Title

Free Speech at Risk - Essays on the Intersection of IP, Technology, and Speech

ISBN

9798189271311

Author

Laketic, Jelena

Publication Date

2026-05-01

Peer reviewed|Thesis/dissertation

Free Speech at Risk - Essays on the Intersection of IP, Technology, and Speech

By

Jelena Laketić

A dissertation submitted in partial satisfaction of the

requirements for the degree of

Doctor of the Science of Law – Juris Scientiae Doctor (J.S.D.)

in the

Graduate Division

of the

University of California, Berkeley

Committee in charge:

Professor Manisha Padi, Chair

Professor Tejas N. Narechania

Professor Molly Shaffer Van Houweling

Spring 2026

Abstract

Free Speech at Risk - Essays on the Intersection of IP, Technology, and Speech

By

Jelena Laketić

Doctor of the Science of Law – Juris Scientiae Doctor (J.S.D.) University of California, Berkeley

Professor Manisha Padi, Chair

This Dissertation explores the tensions between free speech and regulation in an era of increased marketing and advertising, as well as the proliferation of digital services, including online marketplaces, social media platforms, and search engines, which facilitate the spread of both information and disinformation.

Intellectual property rights and the First Amendment frequently exist in tension. Although the First Amendment prohibits the suppression of speech, the enforcement of trademark rights may restrict someone else's speech. This conflict is also evident in the evaluation and management of user-generated content on social platforms. Because these regulatory regimes can prevent individuals from using particular language, they raise substantial free speech concerns. While scholars have acknowledged the tension among intellectual property, content moderation, and free expression, several critical areas remain insufficiently explored. Likewise, in recent years, there have been many new developments in these areas. This Dissertation integrates three papers that explore three such developments.

The first paper in this Dissertation investigates whether trademark law provides adequate protection for speech, and if so, by what mechanisms. In 2023, the Supreme Court addressed a trademark fair use claim in *Jack Daniel's Properties v. VIP Products*, a dispute involving a dog chew toy parodying the Jack Daniel's whiskey bottle. The Ninth Circuit determined that, because

the defendant's use of the marks was expressive, infringement should be assessed using a specialized speech-protective test. The case presented the Supreme Court with a fundamental question regarding the relationship between trademark law and the First Amendment. This paper contends that the Court failed to establish a clear framework for determining when and how speech is protected under trademark law.

The second paper examines the threat to free expression in the United States originating from foreign sources. Foreign free speech rules, particularly stringent European Union regulations on copyright, audiovisual content, hate speech, disinformation, and terrorist content, are increasingly shaping global content moderation, directly pressuring U.S. companies to adopt more restrictive, less speech-protective policies. This paper provides a novel perspective on analyzing the E.U. content moderation approach by placing the Digital Services Act (DSA) within the broader context of its interaction with previously adopted law applicable to online platforms.

The third paper argues that, aside from free speech issues arising from traditional IP and online platforms' activities, it is crucial to recognize the equally important, yet mostly overlooked, infrastructure-level moderation. Internet infrastructure actors, such as the Domain Name System (DNS), play a crucial role in the functioning of the internet and are increasingly receiving demands to moderate user content. This paper argues that they should steadfastly focus on the stability of the technical infrastructure and refrain from content moderation.

Taken together, these studies provide a multifaceted analysis of the evolving dynamics surrounding free speech.

To my father, Milan, whom I lost during this journey. His legacy endures within these pages.

Table of Contents

Preface

Freedom of expression is like the air we breathe. We do not feel it until it is taken away from us. The question arises: when can the speech of individuals or groups be curtailed because those in power to influence it deem it necessary or expedient to do so? Such authority may rest with trademark owners, digital service providers, online marketplaces, social media platforms, or internet domain registries and registrars. Because these entities can prevent individuals or groups from using certain language, they raise significant free speech concerns.

This Dissertation examines how such restrictions occur. It presents a multifaceted analysis that integrates trademark law, technology, digital services, and the fundamental human desire for expression.

The first paper, titled *Jack Daniel's vs. Bad Spaniels— Does a Dog toy Get Heightened First Amendment Protection*?, published in *Berkeley Technology Law Journal*, examines the tension between trademark dilution and free speech. The emergence of trademark dilution has significantly broadened trademark rights beyond consumer protection to include the safeguarding of trademark reputation. This issue is central to the Ninth Circuit's decision in VIP Products LLC v. Jack Daniel's Properties, Inc., which serves as a primary focus of the analysis.

Additionally, the discussion highlights that the Supreme Court's decision in *Jack Daniel's Properties v. VIP Products* did not address the broader implications of the intersection between trademark law and the First Amendment. The analysis concludes that no comprehensive framework currently exists for balancing trademark rights with free speech.

The second paper, titled *Sterilized Speech: The U.S. impacts of E.U. Digital Service Rules*, published in *Cleveland State University Law Review,* studies free speech issues on online platforms. In recent decades, online platforms have transformed how people communicate and interact. Speech on platforms has enabled commerce, driven political processes, facilitated revolution, and built communities. Distinguishing between beneficial and harmful content, however, has grown increasingly difficult. Beginning with the new legal framework for the illegal distribution of copyrighted works and the dissemination of audiovisual and terrorist content, the E.U. has taken the global lead and change in regulating online speech. The culmination of this approach has been the recent adoption of the Digital Services Act (DSA), which promises to revolutionize online platforms' liability.

This paper argues that the new E.U. content moderation approach will significantly affect the most prominent U.S. digital service providers and undermine some fundamental freedoms in ways that have yet to be recognized. In arguing so, this paper provides a novel perspective on analyzing the E.U. content moderation approach by placing the DSA within the broader context of its interaction with other E.U. legal instruments applicable to online platforms. When considered in the context of the E.U.'s sectoral regulation for specific types of content and national laws for Member States, the DSA may profoundly change the landscape of online speech in the U.S. and worldwide. The predominant framework through which the E.U. addresses the risks and shortcomings of online platforms is that of fundamental rights. Platforms are, therefore, expected to assess the legality of content in a wide range of sectors, ranging from copyright and audiovisual content to content linked to terrorism under a plurality of applicable legislation. In other words, online platforms should consider free expression and balance it with other fundamental rights.

However, the E.U. legislation lacks detailed guidance on what balance should be performed and how to achieve that balance in practice. In addition, platforms must rely on algorithmic tools for ex ante prevention. The paper concludes that despite the large number of new rules in the new E.U., significant legal uncertainty persists, which will pave the way for the sterilization of speech across borders. The U.S. is a particularly fertile soil for speech sterilization, considering that protection of U.S. free speech rights considerably differs from those in the E.U., still conferring immunity upon intermediaries for the user's expression.

The third paper, titled *Internet Infrastructure and Content Moderation in the Shadows*, published in Colorado *Technology Law Journal*, argues that it is important to recognize important, yet mostly overlooked infrastructure level content moderation.

Internet infrastructure actors, such as the Domain Name System (DNS), play a crucial role in the functioning of the internet and are increasingly receiving demands to moderate user content. Notably, DNS management is overseen by the Internet Corporation for Assigned Names and Numbers (ICANN), which makes it an attractive target for content monitoring by governments and censorship advocates. Governmental pressures on ICANN to moderate content exist internally through policy influence within the multistakeholder community and externally through recent E.U. Regulation.

Even though ICANN sits atop the DNS governance hierarchy, its multistakeholder bureaucracy is complex and intricate. Importantly, governmental representatives, such as the Governmental Advisory Committee (GAC), often initiate policy parameters within ICANN. This paper explains how ICANN, as the overseer of DNS management, suffers from internal pressures to moderate content through its sophisticated contractual framework. Moreover, this paper emphasizes that a thorough examination reveals that the E.U. DSA shifts content moderation practices toward internet infrastructure, including the DNS. This aspect of the DSA, entirely overlooked in existing scholarly literature, has the potential to fundamentally alter how online content is regulated and monitored.

This paper argues that the ICANN should steadfastly focus on the stability of the technical infrastructure and refrain from content moderation. The potential consequences of not adhering to this posture are grave. Without this focus, the DNS could become a powerful tool for suppressing the speech of internet users, including political dissent and minority views.

Acknowledgments

I extend my sincere gratitude to all who contributed to the completion of this research, with particular appreciation for my dissertation committee: Professor Manisha Padi (Chair), Professor Molly Shaffer Van Houweling, and Professor Tejas N. Narechania. I am especially grateful to my advisor, Professor Padi, whose consistent encouragement and guidance were invaluable throughout this journey.

I am also grateful to Professor Pamela Samuelson for her insightful lectures, constructive feedback, and thoughtful discussions, all of which significantly enriched my work. I further thank Marci Hoffman for her invaluable research expertise and assistance.

I wish to thank the Berkeley Law staff, particularly the J.S.D. program managers, as well as Professor Laurent Mayali, for their essential assistance and support throughout my studies.

I gratefully acknowledge the generous support of the Robbins J.S.D. Fellowship, which made this project possible. Without this support, its completion would not have been feasible.

Finally, I am deeply appreciative of my friends and family for their constant support. I am especially thankful to my husband, Bernardo, whose calm presence was a source of peace during this entire process. I remember those family members lost along the way and cherish my nephews, whose first words were a source of inspiration and motivation.

Any shortcomings or errors in this work are solely my own responsibility.

Part I

Jack Daniel's vs. Bad Spaniels—Does a Dog Toy Get Heightened First Amendment Protection?[*]

1. Introduction

A profound tension lies at the core of trademark law. Traditionally, a trademark's primary function was to identify the source of a product, thus protecting against deceptive uses of trademarks in commerce by enabling trademark owners to create reliable identifiers for their goods or services and reduce search costs for consumers.[1] When trademark law served primarily to prevent consumer confusion regarding the commercial origin of the goods or services, the possibility of conflicts with freedom of expression was limited.[2] However, as mass marketing and advertising techniques became ubiquitous in the commercial marketplace, legal scholars became more receptive to the notion that the primary goal of trademark laws also includes protecting the mark's reputation.[3] Consequently, conceptions regarding the scope and purpose of trademark

[*] This paper is published in *Berkeley Technology Law Journal. See* Jelena Laketic, *Jack Daniel's vs. Bad Spaniels - Does a Dog Toy Get Heightened First Amendment Protection?*, 37 BERKELEY TECH. L. J. 1413 (2022).
[1] *See, e.g.*, G. & C. Merriam Co. v. Saalfield, 198 F. 369, 373 (6th Cir. 1912) ("The entire substantive law of trade-marks . . . is a branch of the broader law of unfair competition. The ultimate offense always is that defendant has passed off his goods as and for those of the complainant."). *See also* Moseley v. V Secret Catalogue, Inc., 537 U.S. 418, 428 (2003) ("Traditional trademark infringement law is part of the broader law of unfair competition . . .That law broadly prohibits uses of trademarks . . . that are likely to cause confusion about the source of a product or service.").
[2] See Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721, 797–98 (2004) ("Traditional federal trademark law doctrinally averted collision with free speech interests by authorizing judicial intervention only in contexts in which consumers were likely to be confused. Anti-dilution statutes, however, protect trademarks from the "likelihood of injury to business reputation or of dilution of the distinctive quality of a mark" absent even arguable or pretextual confusion as to the source of goods or services.").
[3] *See* David S. Welkowitz, Reexamining Trademark Dilution, 44 VAND. L. REV. 531, 532 (1991) (noting how the protection of a trademark has evolved over the years); cf. Note, Harnessing Madison Avenue: Advertising and Products Liability Theory, 107 HARV. L. REV. 895, 904– 06 (citing cases recognizing the impact advertising has on consumer expectations). See generally Mark Bartholomew, Advertising and the Transformation of Trademark Law, 38 N.M. L. REV. 1 (2008).

protection have shifted in a way that threatens freedom of expression.[4] This focus shift is most evident in the doctrine of trademark dilution.[5]

In other words, when the concept of trademark dilution arose, trademark rights have expanded drastically from consumer-oriented protections to protect brand identities of famous marks. The Lanham Act,[6] which establishes the foundation for United States trademark law, provides mark protection against the use of similar marks if the use would likely create consumer confusion or if the dilution of a famous trademark is likely to occur.[7] What matters is not only whether there is consumer confusion about a product or service's origin, but also whether there is consumer distraction.[8] Trademark dilution thus pushes in a separate normative direction, creating a policy that often conflicts with First Amendment rights. While trademark infringement focuses on consumers and aims to prevent misleading representations, trademark dilution focuses on the seller's reputation.

Moreover, famous trademarks frequently become cultural landmarks and an integral part of expressive works. Courts have recognized that some trademarks "enter public discourse and become an integral part of our vocabulary" or "transcend their identifying purpose."[9] Not surprisingly, many of the products people want to parody are from famous brands.

Imagine entering the store intending to pick up some liquor before your party when you come across Silly Squeakers Liquor Bottles toys adorned with brands such as Doggie Walker,[10] Crispaw,[11] and Bad Spaniels. [12] Beyond their parodic features, it is unlikely that you ever

---

[4] *See, e.g.*, Mark A. Lemley, *Romantic Authorship and the Rhetoric of Property*, 75 TEX. L. REV. 873, 900 (1997) (book review) (arguing that trademark owners "are well on their way to owning the exclusive right to pun").
[5] *See* Michael K. Cantwell, *Confusion, Dilution, and Speech: First Amendment Limitations on the Trademark Estate*, 87 TRADEMARK REP. 48, 52 (1997) (noting that antidilution provisions. directly conflict with the free speech guarantees incorporated in the First Amendment).
[6] Pub. L. No. 79-489, 60 Stat. 427 (codified as amended in scattered sections of 15 U.S.C.).
[7] *See* 15 U.S.C. §§ 1125(a), 1125(c).
[8] *See, e.g.*, Lever Bros. Co. v. Am. Bakeries Co., 693 F.2d 251, 259 (2d Cir. 1982) (explaining that "the bustling, self-service atmosphere of a typical supermarket makes careful examination of products unlikely").
[9] Mattel v. Walking Mountain Prods., 353 F.3d 792, 807 (9th Cir. 2003); Twentieth Century Fox Television v. Empire Distr., 875 F.3d 1192, 1197–98 (9th Cir. 2017).
[10] *Silly Squeakers Liquor Bottles: Doggie Walker*, MYDOGTOY.COM, https://mydotoy.com/ p/Silly-Squeaker-Liquor-Bottle-Doggie-Walker (last visited Sept. 21, 2022).
[11] *Silly Squeakers Wine Bottles: Crispaw*, MYDOGTOY.COM, https://mydogtoy.com/p/ Silly-Squeaker-Wine-Bottle-Crispaw (last visited Sept. 21, 2022).
[12] *Silly Squeakers Liquor Bottles: Bad Spaniels*, MYDOGTOY.COM, https://mydogtoy.com/ p/Silly-Squeaker-Liquor-Bottle-Bad-Spaniels (last visited Sept. 21, 2022).

considered the intersection of trademark law and the First Amendment. Well, trademark owners do. They often see these products as a threat to their economic interests and seek to use the trademark law as a medium to bring these forms of cultural expression under their control.

But the question is, what sorts of parodic activity fall on the side of the protected expression as opposed to trademark rights? How can courts distinguish lawful from unlawful parodies? Should speech, both commercial and non-commercial, be allowed in trademark law? What happens when the parodies sell something other than speech itself? How can trademark law be balanced with freedom of expression?

As Ninth Circuit Judge Alex Kozinski sums up, it is when "Speech-Zilla meets Trademark Kong."[13] In assessing these battles, courts apply the *Rogers* test, named for a 1989 case involving the actress Ginger Rogers.[14] There was a need to introduce such a test because trademark law protects consumers' interest in being free from confusion about affiliations and endorsements. Still, this protection is limited by the First Amendment, especially if the product or service involved is expressive work. Aware of the necessity to balance the public's First Amendment interest in free expression against the public's interest in not being confused about affiliation and endorsement of certain products, the Second Circuit created the *Rogers* test. Under the *Rogers* test, § 43(a)[15] of the Lanham Act does not apply to expressive works "unless the [use of the trademark] has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the [use of trademark] explicitly misleads as to the source or the content of the work."[16]

This paper analyzes the development of the *Rogers* test in the Ninth Circuit's decision in *VIP Products LLC v. Jack Daniel's Properties, Inc.*, in which the court held that a squeaking dog toy resembling a bottle of Jack Daniel's whiskey is an expressive work entitled to First Amendment protection.[17]

---

[13] Mattel, Inc. v. MCA Recs., Inc., 296 F.3d 894, 898 (9th Cir. 2002), *cert. denied*, 537 U.S. 1171 (2003).
[14] Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989).
[15] 15 U.S.C. § 1125(a)(1) (prohibiting, inter alia, "any . . . false or misleading representation of fact . . . likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of such person with another person, or as to the origin, sponsorship,
[16] *Rogers*, 875 F.2d at 999.
[17] VIP Prods. LLC v. Jack Daniel's Props., Inc., 953 F.3d 1170, 1172 (9th Cir. 2020), *cert. denied*, 141 S.Ct. 1054 (2021).

Part 2 explains what a trademark is and summarizes policy arguments of trademark law. Moreover, it provides an overview of the development of dilution law and addresses the relationship between trademark infringement, dilution, and parody. Part 3 first summarizes *Rogers v. Grimaldi* and then sets forth the Ninth Circuit's application of the *Rogers* test. Part 4 explores *Jack Daniel's v. VIP Products*, both at the district level and on appeal, and considers the consequences of the Ninth Circuit's decision. This paper argues that courts have applied the *Rogers* test in cases involving a wide range of expressive works, and that was a reasonable approach here. As the Ninth Circuit once stated, the *Rogers* test is not only dependent on the identifying material appearing in the title but "also appl[ies] to the use of a trademark in the body of the work."[18] Therefore, the Ninth Circuit correctly concluded that VIP's speech is inseparable from the medium in conveying that speech. Furthermore, it lays out the Supreme Court opinions which recently sided with Jack Daniel's and strengthened trademark holders' ability to protect their trademarks against alleged parodies.[19]

This paper will argue that the Ninth Circuit was correct in its holding and, therefore, struck the right balance between trademark rights and freedom of expression. In doing so, it facilitates the application of the *Rogers* test to less conventional parodies. Moreover, it also argues that the Supreme Court decision that traditional trademark use does not receive special First Amendment protection, even when it has an expressive message, is inappropriate, and doesn't end ongoing debates regarding First Amendment protection in the context of parodies in trademark disputes.

2. Overview of Trademark Policy and Doctrine

As a springboard for this paper's analysis, Part 2 recounts fundamental aspects of trademark law, starting with an explanation of what a trademark is and how it works linguistically. Thus, this Part analyzes the internal structure of a trademark and how understanding the structure of a trademark helps distinguish it from other forms of intellectual property. Understanding the distinctive character of trademark law also raises the fundamental question of: What are the justifications for trademark law? This Part then discusses economic policy arguments undergirding trademark law

[18] E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1099 (9th Cir. 2008).
[19] Jack Daniel's Props., Inc., v. VIP Prods. LLC, 953 F.3d 1170, No. 22-148, 2023 WL 3872519 (U.S. June 8, 2023).

doctrine to answer this question. In particular, these arguments focus on consumer protection and producer protection.

2.1. The Meaning of Trademark

Trademark law has evolved and expanded beyond its traditional scope. That evolution is central to *VIP Products LLC v. Jack Daniel's Properties, Inc*., making it crucial to understand the development of trademarks and trademark law for our future analysis.

A trademark is any word, name, symbol, or device, or any combination thereof, used in commerce to identify and distinguish the goods of one manufacturer or seller from those of another and to indicate the source of the goods.[20] In simple words, a trademark is a source identifier, that is to say, a designation symbol used to denote a single seller of goods or services and distinguish it from other sellers.[21] The essence of a trademark is to accomplish a communicative task.

