech—might pave the way towards increased democratic discourse. Thus, instead of viewing section 2(a) as a tool for censorship, as many have, this Part sketches out some ways that its intersectionality can be reframed to constitute a powerful tool to facilitate counterspeech by enabling others to have access to a trademark for the purposes of dissent and greater deliberation

429. Cf. Angela P. Harris, *Race and Essentialism in Feminist Legal Theory*, 42 STAN. L. REV. 581 (1990).

within both the marketplaces of goods and ideas. This reframing, in turn, illustrates how the law can craft exceptions that, curiously, avoid rather than perpetuate the substantial First Amendment burdens with which we are familiar.

A. Decommodification and Semiotic Democracy

About five years ago, Gary LaPointe, a University of North Dakota (UND) senior and member of a Native American student group, was threatened with trademark infringement when he tried to use his school's FIGHTING SIOUX logo to manufacture a series of gold pins to demonstrate his profound disagreement with the logo's stereotypical representation of Native Americans.⁴³⁰ The pin appropriated the logo, a caricature of a Native American, adding a dramatic slash across the front of the logo with the slogan, "TIME FOR CHANGE!" "There was nothing professional I could wear [at interviews] that shows my feeling toward the UND nickname," said LaPointe, a college senior and an enrolled member of the Rosebud Sioux Tribe, who was deeply displeased with the stereotypical image of a fighting Sioux, and wanted to communicate his feelings about the mark to others.⁴³¹ The gold pin, meant to be worn on a lapel, was supposed to be sold on campus by Native students and their supporters, and accompanied with a paper—explaining the pin—that read, "UND: a great school, plagued by a racist name."⁴³²

Yet, after LaPointe placed an order with a company to manufacture hundreds of these pins, the Native student organization was promptly threatened with a trademark lawsuit from UND's counsel. In papers filed with the National Collegiate Athletic Association, LaPointe describes being pulled into a meeting with University Counsel, who informed him that the pins were in violation of the University's trademark licensing agreement, and ordered to stop. Worried about his own academic future—LaPointe dropped the plan.⁴³³

430. See Matt Schill, *Student, Pins Oppose Nickname*, DSONLINE, Nov. 23, 2004, <http://www.dakotastudent.com/2.5868/student-pins-oppose-nickname-1.870679>.

431. *Id.*

432. *Id.*

433. See Minority Report From the University of North Dakota American Indian Student Services to Robert Vowels, Chair of NCAA Minority Opportunities and Interests Committee (May 13, 2005), <http://www.ag.state.nd.us/NCAA/Exhibits1of4.pdf>. LaPointe's story is not unique. In fact, several scholars have pointed out that the financial cost and uncertainty of defending a trademark suit can be prohibitive, even for the strongest cases. See Mcgeveran, *supra* note 59; Ramsey, *supra* note 206. In the end, LaPointe dropped out of graduate school in protest of the logo. In a letter addressed to Student Government and select UND administrators, LaPointe said, "I have tried for years to educate people on the issue and do it (in) a positive way, but I can no longer fund this institution with my tuition." See Cory Hahn, *Nickname Issue Sends Student Senator Packing*, DSONLINE, Oct. 30, 2006, <http://www.dakotastudent.com/2.5857/nickname-issue-sends-student-senator-packing-1.868242>.

Consider, for a moment, what this story suggests: that the most powerful line of censorship does not stem from section 2(a), but from the trademark owner's power to control alternate commentaries on a specific mark sold in the marketplace.⁴³⁴ Despite the power of First Amendment defenses, trademark protection has enabled companies, effectively, to lock up images, icons, logos, and brands from public debate—even when they raise strong opinions, even when they are marked with a slash across the front, or even when their commentaries, like this one, suggest important dissenting contributions. Perhaps, as LaPointe's story might suggest, the First Amendment's commitment to democratic discourse allows us to consider the virtue of enabling others to appropriate disparaging trademarks in expressive contexts, even when they occupy the categories of commercial speech, and even when their work involves the appropriation of a logo.⁴³⁵ Had UND's trademark been subject to a successful section 2(a) challenge on the grounds of disparagement, and the mark cancelled, it is at least conceivable that UND would not have been able to enforce its trademark against LaPointe.

Critics of section 2(a) who may favor a determination of unconstitutionality often overlook that their critiques unwittingly advance not speech, but *property*, which, in the trademark context (and as the story above illustrates) can constitute a far more powerful form of censorship than they may have intended. Viewed in this light, then, it is important to note that section 2(a) directly affects the enforcement of trademark protection, rather than the expression itself. When the law applies section 2(a) and cancels a registration, a trademark owner is not barred from using the mark, but is only barred from stopping *others*, like LaPointe, from doing so. Ironically, then, section 2(a) might indirectly facilitate or enable the secondary, unintended result of adding *more* speech, rather than less, to the marketplace of both goods and ideas in the process.⁴³⁶

The few courts that have considered the question of section 2(a)'s constitutionality have rarely analyzed this point. The earliest case on point, *In re McGinley*,⁴³⁷ is from 1981 and involved the trademark of a photograph of a nude man and woman kissing, coupled with an exposure of male genitalia.