Starting from the linguistic meaning of the trademark, this Part's structural analysis clarifies the nature of trademark distinctiveness amongst other forms of intellectual property. Also, it sets the groundwork necessary for the study of trademark dilution to follow in later Parts. As Professor Barton Beebe has observed, a trademark is triadic in structure, consisting of three subsign elements. First, the trademark must take the form of a "tangible symbol," indicating that "the 'word, name, symbol or device, or any combination thereof' constitutes the trademark's signifier."[22] Second, the trademark holder must use the mark in commerce to refer to goods or services, which means that these goods or services constitute the brand's referent.[23] Third, the trademark is required to "identify and distinguish" its referent, which is generally achieved by identifying the referent with a specific source and its goodwill.[24] "Thus, in the case of a trademark

---

[20] *See* 15 U.S.C. § 1127.
[21] *See* Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2104 (2004); *see also* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITIOM § 3:1 (5th ed. 2019) ("Under the modern definition of the term 'trademark,' both state common law and federal law follow the definition set forth in the federal Lanham Act: a trademark is a designation used 'to identify and distinguish' the source of goods and services of a person or company. The role that a designation must play to become a 'trademark' is to identify the source of one seller's goods and distinguish that source from other sources. If the designation performs that role, then the law deems it to be 'distinctive' and legally protectable.").
[22] Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 646 (2004).
[23] *Id*.
[24] *Id*.

such as NIKE, the signifier is the word 'nike,' the signified is the goodwill of Nike, Inc., and the referent is the shoes or other athletic gear to which the 'nike' signifier is attached."[25]

If there is no linkage between the signifier and the goodwill to which it refers, there is no trademark protection. It occurs because "trade name or mark is merely a symbol of goodwill; it has no independent significance apart from the goodwill it symbolizes."[26]

Since the primary purpose of the trademark is to serve as a designation of its origin, *stricto sensu*, the trademarks say almost nothing about the composition or characteristics of the product or services.[27] For a designation to fulfill the function of identifying and distinguishing the source of the goods or services, it must impact the minds of the consumers.[28] "Only where the product configuration has an established meaning as a brand in the minds of consumers is it entitled to protection."[29]

Accordingly, the structure of trademark law is not like other forms of intellectual property. Conceptually, a trademark is a type of intellectual property. Theoretically, though, trademark law only regulates the marketplace in a way that enhances consumer welfare. Courts have also historically held that the lack of absolute ownership in a trademark differentiates it from other intellectual property rights, such as patents and copyrights.[30]

Modern commentators have maintained this critical conceptual insight, which is needed to assess the nature and justification of trademark law. For instance, McKenna argues that "courts

---

[25] *Id*.

[26] Marshak v. Green, 746 F.2d 927, 929 (2d Cir. 1984).

[27] *See* Nicholas S. Economides, *The Economics of Trademarks*, 78 TRADEMARK REP. 523, 526–27 (1988) (explaining how the information of the trademarked product is not provided to the consumers in an analytic form, but rather in summary form, through a symbol).

[28] *See* William P. Kratzke, *Normative Economic Analysis of Trademark Law*, 21 MEMPHIS ST. U. L. REV. 199, 205 (1991) ("Until a word, name, symbol or device plays some informational or identificatory role with respect to a product, it has no value.").

[29] Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 792 (2004) (citing Wal-Mart Stores, Inc. v. Samara Bros. 529 U.S. 205, 212–214 (2000)).

[30] *See, e.g.*, Del. & Hudson Canal Co. v. Clark, 80 U.S. 311, 322 (1871) ("Property in a trade-mark, or rather in the use of a trade-mark or name, has very little analogy to that which exists in copyrights, or in patents for inventions."); Prestonettes, Inc. v. Coty, 264 U.S. 359, 368 (1924) ("[W]hat new rights do the trade mark confer? It does not confer a right to prohibit the use of the word or words. It is not a copyright."); cf., Clorox Co. v. Sterling Winthrop, Inc., 117 F.3d 50, 56 (2d Cir. 1997) ("A trademark, unlike other intellectual property rights, does not confer a legal monopoly on any good or idea.").

did not view trademarks as separable from a producer's underlying business."[31] Hence, the genuine legal interest secured by trademark law is not in the signifier itself. Because trademarks are neither creative nor intellectual creations in the way that patents and copyrights are, most scholars reject the notion that trademark rights should serve as an incentive or reward for creating source-identifier-value. [32]

If the main objective of intellectual property law is to encourage the creation of new works or improvements to existing ones, whether of a technical or expressive nature, [33] the question that naturally arises is the following: What are the justifications for the existence of trademark law?

2.2. Trademark Policy Arguments

As mentioned, prominent legal scholars argue that a trademark is primarily a regulatory entitlement that prevents unfair competition and advances consumer welfare. Consequently, it is not surprising that economic analyses are common in the contemporary trademark law doctrine.[34] These justifications consider intellectual property as a system of rules that promote information efficiency. [35]

It is worth mentioning that other economic justifications for trademark law are sometimes offered. Some authors have argued that trademark law promotes the role of marks in increasing

---

[31] Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1884 (2007).
[32] *See* Roger E. Meiners & Robert J. Staaf, *Patents, Copyrights and Trademarks: Property or Monopoly?* 13 HARV. J.L. & PUB. POL'Y 911, 931 (1990) ("A trademark would have zero value in a world of perfect information because consumers could determine variations in quality and performance among products at no cost."); Deven R. Desai, *From Trademarks to Brands*, 64 FLA. L. REV. 981, 1011–12 (2012) ("Trademarks do not have property rights in gross with the same strong exclusionary and temporary monopoly power that patent and copyright law enjoy."); *see also* United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90, 98 (1918) ("In truth, a trade-mark confers no monopoly whatever in a proper sense, but is merely a convenient means for facilitating the protection of one's good-will in trade by placing a distinguishing mark or symbol-a commercial signature-upon the merchandise or package in which it is sold."); *accord* Beanstalk Grp. v. AM Gen. Corp., 283 F.3d 856, 861 (7th Cir. 2002) ("A trademark is an identifier, not a freestanding piece of intellectual property"); ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915, 922 (6th Cir. 2003) (differentiating between trademarks and patents because the patents confer a property right in gross rather than a limited interest).
[33] *See, e.g.*, Peter S. Menell & Suzanne Scotchmer, Intellectual Property Law, in 2 HANDBOOK OF LAW AND ECONOMICS (A. Mitchell Polinsky & Steven Shavell eds., 2007).
[34] *See* Beebe, *supra* note 22 at 646 ("The Chicago School of law and economics has long offered a totalizing and, for many, quite definitive theory of American trademark law.").
[35] *See* McKenna, *supra* note 31 at 1844 ("It would be difficult to overstate the level of consensus among commentators that the goal of trademark law is and always has been to improve the quality of information in the marketplace and thereby reduce consumer search costs.").

efficiency and attracting quality personnel to companies.[36] Others speak of the role of marks to facilitate franchising, brand differentiation, and national expansion of companies in different markets.[37] Non-economic justifications for trademark law exist as well. [38]Nonetheless, these less common alternative justifications should not distract the reader from the centrality of the concept of information efficiency in a market.

Professor Economides, in his well-known treatise on trademark law, states that the main reasons for the existence and protection of trademarks are that "(1) trademarks facilitate and improve consumer decisions, and (2) they encourage companies to produce products of preferable qualities even when they are not observable before purchase."[39] From an economic perspective, trademark law plays a twofold role. It facilitates the transmission of accurate information to the market and enhances incentives for firms to invest in the quality of their activities. While it is true that the minimization of consumer search costs and the promotion of investment represents "a critical intermediate objective of the trademark system, neither of these goals is an end in itself."[40] The legally protectable economic value of marks lies in their potential to generate more competitive markets.[41]

2.2.1. Consumer Protection

A trademark is a designation, or sign, that resolves an information asymmetry problem. Asymmetric information is a type of market failure where one of the agents has considerably better information about the unobservable features of a commodity for sale than the other one. [42] In the

---

[36] *See* Mira Wilkins, *The Neglected Intangible Asset: The Influence of the Trademark on the Rise of the Modern Corporation*, 34 BUS. HIST. 66, 87–88 (1992).
[37] See Robert P. Merges, Peter S. Menell, Mark A. Lemley, INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL 645–46 (3d ed. 2003) (cited in Dogan & Lemley, *supra* note 29 at 800).
[38] *See* Bone, *supra* note 21, at 2108–13 (summarizing several non-economic justifications for trademark law and describing the limitations of each).
[39] Economides, *supra* note 27, at 526.
[40] Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli,* 54 EMORY L.J. 461, 467 (2005).
[41] Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 370 (1999) ("[T]he only sensible conclusion, and the one eventually reached, was that trademark protection can both advance and disserve the development of an efficient and desirably competitive market.").
[42] Economides, *supra* note 27, at 526 ("In many markets, sellers have much better information as to the unobservable features of a commodity for sale than the buyers. This is known as information asymmetry."); *see also* George A Akerlof, *A Market for Lemons: Quality Uncertainty and the Market Mechanism*, 84 Q. J. ECON. 448, 490–91 (1970) (explaining how information affects economic decisions).

trademark context, there is a problem of uncertainty about the quality of the products. This problem becomes more complex when the consumers face more alternatives of similar perceived quality. In deciding on one product without complete certainty, the most reliable signal for the consumers is the one that commits the seller to fulfill quality promises, which is the trademark.

Trademarks minimize information and transaction costs in the market by allowing customers to evaluate the nature and quality of products before purchasing or using, [43] and sometimes even after use.[44] The more difficult it is to quickly and inexpensively inspect a product to determine its quality, the more consumers rely on trademarks.[45]

2.2.2. Producer Protection

As this paper has already discussed, the second main objective of trademark law from an economic perspective is to provide incentives to maintain and even increase the quality of the products or services. Companies have the motivation to invest resources in developing and maintaining strong trademarks. In turn, however, the value of the trademarks depends on their ability to maintain consistent quality.[46]

For this system to function correctly, legal norms are necessary. Imagine for a moment a world without trademark protection. Consumers would have struggle greatly to distinguish between

---

[43] See WILLIAM LANDES & RICHARD POSNER, THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW 167–68 (2003); Economides, *supra* note 27, at 525–27 (analyzing economic benefits of marks that inform consumers of unobservable product characteristics); Kratzke, *supra* note 28, at 214–17 (explaining how trademarks are highly efficient means of communicating product information); *see also* Qualitex Co. v. Jacobsen Prods. Co., 514 U.S. 159, 163–64 (1995) (trademark law "reduce[s] the customer's cost of shopping and making purchasing decisions," and "helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product"); Ty Inc. v. Perryman, 306 F.3d 509, 510 (7th Cir. 2002) ("The fundamental purpose of a trademark is to reduce consumer search costs by providing a concise and unequivocal identifier of a particular source of goods."). *But see* Mark P. McKenna, *A Consumer Decision-Making Theory of Trademark Law*, 98 VA. L. REV. 67, 141 (2012) ("Focusing on search costs has had serious negative effects on trademark doctrine: courts have accepted virtually any argument sounding in consumer confusion terms and the result has been nearly unbridled expansion.").

[44] *See* Charles J. Walsh & Marc S. Klein, *From Dog Food to Prescription Drug Advertising: Litigating False Scientific Establishment Claims under the Lanham Act*, 22 SETON HALL L. REV. 389, 399 (1992) ("Drugs are true 'credence' goods because they possess qualities that cannot be evaluated through normal use. The assessment of a drug's qualities normally requires complex, time-consuming, and costly studies.").

[45] *See* Menell & Scotchmer, *supra* note 33, at 1536; *see also* Bone, *supra* note 21, at 2106 (arguing that the informational function of trademarks is particularly important for products whose features are not evident upon inspection).

[46] *See* William Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 270 (1987) (noting that trademarks have a self-enforcing nature).

products that appear very similar on the surface. Moreover, trademarks would be copied freely by competitors. The cost of copying someone else's trademark is trivial. Consequently, the incentives to engage in fraudulent actions would be enormous in the absence of legal norms. "If the law does not prevent it, free riding will eventually destroy the information capital embodied in a trademark, and the prospect of free riding may therefore eliminate the incentive to develop a valuable trademark in the first place."[47] In the past, among other things, federal trademark statutes authorized a competitor to obtain relief in limited situations, and many separate laws were confusing and difficult to enforce. For these reasons, Congress passed the Lanham Act in 1946, repealing the laws of 1881, 1905, and 1920.[48]

Nowadays, every trademark infringement claim focuses on the likelihood of consumer confusion.[49] By establishing a specific legal framework for protecting trademarks against confusion, the Lanham Act ensures a trusted and mutually beneficial channel of communication between producers and consumers.[50] Trademark law encourages producers to invest in quality because they will enjoy the benefits in terms of reputation others cannot misappropriate. Consumers, on their part, can count on the reduced costs of informing themselves about the source of the product so that they can continue to buy the products of particular producers or to avoid them. [51]

Before turning to the next Part, it is essential to summarize that a trademark is primarily a regulatory entitlement that protects trademark holders by preventing unfair competition and protects the general public by advancing consumer welfare. Trademarks convey information and facilitate purchasing decisions. Trademark law also provides a remedy when two or more trademarks on the market are the same or similar to such an extent that they are likely to cause

---

[47] *Id.*
[48] See Ethan Horwitz & Benjamin Levi, Fifty Years of the Lanham Act: A Retrospective of Section 43(a), 7 FORDHAM INTELL. PROP. MEDIA ENT. L.J. 59 (1996) (providing further discussion of this topic).
[49] *See* MCCARTHY, *supra* note 21, § 30:2.50 ("All that must be proven to establish liability and the need for an injunction against infringement is the likelihood of confusion.").
[50] *See* 15 U.S.C. §§ 1114, 1125(a) (providing trademark holders, whether for a registered mark under 15 U.S.C. § 1114, or an unregistered mark under 15 U.S.C. § 1125(a), with a cause of action to protect their marks from infringement).
[51] Although we have highlighted two main rationales for the economic justification for trade-mark law, note that some authors offer additional explanations. *See, e.g.,* Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1690 (1999) (discussing the signaling function theory and "the role of trademarks in allowing the growth of complex, long-term organizations spread over a wide geographic area"). *See generally* Paul Milgrom & John Roberts, *Price and Advertising Signals of Product Quality,* 94 J. POL. ECON. 796 (1986) (presenting an economic signaling model).

consumer confusion. Because the primary effect of a trademark is informative, the distinctive character of the sign represents the critical element. That is why trademark infringement claims often focus on the likelihood of consumer confusion test.

2.3. Antidilution law

This paper began with the assertion that trademark law is characterized by a deep internal tension. Within trademark law, we can visualize a traditional central doctrine, the likelihood of confusion, and a newer, more expansive doctrine, trademark dilution. This Section seeks to support that assertion.

Trademarks protect buyers from being confused by the concurrent uses of trademarks in products or services and the relationship between the companies that produce and sell the products or services.[52] Therefore, any lawsuit for infringement of a trademark focuses on the infringement of source distinctiveness, that is, the likelihood of consumer confusion.[53]

Nevertheless, over the past three decades, trademark law has expanded beyond its traditional scope of the likelihood of confusion to protect famous marks against dilution.[54] Dilution does not necessarily imply infringement, but rather a behavior that can compromise the distinguishing effect of a famous trademark in a broader sense.[55] Trademark dilution prohibits commercial trademark uses that cause no confusing interference with a famous mark.

---

[52] *See* Beebe, *supra* note 22, at 653 (explaining that "the trademark does not identify and distinguish goods; it identifies and distinguishes the goods' source, and the identification of the goods' source identifies and distinguishes in turn the goods themselves.").
[53] *See* E. & J. Gallo Winery v. Gallo Cattle Co., 967 F.2d 1280, 1290 (9th Cir. 1992) ("The core element of trademark infringement is the likelihood of confusion, i.e., whether the similarity of the marks is likely to confuse customers about the source of the products.").
[54] *See* Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98 § 3(a), 109 Stat. 985 (codified at 15 U.S.C. §§ 1125(c), 1127 (2000)) (amended by the Trademark Dilution Revision Act in 2006); *see also* DAVID S. WELKOWITZ, TRADEMARK DILUTION: FEDERAL, STATE, AND INTERNATIONAL LAW (2002) (noting that for almost fifty years, until the Federal Trademark Dilution Act arrived in 1996, state dilution laws existed. For example, Massachusetts enacted the first dilution statute, in 1947. In addition to Massachusetts, they were state laws in Illinois (1953), New York (1955), Georgia (1955), and Connecticut (1963).
[55] *See* Christine Haight Farley, *Why We Are Confused about the Trademark Dilution Law*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1175, 1185 (2006) (noting that "[i]nterestingly, bad faith is not even present in any dilution 'test,' as it is under the traditional confusion test.").

It is commonly accepted among trademark scholars that an article by Frank Schechter introduced the concept of dilution.[56] He believed that harm occurs when a famous, distinctive mark loses its singular meaning, which is "the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon non-competing goods."[57] Although it may seem surprising to us today, when Schechter's ideas appeared, there was sustained criticism of his approach.[58]

Trademark dilution occurs when a person or company uses a trademark identical or substantially similar to the pre-existing trademark, stimulating a mental association by consumers concerning the two marks, thus lowering the strength of the original mark. As Schechter explained to Congress, "if you allow Rolls Royce restaurants and Rolls Royce cafeterias, and Rolls Royce pants, and Rolls Royce candy, in 10 years you will not have the Rolls Royce mark any more."[59] In other words, dilution occurs when, because two signifiers are similar, the junior signifier (the tangible form of the mark) dilutes the distinctiveness of the senior signifier.[60] Recall that according to Beebe's semiotic relationship, "differential distinctiveness describes the extent to which a mark's signifier is distinctive from other signifiers in the trademark system."[61] In the typical dilution example, the plaintiff's and the defendant's signifiers (the tangible form of the trademark) are very similar, if not indistinguishable. Still, because their referents id the products to which the marks are affixed) are sufficiently different, consumers are not confused as to source.

---

[56] *See* Frank I. Schechter, *The Rational Basis of Trademark Protectio*n, 40 HARV. L. REV. 813, 816–18 (1927) (discussing the judgment of September 11, 1924, Landgericht Elberfeld, 25 Jurigtiche Wochemschrift 502, XXV Markenschutz and Wettbewerb (M.U.R) 264, in which a German court prevented the name, originally registered in connection with a famous mouthwash, from being used in connection with unrelated steel products).
[57] *Id*. at 825.
[58] *See, e.g.*, John Wolff, *Non-Competing Goods in Trademark Law*, 37 COLUM. L REV. 582, 602 (1937) (arguing that Schechter's position was very radical for the North American courts, basically because the American law of unfair competition rests on the imitation behavior, while German law admits immoral acts, which makes it much broader when it comes to be applied and further stating "[t]he very incongruousness of Schechter's theory with the tradition and the fundamental principles of the common law forms the chief obstacle to its general acceptance in this country"); Felix S. Cohen, *Transcendental Nonsense and the Functional Approach*, 35 COLUM. L REV. 809, 814 (1935) (noting that Schechter had focused on the damage, but not the cause (misappropriation)).
[59] Hearings Before the House Comm. on Patents, 72d Cong. 15 (1932) (statement of Frank I. Schechter), *quoted in* Robert Burrell & Michael Handler, *Dilution and Trademark Registration*, 17 TRANSNAT'L L. & CONTEMP. PROBS. 713, 742 (2008).
[60] *See* Beebe, *supra* note 22, at 676; *see also* Richard A. Posner, *When Is Parody Fair Use?*, 21 J. LEGAL STUD. 67, 75 (1992) ("A trademark seeks to economize on information costs by providing a compact, memorable, and unambiguous identifier of a product or service. The economy is less when, because the trademark has other associations, a person seeing it must think for a moment before recognizing it as the mark of the product or service.").
[61] Beebe, *supra* note 21, at 625.

Consequently, this situation does not give rise to trademark infringement, which requires to show a likelihood of confusion between the two products. As Beebe points out, in this sense, trademark dilution constitutes a type of "nontrespassory nuisance" as to the plaintiff's signifier.[62] The trademark dilution action is intended to avoid such nuisances and, by doing so, preserve the differential distinction of the plaintiff's signifier, regardless of the referent to which it is assigned.[63] "The prohibition against dilution is thus a prohibition against interference in intermark relations of value between the plaintiff's signifier and all other signifiers in the trademark system."[64]

Curiously, the notion of dilution originally arose in Germany in 1924, in the *Odol* case, which was essentially a misappropriation case that happened to implicate a trademark.[65] There, the plaintiff used "Odol" in connection with mouth-wash product, while the respondent succeeded in registering "Odol" for products in steel industry. Nonetheless, the *Odol* court did not analyze the facts before it under trademark provisions.[66] However, as Beebe argued, when Schechter introduced the concept of dilution, he omitted that dilution was a doctrine of misappropriation and went as far as to erase the court's fundamental conclusion from his translation of *Odol'*s opinion to support his concept of trademark dilution theoretically.[67]

---

[62] *Id.* at 676.
[63] *Id*.
[64] *Id*. (emphasis original).
[65] *See* Barton Beebe, *The Suppressed Misappropriation Origins of Trademark Antidilution Law: The Landgericht Elberfeld's Odol Opinion and Frank Schechter's "The Rational Basis of Trademark Protection*,*"* INTELLECTUAL PROPERTY AT THE EDGE: THE CONTESTED CONTOURS OF IP 59, 64–70 (Rochelle Cooper Dreyfus & Jane C. Ginsburg, eds, 2014).
[66] *See id*. at 65 ("Instead, it based its decision on two other provisions in German law, neither of which required a showing of consumer confusion. The first was § 826 of the German Civil Code of 1900 (the 'BGB'): 'Who, in a manner contrary to good morals [*gegen die guten Sitten*], intentionally inflicts damage on another is liable to compensate the other for the damage.' The second was § 1 of the Law against Unfair Competition of 1909 (the 'UWG'): 'Who, in the course of trade, takes actions that impede against good morals [*gegen die guten Sitten*] can be sued for injunctive relief and compensation.'" (citations omitted)).
[67] *See id*. at 71–72 ("Schechter omitted one sentence in particular. The penultimate page of 'Rational Basis' provides a lengthy block quotation from the Wertheimer translation, but from the middle of that block quotation Schechter excised and replaced with an ellipsis the following sentence, now familiar to us, from the *Odol* opinion: 'It is opposed to good morals to appropriate thus the fruits of another's labor in the consciousness that that other will or may thereby be damaged.' Why would Schechter feel compelled to suppress the *Odol* court's core finding, the very foundation of its ruling? Schechter's expurgation of this sentence is consistent with another peculiarity of 'Rational Basis.' While the *Odol* court did not hesitate to explain why the respondent used the 'Odol' mark ('for the obvious purpose of deriving from its selling power some advantage in marketing its own products'), Schechter scrupulously avoided speculating in 'Rational Basis' on what motivated defendants to adopt famous marks. Instead, he addressed only the damage such conduct inflicted on those marks. Indeed, he repeatedly sought to focus attention on the mysterious nature of this damage. Schechter's purpose here was the same that motivated his deletion of the *Odol* court's reference to 'appropriate[ing] thus the fruits of another's labor': he sought to suppress any link between trademark dilution and misappropriation. Schechter did so, I suggest, in an attempt to cloak his concept of dilution in the emerging fashion of legal realism." (citations omitted)).

Nowadays, dilution actions fall into one of two categories. The first is dilution by blurring,[68] which manifests as the weakening of the power of sale and the value of a trademark through the unauthorized use of a trademark or service mark of a different nature but can weaken associations between a trademark and its product category and other distinctive aspects, which then ceases to function as a unique identifier.[69] The second is dilution by tarnishment.[70] It occurs when a famous brand is linked with harmful or poorquality products or services, creating unwanted associations or causing a reduction in the level of preference of the famous mark.[71]

Dilution's importance is not for protecting consumers per se but rather the private interests of trademark owners and trademarks themselves.[72]Then, both types of dilution[73] are similar in that the doctrine of dilution demands neither proof of confusion nor competition between the parties.[74]

---

[68] 15 U.S.C. § 1125(c)(2)(B).
[69] Menell & Scotchmer, *supra* note at 1552 (explaining how dilution by blurring imposes some costs on consumers and the famous trademark owner). As "new use of the Rolls Royce term gained popularity, the association between the mark and a particular source would become blurred. Furthermore, as more companies in unrelated markets adopt this moniker—Rolls Royce tennis racquets, Rolls Royce landscaping, Rolls Royce tacos—the distinctive quality of the mark would become further eroded. Over time, consumers would lose the non-product specific identity (i.e., Rolls Royce as a brand of uncompromising quality and ornate styling) that the original Rolls Royce mark once evoked." *Id*.
[70] 15 U.S.C. § 1125(c)(2) C).
[71] See Menell & Scotchmer, *supra* note 33, at 1553 ("If the maker of pornographic films were to sell their movies under the brand 'Disney,' it is unlikely that consumers would believe that the Disney Corporation, famous for family orient-ed entertainment, was the manufacturer of such unwholesome products. Nonetheless, consumers' shopping lexicon would arguably be distorted because the Disney name would trigger associations with both family-oriented content and smut. Such a negative association could well injure the Disney Corporation's brand equity. As with blurring, tarnishment interferes with established associations. Perhaps even more so than blurring, it undermines brand equity.").
[72] Eric A. Prager, *The Federal Trademark Dilution Act of 1995: Substantial Likelihood of Confusion*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 121, 123 (1996); *see also* Mosely v. V Secret Catalogue, Inc., 537 U.S. 418, 428 (2003) (nothing that "[u]nlike traditional infringement law, the prohibitions against trademark dilution . . . are not motivated by an interest in protecting consumers."); *cf*. Transcript of Oral Argument, Ringling Bros.-Barnum & Bailey v. Utah Div. of Travel Dev., 935 F. Supp. 763 (E.D. Va. 1996), quoted in Farley, *supra* note 55 at 1177 (where the federal appellate judge in litigation under the first federal dilution statute said to the attorney of the trademark owner "boy you must have some lobby to get a law like that passed.").
[73] Interestingly, Schechter never conceived of blurring or tarnishment as forms of trademark dilution, nor did he ever use these denominations. Yet these conceptualizations of dilution have become dominant in the US approach to antidilution protection. For more information, *see* Beebe, *supra* note 65, at 79–80 ("It is a strange irony that the German- American treatise writer Rudolf Callmann is largely responsible for the Americans' embrace in the late century of blurring and tarnishment, terms which Callmann initially took from an anonymous 1964 Harvard Law Review note. The irony is that Callmann made no effort in his many publications on dilution to hide the misappropriation basis and rights-in-gross nature of antidilution protection. On the contrary, he openly advocated conceiving of trademark law as a species of property law rather than unfair competition law and candidly stated his belief that when courts held in favor of antidilution plaintiffs, they did so on misappropriation grounds.").
[74] Franklin Mint Co. v. Manatt, Phelps & Phillips, LLP, 109 Cal. Rptr. 3d 143, 170 (Cal. App. 2010) ("In the dilution context, likelihood of confusion is irrelevant."). Some courts even recognized actionable dilution in the post-sale context. *See* Ferrari S.P.A. Esercizio v. Roberts, 944 F.2d 1235, 1245–46 (6th Cir. 1991); Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208, 218 (2d Cir. 1999). On the other hand, trademark law has traditionally tolerated numerous uses of same word in unconnected context, as long as these uses do not confuse the consumers. *See* MCCARTHY, *supra* note

However, in a claim for dilution by tarnishment, the focus is on the mark owner's goodwill, not on the mark's distinctiveness. [75] The underlying idea is that although consumers are unlikely to think that the trademark owner is affiliated with the junior user's distasteful or substandard goods, they "will nonetheless no longer have uniformly positive associations with the original trademark as a result of her exposure to the tarnishing use."[76] As advertising shifted from informative to persuasive strategies, trademark dilution came to safeguard the advertising power of trademarks. In this regard, dilution constitutes a significant shift in trademark jurisprudence. To put it simply, "dilution begins where infringement and its likelihood of confusion test reach their doctrinal limits."[77]

Hence, dilution theories are difficult to square with traditional trademark principles because, in the long term, dilution is more about enforcing moral judgments than regulating economic behavior. [78] "[M]odern trademark law differs fundamentally from its traditional counterpart in its understanding of what a trademark does and how it adds value."[79] There can be no doubt that most

21, § 24:11 ("If there is no likelihood of confusion (and in absence of dilution), the same marks can peacefully co-exist on different goods and services. Some well-known examples of co-existence include United Airlines and United Van Lines, Eagle Shirts, Eagle Pencils, Eagle Pretzels, Eagle Brand Condensed Milk, Champion spark plugs and Champion sportswear, Delta Airlines, Delta Dental Insurance and Delta Faucets, Ace retail hardware stores and Ace bandages, Tropicana Las Vegas Hotel and Tropicana orange juice, The Dow Stock Market Index and Dow Chemical Company, Dell Computers and Dell Magazines."). *But see* Robert Brauneis & Paul Heald, *Trademark Infringement, Trademark Dilution, and the Decline in Sharing of Famous Brands: An Introduction and Empirical Study*, 59 BUFF. J. INT'L L. 141 (2011) (stating that brand sharing has declined significantly over the past decades due to the anti-dilution law).

75 Sandra L. Rierson, *The Myth and Reality of Dilution*, 11 DUKE L. & TECH. REV. 212, 245 (2013) (" [I]n a claim for dilution by tarnishment, the association between the two marks is actionable not because it harms the mark's distinctiveness, but because, in theory, it harms the mark owner's goodwill."); *see also* TY Inc. v. Perryman, 306 F.3d 509, 511 (7th Cir. 2002) ("[C]onsumers will not think the striptease joint [is] under common ownership with the jewelry store. But because of the inveterate tendency of the human mind to proceed by association, every time they think of the word 'Tiffany' their image of the fancy jewelry store will be tarnished by the association of the word with the strip joint.").

76 Rierson, *supra* note 75 at 246. *But see* Landes & Posner, *supra* note 43, at 306–07 (holding that there are possible economic justifications for this extension of the trademark law. These justifications are related to the potential for confusion, external benefits, and investment in reputation capital.).

77 Paul Edward Kim, *Preventing Dilution of the Federal Trademark Dilution Act: Why the FTDA Requires Actual Economic Harm*, 150 U. PA. L. REV. 719, 723 (2001). *But see* Gerard N. Magliocca, *One and Inseparable: Dilution and Infringement in Trademark Law*, 85 MINN. L. REV. 949, 966 (2001) ("Although dilution is often described as starting where the likelihood of confusion test leaves off, it is more accurate to say that infringement follows a fortiori from dilution.").

78 *See* Mark Bartholomew, *Trademark Morality*, 55 WM. & MARY L. REV. 85, 138 (2013); *see also* Farley, *supra* note 55 at 1183–84 (stating that "what is being sought by the trademark bar is statutorily enforced mind control" and that "the main problem with dilution law is that it provides a remedy without a supportable theorization of the harm").

79 McKenna, *supra* note 31 at 1843.

the important assignment in designing a new legal institution is the choice of a leading concept fit to be instantiated. In doing so, a new legal context as well as existing laws should be considered.

Yet Professor McCarthy has stated that "[n]o part of trademark law that I have encountered in my forty years of teaching and practicing IP law has created so much doctrinal puzzlement and judicial incomprehension as the concept of "dilution" as a form of intrusion on a trademark."[80] Even the United States Supreme Court has had trouble understanding what dilution is.[81] Not surprisingly, almost every aspect of dilution law has been the subject of sustained criticism over the last decades.[82] Before proceeding to the next Part, note that dilution law grants special

---

[80] J. Thomas McCarthy, *Dilution of a Trademark: European and United States Compared*, 94 TRADEMARK REP. 1163, 1163 (2005); *see also* Robert G. Bone, *Schechter's Ideas in Historical Context and Dilution's Rocky Road*, 24 SANTA CLARA COMPUT. & HIGH TECH. L.J. 469, 470 (2008) ("Dilution is one of the great mysteries of trademark law. Judges have trouble understanding it and scholars have difficulty justifying it.").

[81] *See* Farley, *supra* note 55 at 1177 (explaining how in *Moseley v. V Secret Catalog*, 537 U.S. 418 (2005) nearly all the questions from the Justices were seeking to simply understand what dilution is).

[82] *See, e.g.*, Clarisa Long, *Dilution*, 106 COLUM. L. REV. 1029, 1037 (2006) (highlighting that the harm of dilution is elusive because it is not clear whom the law is trying to protect); Farley, *supra* note 55 at 1184 (arguing that anti-dilution law provides a remedy without a supportable theory of the harm and that, if any harm can be traced to dilutive speech, it is harm to the ability of merchants to profit from psychological manipulation of consumers); Mary LaFrance, *No Reason to Live: Dilution Laws as Unconstitutional Restrictions on Commercial Speech*, 58 S.C. L. REV. 709 (2007) (analyzing the free speech implications of anti-dilution protection); *accord* Robert G. Bone, *A Skeptical View of the Trademark Dilution Revision Act*, 11 INTELL. PROP. L. BULL. 197 (2007) (arguing that dilution lacks a coherent policy foundation); *see* Robert N. Klieger, *Trademark Dilution: The Whittling away of the Rational Basis for Trademark Protection*, 58 U. PITT. L. REV. 789, 841 (1997); Kristen Friday, *Does Dilution Make Trademarks into Unconstitutional Patents?*,12 J. CONTEMP. LEGAL ISSUES 180, 183 (2001) (both questioning the constitutionality of the Federal Trademark Dilution Act); Kenneth L. Port, *The Commodification of Trademarks: Some Final Thoughts on Trademark Dilution*, 46 HOFSTRA L. REV. 669, 669 (2017) (arguing that the Federal Trademark Dilution Act "has not been the panacea for famous marks it was intended to be and has created perverse unintended consequences"); *cf*. Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507 (2008) (questioning the imagination cost argument); Graeme W. Austin, *Tolerating Confusion about Confusion: Trademark Policies and Fair Use*, 50 ARIZ. L. REV. 137 (2008) (pouring scorn on the imagination cost argument); Sarah Lux, *Evaluating Trade Mark Dilution from the Perspective of the Consumer*, 34 U.N.S.W. L.J. 1053 (2011) (arguing that consumer-based justifications for anti-dilution protection lack internal consistency); Rierson, *supra* note 75 (arguing that the costs of anti-dilution laws to free speech and competition exceed any benefits to trademark owners); Christopher Buccafusco, Paul J. Heald & Wen Bu, *Testing Tarnishment in Trademark and Copyright Law: The Effect of Pornographic Versions of Protected Marks and Works*, 94 WASH. U. L. REV. 341 (2017) (finding no statistically significant empirical proof of trademark tarnishment, and some significant evidence of enhanced consumer preferences to the tarnished movies); *see also* Barton Beebe & C. Scott Hemphill, *The Scope of Strong Marks: Should Trademark Law Protect the Strong More Than the Weak?*, 92 N.Y.U. L. REV. 1339, 1339 (2017) (holding that strong trademarks are less likely to be confused with imitations); Graeme W. Austin, *Trademarks and the Burdened Imagination*, 69 BROOK. L. REV. 827, 904–05 (2004) (explaining that "trademark law's understanding of the consumer is sometimes much less rational than consumers have been throughout history"); Chris Brown, *A Dilution Delusion: The Unjustifiable Protection of Similar Marks*, 72 U. CIN. L. REV. 1023, 1038–39 (2004) (quoting psychology evidence that the mental activity regarding related uses may reinforce rather than blur the trademark in some cases). *See generally* Barton Beebe, Roy Germano, Christopher Jon Sprigman & Joel Steckel, *Testing for Trademark Dilution in Court and the Lab*, 86 U. CHI. L. REV. 611 (2019) (casting doubt on evidence of dilution by blurring). *But see* Jerre B. Swann, *An Interdisciplinary Approach to Brand Strength*, 96 TRADEMARK REP. 943, 975–76 (2006) (defending dilution law).

protection to well-known marks by prohibiting all variations and evocation of the trademark, even those that do not constitute trademark infringement. Unlike a trademark infringement action, which protects both consumers and trademark owners, the dilution action works to benefit the trademark owners. It does so even when there is no appreciable risk that a consumer will confuse the origin of the product associated with the trademark.

2.4. Dilution v. Parody

Dictionaries provide two definitions of parody: (1) a "composition in prose or verse in which the characteristic turns of thought and phrase in an author or class of authors are imitated in such a way as to make them appear ridiculous,"[83] and (2) a "literary or artistic work that imitates the characteristic style of an author or a work for comic effect or ridicule."[84]

As some scholars have noted, "[p]arodies make fun of a thing by copying enough of it to make it the author of a parody knows his or her subject well; however, the parodist does not need to affect a pretension of ignorance. In fact, the parodist makes his or her familiarity with the original work obvious."[85]

To understand what parody means in trademark law context, it is helpful to mention how the courts define a parody. An often-cited decision says that a parody is "a simple form of entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark's owner."[86] The Supreme Court follows this order of ideas by defining parody as "the use of some elements of a prior author's composition to create a new one that, at least in part, comments on that author's works."[87]

---

[83] Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 580 (1994) (quoting 11 THE OXFORD ENGLISH DICTIONARY 247 (2d ed. 1989)).
[84] *Id*. (quoting THE AMERICAN HERITAGE DICTIONARY 1317 (3d ed. 1992)).
[85] Roger J. Kreuz & Richard M. Roberts, *On Satire and Parody: The Importance of Being Ironic*, 8 METAPHOR & SYMBOLIC ACTIVITY 97, 103 (1993).
[86] Louis Vuitton Malletier, S.A. v. My Other Bag, Inc., 156 F. Supp. 3d 425, 434 (S.D.N.Y. 2016) (quoting Haute Diggity Dog, 507 F.3d at 260); *see also* L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 34 (1st Cir.1987).
[87] *Campbell*, 510 U.S. at 580. Although a copyright fair use case, *Campbell*'s application has not been limited to copyright cases; *see, e.g.*, Elvis Presley Enters., Inc. v. Capece, 141 F.3d 188, 199 (5th Cir. 1998) ("[T]he Supreme Court considered parody in the copyright context, which is relevant to the treatment of parody in the trademark context."); Mattel, Inc. v. MCA Recs., Inc., 296 F.3d 894, 901 (9th Cir. 2002) (applying *Campbell*'s requirement that parody must target the original).

Generally, to be successful, a parody must: "communicate some articulable element of satire, ridicule, joking, or amusement,"[88] it "must convey two simultaneous—and contradictory—messages: that it is the original, but also that it is not the original."[89] Thus, "[a] parody relies upon a difference from the original mark, presumably a humorous difference, in order to produce its desired effect."[90]

Now that we know why the dilution doctrine represents "a fundamental shift in the nature of trademark protection,"[91] it is easier to understand how dilution laws have far-reaching non-economic costs, as they have the potential to infringe upon protected speech, such as parody. [92] For example, trademark owners repeatedly invoke anti-dilution provisions against junior users of their trademarks in a manner they dislike. They bring claims for singing about Barbie doll, [93] poking fun of a Louis Vuitton handbag,[94] making fun of L.L. Bean's mail order catalog, [95]or operating suck sites. [96]

As one commentator put it, "[p]roponents of anti-dilution law often argue that dilution doctrine is properly limited if it is applied to prevent only 'commercial' and not 'expressive' junior uses of

---

[88] *Louis Vuitton*, 507 F.3d 252, 260 (4th Cir. 2007).
[89] PETA v. Doughney, 263 F.3d 359, 366 (4th Cir. 2001) (quoting Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc., 886 F.2d 490, 494 (2d Cir. 1989)).
[90] Jordache Enters, Inc. v. Hogg Wyld, Ltd., 828 F.2d 1482, 1486 (10th Cir.1987) (finding the use of "Lardashe" jeans for larger women to be a successful and permissible parody of "Jordache" jeans).
[91] Lemley, *supra* note 51 at 1698; *see also* Rierson, *supra* note 75 at 212 (2013) ("A plaintiff may state a claim for dilution even though no one is likely to be confused; plaintiff and defendant do not compete; and plaintiff has incurred no actual economic injury."); *id*. at 214 ("We do not require trademark holders to prove actual economic injury in the context of a dilution claim because, in truth, there probably is none. Instead, we have granted the holders of famous trademarks the equivalent of a moral right to these marks: an extension of the rights granted to a creator of an expressive work in the copyright context."); Long, *supra* note 82 at 1035–36 ("Dilution is a more exclusionary version of the trademark entitlement than the classic likelihood-of-confusion variant."); Margaret Jane Radin & R. Polk Wagner, *The Myth of Private Ordering: Rediscovering Legal Realism in Cyberspace*, 73 CHI.-KENT L. REV. 1295, 1305 (1998) (noting that modern trademark law is moving towards a property rights regime).
[92] Wendy J. Gordon, *Introduction, Symposium, Ralph Sharp Brown, Intellectual Property, and the Public Interest*, 108 YALE L.J. 1611, 1614–15 (1999) (expressing concern regarding dilution's capability to frustrate comparative advertising and parody); *see also* Barton Beebe & Jeanne Fromer, *Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion*, 131 HARV. L. REV. 945, 982 (2018) ("[W]hen we use our language, nearly three-quarters of the time we are using a word that someone has claimed as a trademark.").
[93] *See* Mattel, Inc. v. MCA Recs., Inc., 296 F.3d 894, 899 (9th Cir. 2002); *see also* Stacey L. Dogan & Mark A. Lemley, *Parody as Brand*, 47 U.C. DAVIS L. REV. 473, 474–77 (2013) (discussing trademark cases concerning parodies).
[94] Louis Vuitton Malletier, S.A. v. My Other Bag, Inc., 156 F. Supp. 3d 425, 430 (S.D.N.Y. 2016); Louis Vuitton, 507 F.3d 252 at 257.
[95] *See* L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 27 (1st Cir. 1987).
[96] *See, e.g.*, Bosley Med. Inst. v. Kremer, 403 F.3d 672 (9th Cir. 2005); Lamparello v. Falwell, 420 F.3d 309, 311 (4th Cir. 2005).

trade marks."[97] Apropos the issue at hand, dilution law provides a general exemption from dilution liability for any non-commercial use of a trademark.[98] There are internal statutory safeguards for any *fair use* of a trademark designed to identify and parody, criticize, or comment upon "the famousmark owner or the goods or services of the famous mark owner."[99]Nonetheless, these safeguards do not apply if the defendant has used the plaintiff's trademark as a source designation for his or her own goods or services. [100]

For parodists, the statute configuration produces difficulties in evaluating potential liability. Although there is an unequivocal defense for parody, it applies specifically to parody that uses the trademark other than as a designation of source. Both First Amendment and trademark jurisprudence give special status to non-commercial speech, which is reflected in court decisions.[101] Consequently, parody in many cases does not benefit from this defense. It occurs because, most commonly, variations of famous trademarks appear on the front of T-shirts, posters, toys, or mugs intended for commercial sale. In these cases, we have a symbiosis of commercial and non-commercial speech. There is an offer to sell something apart from the parody itself.