434. While it may be true that other trademark defenses might have been available to LaPointe, such as a defense for parody or nominative use, it is not clear that those defenses were raised on the student's behalf.

435. See STEPHEN H. SHIFFRIN, *DISSIDENT, INJUSTICE, AND THE MEANINGS OF AMERICA* 93 (1999); Vincent Blasi, *The Checking Value in First Amendment Theory*, 1977 AM. B. FOUND. RES. J. 521, 527.

436. See generally Note, *Dissent, Corporate Cartels, and the Commercial Speech Doctrine*, 120 HARV. L. REV. 1892 (2007).

437. 660 F.2d 481 (C.C.P.A. 1981).

There, the court concluded that denial of registration would not abridge the applicant's First Amendment rights, observing:

[I]t is clear that the PTO's refusal to register [the] mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, [the applicant]'s First Amendment rights would not be abridged by the refusal to register his mark.⁴³⁸

While the legislative history surrounding section 2(a) is unclear, some scholars have argued that these observations suggest that "the government has a substantial interest in prohibiting certain marks from carrying the implied approval of the federal government."⁴³⁹ Courts, however, have disagreed with the imprimatur rationale, observing, "[j]ust as the issuance of a trademark registration by this office does not amount to a government endorsement of the quality of the goods to which the mark is applied, the act of registration is not a government imprimatur or pronouncement that the mark is a 'good' one in an aesthetic, or any analogous, sense."⁴⁴⁰ Thirteen years after *McGinley*, the Federal Circuit offered a similarly dismissive answer to the question of constitutionality, concluding that *McGinley* foreclosed any constitutional challenges to the statute, either facially or as applied.⁴⁴¹ In another parting shot, in 2003, the Federal Circuit again echoed that section 2(a) was not "an attempt to legislate morality, but, rather, a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government."⁴⁴²

In this manner, trademark cancellation functions differently than the other unconstitutional condition cases we have discussed. Denial of registration does not preclude use; it precludes the statutory benefits from federal registration.⁴⁴³ In other words, cancellation does not prohibit a trademark owner from using a mark; it only prevents her from excluding others from doing so. That difference

438. *Id.* at 484 (citation omitted).

439. Bruce C. Kelber, "Scalping the Redskins:" *Can Trademark Law Start Athletic Teams Bearing Native American Nicknames and Images on the Road to Racial Reform?*, 17 *HAMLIN L. REV.* 533, 560 (1994); see also GRAEME DINWOODIE & MARK JANIS, *TRADEMARKS AND UNFAIR COMPETITION: LAW AND POLICY* 321 (2007); Smith, *Squeezing the Juice*, *supra* note 80, at 1326, (citing *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. 176 (T.T.A.B. 1978)).

440. *In re Old Glory Condom Corp.*, 26 U.S.P.O.2d 1216, 1220 n.3 (T.T.A.B. 1993).

441. See *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994).

442. *Id.* (quoting *In re McGinley*, 660 F.2d at 486). Other cases in the Federal Circuit have offered similarly cursory observations, usually either by arguing that section 2(a) doesn't affect an owner's use of the mark, see *Ritchie v. Simpson*, 170 F.3d 1092, 1099 (Fed. Cir. 1999), by deferring to findings in previous case law, see *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003), or by citing the doctrine of constitutional avoidance in resolving trademark disputes, see *Pro-Football, Inc. v. Harjo*, 57 U.S.P.Q.2d 1140, 1143 (D.D.C. 2000) (resolving the case on the issue of laches instead).

443. Baird, *supra* note 80, at 673 n.39.

is significant and has led two prominent commentators to query whether a First Amendment analogy is even necessary.⁴⁴⁴ Unlike many cases discussed in this Article, section 2(a) mandates no prior restraint, no criminal prohibition.⁴⁴⁵ *Sambo's*, in contrast, is an apt example of an unconstitutional condition: It revoked a series of sign permits due to the potentially offensive connotations of the trademark. Similarly, *Hornell* and *Bad Frog* dealt with a prohibition on the issuance of a brand, label, and logo within a heightened sphere of regulation of alcohol labels. All of these cases, however, are based on a direct prohibition on speech. In section 2(a) cases, the remedy of cancellation introduces not a basic prohibition, but a secondary effect: The trademark owner can continue to use the mark, but cannot rely on the state to enforce her rights. The result, however, might indirectly enable other, competing views on the mark, maintaining the fluidity of language and social meaning without actively relying on the Federal Register to enforce only one particular mark, as the next Subpart further discusses.

Of course, one valid objection to this recharacterization concerns the fact that while cancellation may open the door for a variety of other commentaries, it also opens the door for a variety of imitations to flood the marketplace, thereby indirectly creating a financial disincentive for the mark holder to continue using the mark. Even then, the mark holder could still conceivably institute a cause of action for “palming off” or deceiving the public regarding source under section 1125(a) of the Lanham Act and even common law principles of misappropriation.⁴⁴⁶ Under this view, a subsequent competitor could not be prevented from using the mark, but it may be enjoined from passing itself off as the officially sponsored merchandise.⁴⁴⁷ A court, therefore, could still require the competitor

444. See DINWOODIE & JANIS, *supra* note 439, at 324 (“Should Congress amend Section 2(a) to prohibit the registration of ‘obscene’ marks, eliminating references to scandalousness? Or are the stakes so much smaller in the trademarks context (registration vs. exclusion from registration) as compared to the First Amendment context (speech vs. exclusion from speaking) that no analogy properly can be drawn?”).

445. See *N.Y. Times v. United States*, 403 U.S. 713, 714 (1964) (per curiam); *Near v. Minnesota*, 283 U.S. 697, 713–14 (1931).

446. This section provides:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact . . . shall be liable to a civil action by any person who believes that he is or likely to be damaged by such act.

15 U.S.C. § 1125(a) (2006). Note, however, that at least one prominent scholar has disagreed with this view. See Baird, *supra* note 80, at 791 (noting that scandalous and disparaging marks should not receive de jure protection under the Lanham Act; otherwise it would enable parties to easily circumvent section 2(a)’s restrictions, and subvert the policy of not encouraging their use).

447. See *Blinded Veterans Ass’n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1043–44 (1989) (discussing this provision in the context of a generic trademark).

to take “whatever steps are necessary to distinguish itself or its product” from the original source if confusion results, such as a disclaimer or distinguishing moniker from the original.⁴⁴⁸

In the case of a critical commentary, however, like LaPointe’s example of a pin that replicates and critiques the FIGHTING SIOUX logo, since no one would think that it was officially sponsored merchandise, UND would not be able to prevent the mark from being sold in the marketplace. In sum, the primary effect on disparaging marks, for the purposes of section 2(a), might arguably remove the government mantle of federal enforcement, potentially facilitating greater commentary, and greater speech, in the process.

B. Recommodification and Dissent

I began this Article with a question: Whether it was possible for the law of section 2(a) to reconcile two cases, one involving the mark for the WASHINGTON REDSKINS, and the other involving the mark for the group DYKES ON BIKES. As I explained, the first case involved the appropriation of a racial epithet by a sports team, while the second case involved the reappropriation of a homophobic slur by the very group that has been targeted by its use. Should the law draw a distinction between the two?

So far, trademark law has avoided theorizing the significance of section 2(a) in light of these questions, even though a few scholars have done so.⁴⁴⁹ As every First Amendment scholar now recognizes in the wake of cases like *Finley*, substantial problems arise regarding the targeting of sexual minorities when the government imposes sexual purity within the marketplace of goods, just as it has in the marketplace of ideas. As Elizabeth Glazer has persuasively argued with respect to obscenity, and as the *Dykes on Bikes* case suggests, there are unspoken tendencies within the law to target the expressions of sexual minorities under the guise of a general rule against scandalous marks.⁴⁵⁰ One need only look at *Finley*, which protected the government’s role in applying decency criteria to the realm of arts funding, enabling the exclusion of several controversial artists for their projects involving homosexuality. “The real danger in the injection of government money into the marketplace of ideas is that the market will be distorted by the promotion of certain messages but not others,” one court has observed.⁴⁵¹

448. *Id.* at 1044–45 (describing cases).

449. Anten, *supra* note 8; Smith, *Trademark Law*, *supra* note 80.

450. See Elizabeth M. Glazer, *When Obscenity Discriminates*, 102 NW. U. L. REV. 1379, 1383–84 (2008).

451. *Advocate for the Arts v. Thomson*, 532 F.2d 792, 798 (1st Cir. 1976).

Most scholars who write on section 2(a) tend to conflate scandalous and disparaging marks, and decry both standards as unrelentingly vague, without taking into account their very different functions and justifications.⁴⁵² Admittedly, in the context of section 2(a)'s prohibition against scandalous and immoral marks, the danger of subjectivity at times risks outweighing the appreciable benefits that section 2(a) offers, weighing in favor of interpreting these terms in relation to a more *Miller*-like standard of obscenity.⁴⁵³

On this point, leading trademark scholars have also queried whether the "scandalous" standard should be replaced with an "obscene" standard in section 2(a).⁴⁵⁴ Surely, an amendment of this nature would arguably ameliorate many of the constitutional concerns that may plague the vagueness of the present "scandalous" standard, since the *Miller* test offers a more precise inquiry. However, it would not solve well-founded concerns about selectivity in enforcement against sexual minorities, particularly regarding the potential risk of conflating "sex" with "sexual orientation."⁴⁵⁵ The operable standard must also be considered in the context of section 2(a); while scandalous marks are doctrinally required to be shocking to a substantial composite of the general public, disparaging marks are thought to target only an identifiable subgroup.⁴⁵⁶ Such a standard may be difficult, however, to reconcile with *Miller*'s directive to consider, in part, "whether the average person, applying contemporary community standards' would find that the work, taken as a whole, appeals to the prurient interest . . ."⁴⁵⁷ Given the diverse interpretations of *Miller*'s "contemporary community standards" standard, it becomes difficult to parse whether these considerations will mesh successfully with section 2(a)'s requirement to consider the mark from the perspective of a "substantial composite" of the general public.⁴⁵⁸

452. Smith, *Squeezing the Juice*, *supra* note 80, at 1305; Anten, *supra* note 8, at 409–10 n.146 (noting that courts and the PTO often conflate the two).