Since the statute's fair use defense does not include all parodies that behave as trademarks, courts engage in a fact-specific analysis of factors in these kinds of cases. [102] Unsurprisingly, courts

---

[97] Lux, *supra* note 82 at 1062; *see also* 15 U.S.C. § 1125(c)(3)(C) (containing a general exemption from dilution liability for any non-commercial use of a trademark).
[98] 15 U.S.C. § 1125(c)(3)(C).
[99] 15 U.S.C. § 1125(c)(3)(A)(ii).
[100] 15 U.S.C. § 1125(c)(3)(A)); *see also* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:90 (5th ed. Dec. 9) ("First Amendment protection is greatest in the case of an editorial, noncommercial parody which causes tarnishment. Free speech concerns are somewhat lessened, but still relevant, where the parody is a trademark used to identify a commercial product such as wearing apparel.").
[101] *See* Brown v. Ent. Merchs. Ass'n, 564 U.S. 786, 790 (2011) (noting that non-commercial speech is often sold for profit); *see also* L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 32 (1st Cir. 1987) (concluding there is no dilution because defendant "did not use Bean's marks to identify or promote goods or services to consumers; it never intended to market the 'products' displayed in the parody"). *But see* Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC, 221 F. Supp. 2d 410, 415–16 (S.D.N.Y. 2002) (noting that the parody was serving as a brand and was not entitled to First Amendment protection).
[102] *See* 15 U.S.C. §§ 1125(c) (2) (B) (i) (vi) (listing six non-exclusive factors that courts may consider in determining whether dilution by blurring is likely to occur, but not suggesting any specific factor for a court to consider when deciding whether dilution by tarnishment has occurred); *see also* Dogan & Lemley, *supra* note 93 at 490 ("Brand parodies, then, don't fit well within existing trademark infringement or dilution law. Parodies generally don't confuse consumers, and because they refer back to the plaintiff's mark directly they will not generally blur or tarnish that mark in the way dilution law prohibits. True parodies thus cause none of the harms that trademark law seeks to avoid. But because neither law is structured with parodies in mind, rote application of infringement and dilution standards can result in a condemnation of even obvious parodies. Lacking tools specifically designed for parody, courts treat it in an ad hoc way that reflects their own subjective assessment of the value or parody and the morality of free rides.").

have struggled with the parody analysis. While courts have protected parodies in some trademark cases, they have also held other parodies to be illegal.[103]

In *State University of New York v. Fox*, the Supreme Court ruled that when the commercial elements of a mixed communication are not "inextricably intertwined" with its fully protected non-commercial elements, the entire communication can be regulated as commercial speech. [104] Curran explained the that "inextricably intertwined" inquiry provides complete First Amendment protection for high-value speech, such as parody or criticism, when lower-value elements such as commercial advertising represent a fraction of the general message. [105] Moreover, Curran suggested using the Fox test to establish whether dilutive use is "inextricably intertwined" with the noncommercial elements of speech. [106] In this sense, if a dilutive use points to a famous mark to parody or criticize it, its high-value expressive content cannot be separated from its dilutive use of the trademark, because those uses are an essential element of parody or criticism targeting a trademark.[107]

Courts have used similar reasoning in when deciding issues of whether commercial and non-commercial aspects of speech are intertwined. [108] They all indicate that commercial speech cannot,

---

[103] Lux, *supra* note 82 at 1063 ("Courts have vacillated between the view that the slightest amount of commercial intent, content or effect should cause the entirety of the speech in question to be regarded as commercial and the notion that even the most trivial expressive content or purpose must render speech non-commercial lest freedom of expression become illusory."); see*, e.g.*, Hormel Foods Corp. v. Jim Henson Prods., Inc., 73 F.3d 497, 508 (2d Cir. 1996) (holding that the defendant's use of a character named "SPA'AM" in a Muppets movie was a permissible parody of plaintiff's "Spam" mark for potted meat. However, by focusing on finding that there was no likelihood of confusion or dilution, the court did not apply any sort of speech or some parody related test); Black Dog Tavern Co. v. Hall, 823 F. Supp. 48, 55 (D. Mass. 1993) (finding "Black Hog" and "Dead Dog" marks unlikely to be confused with "Black Dog" trademark); Smith v. Wal-Mart Stores, Inc., 537 F. Supp.2d 1302, 1339–40 (N.D. Ga. 2008) (a critic of Wal-Mart who created "Walocaust" T-shirts was held not to have tarnished the plaintiff's "Wal-Mart" marks because he was not engaging in commercial speech, and thus the parody was non-commercial); *see also* Dogan & Lemley, *supra* note 93 at 490 ("[B]ecause neither law is structured with parodies in mind, rote application of infringement and dilution standards can result in a condemnation of even obvious parodies. Lacking tools specifically designed for parody, courts treat it in an ad hoc way that reflects their own subjective assessment of the value or parody and the morality of free rides."). *But see*, Mutual of Omaha Ins. Co. v. Novak, 836 F.2d 397, 399 (8th Cir. 1987) (holding that defendant's antinuclear T-shirts, featuring a picture and the words "Mutant of Omaha," were likely to confuse consumers whether the insurance company "Mutual of Omaha" was sponsoring the shirts).

[104] Bd. of Trs. v. Fox, 492 U.S. 469, 474 (1989).

[105] Patrick D. Curran, *Diluting the Commercial Speech Doctrine: Noncommercial Use and the Federal Trademark Dilution Act*, 71 U. CHI. L. REV. 1077, 1102 (2004).

[106] *Id.*

[107] *Id.*

[108] *See, e.g.*, Riley v. Nat'l Fed'n of the Blind, 487 U.S. 781, 796 (1988) ("[W]e do not believe that the speech retains its commercial character when it is inextricably intertwined with otherwise fully protected speech."); Mattel, Inc. v. MCA Recs., Inc., 296 F.3d 894, 906–07 (9th Cir. 2002) (noting that the commercial purpose of using "Barbie" in a

and should not, be equated with political or artistic speech and should, therefore, not receive the same degree of protection. Like in the many cases that involved "inextricably intertwined" speech, it was reasonable for the Ninth Circuit to embrace this perspective in *VIP Products LLC v. Jack Daniel's Properties, Inc*. The commercial purpose of imitating Jack Daniel's in a dog toy was "inextricably intertwined" with the expressive elements. Eliminating the commercial aspects of the Bad Spaniels parody dog toy would necessarily excise non-commercial parts, as the restriction would apply to the parody itself.

From a legal perspective, it is necessary to achieve coherence to the concept of parody despite its diverse appearances. "To create a defense for brand parodies, we need either a definition of what a parody is or a general principle that encompasses brand parodies along with other forms of protected uses of a trademark."[109] Although there is no uniform position on whether parody deserves legal protection, jurisprudence and legal doctrine recognize that parody is a valuable form of social commentary. [110]As such, it is recognized within the *Rogers* test, which was developed explicitly to deal with non-commercial speech. Subsequently, circuit courts have applied *Rogers* test to a wide range of non-commercial speech.[111]

---

song title was "inextricably intertwined" with the "expressive elements"); Parks v. LaFace Recs., 329 F.3d 437, 449 (6th Cir. 2003) ("[I]f a song is sold, and the title is protected by the First Amendment, the title naturally will be 'inextricably intertwined' with the song's commercial promotion.").

[109] *See* Dogan & Lemley, *supra* note 93 at 498; *see also* Acuff-Rose Music, Inc. v. Campbell, 972 F.2d 1429 (6th Cir. Tenn. Aug. 17, 1992) ("Unfortunately, the terminology of the fair use analysis has evolved in such a way that the popular definition of parody and the statutory definition of parody as a form of criticism have become somewhat confused.").

[110] *See* Simon Dentith, PARODY, 159–64 (2000) (noting significant importance of parody in contemporary culture); *see also* Dogan & Lemley, *supra* note 93 at 486 ("Even more than non-commercial forms of parody, the subversive use of a parody as brand invites critical reflection on the role of brands in society and the extent to which we define ourselves by them. Brands that parody, in other words, offer a unique platform for expression and pose little threat to trademark law's core values."); *id*. at 494–95 ("Traditional trademarks serve as the source of goods and therefore protect the customer from fake goods. By contrast, Nike swooshes, red shoe bottoms, and Chanel purse logos are not really about ensuring purchasers make the right decision, but about allowing purchasers to tell the rest of the world about that decision. Were it otherwise, known counterfeits wouldn't be so popular. Brands, then, don't just help trademark owners speak; they help all of us speak. And that speech is so common that refusing to wear brand names is itself a recognized counter-cultural statement. Which brings us back to brand parody. As discussed above, brands that parody have a dual target: the brand itself and the phenomenon of branding. Given the prevalence of branding and its economic and social impact, commentary about both brands and branding is a matter of public concern."); Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994) ("Like less ostensibly humorous forms of criticism, [parody] can provide social benefit, by shedding light on an earlier work, and, in the process, creating a new one."); Hariman, Robert, *Political Parody and Public Culture*, Q.J. SPEECH 247, 260 (2008) (explaining how genres such as parody play a particularly crucial role in keeping democratic speech a multiplicity of discourses). "Other forms of speech such as formal debate will also generate awareness that public speech is both partial and disposed to exaggerate, but parody does it best." *Id.*

[111] *See, e.g.*, Seale v. Gramercy Pictures, 949 F. Supp. 331, 339–40 (E.D. Pa. 1996) (applying *Rogers* test to film content); Found., Inc. v. NAACP, 786 F.3d 316, 329 (4th Cir. 2015) (applying R*ogers* test to social issues speech);

3. Rogers test

As noted above, parsing the difference between commercial and expressive trademark uses tends to be quite onerous in practice. In lacking tools designed explicitly for brand parodies contrasted with trademarks, courts decide on their subjective assessment of the value of parody and the morality of free rides. [112] These approaches involve ad hoc balancing, which implies that the courts recognize that the defendant uses the plaintiff's mark in a socially valuable expressive way and then apply that appreciation to the likelihood of confusion test.[113] In addition to the ad hoc balancing approach, in recent years, courts have developed a specific mechanism for addressing free speech concerns in trademark law by adopting the *Rogers* test.

3.1. Rogers V. Grimaldi

In 1986, Federico Fellini, a famous Italian film director and screenwriter, made a film centered around fictional Italian cabaret singers Pippo and Amelia, who imitated Ginger Rogers and Fred Astaire, hence becoming known in Italy as "Ginger and Fred." [114] Following a short run in American theaters and mixed commentaries, Ginger Rogers filed suit against the producers and distributors of the film, claiming that the film gave a false impression of her endorsement, violated her right of publicity, and defamed her by depicting her in a false light. [115]The district court granted summary judgment to the defendant, holding that the title was "exercise of artistic expression rather than commercial speech." [116]

On appeal, the Second Circuit noted that the central question in this case was:

Brown v. Elec. Arts, Inc., 724 F.3d 1235, 1241–42 (9th Cir. 2013) (applying the *Rogers* test to video games); Univ. of Ala. Bd. of Tr. v. New Life Art, Inc., 683 F.3d 1266, 1278 (11th Cir. 2012) (applying the *Rogers* test to the content of artwork); Parks v. LaFace Recs., 329 F.3d 437, 451–52 (6th Cir. 2003) (applying the *Rogers* test to song title); Westchester Media v. PRL USA Holdings, Inc., 214 F.3d 658, 664–65 (5th Cir. 2000) (applying the *Rogers* test to magazine title); Gordon v. Drape Creative, Inc., 909 F.3d 257 (9th Cir. 2018) (applied the *Rogers* test to greeting cards).

[112] *See* Dogan & Lemley, *supra* note 93 at 490.

[113] *See, e.g.*, Mark Bartholomew & John Tehranian, *An Intersystemic View of Intellectual Property and Free Speech*, 81 GEO. WASH. L. REV. 1, 43 (2013) (noting that Thomas Mccarthy describes such balancing test as "putting a discrete judicial finger on the scales in favor of the defendant.").

[114] Rogers v. Grimaldi, 875 F.2d 994, 997 (2d Cir. 1989).

[115] *Id*.

[116] *Id*.

> [A] conflict between Rogers' right to protect her celebrated name and the right of others to express themselves freely in their own artistic work. Specifically, we must decide whether Rogers can prevent the use of the title 'Ginger and Fred' for a fictional movie that only obliquely relates to Rogers and Astaire.[117]

In responding to whether a title of an artistic work is entitled to First Amendment protection in trademark infringement cases, the Second Circuit formulated a two-pronged test.[118] Under this test, a defendant must show that (1) the defendant's title is artistically relevant to the underlying work, and (2) the title is not explicitly misleading as to the source or content of the work.[119]

Although the court admitted that "Ginger and Fred" could cause consumer confusion, the court emphasized that, given the context, the irony of the ambiguous title was a central element of the film.[120] Therefore, the court held that the trademark liability should exist just if "the public interest in avoiding consumer confusion outweighs the public interest in free expression."[121]

Since then, the *Rogers* test has undergone a revolution. Courts have adopted the *Rogers* test and inserted new glosses to it to "encompass all works of artistic expression,"[122] rather than just titles of expressive works. Nevertheless, it is worth noting that the *Rogers* test is not without its critics. One critic observed that these later developments have "muddled the Rogers test."[123] Another criticism of the *Rogers* test is that it is easily applied to trademarks and affects an equitable balance between free expression and trademark holder's rights. As a result, some authors argue, "the *Rogers* test was intentionally designed as a low bar for those invoking the protection of the First Amendment."[124] They contend that the *Rogers* test provides minimal protection for trademark owners while immunizing the work of content producers.

---

[117] *Id.* at 996.
[118] *Id.* at 999.
[119] *Id.*
[120] *See id*. at 998–99.
[121] *Id*. at 996.
[122] J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 10:22 (4th ed. 2006) (cited in E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1038 (9th Cir. 2008)).
[123] William McGeveran, *The Trademark Fair Use Reform Act*, 90 B.U. L. REV. 2267, 2313 (2010); *see also* David Jacob Wright, *Explicitly Explicit: The Rogers Test and the Ninth Circuit*, 21 J. INTELL. PROP. L. 193, 203–06 (2013) (stating that the circuits have applied the *Rogers* test in different and perhaps contradictory ways, and that its application within the Ninth Circuit has proven particularly confusing).
[124] Wesley W. Wintermeyer, *Who Framed Rogers v. Grimaldi? What Protects Trademark Holders Against First Amendment Immunity for Video Games?*, 64 ALA. L. REV. 1243, 1252 (2013). *But see* Matthew D. Bunker, *Mired in Confusion: Nominative Fair Use in Trademark Law and Freedom of Expression*, 20 COMM. L. & POL'Y 191, 209–212 (2015) (suggesting a more expansive application of the *Rogers* test to include other uses beyond simply titles and artistic works).

Despite these criticisms, the *Rogers* test remains the most commonly applied framework in which to analyze cases involving the Lanham Act's application to expressive works.

3.2. Rogers Test Applied in the Ninth Circuit

The Ninth Circuit adopted the *Rogers* test in *Mattel, Inc. v. MCA Records, Inc.*,[125] thirteen years after the Second Circuit decided *Rogers v. Grimaldi*. In this case, the manufacturer of a famous Barbie doll sued a music band that parodied the doll and its associated trademark within its song "Barbie girl."[126] Noting that some "trademarks transcend their identifying purpose . . . enter our public discourse and become an integral part of our vocabulary,"[127] the Ninth Circuit applied the *Rogers* test to decide the case.[128]

Applying the test's first prong, the Ninth Circuit determined that the use of the mark was artistically relevant because it was an obvious parody, making fun of Barbie.[129] Additionally, the Ninth Circuit held that the use of the term "Barbie" in the song's title did not explicitly mislead as to Mattel's association with the song.[130] As a result, no likelihood of confusion was provided.[131]

Subsequently, the Ninth Circuit readdressed the *Rogers* test in *Mattel, Inc. v. Walking Mountain Productions*.[132] In this case, the Barbie manufacturer brought a trademark infringement claim against a photographer specializing in pictures of nude Barbie dolls portrayed "in danger of being attacked by vintage household appliances."[133] The defendant claimed that his photographs were "an attempt to "critique [ ] the objectification of women associated with [Barbie], and [ ][to] lambast [ ] the conventional beauty myth and the societal acceptance of women as objects because this is what Barbie embodies."[134] In applying the *Rogers* test, the court's analysis followed the

---

125 Mattel, Inc. v. MCA Recs., Inc., 296 F.3d 894, 902 (9th Cir. 2002).
126 *Id.* at 899.
127 *Id.* at 900.
128 *Id.* at 901–02.
129 *Id.* at 902. ("Under the first prong of *Rogers*, the use of Barbie in the song tide clearly is relevant to the underlying work, namely, the song itself. As noted, the song is about Barbie and the values [Defendant] claims she represents.").
130 *Id.* ("The song title does not explicitly mislead as to the source of the work; it does not, explicitly or otherwise, suggest that it was produced by Mattel. The only indication that Mattel might be associated with the song is the use of Barbie in the title; if this were enough to satisfy this prong of the *Rogers* test, it would render *Rogers* a nullity.").
131 *Id.* at 900.
132 Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792 (9th Cir. 2003).
133 *Id.* at 796.
134 *Id.* at 796–97.

perspective outlined in *Mattel, Inc. v. MCA Records,* concluding that the mark's use was artistically relevant to the underlying work and did not mislead consumers as to Mattel's association with the work.[135] However, while the *MCA Records* court mentioned the cultural significance of the Barbie doll in its earlier ruling, the court did not explicitly envision that creator receives First Amendment protections for works that only utilize trademarks that have entered the public discourse.[136] This decision is significant because many of our cultural discussions revolve around the various products we consume. Sometimes those conversations involve destroying or reusing a trademarked asset to comment on the brand itself, even when such reuse does not please the trademark owner, as when an artist puts a Barbie doll in a blender, an oven, or an enchilada.