453. The *Miller* test, is "(a) whether the average person, applying contemporary community standards would find that the work, taken as a whole, appeals to the prurient interest; (b) whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law; and (c) whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value." *Miller v. California*, 413 U.S. 15, 24 (1973) (internal citations omitted). Though the implications of applying *Miller* to section 2(a) are a subject for future research, they are beyond the scope of this Article.

454. DINWOODIE & JANIS, *supra* note 439, at 324.

455. Glazer, *supra* note 450, at 1399–1400; see also William N. Eskridge, Jr., *Body Politics: Lawrence v. Texas and the Constitution of Disgust and Contagion*, 57 FLA. L. REV. 1011, 1036 (2005) (noting that *Miller* led to censorship against gay publications, and noting that the doctrine "rende[red] homosexuality itself the epitome of obscenity").

456. See Saunders & Rymza, *supra* note 79, at 20; Anten, *supra* note 8, at 409.

457. See *Miller*, 413 U.S. at 39.

458. See Christopher Thomas McDavid, Comment, *I Know It When I See It: Obscenity, Copyright, and the Cautionary Tale of the Lanham Act*, 47 U. LOUISVILLE L. REV. 561, 567 (2009) (noting, in the

Leaving aside these interpretative concerns, however, it also bears mentioning that the Supreme Court's directives have led to the institution of procedural safeguards to guard against unconstitutional prior restraints in obscenity and related cases, stemming from the Supreme Court's decisions in *Freedman v. Maryland*, *Kingsley Books, Inc. v. Brown*, and others.⁴⁵⁹ These safeguards may prove instructive in considering future amendments to section 2(a). Central to these safeguards is the requirement of a judicial determination when a state seeks to enjoin obscene content:

[T]he Supreme Court has insisted that any statutory scheme designed to prohibit the free flow of obscenity be imbued with a series of safeguards to ensure that nonobscene materials not get ensnared along the way. First, a judge must make a final determination whether the speech in questions is obscene before an otherwise valid prior restraint can go into effect. Second, the burden of seeking judicial review of an administrative determination of obscenity must rest with the government. Third, the agency must make its finding promptly and must seek such review in a timely manner. Fourth, "any restraint imposed in advance of a final judicial determination on the merits must similarly be limited to preservation of the status quo for the shortest fixed period compatible with sound judicial resolution." Finally, the burden of proof that the materials are obscene must rest on the government at the administrative level. Absent these safeguards, the statute imposes an unconstitutional prior restraint.⁴⁶⁰

Although many of these safeguards are more appropriate for the prior restraint context, it is also conceivable to employ these elements to ensure a more rigorous determination under section 2(a), particularly if it moves toward a more obscenity-based standard of interpretation. The Court has observed, "because only a judicial determination in an adversary proceeding ensures the necessary sensitivity to freedom of expression, only a procedure requiring a judicial determination suffices to impose a valid final restraint."⁴⁶¹ Although section 2(a), as courts have found, is not a prior restraint (as a bar to registration

context of copyright, that application of a community standard to a federal provision would fragment a uniform national standard).

459. See *Freedman v. Maryland*, 380 U.S. 51 (1965); *Kingsley v. Brown*, 354 U.S. 436 (1957). See generally Allan Tananbaum, Note, "New and Improved": *Procedural Safeguards for Distinguishing Commercial From Noncommercial Speech*, 88 COLUM. L. REV. 1821 (1988) (discussing these safeguards and listing cases).

460. Tananbaum, *supra* note 459, at 1823. For more discussions of the relationship between administrative and constitutional law, see also Gillian Metzger, *Ordinary Administrative Law as Constitutional Common Law*, 110 COLUM. L. REV. 479 (2010), and Reuel E. Schiller, *Free Speech and Expertise: Administrative Censorship and the Birth of the Modern First Amendment*, 86 VA. L. REV. 1, 2–3 (2000).