In *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*,[137] the operator of a strip club in Los Angeles called Play Pen Gentleman's Club, filed suit against the developers of the "Grand Theft Auto" video games for portraying the plaintiff's strip club in the game "Grand Theft Auto: San Andreas" and calling it "Pig Pen." E.S.S. argued that the similarities between the Pig Pen logo and the design of the building would cause consumer confusion as to whether the strip club in the video game was associated with E.S.S. or whether E.S.S. endorsed it.[138] The Ninth Circuit permitted a First Amendment defense, observing that it is "true that Play Pen has little cultural significance, but the same could be said about most of the individual establishments in East Los Angeles."[139]

Adjusting the cultural significance requirement, the court held that "the level of relevance merely must be above zero."[140] Because "[a] reasonable consumer would not think a company that owns one strip club in East Los Angeles, which is not well known to the public at large, also produces a technologically sophisticated video game,"[141] the court held that Rockstar's work was not explicitly misleading. Similarly, the court observed that the location was "incidental to the

[135] *Id*. at 806–07.
[136] *Id*.
[137] E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1096–97 (9th Cir. 2008).
[138] *Id*. at 1097.
[139] *Id*. at 1100.
[140] *Id*.
[141] *Id*. at 1100–01.

overall story of the Game" and "the chance to attend a virtual strip club is unambiguously not the main selling point of the Game."[142]

The Ninth Circuit held that even though the game principally was not about the Play Pen, the video game's use was artistically relevant to its purpose of creating the fictional city.[143] What counts is that the expressive work represents creative expression and involves substantially more artistic elements than the simple use of a third party's trademark.

More recently, in *Twentieth Century Fox Film Corp. v. Empire Distribution, Inc.,* the Ninth Circuit employed the *Rogers* test to determine whether the title of the television show "Empire" infringed on the name of the record label "Empire Distribution."[144] In this case, "Empire Distribution," a record label that records and releases music albums, including compilations featuring "EMPIRE Presents" in their titles, sued Twentieth Century Fox after the television company began to sell music bearing the show's "Empire" brand. Following the District Court's grant of summary judgment for Fox, the Ninth Circuit reviewed the case *de novo*.[145] The Ninth Circuit held that Fox's show title did not infringe under the *Rogers* test.[146] First, the court found that Fox's purpose in using the word "Empire" for the show was artistically relevant because "the show's setting is New York, the Empire State, and its subject matter is a music and entertainment conglomerate, "Empire Enterprises," which is itself a figurative empire."[147] Regarding the second prong of the *Rogers* test, the court emphasized that the Empire Distribution did not provide sufficient evidence demonstrating that Fox's use was explicitly misleading, nor did the show contain any "overt claims or explicit references to the record label."[148]

---

[142] *Id*.
[143] Other video game cases have reached similar conclusions. *See, e.g*., MilSpec Monkey Inc v. Activision Blizzard, 74 F. Supp. 3d 1134, 1142 (N.D. Cal. 2014) (the court found that trademark-protected "angry monkey" patches used in a video game were relevant because they represent "part of an authentic universe of morale patches" used by military staff).
[144] Twentieth Century Fox Television v. Empire Distrib., Inc., 875 F.3d 1192, 1196 (9th Cir. 2017); *see also* Brown v. Elec. Arts, Inc., 724 F.3d 1235, 1244–45 (9th Cir. 2013) (holding that the use of former player Jim Brown was relevant for creating realistic representations in the virtual world).
[145] *Twentieth Century Fox Television*, 875 F.3d at 1196 (9th Cir. 2017).
[146] *Id.* at 1196.
[147] *Id*. at 1198.
[148] *Id*. at 1199.

The hermeneutical relevance of this decision is evident when one comprehends its repercussions. First, the Fox uses of the "Empire" term have acted "as an umbrella brand to promote and sell music and other commercial products," including "appearances by cast members in other media, radio play, online advertising, live events, and the sale or licensing of consumer goods."[149] Concerning this issue, the Ninth Circuit has characterized Fox's uses primarily as an expressive work, requiring "only a minor logical extension of the reasoning of Rogers" to shield that use behind the First Amendment.[150]

This last case indicates that the *Rogers* test applies not only to the expressive work itself but also to promotional attributes of that expressive work. Where the use of a third party's trademark has artistic relevance to the underlying work and it is not explicitly misleading, the *Rogers* defense can extend to the promotional activities of that artistic work. These promotional activities include appearances by cast members in other media, radio play, online advertising, live events, and the sale or licensing of consumer goods. [151] For parodists, this development in the law raises new benefits and considerations.

Most recently, in *Gordon v. Drape Creative, Inc*., the Ninth Circuit analyzed the "outer limits" of the *Rogers* test.[152] In this case, the plaintiff, Christopher Gordon, created the popular YouTube video "The Crazy Nastyass Honey Badger."[153] This video became known for its catchphrases, including "Honey Badger Don't Give a S---" and "Honey Badger Don't Care."[154] Gordon trademarked the latter catchphrase for various classes of products, including greeting cards, mugs, clothing, but he never registered the phrase "Honey Badger Don't Give a S---."[155] Gordon brought trademark infringement claims against Drape Creative, Inc., a greeting-card design studio, and Papyrus-Recycled Greetings Inc., a greeting card manufacturer and distributor, for designing and producing a variety of greeting cards using variations of both catchphrases mentioned above without Gordon's permission. [156] The district court granted summary judgment for defendants,

---

[149] *Id*. at 1196.
[150] *Id*.
[151] *Id*.
[152] Gordon v. Drape Creative, Inc., 909 F.3d 257, 268 (9th Cir. 2018).
[153] *Id*. at 260.
[154] *Id*.
[155] *Id*.
[156] *Id*.

holding that the greeting cards were expressive works, and that the *Rogers* test holds impassable plaintiff's claims. [157]

In applying the *Rogers* test, the Ninth Circuit noted that "Gordon's mark is certainly relevant to defendants' greeting cards; the phrase is the punchline on which the cards' humor turns."[158] Holding that the defendant's work was expressive and hence justified applying the *Rogers* test, the court focused on whether the defendant's use of the mark was explicitly misleading.[159] The Ninth Circuit rejected the district court's requisite the defendant must make an "affirmative statement of the plaintiff's sponsorship or endorsement."[160] Equally interestingly, the Ninth Circuit came to theorize about the instances in which the use of the mark, while relevant to expressive content, would establish misleading use.[161]

Regarding the second prong of the *Rogers* test, the Ninth Circuit reasoned that a more relevant deliberation would be the point to which the defendants use the trademark in the same manner as the plaintiff. "Indeed, the potential for explicitly misleading usage is especially strong when the senior user and the junior user both use the mark in similar artistic expressions."[162] The court decided in favor of the plaintiff, stating that the "[d]efendants have not used Gordon's mark in the creation of a song, photograph, video game, or television show, but have largely just pasted Gordon's mark into their greeting cards."[163]

In sum, this paper has explained how the Second Circuit developed the *Rogers* framework, which precludes trademark liability for non-commercial speech unless the implicated speech is not artistically relevant or is explicitly misleading. As it has been explained, the *Rogers* test has served the role of preventing trademark law, which developed as a concept of information efficiency in a

---

[157] *Id*.
[158] *Id*. at 269.
[159] *Id*. at 268.
[160] *Id*. at 269.
[161] *See id*. at 270 ("If an artist pastes Disney's trademark at the bottom corner of a painting that depicts Mickey Mouse, the use of Disney's mark, while arguably relevant to the subject of the painting, could explicitly mislead consumers that Disney created or authorized the painting, even if those words do not appear alongside the mark itself."); *see also id*. at 271 ("In the cases extending *Rogers* to instances in which a mark was incorporated into the body of an expressive work, we made clear that the mark served as only one component of the larger expressive work.").
[162] *Id*. at 270.
[163] *Id*. at 261; *see also id*. at 270 ("The court making determinations whether the defendants added their "own expressive content to the work beyond the mark itself.").

market, from improperly invading the freedom to engage in non-commercial speech, including non-commercial speech sold for profit.

Regarding the *Rogers* test, the Ninth Circuit has crafted a simple and consistent application to a wide range of references to trademarks within a very liberal defense of parody speech. All these cases from the Ninth Circuit have in common that they protect expressive works, meaning creative expressions that involve more artistic elements than the mere use of a third party's trademark.

Likewise, the Ninth Circuit has explained how the test requires the defendant to show, as a threshold matter, that the work in question is expressive. Then, the burden passes to the plaintiff to prove one of the two elements of the *Rogers* test, that either the plaintiff's mark "has no artistic relevance to the underlying work whatsoever" or the defendant "explicitly misleads as to the source or the content of the work."[164] Such an approach balances the First Amendment and trademark rights with a judicial evaluation tilted in favor of the parodist.

4. VIP Products LLC v. Jack Daniel's Properties, Inc.

The Ninth Circuit *Rogers* policy balance favoring First Amendment concerns reached its zenith in a decision involving a product arguably different than the songs,[165] photographs,[166] video games,[167] television programs,[168] or greeting cards.[169] Indeed, this case is about a dog chew toy.[170]

Figure 1: The Jack Daniel's bottle next to the VIP Products "Bad Spaniels" dog toy

[164] *Id*. at 264.
[165] Mattel, Inc. v. MCA Recs., Inc., 296 F.3d 894, 899 (9th Cir. 2002).
[166] Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792 (9th Cir. 2003).
[167] E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1096 (9th Cir. 2008).
[168] Twentieth Century Fox Television v. Empire Distrib., Inc., 875 F.3d 1192 (9th Cir. 2017); *see also* Brown v. Elec. Arts, Inc., 724 F.3d 1235 (9th Cir. 2013).
[169] Gordon v. Drape Creative, Inc., 909 F.3d 257 (9th Cir. 2018).
[170] VIP Prods. LLC v. Jack Daniel's Properties., Inc., 953 F.3d 1170, 1172 (9th Cir. 2020).

VIP Products, an Arizona-based company, sells "Silly Squeaker" dog toys.[171] In July of 2013, VIP Products released a toy in the shape of a Jack Daniel's whiskey bottle, containing an image of a spaniel over the words "Bad Spaniels."[172] Jack Daniel's label says, "Old No. 7 Brand Tennessee Sour Mash Whiskey," while the label on the Bad Spaniels toy instead has the phrase "the Old No. 2, on your Tennessee Carpet."[173] Additionally, the name "Jack Daniel's" is replaced with "Bad Spaniels," "Old No. 7" with "Old No. 2," and alcohol content descriptions with "43% POO BY VOL." and "100% SMELLY."[174] In addition to these similarities between the "Bad

[171] *Id*.
[172] *Id*.
[173] *Id*. at 1172.
[174] *Id*.

Spaniels" and the bottle of Jack Daniel's whiskey, the products share various visual features, such as the product's shape, the use of white lettering over a black background, and font style.[175] However, a disclaimer on its packaging states that the Bad Spaniels "product is not affiliated with Jack Daniel Distillery."[176]

4.1. District Court Decision

Unsurprisingly, Jack Daniel's Properties was not amused and sent the parodist a demand letter asking him to cease and refrain from selling the chewy dog toy parodying its whiskey. VIP Products filed suit seeking a declaratory judgment of non-infringement.[177] Jack Daniel's Properties counterclaimed for trademark infringement and dilution.[178]

In its holding, the district court noted that VIP was not entitled to the nominative fair use defense because the dog toy is not an expressive work.[179] Moreover, by distinguishing between "the standard trademark likelihood of confusion analysis," within which a parody defense potentially applies to VIP Products, and the notion of the "artistic expression" from the *Rogers* test, the district court held that the *Rogers* test was inapplicable.[180] The court pointed out that this test applies to artistic expressions such as songs, movies, and books and "requires courts to construe trademark law only where the public interest in avoiding consumer confusion outweighs the public interest in free expression."[181]

Regarding Jack Daniel's trademark dilution counterclaim, the court first held that "it is undisputed that the sales, advertising, and public exposure of Jack Daniel's whiskey packaged in the Jack Daniel's trade dress provide substantial indirect evidence of fame."[182] Second, the court held that "a reasonable trier of fact could find that the VIP product and Jack Daniel's trade dress

---

[175] *Id.*
[176] *Id.*
[177] *See* VIP Prods. LLC v. Jack Daniel's Props., Inc., 2016 WL 5408313, at *1 (D. Ariz. Sept. 27, 2016).
[178] *Id.* at *2.
[179] *Id.* at *5.
[180] *Id.* at *6.
[181] *Id.*
[182] *Id.* at *13.

meet the requisite similarity standard for dilution, an “association arising from the similarity between a mark or trade name and a famous mark.”[183]

After a four-day bench trial, the district court decided in favor of Jack Daniel’s, finding that it was clear that VIP’s intent “sought to capitalize on Jack Daniel’s popularity and good will for its own gain.”[184] The court issued a permanent injunction prohibiting VIP from manufacturing and selling the “Bad Spaniels Silly Squeaker” dog toy.[185]

4.2. Ninth Circuit Decision

VIP Products appealed to the Ninth Circuit, which found that the dog toy is an expressive work entitled to First Amendment protection.[186] In deciding so, the Ninth Circuit reversed and vacated the lower court’s permanent injunction and held that the “Bad Spaniels” constituted a non-commercial use.[187] Hence, it did not dilute Jack Daniel’s mark by tarnishment as a matter of law.[188]

Although the “Bad Spaniels Silly Squeaker” dog toy resembles a bottle of Jack Daniel’s Old No. 7 Black Label Tennessee Whiskey, it has “light-hearted, dog-related alterations.”[189] As this paper will analyze, the court found that those alterations were protectable under the *Rogers* test. In determining whether the “Bad Spaniels” was expressive, the Ninth Circuit analyzed “whether

---

[183] *See id*. at *1.
[184] VIP Prods., LLC v. Jack Daniel’s Props., Inc., 291 F.Supp.3d 891, 908 (D. Ariz. 2018). The court relied upon the testimony from an expert in consumer behavior, based on conventional consumer psychology research to observe that “when you associate any food or beverage with defecation, you are creating disgust in the mind of the consumer with respect to that food or beverage.” *Id*. at 903. Based on this testimony, the court support a finding of dilution by tarnishment because the parody product’s references to defecation would result in “creating negative associations, either consciously or unconsciously, and undermining the pre-existing positive associations with its whiskey” that would be “particularly harmful for a company such as Jack Daniel’s because the goods it offers for sale involves human consumption and human consumption and canine excrement do not mix.” *Id.* Moreover, the court also found tarnishment of Jack Daniel’s trademarks by associating the whiskey with toys that might appeal to children. “[W]hile an association with toys may not ordinarily cause reputational harm, Jack Daniel’s is in the whiskey business, and does not market to children, does not license goods for children, and does not license goods that might appeal to children. *Id*. at 904. Lastly, the district court relied upon the trademark owner’s internet survey showing that over 29% of potential consumers likely experienced confusion as to the connection between the Bad Spaniels dog toy and Jack Daniel’s. *See id.* at 907.
[185] *Id*. at 911.
[186] *See* VIP Prods. LLC v. Jack Daniel’s Props., Inc. 953 F.3d 1170, 1172 (9th Cir. 2020).
[187] *Id*. at 1176.
[188] *Id*.
[189] *Id.* at 1172.

the work [wa]s 'communicating ideas or expressing points of view.'"[190]The court noted that "VIP's purported goal in creating Silly Squeakers was to 'reflect' 'on the humanization of the dog in our lives,' and to comment on 'corporations [that] take themselves very seriously.'"[191]

In granting a dog toy expressive work status, the Ninth Circuit explained that "although surely not the equivalent of the *Mona Lisa*," "Bad Spaniels" is "an expressive work."[192] It "communicates a humorous message using wordplay to alter the serious phrase that appears on a Jack Daniel's bottle" and "is not rendered non-expressive simply because it is sold commercially."[193] The result is "'a simple' message conveyed by 'juxtaposing the irreverent representation of the trademark with the idealized image created by the mark's owner.'"[194] The court noted that the fact that VIP chose to convey this humorous message through a new artistic medium is irrelevant message because "the Constitution looks beyond written or spoken words as mediums of expression."[195] Likewise, the Ninth Circuit paid attention to the fact that it was not the first time the court found that dog toys can be successful parodies of the well-known trademark.[196]

Citing *Twentieth Century Fox Television v. Empire Distribution, Inc.*, [197] the Ninth Circuit stated that trademark infringement claims are generally governed by a likelihood-of-confusion test to "strike the appropriate balance between the First Amendment and trademark rights."[198] However, the court noted that "when artistic expression is at issue, however, the general likelihood-of-confusion test fails to account for the total weight of the public's interest in free expression."[199] According to the Ninth Circuit, the district court mistakenly found that VIP's

---

[190] *Id*. at 1174 (citing Mattel, Inc. v. MCA Recs., 296 F.3d 894, 900 (9th Cir. 2002) (quoting L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 29 (1st Cir. 1987))).
[191] *Id.* at 1172.
[192] *Id.* at 1175 (analogizing to the greeting cards in Gordon v. Drape Creative, Inc., 909 F.3d 257, 264 (9th Cir. 2018) (finding that although the cards did not show a great level of creativity, they were protected under the First Amendment because they "convey[ed] a humorous message through the juxtaposition of an event of some significance"); *see also id*. (quoting Brown v. Elec. Arts, Inc., 724 F.3d 1235, 1241) ("A work need not be the 'expressive equal of Anna Karenina or Citizen Kane' to satisfy this requirement.").
[193] *Id*.
[194] *Id*. (quoting L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 34 (1st Cir. 1987)).
[195] *Id*. (quoting Hurley v. Irish-Am. Gay, Lesbian & Bisexual Grp.., 515 U.S. 557, 569 (1995).
[196] *See id*. (discussing Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252 (4th Cir. 2007).
[197] Twentieth Century Fox Television v. Empire Distrib., Inc., 875 F.3d 1192 (9th Cir. 2017).
[198] *VIP Prods*., 953 F.3d at 1174.
[199] *Id.* (internal citations omitted) (quoting Gordon v. Drape Creative, Inc., 909 F.3d 257, 264 (9th Cir. 2018)); *see* Arnold v. Treadwell, 642 F.Supp.2d 723, 729 (E.D. Mich. 2009); Rebellion Devs. Ltd v. Stardock Ent. Inc., No. 12-12805, 2013 WL 1944888, at *4 (E.D. Mich. May 9, 2013) (both showing that if the *Rogers* test is met, confusion is irrelevant); *see also* Mikhaila Duvall, *A Good Day to Be a Bad Spaniel: Broadening the Application of the Rogers*

product was not a creative and expressive good and thus not eligible for the protection under the *Rogers* test.[200]

As a threshold matter, the Ninth Circuit concluded that it was necessary to apply the *Rogers* test.[201] Because the district court concluded the possible confusion under the multifactored test without first deciding whether the plaintiff could meet either prong of *Rogers* test, the Ninth Circuit remanded the matter for a finding of that issue.[202]

Moreover, the Ninth Circuit instructed the district court judges to tilt their interpretation to a critical perspective "if the plaintiff satisfies one of the Rogers elements, 'it still must prove that its trademark has been infringed by showing that the defendant's use of the mark is likely to cause confusion.'"[203]

4.3. Aftereffects

Fourteen days after the court made its decision, Jack Daniel's filed a petition for rehearing or rehearing *en banc*,[204] after which the International Trademark Association (INTA) filed an *amicus* brief because the "panel's expansive application of Rogers threaten[ed] to make this new iteration of the Rogers test the exception that swallows the likelihood of confusion standard that has been applied in trademark infringement cases for nearly a century."[205]

Stating that the Ninth Circuit panel's application of the law contradicts the law in other circuits, Jack Daniel's argued that the "unnecessary constitutionalization of routine trademark disputes" via the *Rogers* test "restricts trademark owners' ability to protect consumers against the likely confusion."[206]

Test, 21 UIC REV. INTELL. PROP. L. 193, 208–210 (2022) (explaining that even though the Ninth Circuit declined to directly apply the likelihood of confusion test, the result would have been the same had the test been applied).
[200] *VIP Prods*., 953 F.3d at 1176
[201] *Id*.
[202] *Id*.
[203] *Id*. at 1176 n. 2 (quoting Gordon v. Drape Creative, Inc., 909 F.3d 257, 265 (9th Cir. 2018).
[204] Appellee's Petition for Rehearing and Petition for Rehearing En Banc, VIP Prods., 953 F.3d 1170 (No. 18-16012), ECF No. 63 [hereinafter Appellee's Petition].
[205] *See* Brief of Amicus Curiae International Trademark Association in Support of Appellee at 18, VIP Prods. LLC., 953 F.3d 1170 (No. 18-16012).
[206] Appellee's Petition, *supra* note 204 at 3–4.