461. *Freedman*, 381 U.S. at 58.

does not preclude use of the mark), a potential move towards an obscenity-based standard weighs in favor of a more searching inquiry into whether section 2(a)'s procedural safeguards are sufficient in protecting First Amendment concerns in such cases. Even if courts have dismissed these considerations (after all, as *McGinley* noted, a refusal does not implicate the applicant's First Amendment rights), a more searching inquiry dictates a more rigorous evaluation of the procedural safeguards nonetheless.⁴⁶²

Yet in the context of disparaging marks, which require a substantial composite of a targeted population to perceive the term as such, the danger of subjectivity is tied, not to the government, but to the third party challenging the trademark application, and this may, at times (but not always), ameliorate concerns about arbitrary applications and government subjectivity and offer a more empirically appreciable standard of harm. Of course, given the rarity of such cases, it is difficult to craft a single standard that resolves the well-founded fears of First Amendment absolutists regarding section 2(a). But they may take comfort from the fact that, as I discuss more below, the initial refusal to register in the *Dykes on Bikes* case was eventually overturned, enabling a more pronounced embrace of the fluidity of language in the process, and also, at the other extreme, *Harjo*'s legacy dictates a more searching inquiry of disparagement in the process.

In the wake of *Harjo* and *Squaw Valley*, two cases discussed earlier in this Article, both critics and supporters of section 2(a) may be affirmed at different points in determining disparagement. *Harjo*, it may be said, offered the more narrow view of relevant evidentiary information; the district court, as we saw, sharply criticized survey evidence that attempted to extrapolate the views of Native Americans from a comparatively small survey sample, and dismissed the viewpoints of the individual plaintiffs, finding that both failed to demonstrate disparagement at the time of the mark's registration.⁴⁶³ The court's observations certainly point, in future cases, to the need for more precision in empirical research, but the court failed to establish any guidelines for future plaintiffs to follow. As Regan Smith points out, "[i]f the group is diffuse, as Native Americans are, there is a greater burden on those attempting to cancel a trademark to demonstrate disparagement," particularly in cases (like those involving mascots) that often entail different social meanings in different contexts, especially when there may be some divergence in opinion within the

462. See *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981).

463. See *supra* text accompanying footnotes 161–163.

target group.⁴⁶⁴ In other words, as Smith suggests, the term “substantial composite” can be prone to varied interpretations, depending upon context.⁴⁶⁵

Yet in *Squaw Valley*, a case that involved similar issues (raised in an *ex parte*, as opposed to a cancellation, proceeding), the T.T.A.B. employed *Harjo*’s analytical and empirical rigor but reached a different conclusion, relying on a broader array of evidence that was more consistent with traditional trademark approaches. As *Squaw Valley* and other cases suggest, dictionary definitions, linguistic expert evidence, “slang dictionaries,” and even “locker room talk” may be relevant; even a broader context that surrounds the mark can be considered in assessing disparagement.⁴⁶⁶ For both *Harjo* and *Squaw Valley*, then, empirical, anecdotal, and linguistic evidence will be key to the outcome of a case, but whether a court takes a narrow or broad approach in assessing such evidence may depend on whether it is a cancellation or *ex parte* proceeding, and perhaps, indirectly, on a decisionmaker’s own subjective evidentiary preferences.

Here again, it may be possible to distinguish the DYKES ON BIKES scenario from the REDSKINS one. In the former, an epithet is reappropriated and essentially recommodified, in other words, self-branded by the very group that is targeted by the term, and the mark is primarily selected for self-expressive purposes; and in the latter context, an epithet is commodified instead by a third party, not for the purposes of self-expression, but in order to brand something else. In one context, the social meaning of the mark explains its attractiveness as a brand (illustrating the desire to recode an epithet, such as *dyke*); yet in another context, the REDSKINS brand’s commercial significance and its secondary meaning, for the district court, overtook the mark’s expressive significance as a racial epithet. In other words, each brand represents the intersection of both the commercial and expressive aspects that a trademark embodies. And like other intersectional identities, one aspect—the political or the commercial—may dominate the other at different points, each affecting the other. The intersectionality of trademarks may suggest, at the very least, that different regimes may need to be employed at different points, depending upon whether the mark is operating in a commercial sphere or a political sphere, also depending on intent, audience, and context.

In the end, the call of many of these cases, for both supporters and critics of section 2(a), might be to reconsider the trademark owner’s intent in inviting an audience response. As I have suggested in this Article, economically oriented

464. Smith, *Trademark Law*, *supra* note 80, at 465.

465. *Id.*

466. *Id.* at 464 (offering an example of a court rejecting the proposition that the term “Memphis Mafia” for a group of musicians disparaged Italian Americans); *see also* *Order of Sons of Italy in America v. Memphis Mafia*, 52 U.S.P.Q.2d. (BNA) 1364 (T.T.A.B. 1999).

theories of trademark law have little to say about how language, associations, and culture can often destabilize the significance of a trademark term. For the most part, the economic literature surrounding trademarks overlooks the preexisting meanings of some brands, largely presuming that the meaning of a trademark is somewhat immutable, fixed, a vessel for corporate signification. As a result, within commerce, our system of trademark rights confers primary power on the owner over all other parties. Most of the literature, therefore, operates from this foundational assumption, often presuming a linear relationship between the meaning of a cultural producer and the reception of the consumer.

Such perspectives, however, overlook the fact that ever since labels and brands have existed, there have always been individuals who recode and challenge these marks when changes in social meaning have called for a shift. Consider some examples. The legendary pink triangle that denoted gays and lesbians during the period of the Nazi Holocaust has now become an iconic rallying cry for political action, accompanied by the slogan SILENCE=DEATH. The term queer, once an epithet hurled at nonconforming individuals living outside of the codes of gender and sexuality, has now been resignified to stand for a particular posture that suggests a choice made to live outside of the norms of conformity.⁴⁶⁷ The racial epithet Nigger has been reappropriated by those in the African American community, culminating in a best-selling book by the same title, and a 1995 application by the actor Damon Wayans to trademark N.I.G.G.A to denote "NATURALLY INTELLIGENT GOD GIFTED AFRICANS."⁴⁶⁸ (The application was first denied and then abandoned).⁴⁶⁹

Traditional First Amendment absolutists might understandably focus on section 2(a)'s risk of censorship, erasure, or suppression, centering on the chilling effect of prohibitions or abridgements on speech. However, in the context of section 2(a), their perspectives might tend to overlook the powerful role of the

467. See DAVID A. HALPERIN, *ST. FOUCAULT: TOWARDS A GAY HAGIOGRAPHY* (1995); Gibbons, *supra* note 80, at 188–89 (quoting one activist, "[b]y defining myself as queer I can invert society's definitions, redefine them, and add new layers of meaning").

468. See Application Serial No. 75/002,364 filed Oct. 6, 1995. Other examples, collected by Anten, *supra* note 8, at 393, include: (a) An application to register S.P.I.C. SPANISH PEOPLE IN CONTROL; (b) and a 2005 application by a Jewish woman to register BABY JAP for a clothing line. Many scholars and commentators have written about the phenomenon of reappropriating slurs and epithets. See, e.g., RANDALL KENNEDY, *NIGGER: THE STRANGE CAREER OF A TROUBLESOME WORD* (2002); Anten, *supra* note 8; Gibbons, *supra* note 80; Ratna Kapur & Tayyub Mahmud, *Hegemony, Coercion and Their Teeth-Gritting Harmony*, 5 MICH. J. RACE & L. 995, 1023 (2000); Mithlo, *supra* note 7.

469. See Rogers Cadenhead, *Actor Tries to Trademark 'N' Word*, WIRED, Feb. 23, 2006, available at <http://www.wired.com/science/discoveries/news/2006/02/70259>. Courts have not allowed a person to change his name to "nigger" either. *Lee v. Superior Court*, 11 Cal. Rptr. 2d 763, 764 (Ct. App. 1992) (denying a petition for a name change to "Misteri Nigger" because the court refused to sanction a racial epithet).

audience in remaking meaning.⁴⁷⁰ Viewed in this light, and demonstrated by the litany of cases discussed in this Article, meaning is never fixed, but it is always arbitrary—words change historically, and their meaning is often determined by the fluidity of context and communication.⁴⁷¹ The theorist Stuart Hall reminds us that “in order to say something meaningful, we have to ‘enter language,’ where all sorts of older meanings which pre-date us, are already stored from previous eras, we can never cleanse language completely, screening out all the other, hidden meanings which might modify or distort what we want to say.”⁴⁷² As Hall suggests, the audience—just as LaPointe demonstrated in the FIGHTING SIOUX context—can often become as crucial as the speaker in uncovering and challenging the codes of meanings and their significance.⁴⁷³ Because meanings are contingent, they can be opened up, unfixed, at different points, offering new combinations for “the constant ‘play’ or slippage of meaning, to the constant production of new meanings, new interpretations.”⁴⁷⁴

As Ed Baker has suggested, if we view free expression as a value instrumental to equality, rather than an end in and of itself, it may be easier for us to understand the need for trademark regulation to reflect an equality of speech considerations at the heart of the First Amendment.⁴⁷⁵ As the First Amendment has long recognized, the social meaning of a mark can be changed, altered, and recoded in creative ways, and there is some evidence that trademark law can be employed to honor this transition when it has fully unfolded, when the empirical and anecdotal evidence suggests a fuller and more complete shift in meaning.

Consider a recent case, handed down in 2008 by the TTAB, involving a trademark application for the term “HEEB,” filed by a Jewish publisher of a popular magazine for apparel and entertainment services aimed towards young Jewish individuals.⁴⁷⁶ In that case, the court first separated out the use of the trademark on the magazine from the other goods and services in question, and then concluded that the applicant had failed to rebut the prima facie case of disparagement.⁴⁷⁷ For evidence, the court cited a variety of dictionaries and

470. See Sut Jhally, *Commercial Culture, Collective Values, and the Future*, 71 TEX. L. REV. 805, 808 (1993) (“The consumer culture is no paradise of freedom, justice, and reason—but it is also no mere den of deception.”) (citing Stephen Kline & William Leiss, *Advertising, Needs, and “Commodity Fetishisms”*, 2 CAN J. POL. & SOC. THEORY 5, 26 (1978)).