On the other hand, a group of prominent law professors filed an *amicus curiae* brief in opposition to Jack Daniel's petition for rehearing advancing one important argument. [207]They argued that the Ninth Circuit correctly applied the *Rogers* test and that the "Bad Spaniels" dog toy was correctly considered non-commercial, and thus exempt from trademark infringement liability. However, the petition for panel rehearing and rehearing *en banc* was denied.[208]

In consequence, Jack Daniel's filed a petition for certiorari at the United States Supreme Court on September 15, 2020,[209] and was supported by several amici, including INTA, the Intellectual Property Law Association of Chicago, various alcohol beverage industry associations Campari America LLC, Constellation Brands Inc., and Campbell Soup Company.[210] Again, trademark law professors filed an amicus brief in opposition to the petition for certiorari.[211] In January 2021, the Supreme Court denied certiorari.[212]

Reactions to this decision immediately followed. Some authors argued that the Ninth Circuit decision is distinguished by its "potential to render any commercial product that contains humorous elements a 'work of artistic expression.'"[213] Moreover, the Ninth Circuit has been said to have improperly extended First Amendment protection "for allegedly infringing uses of protected trademarks and unsettling the balance between trademark protection and freedom of expression."[214] Other authors argue that this decision "is distinguished by its overly expansive

---

[207] Brief of Amici Curiae Trademark Law Professors in Opposition to Motion for Rehearing En Banc, VIP Prods., 953 F.3d 1170 (No. 18-16012) (filed by Rebecca Tushnet, Mark A. Lemley, Mark P. McKenna, Lisa P. Ramsey, Jennifer Rothman, Pamela Samuelson & Eugene Volokh).

[208] *See* Order at 1, VIP Prods. LLC v. Jack Daniel's Props., Inc., No. 18-16012 (9th Cir. June 3, 2020), ECF No. 72 (denying rehearing and rehearing *en banc*).

[209] *See* Petition for Writ of Certiorari, Jack Daniel's Props., Inc. v. VIP Prods. LLC, 141 S. Ct. 1054 (2021) (No. 20-365).

[210] *See* Brief for International Trademark Association as Amicus Curiae Supporting Petitioner, VIP Prods., 141 S. Ct. 1054 (No. 20-365); Brief for the Intellectual Property Law Association of Chicago as Amicus Curiae Supporting Petitioner, VIP Prods., 141 S. Ct. 1054 (No. 20-365); Brief for Campari America LLC as Amicus Curiae Supporting Petitioner, VIP Prods., 141 S. Ct. 1054 (No. 20-365); Brief for Constellation Brands, Inc. as Amicus Curiae Supporting Petitioner, VIP Prods., 141 S. Ct. 1054 (No. 20-365); Brief for Campbell Soup Co. as Amicus Curiae Supporting Petitioner, VIP Prods., 141 S. Ct. 1054 (No. 20-365).

[211] *See* Brief of Amici Curiae Trademark Law Professors in Opposition to Petition for Certiorari, VIP Prods., 141 S. Ct. 1054 (No. 20-365) (filed by Rebecca Tushnet, Mark P. McKenna & Jessica Silbey).

[212] VIP Prods. LLC v. Jack Daniel's Props., Inc., 953 F.3d 1170 (9th Cir. 2020), *cert. denied*, 141 S. Ct. 1054 (2021).

[213] Jared I. Kagan & Emily R. Hush, *Parody Chew Toys and the First Amendment*, 13 LANDSLIDE 22, 24 (2021).

[214] *Id.*

view of the Rogers test and its misunderstanding of the fragile balance between First Amendment and trademark dilution laws."[215]

Arguably, these criticisms represent no more than a analytical extension of the existing conceptual differences in approach that still exist between supporters and critics of trademark dilution. There are two irreconcilable poles in the debates on the convenience of protecting trademarks against dilution. At one extreme are those whose notion is that a dilution is a necessary form of trademark protection. At another extreme are those who hold that antidilution statutes are the too broad mechanism for protecting trademark rights. In their opinion, this form of protection has the possibility of granting an almost exclusive property right over a trademark to its owner, something that traditional trademark law has avoided. While it is true that the *Rogers* test has been extended beyond the titles of an expressive work, which at first sight could be approximated as a stretching of its purpose, this decision also reflects trademark acromegaly. Never before, and on so many occasions, could one imagine that consumers could be confused about sponsorship or permission when viewing a product in a video game, music video, or movie or hearing it as part of a podcast or a rap song. What is true is that these both types of concerns will become increasingly important as our consumer culture continues to bloom.

4.4. Supreme Court Decision

After the Supreme Court, without comment or reasoning, denied Jack Daniel's petition for certiorari in January 2021,[216] the famous whisky manufacturer took a second shot when it filed a second petition for certiorari, which has proven to be worthwhile.[217] In the latest petition, Jack Daniel's asked the Court to consider "[w]hether humorous use of another's trademark as one's own on a commercial product is subject to the Lanham Act's traditional likelihood-of-confusion analysis, or instead receives heightened First Amendment protection from trademark-infringement

[215] Zachary Shufro, *Based on a True Story: The Ever-Expanding Progeny of Rogers v. Grimaldi*, 32 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 391, 424 (2022). *See generally* Hannah Knab, *Jack Daniel's Highlights the Second and Ninth Circuit's Divide on the Application of the Rogers Test*, 10 AM. U. BUS. L. REV. 517 (2022) (claiming that the Ninth Circuit has adopted the *Rogers* test in a way that expands the plain language of the Lanham Act and, therefore, has broadened the test beyond its original purpose).

[216] *See* VIP Prods. LLC v. Jack Daniel's Props., Inc., 953 F.3d 1170 (9th Cir. 2020), *cert. denied*, 141 S. Ct. 1054 (2021).

[217] *See VIP* Prods. LLC v. Jack Daniel's Props., Inc., 953 F.3d 1170 (9th Cir. 2020), cert. granted, 143 S. Ct. 476 (2022).

claims,"[218] and "[w]hether humorous use of another's mark as one's own on a commercial product is 'noncommercial' under 15 U.S.C. § 1125(c)(3)(C), thus barring as a matter of law a claim of dilution by tarnishment under the Trademark Dilution Revision Act."[219]

On the Supreme Court, disagreement about how to answer the threshold question of when a particular use of another's mark qualifies to apply the standard for infringement outlined in Rogers continued. Jack Daniel's and some of its supporters argued that the higher standard for infringement in the Ninth Circuit's version of the *Rogers* test is a via to infringe trademarks and does not prevent misleading uses of trademarks.[220] In other words, Jack Daniel's and its supporters argued that the *Rogers* test has a narrower threshold requirement. They insisted that the *Rogers* test should not apply in Jack Daniel's trademark dispute because dog toys are more like "cans of peas" and not like traditional artistic and literary creations.[221] Under this view, *Rogers*' standard for infringement would apply only when the infringer's products are movies, books, songs, and similar expressive works with titles and not ordinary commercial products.[222] Thus, Jack Daniel's argued that the dilution statute should apply because VIP's dog toy is not a non-commercial use of the trademark.[223]

On the other hand, VIP Products and its supporters argued that the *Rogers* test should apply to the humorous message of Bad Spaniels because the fact that the expression appears in connection with a dog toy rather than in a painting is irrelevant.[224] When the expression combines artistic and commercial speech, and these message components are inextricably intertwined, the *Rogers* test

[218] *See* Petition for a Writ of Certiorari at I, Jack Daniel's Props., Inc. v. VIP Prods. LLC, 2022 WL 3561781 (S. Ct. Aug. 5, 2022) (No. 22-148).
[219] *Id.*
[220] *See* Brief for Petitioner at 2–5, 19–39, Jack Daniel's, 143 S. Ct. 476 (No. 22-148*). See also* Brief of Amici Curiae American Apparel & Footwear Association, Footwear Distributors & Retailers of America, Council of Fashion Designers of America, Inc., and the Accessories Council in Support of Petitioner at 3, Jack Daniel's, 143 S. Ct. 476 (No. 22-148) (arguing that the Ninth Circuit's version of the Rogers test will increase counterfeits); Brief of Amici Curiae of Levi Strauss & Co. and Patagonia, Inc. in Support of Petitioner at 11, Jack Daniel's, 143 S. Ct. 476 (No. 22-148) (arguing that the Ninth Circuit's application of the Rogers test doesn't include discovery about defendant's intent or actual confusion).
[221] *See* Brief for Petitioner at 4, 19–39, Jack Daniel's, 143 S. Ct. 476 (No. 22-148) (citing Rogers, 875 F.2d at 997).
[222] *Id*.
[223] *Id.* at 5, 39-52.
[224] *See* Brief of Respondent at 13, 24–27, Jack Daniel's Props., Inc. v. VIP Prods. LLC, 143 S. Ct. 476 (2022) (No. 22-148). *See also* Brief of Amici Curiae First Amendment Professors in Support of Respondent, Jack Daniel's, 143 S. Ct. 476 (No. 22-148).

and the First Amendment limit the scope of trademark protection if the artistically relevant use of another's mark is not explicitly misleading.[225]

In a unanimous opinion with two concurrences delivered by Justice Kagan, the Supreme Court held that the *Rogers* test for trademark infringement claims challenging expressive works does not apply "when the alleged infringer uses the trademark as a designation of source for the infringer's own goods."[226] Moreover, non-commercial exclusion from dilution liability under Lanham Act "does not shield parody or other commentaries when their use of a mark is source-identifying."[227] The Court distinguished the case at bar from cases employing a First Amendment defense "in which a trademark is used not to designate a work's source, but solely to perform some other expressive function."[228] According to the Court, for example, when the manufacturer of a famous Barbie doll sued a music band over the song "Barbie Girl," the Ninth Circuit applied the *Rogers* test because the band's use of the Barbie name was not performing a source identifier task.[229] In other words, the Court held that the First Amendment filter only applies where a trademark is not used to designate the source of the goods. However, the Court explained that lower courts can consider the core of VIP's argument because "[an] expressive message of the trademark—particularly a parodic one, as VIP asserts—may properly figure in assessing the likelihood of confusion."[230] Thus, the most important takeaway from the decision is that trademark use does not necessarily result in non-commercial use when it parodies, criticizes, or comments on someone else's product. Consequently, the traditional likelihood of confusion analysis applies to those marks, and they are not exempt from dilution claims when used to designate the source of goods or services. Therefore, the Supreme Court remanded the judgment for further proceedings consistent with their opinion.[231]

Although the Supreme Court decision represents a victory for Jack Daniel's, which argued that the Ninth Circuit erred when it said the dog toy was non-commercial and therefore enjoyed constitutional protection, the Justices did not decide the fate of the *Rogers* test. Interestingly,

---

[225] *Id*.
[226] Jack Daniel's Properties, Inc. v. VIP Prod. LLC, No. 22-148, 2023 WL 3872519, at *2 (U.S. June 8, 2023).
[227] *Id*.
[228] *Id*. at *7.
[229] *Id*.
[230] *Id*. at *10.
[231] *Id*. at *11.

despite an extensive briefing on the topic, the Supreme Court made clear it "choose[d] a narrower path"[232] without deciding "whether Rogers has merit in other contexts"[233] or "how far the "noncommercial use" exclusion goes."[234]

The question arises of which cases would be considered to have met the standards of not confusing under a First Amendment filter. If the books, movies, songs, and T-shirts fit the bill, but dog toys are a bridge too far, we need the principles to let us know which objects will enter the protection category and which will not. Unfortunately, the Supreme Court does not provide a guide in this regard.[235] Jack Daniel's strategy of going after *Rogers* test in its entirety and convincing the Court to compromise turns into a win at Jack Daniels' corner. However, by saying the test has its place but is inappropriate for a dog's toy, the Supreme Court necessarily leaves much about *Rogers* test unaddressed. In addition, the decision makes it harder for everyone to determine what happens next. For example, Justice Gorsuch's concurrence, joined by Justices Thomas and Barrett, expressed general uncertainty about "where Rogers' evidence comes from."[236] Moreover, the concurrence opinion stated that "it's not obvious that *Rogers* is right on all of his details" and cautioned lower courts that they "must be attuned to that fact."[237] While the Supreme Court decision leaves unsolved questions of free speech concerns in the context of parodies in trademark disputes, it appears to be a victory for trademark owners seeking to assert their rights against those who sell uncompetitive goods intended to mock those marks.

5. Conclusion

Traditional trademark law restricts only commercial speech when it is false or misleading. On the other hand, dilution laws enable the owner of a famous trademark to prevent the use of its mark, even if the user is neither misleading nor confusing. Moreover, relying on commerciality as a responsibility requirement supposes difficulties when creating a defense for brand parodies.

---

[232] *Id*. at *6.
[233] *Id*. (noting that Rogers test has merit when an alleged infringer uses a trademark as a designation of source for the infringer's own goods).
[234] *Id*. at *11.
[235] *Id*. at *8 ("The point is that whatever you make of Rogers—and again, we take no position on that issue—it has always been a cabined doctrine.").
[236] *Id*. at *12 (Gorsuch, J., concurring).
[237] *Id*.

Following the *Rogers v. Grimaldi* decision, the *Rogers* test provided a safe harbor for junior users to escape liability if their use had an underlying artistic relevance. In the Ninth Circuit, the *Rogers* test has generally served to prevent trademark law from intruding on the freedom to participate in noncommercial speech, including non-commercial speech sold for profit.

In recognizing the unmistakable parodic message of the dog toy, the Ninth Circuit applied the *Rogers* test, finding VIP's "Bad Spaniels" to be an expressive work. While a dog toy may not be the most typical form of artistic expression, as detailed in Part IV, courts have applied the *Rogers* test in cases involving a wide range of expressive works. Moreover, what is considered artistically relevant evolves through time.[238]The same is true for our cultural habits and values. For instance, the pet industry has tripled in the past 15 years, reaching $123.6 billion in sales in 2021, the highest level in history.[239] According to the American Pet Products Association (APPA), 69% of U.S. households own a dog. [240]

This decision is one more in line to reflect the current Ninth Circuit *Rogers* policy balance favoring First Amendment concerns. Nonetheless, if the Ninth Circuit issued a more clarifying decision, it could help instruct future courts in their struggle to balance free speech with trademark protection. The *Rogers* test tries to establish the balance between the public interest in free speech and the interests of trademark owners. However, despite several decades of use, more clarity is needed about the exact contours of the test. The unknowns of how exactly such a test should work rest on the changing nature of trademarks in contemporary society, which have developed beyond their role as source indicators to acquire significant cultural value. However, both the Ninth Circuit and the Supreme Court failed to provide such clarity in this case.

[238] David M. Kelly & Lynn M. Jordan, *Twenty Years of Rogers v. Grimaldi: Balancing the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 99 TRADEMARK REP. 1360, 1365 (2009).
[239] *See Total U.S. Pet Industry Expenditures, 2012–2021*, INS. INFO. INST., https://www.iii.org/table-archive/22253 (last visited Sept. 22, 2022).
[240] *See 2021–2022 APPA National Pet Owners Survey Statistics*, AM. PET PRODS. INST., https://www.americanpetproducts.org/press_industrytrends.asp (last visited Sept. 22, 2022).

Part II

Sterilized Speech: The U.S. Impacts of E.U. Digital Service Rules[1]

1. Introduction

More than five billion social media accounts serve to facilitate commerce, engage in political process, organize revolution, and create communities.[2] Online platforms provide primary access points to information in the digital age.[3] They encourage a user's ability to share ideas and opinions.[4] However, users are often unaware that platforms engage in content moderation and that their choices to censor or promote content determine how citizens experience free expression.

Online platforms make key decisions that reflect their governing values and shape ordinary users' access to information.[5] Should a platform host commentary inciting violence against the Rohingya minority in Myanmar?[6] Should a platform censor a doctor's advice about COVID-19

---

1 This paper is published in *Cleveland State University Law Review. See* Jelena Laketić, *Sterilized Speech: The U.S. Impacts of E.U. Digital Service Rules*, 73 CLEV. ST. L. REV. 1005 (2025).
2 Simon Kemp, *5 Billion Social Media Users*, DATAREPORTAL (Jan. 31, 2024), https://datareportal.com/reports/digital-2024-deep-dive-5-billion-social-media-users (noting that a huge new milestone in social media is that there are now over 5 billion active social media user accounts).
3 Elisa Shearer, *More than Eight-in-Ten Americans Get News from Digital Devices*, PEW RSCH. CTR. (Jan. 12, 2021), https://www.pewresearch.org/short-reads/2021/01/12/more-than-eight-in-ten-americans-get-news-from-digital-devices/ (noting that 86% of U.S. adults get news online, though 68% get news from TV, and even less on radio).
4 Jack M. Balkin, *Free Speech is a Triangle*, 118 COLUM. L. REV. 2011–12 (2018) (explaining how besides territorial governments and speakers, "freedom of speech increasingly depends on a third group of players: a privately owned infrastructure of digital communication composed of firms that support and govern the digital public sphere that people use to communicate.").
5 Rory Van Loo, *The New Gatekeepers: Private Firms as Public Enforcers*, 106 VA. L. REV. 467–68, 482–84 (2020) (denominating platforms as the "New Gatekeepers" that are "perform[ing] the duties of public regulator" and "police other businesses"); *see also* Nikolas Guggenberger, *Essential Platforms*, 24 STAN. TECH. L. REV. 237, 242 (2021) ("[P]latforms create and curate markets, like Amazon Marketplace. They provide infrastructure and act as umpires, developing and enforcing governing norms by which platform users must abide.").
6 Chad de Guzman, *Meta's Facebook Algorithms 'Proactively' Promoted Violence Against the Rohingya, New Amnesty International Report Asserts*, TIME (Sep. 28, 2022; 9:13 PM), https://time.com/6217730/myanmar-meta-rohingya-facebook/.

treatments?[7] Should a platform remove defamatory postings implicating a politician?[8] More importantly, should a United States-based platform remove insults to an Austrian politician worldwide?[9] These are some content moderation questions that dominate media headlines.

Although content moderation is shrouded in mystery,[10] it is critical to online intermediaries' continued success in assessing and adjudicating user-generated content.[11] Simply put, moderation plays a crucial role in deciding what can stay online and what must be removed. As such, it has received recognition for creating a safe online environment.[12]

However, digital services have significantly changed in the last two decades, and so has content moderation. Over the past two decades, digital platforms have enabled human interaction on an unprecedented global scale. An average social media user hops between 6 and 7 platforms every month.[13] Such a massive online presence made platforms a fertile ground for illegal activities, such as the illegal distribution of copyrighted works,[14] misinformation,[15] the dissemination of hate speech,[16] and content glorifying violence.[17]

---

7 Faye Flam, *YouTube Erred in Censoring Covid-19 'Misinformation'* BLOOMBERG OP. (June 7, 2021), https://www.bloomberg.com/opinion/articles/2021-06-07/facebook-youtube-erred-in-censoring-covid-19-misinformation.

8 Adi Robertson, *Facebook Must Delete Insults to Austrian Politician Worldwide, Says Court*, (Nov. 12, 2020; 1:57PM), THE VERGE https://www.theverge.com/2020/11/12/21562870/facebook-austria-supreme-court-eva-glawischnig-comment-reputation-ruling.

9 *Id.*

10 SARAH I. ROBERTS, BEHIND THE SCREEN: CONTENT MODERATION IN THE SHADOWS OF SOCIAL MEDIA 24–27 (2019) (describing the hidden digital labor of content moderation).

11 *See* Hannah Bloch-Wehba, *Automation in Moderation*, 53 CORNELL INT'L L.J. 41, 42 (2020) (defining content moderation as "the set of practices that online platforms use to screen, rank, filter, and block user-generated content").

12 *See* James Grimmelmann, *The Virtues of Moderation,* 17 YALE J.L. TECH 42, 47 (2015) (defining content moderation as "the governance mechanisms that structure participation in a community to facilitate cooperation and prevent abuse").

13 Shubham Singh, *How Many People Use Social Media 2025 [Statistics]*, DENAMDSAGE (Mar. 6, 2025), https://www.demandsage.com/social-media-users/.