471. See Stuart Hall, *The Work of Representation*, in REPRESENTATION, *supra* note 421, at 1, 32–33 (discussing work of Ferdinand de Saussure).

472. *Id.* at 33.

473. *Id.*

474. *Id.* at 32.

475. Baker, *supra* note 184, at 974–78.

476. *In re Heeb Media LLC*, 89 U.S.P.Q.2d 1071, 1072 (T.T.A.B. 2008).

477. Interestingly, the PTO had granted a trademark for the use of the term on the magazine in 2003. See Anten, *supra* note 8, at 391 (citing registration number).

commentaries from a variety of sources, all of whom objected to the use of the term as a derogatory term for Jewish people.⁴⁷⁸ The court recognized, however, the strong showing of institutional and community support for the magazine from the Jewish community, including one professor who observed that “[w]hile there will be those in the Jewish community who find the magazine, both its name and its content, offensive, there are many others who embrace its unflinching and confrontational style in giving voice to a new generation of proudly Jewish youth in search of unconventional ways of defining themselves.”⁴⁷⁹ While the TTAB recognized a split in opinion, perhaps along generational lines, it concluded that there was still some likelihood that the term would be found disparaging if displayed on a T-shirt or as part of a promotion.⁴⁸⁰ “While applicant may intend to transform this word,” the court noted, “the best that can be said is that it is still in transition.”⁴⁸¹ It continued by noting, however, that the applicant was still free to use the term, citing *McGinley* for the proposition that section 2(a) did not suppress either speech or conduct.⁴⁸²

Both cases—*Heeb* and *Dykes on Bikes*—also illustrate something important regarding the overlap between marketplaces of speech and of goods. As Richard Delgado has persuasively suggested, the myth of a free marketplace of ideas often obscures the simple fact that inequalities in resources shape access to that marketplace. Speech is expensive, Delgado explains, and not everyone has access to the cost of a microphone, computer, or television.⁴⁸³ However, Delgado’s observation can also be extended to the role that symbols, brands, and logos can play within the marketplace of speech.⁴⁸⁴ For Delgado, stories and their counterstories—like the gold pin offered by Gary LaPointe—carry a key potential; they are “powerful means for destroying mindset—the bundle of presuppositions, received wisdoms, and shared understandings against a

478. *Heeb Media*, 89 U.S.P.Q.2d at 1073, quoting one radio host who noted: “Just knowing that it is a derogatory name and it has a derogatory history, you have to start thinking, well if it was a black magazine trumpeting African-American history or events or culture, would it be named the N-word? Or [if] it was Hispanic, would an editor come along and name it a word that starts with S? I can’t see it happening. And I don’t understand why there are Jewish groups and charities and whatever that help fund this magazine. I think it is a terrible choice for a name.”

479. *Id.* at 1076.

480. *Id.* at 1077.

481. *Id.*

482. *Id.*

483. See Richard Delgado, *Toward a Legal Realist View of the First Amendment*, 113 HARV. L. REV. 778, 791 (2000) (reviewing STEPHEN H. SHIFFRIN, *DISSENT, INJUSTICE, AND THE MEANINGS OF AMERICA* (1999)).

484. Richard Delgado, *Counterstories: We Begin to Talk Back and ‘Name Our Own Reality,’* in *THE LATINO/A CONDITION* 251 (Richard Delgado & Jean Stefancic eds. 1998).

background of which legal and political discourse takes place.”⁴⁸⁵ The same goes for brands and their counterbrands. Thus, just as access to media resources is necessary for the forces of social change, access to brand resources, as LaPointe’s story illustrates, is needed as well.

Because meaning has to be interpreted according to the changing codes within society, however, we can often run into a conflict, like that we see in the *Dykes on Bikes* case, whereby a past meaning conflicts with a current one. But it is important to note that the PTO’s section 2(a) involves a constant reassessment of the mark’s fluidity; in the *Dykes on Bikes* case, enough evidence was introduced to rebut the prima facie case of disparagement, compelling the court to reconsider its position. Even in the *Heeb* case, the court noted that the term might be “in transition,” implicitly suggesting that it might revisit the issue in a later context, just as it did in the *Dykes on Bikes* case.⁴⁸⁶

In the previous Part, I suggested that decommodification provides one way to engage the fertile imagination of the public in remaking the meaning surrounding racially harmful trademarks. Just as Gary LaPointe sought to recode the icon of the FIGHTING SIOUX by attaching—and marketing—his distaste of the mark, the DYKES ON BIKES mark sought to excise the epithet’s harmful power by recommodifying the mark in a consumer context. Both actions, however, fell within areas of significant legal uncertainty—LaPointe was threatened with a lawsuit, and the DYKES ON BIKES mark was rejected, repeatedly, by the PTO, until a public outcry shifted its determination.

For some, the fact that certain labels can be reclaimed, and thus excised of their disparaging power, is a sign that the fluidity of language can often result in a secondary association that erases the harms of the previous one. But one still has to recognize the inherent difference between a mark such as DYKES ON BIKES, where a group once targeted by the term seeks registration after a long period of actively changing the meaning of a term, and the *Redskins* case, in which a sports team drew upon a disparaging mark for an entirely different purpose. This observation has led at least one commentator to suggest that the PTO recognize, on a more formal level, the phenomenon of self-disparaging trademarks and enable their protection, particularly when the person filing the application is a member of the (allegedly) disparaged group.⁴⁸⁷ Under this proposal, members of

485. Richard Delgado, *Storytelling for Oppositionists and Others: A Plea for Narrative*, 87 MICH. L. REV. 2411, 2413 (1989).

486. In fact, in at least one case, the T.T.A.B. considered evidence of intent (and the applicant’s Japanese ethnicity) in permitting the registration of JAP as a trademark, reasoning that it seemed unlikely that someone would choose to disparage their own community. *In re Condas*, 188 U.S.P.Q. (BNA) 544, 544 (T.T.A.B. 1975).

487. See Anten, *supra* note 8, at 421.

the group would still be able to initiate challenges to the mark, just as they are today.⁴⁸⁸ As one commentator notes in that context:

The applicant's purposeful use of the slur is thus persuasive evidence that the slur is no longer disparaging in all situations—the mark is transforming into a contextually disparaging mark that might not disparage a “substantial composite” of the referenced group, depending on the context of use.⁴⁸⁹

Understandably, the proposition that the law should allow the commodification of self-disparaging marks might strike some as counterintuitive. However, it accords nicely with section 2(a)'s goal to avoid disparaging or scandalous content, particularly since any shift in meaning would rely heavily on the findings of a substantial composite of a particular audience (as the *Dykes on Bikes* case signifies, the meaning of a mark can change across time and be embraced instead of reviled). In such cases, the courts' recognition of evidence demonstrating that a minority has embraced the changing meaning of a term might actually advance, rather than prevent, the fluidity of trademarks and their expressive connotations. After all, today's economists widely recognize that some forms of government regulation are needed to correct market failures caused by real world conditions, and a similar justification might arguably apply to the marketplace of speech to correct communicative market failures as well.⁴⁹⁰ However, in order to fully explore these possibilities, we have to reexamine the relationship between a trademark's economic and political functions, and consider redefining the nature between the symbolism of the trademark and the discordant functions of language itself, as I have suggested in this Article.

CONCLUSION

Throughout this Article, I have explored several types of trademark intersectionalities—the first stemming from a trademark's status as both a public and private good. The second binary stems from a trademark's function, both as an economic value and as a receptacle and producer of social meaning. The third binary I explored was the intersectionality between property and speech, as trademark law functions both as a commercial expression and a political or expressive one, raising a tension about how much constitutional protection the

488. *Id.* at 428.

489. *Id.* at 412. In another case that involved an application to register the mark JAP, an examiner refused the application on the grounds that the mark may disparage the Japanese, without noting that the application was filed by a person of Japanese ancestry. The examiner's finding was reversed on appeal. See *In re Condas*, 188 U.S.P.Q. (BNA) 544 (T.T.A.B. 1975).

490. Stanley Ingber, *The Marketplace of Ideas: A Legitimizing Myth*, 1984 DUKE L.J. 1, 4–5.

speech should receive. Throughout these debates, as I have suggested, each element has surfaced at different points, revealing section 2(a)'s unique architecture in accommodating different areas of the law in its own governance, and in inviting audience response.

To demonstrate the power of the audience, consider, again, the icon of AUNT JEMIMA. To many of those in the consumer audience, AUNT JEMIMA didn't symbolize the warmth of southern hospitality, but instead personified the persistence of racial prejudice. Through the years, as she became less of a trade symbol, and more of a cultural icon, she began to symbolically capture all of the contradictions between the commodification of an intellectual property and the commodification of a person who resembled a stereotype. In one particularly memorable exhortation, the civil rights leader Malcolm X used AUNT JEMIMA to demonstrate how white-owned businesses made millions from negative portrayals of African Americans:

Instead of so much effort to escape being black, so much trying to be like the white man, he [the black man] might have the sense to wake up from his sleep and put to use for himself the image that the white man won't let him escape.⁴⁹¹

Tens of years after AUNT JEMIMA was created, and only a few years after X's exhortation, it bears noting that a few artists have come along to challenge her stereotypical image, and do precisely what Malcolm X suggested. In one very famous painting, titled *The Liberation of Aunt Jemima*, the artist Bettye Saar challenges the smiling brand of AUNT JEMIMA by replacing her trademark broad smile with a more militant image: She is shown holding a broom in one hand and a rifle in another. One commentator suggests, "[i]t appears she is not smiling because she is happy . . . but at the prospect of one day gaining her freedom."⁴⁹²

491. KERN-FOXWORTH, *supra* note 15, at 85 (quoting an omitted portion of Malcolm X's autobiography).

492. *Id.* at 101.