14 Lakesh Pal, *What Makes Copyright Infringement So Easy Online*, BYTESCAREBLOGS, https://bytescare.com/blog/what-makes-copyright-infringement-so-easy-online (last updated Jun. 6, 2024).

15 Janna Anderson & Lee Rainie, *The Future of Truth and Misinformation Online*, PEW RSCH. CTR. (Oct. 19, 2017), https://www.pewresearch.org/internet/2017/10/19/the-future-of-truth-and-misinformation-online/.

16 Caroline Crystal, *Facebook, Telegram, and the Ongoing Struggle Against Online Hate Speech*, CARNEGIE (Sep. 7, 2023), https://carnegieendowment.org/2023/09/07/facebook-telegram-and-ongoing-struggle-against-online-hate-speech-pub-90468.

17 Will Oremus & Naomi Nix, *Graphic War Videos Go Viral, Testing Social Media's Rules*, WASH. POST (Oct. 11, 2023, 12:01PM), https://www.washingtonpost.com/technology/2023/10/11/tiktok-youtube-israel-hamas-content-moderation/.

Importantly, these events, along with digital content's enormous speed and scale, also transformed how digital platforms govern speech. For example, in just one minute on Facebook, "510,000 comments are posted, 293,000 statuses are updated, 4 million posts are liked, and 136,000 photos are uploaded."[18] To handle the enormous traffic, digital platforms employ automation and algorithmic systems to detect and moderate content.[19] These algorithmic tools upgrade online content moderation, which has become industrial-scale organized.[20] Indeed, we live in an "Algorithmic Society."[21]

This paper argues that we are heading toward a "sterilized society" in which online speech is heavily constrained.

For two decades, platforms in both the U.S. and the E.U. were virtually free to moderate their content.[22] This self-governance allowed digital intermediaries to voluntarily establish and apply their moderation practices.[23]

As of 2024, however, the situation in the E.U. has changed radically. Although academics have suggested that "no regulatory approach can solve all of content moderation's current accountability deficits,"[24] the E.U. is attempting a radical regulatory transformation. Described as a way of

---

18 Maddy Osman, *Wild and Interesting Facebook Statistics and Facts,* KINSTA, https://kinsta.com/blog/facebook-statistics/ (July 19, 2024).

19 *See* Kate Klonick, *The New Governors: The People, Rules, and Processes Governing Online Speech*, 131 HARV. L. REV. 1598, 1636 (2018) ("The vast majority of [content] moderation is an automatic process run largely through algorithmic screening without the active use of human decision making.").

20 *See* Evelyn Douek, *Content Moderation as Systems Thinking*, 136 HARV. L. REV. 526, 531 (2022) ("Content moderators include engineers, product managers, authorities outside platforms, teams monitoring behavioral signals, industry peers, and government partners.").

21 *See* Jack M. Balkin, *The Three Laws of Robotics in the Age of Big Data*, 78 OHIO ST. L.J. 1217, 1219 (2017) (defining the Algorithmic Society as "a society organized around social and economic decision-making by algorithms, robots, and AI agents"); Jack M. Balkin, *Free Speech in the Algorithmic Society: Big Data, Private Governance, and New School Speech Regulation*, 51 U.C. DAVIS L. REV. 1149, 1151 (2018) ("[T]he Algorithmic Society . . . features large, multinational social media platforms that sit between traditional nation states and ordinary individuals, and the use of algorithms and artificial intelligence agents to govern populations.").

22 Martin Husovec, *Rising Above Liability: The Digital Services Act as a Blueprint for the Second Generation of Global Internet Rules*, 38 BERKELEY TECH. L.J. 884, 892 (2023) (noting that the liability exemptions that existed in the E.U and U.S. were "clearly driven by the same rationale – to encourage investment by giving more legal certainty").

23 *See* Klonick, *supra* note 19, at 1625–30 (explaining how platforms create content moderation rules to curate speech out of a sense of corporate social responsibility, but also, more importantly, because their economic viability depends on matching users' expectations).

24 *See* Douek, *supra* note 20, at 534.

bringing European values online,[25] new E.U. legislation supposes a drive from the non-liability of online intermediaries to increased responsibility. The Digital Services Act (DSA) represents the world's most significant attempt to address illegal online content.[26] Fully effective from February 17, 2024,[27] the DSA is part of the Digital Services package[28] and represents an ambitious legal document that establishes a framework relying on algorithmic tools to address various issues, such as content moderation, user rights, platform transparency, and systemic risks. Meanwhile, in the U.S., states on both ends of the political spectrum have recently enacted laws concerning content moderation. [29]

This paper focuses on free speech issues arising from the new E.U. content moderation legal framework. It draws on earlier work to explain how the DSA will likely follow its groundbreaking European predecessor, the General Data Protection Regulation (GDPR), to achieve a global impact, a phenomenon which the scholar Anu Bradford has denominated a "Brussels Effect."[30] Moreover, because the DSA creates additional obligations for "very large online platforms"[31] and because the majority of them are American,[32] some authors argued that the DSA will have significant adverse effects on the most prominent U.S. digital service providers.[33] Conversely,

---

25 Emma Roth, *The EU's Digital Services Act Goes Into Effect Today: Here's What that Means*, THE VERGE (Aug. 25, 2023 9:50 AM) https://www.theverge.com/23845672/eu-digital-services-act-explained.

26 *See generally* Commission Regulation 2022/2065, of the European Parliament and of the Council of 19 October 2022 on a Single Market for Digital Services and amending Directive (Digital Services Act), 2000/31/EC, 2022 O.J. (L 277) 1 [hereinafter DSA].

27 *See* The Digital Services Act Package, EUR. COMM'N, https://digital-strategy.ec.europa.eu/en/policies/digital-services-act-package (last visited Jun. 1, 2025).

28 The second instrument in this package, the Digital Markets Act, is outside the scope of this paper.

29 *See* Act of May 24, 2021, ch. 32, 2021 Fla. Laws 503 (codified as amended in FLA. STAT. *§§* 106.072, 287.137, 501.2041, 501.212 (2022)); Act of Sept. 9, 2021, ch. 3, 2021 TEX. GEN. LAWS 2d Sess. 3904 (codified at TEX. BUS. & COM. CODE ANN. ***§§*** 120, 321 (2021); TEX. CIV. PRAC. & REM. CODE ANN. *§*143A.001-.008 (2023)); California Age-Appropriate Design Code Act, ch. 320, 2022 CAL. STAT. 4916 (sec. 2, *§* 1798.99.31 effective July 1, 2024) (to be codified at CAL. CIV. CODE *§* 1798.99.28-.40); Act of June 6, 2022, ch. 204, 2022 N.Y. LAWS 1176 (codified at N.Y.GEN. BUS. LAW*§* 394-ccc (2023)).

30 *See generally* Anu Bradford, *The Brussels Effect*, 107 NW. U. L. REV. 1, 22–26 (2012); *see also* Dawn Carla Nunziato, *The Digital Services Act and the Brussels Effect on Platform Content Moderation*, 24 CHI. J. INT'L L. 115 (2023). *See also* Anupam Chander, *When the Digital Services Act Goes Global*, 38 BERKELEY TECH. L.J. 1068, 1071–72 (2023) (explaining how a number of mechanisms might globalize the DSA).

31 *See* DSA, *supra* note 26, art. 33; s*ee also id.* art. 52(3) (imposing on very large online platforms a fine of 6% of their total annual worldwide turnover).

32 *See Digital Services Act: Commission Designates First Set of Very Large Online Platforms and Search Engines*, EUR. COMM'N (Apr. 25, 2023), https://ec.europa.eu/commission/presscorner/detail/en/ip_23_2413 (naming seventeen VLOPs – Alibaba AliExpress, Amazon Store, Apple AppStore, Booking.com, Facebook, Google Play, Google Maps, Google Shopping, Instagram, LinkedIn, Pinterest, Snapchat, TikTok, Twitter, Wikipedia, YouTube, and Zalando).

33 Kati Suominen, CTR. FOR STRATEGIC & INT'L STUD., *Implications of the European Union's Digital Regulations on U.S. and EU Economic and Strategic Interests*, 1 (2022) ("Depending on the regulatory scenario, the DMA and DSA alone can, even in conservative calculations, entail some $22 billion to $50 billion in new compliance and operational

other U.S. scholars argued that the DSA is a model for combating social media harm to democracy.[34]

Although some scholars have already argued that DSA could conflict with U.S. freedom of speech,[35] this paper aims to capture much broader aspects of the new E.U. content moderation approach. The paper does not focus exclusively and solely on the DSA. Rather, it discusses the DSA in a broader context because, in the E.U., illegal content online is subject to different layers of regulation. And in the U.S., this is not easily understood.

More recently, some U.S. scholars argued that, unlike the classic liberal models that have long dominated First Amendment jurisprudence, the DSA provides a superior policy framework for defending democratic institutions.[36] This paper argues that these conclusions are based on the erroneous premise that the DSA can be divorced from other European legislation. The DSA, however, does not operate in isolation.

In the E.U., there is a horizontal framework and sectoral regulation for specific types of content, and then there are national laws for Member States. On the one hand, the DSA explicitly foresees a general and horizontal, rather than sectoral, reform of intermediary liability for third-party content. On the other hand, the E.U. recently adopted several sectoral rules: the Directive on Copyright in a Digital Single Market (CDSM Directive),[37] the Audiovisual Media Services Directive (AVDSM),[38] and the Terrorism Online Content Regulation (TERREG).[39]

---

costs to U.S. digital services providers, equivalent to 8 to 17 percent of these providers' EU revenues, and force them to forgo critical business opportunities.").

34 *See generally* Neil Netanel, *Applying Militant Democracy to Defend Against Social Media Harms*, 45 CARDOZO L. REV. 489 (2023).

35 *See, e.g.*, Ioanna Tourkochoriti, *The Digital Services Act and the EU as the Global Regulator of the Internet,* 24 CHI. J. INT'L L. 129, 132 (2023) (claiming that "the DSA will trump US free speech law insofar as the major companies are transnational and must therefore follow European rules as well as American law").

36 *See generally* Netanel, *supra* note 34.

37 Directive 2019/790 of the European Parliament and of the council 17 April 2019 on copyright and related rights in the Digital Single Market and amending Directives 96/9/EC and 2001/29/EC 2019 O.J. (L 130) 92 (EU) [hereinafter CDSMD].

38 Directive 2018/1808, of the European Parliament and of the Council of 14 November 2018 amending Directive 2010/13 on the coordination of certain provisions laid down by law, regulation or administrative action in Member States concerning the provision of Audiovisual media services, 2018 O.J. (L 303) 69 [hereinafter AVDSM].

39 Commission Regulation 2021/784, of the European Parliament and of the Council of 29 April 2021 on addressing the dissemination of terrorist content online, 2021 O.J. (L 172) 79 [hereinafter TERREG].

Therefore, establishing a core legal regime through a transversal standard and a set of sectoral standards characterizes the new European approach. In other words, the DSA is a horizontal norm that respects the function of the vertical competent authorities due to the matter, which remain responsible for removing content in their particular scope of action.

Hence, the interplay between the DSA and sector-specific legislation is critical in shaping a new E.U. content moderation approach. Importantly, these sectoral instruments give us a sobering glimpse of the future regarding how the new E.U. approach will interact with free speech.

This paper argues that even though the E.U.'s content moderation legislation relies on fundamental rights motives, these well-intentioned, interconnected E.U. digital economy rules undermine some fundamental freedoms in ways that have yet to be recognized. Thus, the paper argues that this new legislation will change content moderation practices, digital governance, and the protection of freedom of speech online. Moreover, the ramifications are far reaching. The scope of these changes is significant, as a whole new generation of Americans will grow up in a world where the main moderators of online discourse will adopt new values alien to U.S. tradition.

Indeed, the E.U. free speech norms considerably differ from those in the U.S., and its regulatory framework will have repercussions on what U.S. citizens can and cannot say online. Turning from a light approach to increased care and duty for platforms, the DSA contrasts the U.S. approach, which traditionally prioritizes markets and tech companies' self-regulation, and still confers sweeping immunity upon intermediaries for the users' expression.

Part 2 of this paper presents two extremes in moderating online content, the U.S. and the E.U., which helps explain why the E.U. approach will trump U.S. free speech law. Moreover, this Part will review the DSA and sector-specific legislation. It will explain how they interact, establishing a solid base for understanding how those instruments unleash some discriminatory forces on their own, such as targeting the speech of racial, national, and sexual minorities and other already marginalized groups.

Part 3 addresses these discriminatory forces. It has a dual purpose in investigating challenges arising from the new E.U. approach. First, it will explain how online intermediaries are now subject to increasingly broad and strict obligations to moderate users' content. Second, it will clarify that online intermediaries should now undertake extensive private enforcement via algorithmic structure and practices. This Part will also explain the shortcomings within the imposed E.U. obligations and how these will lead to collateral censorship, even of lawful content. Part 4 takes a broader look at some of the lessons learned from the E.U. regulatory regime. It will explain that the E.U. approach lacks clarity and substance before the procedure, shifts the liability to online intermediaries, and thus incentivizes private enforcement of fundamental rights. Likewise, it proves that the more varied regulatory burdens contribute to excessive content moderation. Regarding the latter, a particular recommendation will be given for the U.S., considering that, lately, some states have enacted laws regarding content moderation. Finally, Part 5 concludes.

2. Two extremes of content moderation

The internet's development offers unprecedented opportunities for freedom of expression, while also giving rise to new possibilities for censorship. Both E.U. and U.S. laws value the freedom of expression, but how the laws protect those values differ. By their diction, the First Amendment protections do not serve as a check on private actors, such as online platforms.[40] Unlike the United States, Europe lacks analogous constitutional limitations.[41]

This Part will explain how those differences contribute to two opposite extremes in content moderation, from non-intervention to intervention through algorithmic administration as a legislative novelty. First, this Part will explain the essential characteristics of U.S. and E.U. approaches to content moderation. In doing so, it will explain the most important differences between free expression in the E.U. and the U.S. It will then present the key characteristics of the DSA and its relationship to sectoral rules, which are necessary to understand the problems for free expression that arise from such instruments, which will be explored in more detail in the next Part. Even if these speech issues go beyond what U.S. regulators could require, the First Amendment will not prevent them. Therefore, this Part helps us understand why the E.U. approach will trump even U.S. free speech law insofar as the primary digital intermediaries are transnational and must follow E.U. rules and U.S. law.

---

40 Bronner v. Duggan, 249 F. Supp. 3d 27, 41 (D.D.C. 2017) ("To trigger First Amendment protection, the infringement upon speech must have arisen from state action of some kind.").
41 Jack M. Balkin, *Old-School/New-School Speech Regulation*, 127 HARV. L. REV. 2296, 2298 (2014).

2.1. U.S. Approach to Content Moderation (Non-intervention)

The First Amendment of the Constitution clearly states that "Congress shall make no law . . . abridging the freedom of speech, or the press."[42] However, the state action doctrine draws the line between private and governmental actors, immunizing the behavior of private parties from constitutional constraints.[43] To put it simply, constitutional guarantees of individual rights are effective only when they are "fairly attributable to the State."[44] Because the freedom of expression is instantiated in the form of rights to noninterference, the First Amendment functions as a negative right, protecting private entities from undue interferences by public authorities. [45]

However, as Professor Goldman argues, "the First Amendment only sets a floor, not a ceiling, on free speech protections in the United States."[46] Section 230 protects online platforms beyond the First Amendment's free speech protections.[47]

Subject to a few statutory exemptions,[48] Section 230 ensures that online platforms cannot be held liable for their users' speech, even if they attempt to police their services.[49] Therefore, it grants far-reaching immunity to online intermediaries from liability for their content moderation policies.

By shielding digital platforms from legal liability and encouraging self-regulation, Section 230 has inspired other pieces of legislation.[50] For example, the Digital Millennium Copyright Act

---

42 U.S. CONST. amend. I.

43 *See* ERWIN CHEMERINSKY, CONSTITUTIONAL LAW: PRINCIPLES AND POLICIES 569 (7th ed. 2023) ("The Constitution applies to government at all levels–federal, state and local–and to the actions of government officials at all levels. The Constitution, however, generally does not apply to private entities or actors.").

44 Lugar v. Edmondson Oil Co., 457 U.S. 922, 923 (1982) ("Conduct allegedly causing the deprivation of a constitutional right protected against infringement by a State must be fairly attributable to the State.").

45 *See generally* David P. Currie, *Positive and Negative Constitutional Rights*, 53 U. CHI. L. REV. 864 (1986).

46 Eric Goldman, *Why Section 230 Is Better than the First Amendment*, 95 NOTRE DAME L. REV. ONLINE 33, 35 (2019).

47 *Id.* at 36–39 (explaining how commercial speech gets more protection under Section 230 than it would under the First Amendment, how its immunity does not vary with the internet service's scienter since it applies even to actual malice allegations, and how courts routinely interpret Section 230 to immunize all claims based on third-party content, regardless of what causes of action the plaintiff alleges). *But see* Malwarebytes, Inc. v. Enigma Software Grp. USA, LLC, 141 S. Ct. 13, 18 (2020) ("Extending § 230 immunity beyond the natural reading of the text can have serious consequences. Before giving companies immunity from civil claims for 'knowingly host[ing] illegal child pornography,' or for race discrimination, we should be certain that is what the law demands.").

48 47 U.S.C. § 230(e).

49 47 U.S.C. § 230(c)(2)(A)(B).

50 *See* Anupam Chander, *How Law Made Silicon Valley,* 63 EMORY L.J. 639, 642 (2014) ("[L]egal innovations in the 1990s that reduced liability concerns for Internet intermediaries . . . created a legal ecosystem that proved fertile for the new enterprises.").

(DMCA)[51] protects platforms from liability concerning copyright-infringing material as long as they follow specific policies, including removing illegal content once the copyright owner requests it. At the heart of the DMCA lies the "notice and takedown" procedure through which copyright holders can notify intermediaries of allegedly copyright-infringing user content and request its removal.[52] Recently, European legal scholar Husovec argued that the DMCA needs to be more widely given the credit it deserves.[53] Indeed, its influence at a global level was significant, given that it offered a reference model for many countries for which Section 230 was a constitutionally unacceptable model.[54]

Because the U.S. houses some of the largest world platforms, the U.S.' free speech norms and democratic culture became the de facto standard internationally.[55] By preventing the government and other private parties from holding platforms accountable, these instruments created a perfect environment for platforms to grow.[56] At the same time, this means that platforms retain virtually complete control over all aspects of content moderation. Therefore, when the rights of online intermediaries and their users conflict, intermediaries will have arguments for resolving issues in their favor. First, they can argue that their content moderation decisions are protected by the First Amendment. Second, they can enjoy statutory immunity under Section 230.[57]

It is essential to recognize, however, that while the U.S. legal system protects U.S. citizens from domestic governmental overreach, it leaves them vulnerable to the legislative measures imposed by foreign governments. This paper will explore this vulnerability, emphasizing how U.S.

---

51 Digital Millennium Copyright Act of 1998, Pub. L. No. 105-304, 112 Stat. 2860 (Oct. 28, 1998); *see also* 17 U.S.C. § 512.
52 FOLKERT WILMAN, THE RESPONSIBILITY OF ONLINE INTERMEDIARIES FOR ILLEGAL USER CONTENT IN THE EU AND THE US 131 (2020).
53 *See* Husovec, *supra* note 22, at 885.
54 *Id.*
55 *See* Klonick, *supra note* 19, at 1621 ("American lawyers trained and acculturated in American free speech norms and First Amendment law oversaw the development of company content-moderation policy. Though they might not have 'directly im–ported First Amendment doctrine,' the normative background in free speech had a direct impact on how they structured their policies."); s*ee also* Daniel Seng, *The State of the Discordant Union: An Empirical Analysis of DMCA Takedown Notices*, 18 VA. J.L. & TECH. 369, 374 (2014) ("[T]he DMCA safe harbors have indeed gone global. And the world has embraced the DMCA."); Jennifer M. Urban et al., *Notice and Takedown in Everyday Practice,* U.C. BERKELEY PUB. L. & LEGAL THEORY RES. PAPER SERIES 19 (2017) (noting that the DMCA's framework has been "adopted in jurisdictions around the world").
56 ANU BRADFORD, DIGITAL EMPIRES: THE GLOBAL BATTLE TO REGULATE TECHNOLOGY 33–68 (describing the American market-driven regulatory approach).
57 *See* 47 U.S.C. § 230(c)(1)(2).

citizens are not shielded from the new content moderation regulations introduced by the E.U.[58] Before delving into that, however, it will provide an overview of the new E.U. framework.

2.2. How the E.U. Changed Its Approach to Content Moderation (from non-intervention to intervention)

If I wrote this paper a few years ago, I would say that both the U.S. and the E.U. law provide statutory safe harbors that protect online intermediary services from liability for their user's content. As noted, in the U.S., the leading safe harbors are the CDA and the DMCA. In the E.U., it was the e-Commerce Directive. However, things have changed. While the E.U. lawmakers comprehended that the e-Commerce Directive fell short to the E.U. digital market predictions, recent legislative initiatives within the E.U. are to be understood as part of a vision of "Europe's Digital Decade" for 2030.[59] A new framework in Europe draws on fundamental rights. The DSA and sectoral laws establish that protecting fundamental rights online is one of the key objectives.[60]

Notably, the status of private parties regarding the freedom of expression is an important field in which U.S. doctrine differs from the E.U. criterion. The European Convention on Human Rights (ECHR) establishes the fundamental right to freedom of expression.[61] In addition, the European Court of Human Rights (ECtHR), which oversees compliance with the ECHR confirmed that Article 10 of the ECHR may impose so-called positive obligations.[62] These positive obligations

58 *See infra* Part 3.
59 Decision 2022/2481, of the European Parliament and of the Council of 14 December 2022 establishing the Digital Decade Policy Programme 2030, 2022 O.J. (L 323) art. 3 (1)(a) (noting that one of the key goals is "promoting a human-centered, fundamental-rights-based, inclusive, transparent and open digital environment where secure and interoperable digital technologies and services observe and enhance Union principles, rights and values and are accessible to all, everywhere in the Union").
60 *See* DSA, *supra* note 26, Recitals 3, 9, 22, 36, 39–42, 47, 51–54, 63, 154–56; *see also* TERREG, Recitals 3 and 9–10; *see also* CDSMD, art. 17(10); *see also* AVDSM, art. 28(b).
61 Convention for the Protection of Human Rights and Fundamental Freedoms, art. 10, Nov. 4, 1950, 213, U.N.T.S. 221, 230 provides, "1. Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This Article shall not prevent States from requiring the licensing of broadcasting, television, or cinema enterprises. 2. The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary."
62 *See, e.g.*, Palomo Sanchez v. Spain, App. Nos. 28955/06, 28957/06, 28959/06, 28964/06 Eur. Ct. H.R. ¶ 59 (2011) (citing Dink v. Turkey, App. Nos. 2668/07, 6102/08, 30079/08, 7072/09, 7124/09 Eur. Ct. H.R. ¶ 106 (2010)); Fuentes Bobo v. Spain, App. No. 39293/98 Eur. Ct. H.R. ¶ 38 (2000).

are responsibilities for the states to proactively contribute to the freedom of expression, as opposed to merely refraining from intervention.[63] Fundamental rights operating within this framework will significantly influence the future development of content moderation in the E.U. Likewise, they can enable international influence on content moderation from the E.U., even on U.S. speakers, who do not have a constitutional framework based on which they can resist such influences.

Moreover, the DSA and sectoral instruments can also unleash some reprehensible discriminatory forces on their own, such as targeting the speech of racial, national, and sexual minorities and other already marginalized groups. To understand how this occurs, it is crucial to understand what new features the horizontal framework and sectoral regulation for specific types of content introduce and how they interact with each other and with the national laws of Member States.

2.2.1 Digital Services Act (DSA)

DSA reflects a radical change in the regulatory landscape for digital intermediaries. As a legal instrument, the DSA is directly applicable in all Member States.[64] In addressing the rights of both the online intermediaries and their users,[65] one of its main objectives is to harmonize the laws between online and offline illegal content.[66] Among other things, the DSA seeks to protect a solid commitment to freedom of expression while imposing a broad series of responsibilities on the internal functioning of the providers of intermediary services.[67]

63 *See, e.g*., Fuentes Bobo v. Spain, App. No. 39293/98, ¶ 38 (Eur. Ct. H.R. May 5, 2000) (finding that Spain had a positive obligation to protect the freedom of expression of a television producer who was fired after making statements criticizing his employer in radio broadcasts). *But see* Palomo Sanchez v. Spain [GC], App. Nos. 28955/06, 28957/06, 28959/06, 28964/06, 1 76–79 (Eur. Ct. H.R. Sept. 12, 2011) (finding that Spain had no positive obligation to annul dismissal of employees by a private company after they published offending material about their employers in a union newsletter).
64 *See* DSA, *supra* note 26, art. 9.
65 *Id.* at Recital 3.
66 *Id.* at Recital 12 ("In order to achieve the objective of ensuring a safe, predictable and trustworthy online environment, for the purpose of this Regulation the concept of 'illegal content' should broadly reflect the existing rules in the offline environment.").
67 *Id.* at Recital 3 ("Responsible and diligent behaviour by providers of intermediary services is essential for a safe, predictable and trustworthy online environment and for allowing Union citizens and other persons to exercise their fundamental rights guaranteed in the Charter of Fundamental Rights of the European Union (the 'Charter'), in particular the freedom of expression and of information, the freedom to conduct a business, the right to non-discrimination and the attainment of a high level of consumer protection."); s*ee also id.* at Recital 52.

a) General provisions

Importantly, the geographic reach of the DSA is extensive.[68] It "appl[ies] to intermediary services offered to recipients of the service that have their place of establishment or are located in the Union, irrespective of where the providers of those intermediary services have their place of establishment."[69] However, the DSA's scope could be even more extensive. For instance, Recital 8 further raises a "substantial connection." Such a substantial connection to the E.U. exists, for example, if "the number of recipients of the service in one or more Member States is significant" or if the provider directs its activities towards member states by using "a currency generally used in the Member State" or "a relevant top-level domain."[70]

b) Liability of intermediary service providers

Although safe harbors have been replaced with a ban on general monitoring obligations,[71] the DSA introduces new regulatory coverage, which consists of a new set of asymmetric obligations, always respecting the principle of proportionality.[72] Therefore, the DSA pursues addressing illegal content online and instituting a scalable accountability framework to protect fundamental rights. In other words, the larger the platform, the broader and more profound the set of rules is.

Interestingly, the DSA regime for the liability of online intermediary services contains new developments in the form of a Good Samaritan clause.[73] Noteworthy, the Good Samaritan clause is a U.S. legal invention.[74] It provides immunity to those who voluntarily assume a duty of assistance not required by law and make "good faith" content moderation efforts of "obscene,

68 *See generally id.* at art. 2.
69 *Id.* at art. 2(1).
70 *Id.* at Recital 8.
71 *Id.* at art. 8 ("No general obligation to monitor the information which providers of intermediary services transmit or store, nor actively to seek facts or circumstances indicating illegal activity shall be imposed on those providers.").
72 *Id.* at Recital 144 ("Compliance with the relevant obligations imposed under this Regulation should be enforceable by means of fines and periodic penalty payments. To that end, appropriate levels of fines and periodic penalty payments should also be laid down for non-compliance with the obligations and breach of the procedural rules, subject to appropriate limitation periods in accordance with the principles of proportionality. . . .").
73 João Pedro Quintais & Sebastian Felix Schwemer, *The Interplay Between the Digital Services Act and Sector Regulation: How Special Is Copyright?*, 13 EUR. J. RISK REGUL. 191, 201 (2022); *see also* Kinga Sorbán, *An Elephant in the Room—EU Policy Gaps in the Regulation of Moderating Illegal Sexual Content on Video-Sharing Platforms*, 31 INT. J.L. & INFO. TECH. 171, 177 (2023) ("The DSA maintains this framework of limited liability and complements it with a good Samaritan clause similar to the American CDA's rules.").
74 47 U.S.C. § 230(c)(2).

lewd, lascivious, filthy, excessively violent, harassing, or otherwise objectionable" content.[75] Moreover, the Good Samaritan clause protects intermediaries for any action "taken to enable or make available to . . . others the technical means to restrict access to material" that falls within the specific categories mentioned above.[76] Yet, this part does not contain an explicit requirement for the provider to act in good faith. Therefore, it provides an opportunity for intermediaries who cannot satisfy a good faith requirement to nonetheless obtain immunity.

However, the DSA offers only half of the U.S. Good Samaritan protection since online intermediaries in the E.U. would not lose their immunity if they took voluntary action resulting in removal of illicit content, but they would not be protected if they did not act.[77] This solution could be problematic if we think about how the platforms generally function. They train their algorithms on certain types of content. As a consequence, and as this paper will argue later, there is a risk that algorithms may produce biased outcomes, which therefore can lead to inequalities of online visibility with broader social implications.[78]

c) Due diligence obligations

Crucially, due diligence obligations constitute an important novelty in relation to the e-Commerce Directive.[79] These new obligations do not apply uniformly. Instead, they apply asymmetrically to all providers of intermediary services, with special rules for hosting services, online platforms, and very large online platforms (VLOPs).

Online platforms represent a subset of hosting providers that not only store information provided by the recipients of their services but, upon request of a recipient of the service, disseminate such information to the public.[80] An online platform transforms into a VLOP when "a number of average monthly active recipients of the service in the Union are equal to or higher than 45 million."[81] The DSA design is basically a legal Matryushka doll. Hosting providers are a type of intermediary service provider, online platforms a type of hosting provider, and VLOPs a

---

75 47 U.S.C. § 230(c)(2)(A).
76 47 U.S.C. § 230(c)(2)(B).
77 DSA, *supra* note, 26 at art. 7.
78 *See infra* Part 3.2.
79 DSA, *supra* note, 26, at arts. 11–48.
80 *Id.* at art. 3(i).
81 *Id.* at art. 33(1).

type of online platform. This framework is important because due diligence obligations are imposed gradually.

General duties apply to all companies, while greatest responsibilities are assigned to the VLOPs.[82] The European Commission directly supervises VLOPs and their failure to comply with a DSA obligation may give rise to a fine of up to 6% of their annual worldwide turnover.[83]

To address the challenges posed by online intermediary services, the DSA introduced a wide range of new due diligence obligations to "ensure a safe and transparent online environment."[84] Due diligence obligations consist of three main pillars, transparency duties,[85] risk management obligations[86] and due process requirements for content moderation.[87] All hosting providers must comply with transparency duties, but they are particularly stringent for VLOPs.[88] Moreover, VLOPs should address systemic risk which cover a broad category, from risk associated with the dissemination of child abuse, gender-based violence or illegal hate speech material, to public security or public health concerns.[89] When conducting risk assessments, VLOPs particularly must consider "their content moderation systems" and "the amplification and potentially rapid and wide dissemination of illegal content."[90]

Likewise, the DSA requires an active involvement and taking measures against illegal content. On the one hand, content moderation is defined broadly.[91] On the other hand, content moderation must be comprehensible.[92] All hosting providers must implement notification and action

---

82 Press Release, Eur. Comm'n, *Digital Services Act: Commission designates first set of Very Large Online Platforms and Search Engines* (Apr. 25, 2023) (IP/07/1567), https://digital-strategy.ec.europa.eu/en/policies/dsa-vlops.
83 DSA, *supra* note, 26, at art. 74.
84 *Id.* at Recital 40.
85 *Id.* at art. 15.
86 *Id.* at art. 34; *see also id.* at Recitals 80–83.
87 *Id.* at art. 15–18.
88 *Id.* at art. 39 and 42.
89 *Id.* at Recitals 80–83.
90 *Id.* at art. 34(2).
91 *Id.* at art. 3(t) ("'[C]ontent moderation' means the activities, whether automated or not, undertaken by providers of intermediary services, that are aimed, in particular, at detecting, identifying and addressing illegal content or information incompatible with their terms and conditions, provided by recipients of the service, including measures taken that affect the availability, visibility, and accessibility of that illegal content or that information, such as demotion, demonetisation, disabling of access to, or removal thereof, or that affect the ability of the recipients of the service to provide that information, such as the termination or suspension of a recipient's account.").
92 *Id.* at art. 14(1) ("Providers of intermediary services shall include information on any restrictions that they impose in relation to the use of their service in respect of information provided by the recipients of the service, in their terms and conditions. That information shall include information on any policies, procedures, measures and tools used for

mechanisms to allow individuals or entities to notify them of the existence of allegedly illegal content.[93] Such notification gives rise to actual knowledge or awareness, and therefore, the hosting provider is not able to enjoy any liability exemption.[94]

A large portion of content moderation decisions is subject to an obligation of a clear and specific statement of reasons to any affected recipients.[95] More importantly, decisions are subject to an internal complaint-handling system.[96]

However, many provisions are vague. Providers need to make decisions "in a timely, diligent, nonarbitrary and objective manner"[97] and enforce them "with due regard to the rights and legitimate interests of all parties involved, including the fundamental rights of the recipients of the service, such as the freedom of expression, freedom and pluralism of the media."[98] Put differently, while what online intermediaries must do may sound sensible in theory, how it should be done in practice is not the clearest.

Speaking of practice, from July to September, YouTube alone removed 8,115,659 videos.[99] But, as Keller argues, YouTube still does not do what the DSA requires—it does not "offer appeals for the billion additional comments it removes."[100]

2.2.2 Sectoral legal instruments

DSA creates a sophisticated content moderation framework consisting of mandatory safeguards, including providing explanatory information to the user and obligatory internal complaint-handling mechanisms. However, the DSA is not alone on this path.

---

the purpose of content moderation, including algorithmic decision-making and human review, as well as the rules of procedure of their internal complaint handling system. It shall be set out in clear, plain, intelligible, user-friendly and unambiguous language, and shall be publicly available in an easily accessible and machine-readable form.").

93 *Id.* at art. 16(1); *see also id*. at Recitals 50–54.

94 *Id.* at art. 16(3).

95 *Id.* at art. 17.

96 *Id.* at art. 20.

97 *Id.* at art. 16(1).

98 *Id.* at art. 14(4).

99 *See YouTube Community Guidelines Enforcement*, GOOGLE TRANSPARENCY REP, https://transparencyreport.google.com/youtube-policy/removals?hl= (last visited Apr. 1, 2025).

100 Daphne Keller, *The EU's New Digital Services Act and the Rest of the World, of the World*, VERFBLOG (Nov. 7, 2022), https://verfassungsblog.de/dsa-rest-of-world/.

Prior to the adoption of the DSA, a variety of sector-specific legislative instruments have been adopted. These include the Audiovisual Media Services Directive,[101] which extends obligations of video sharing platforms and social media services; Article 17 Directive on Copyright in the Digital Single Market,[102] which introduces a new liability regime for online content-sharing platforms; and Regulation for terrorist content,[103] which prevents the dissemination of terrorist content online. These new obligations are effectively executed by monitoring and removing content. Therefore, the interplay between the DSA and sectoral laws is critical in shaping online content moderation in and from the E.U.

This section explains in more detail how sector-specific instruments depart from the pre-existing acquis. Understanding this departure is essential to elucidate their intricate interaction with freedom of expression.

Article 17 of the CDSMD introduced a new set of obligations for online content-sharing service providers (OCSSPs),[104] who are now primarily liable for copyright infringement unless they make best efforts to ensure unavailability of unlicensed copyright works. Before the adoption of Article 17, digital intermediaries, such as YouTube, did not have to license copyrighted content uploaded by its users.[105]

Currently, this lengthy provision attaches direct liability to online content-sharing service providers for the content uploaded by its users to their services when such content infringes copyright-protected works. To escape liability for illegal uploads, the providers must demonstrate that they have made "best efforts" to obtain authorization from rights holders,[106] and to ensure the

---

101 *See* AVDSM, *supra* note 38; *see also id*. at Recital 1.
102 CDSMD, *supra* note 37, at art. 17.
103 TERREG, *supra* note 39, at Recital 9.
104 COMMISSION TO THE EUROPEAN PARLIAMENT AND THE COUNCIL, GUIDANCE ON ARTICLE 17 OF DIRECTIVE 2019/790 ON COPYRIGHT IN THE DIGITAL SINGLE MARKET 21 (2021), https://eur-lex.europa.eu/legal-content/EN/TXT/?qid=1625142238402&uri=CELEX%3A52021DC0288 ("[O]nline content-sharing service provider is defined as an information society service provider of which the main or one of the main purposes is to store and give the public access to a large amount of copyright-protected works or other protected subject matter uploaded by its users, which it organises and promotes for profit-making purposes.") [hereinafter *Guidance on Article 17*].
105 *See* João Pedro Quintais et al., *Copyright Content Moderation in the EU: An Interdisciplinary Analysis*, SSRN 91 (Aug. 8, 2022) ("Until now, EU copyright law did not attach liability to a legally specified category of providers, but rather on the basis of acts (communication to the public) and services or functions (hosting). Now, direct liability for communication to the public is attached to the legal qualification of a provider as an OCSSP.").
106 CDSMD, *supra* note 37, at art. 17(4)(a).

unavailability of legally protected content,[107] including making best efforts to prevent future uploads.[108] In other words, this new provision involves content filtering measures with an *ex-ante* effect.

Moreover, it also creates a significant distancing from the U.S. approach. Whereas the DMCA's section 512 protects online intermediaries from liability for copyright infringement,[109] the new E.U. approach holds OCSSPs liable for unlicensed content displayed on their platforms by users. In other words, the change brought by Article 17 of the CDSMD regarding copyright infringement online is the shift of responsibility from copyright holders to the OCSSPs.

Furthermore, notice and takedown versus notice and stay down approaches create very different incentives for content moderation.[110] This change in the E.U. approach is not minor, considering that copyright law accounts for most frequent content removals from online platforms.[111]

Likewise, the updated AVDSM introduced specific rules for video sharing platforms (VSPs).[112] Before the amendment of the AVDSM, the E-commerce Directive offered a limited set of rules on hosting service providers.[113] Today, social media services are within the scope of the AVDSM because "they compete for the same audiences and revenues as audiovisual media services" and "have a considerable impact in that they facilitate the possibility for users to shape and influence the opinions of other users."[114] Therefore, the AVDSM imposes content moderation duties to protect minors and the general public from several types of content, including hate speech,[115] audiovisual commercial communications,[116] and mental or moral development of

107 *Id.* at art. 17(4)(b).
108 *Id.* at art. 17(4)(c).
109 *See supra* notes 53–56, and accompanying text.
110 *See generally* Martin Husovec, *The Promises of Algorithmic Copyright Enforcement: Takedown or Staydown? Which is Superior? And Why?,* 42 COLUM. J.L. ARTS 53, 53–54 (2018).
111 *See* Alexander Peukert et al., *Eur. Copyright Soc'y – Comment on Copyright and the Digital Services Act Proposal*, 53 IIC-INT'L REV. INTELL. PROP. AND COMPETITION L. 358, 359 (2022) ("Copyright law accounts for most content removal from online platforms, by an order of magnitude. Thus, copyright enforcement online is a major issue in the context of the DSA, and the DSA will be of utmost importance for the future of online copyright in the EU.").
112 AVDSM, *supra* note 38, at art. 1(1)(e) (defining "video-sharing platform provider" as "the natural or legal person who provides a video-sharing platform service").
113 *See* Sorbán, *supra* note 73, at 174.
114 *See* AVDSM, *supra note* 38, at Recital 4.
115 *Id.* at art. 9(1)(c).
116 *Id.* at arts. 9(d), 9(e), 9(f), and 9(g).

minors, particularly content that involves pornography or violence.[117] In addition, the AVDSM encourages self-regulation.[118] Video-sharing platforms must adopt measures concerning the possible dissemination of illegal content. Moreover, they must also provide out-of-court redress mechanisms to settle user disputes[119]

Finally, TERREG imposes obligations on hosting service providers to remove illegal and harmful content and implement measures to combat terrorist content online.[120] Although the regulation states that providers should take "into account the risks and level of exposure to terrorist content as well as the effects on the rights of third parties and the public interest to information,"[121] how those measures should be implemented is not explained clearly enough. Notably, the CDSM,[122] the AVDSM,[123] and the TERREG[124] request online intermediaries to consider fundamental rights, including freedom of speech when implementing their measures.

2.2.3 Sectoral laws and DSA interaction

As noted, sectoral legislation introduced a new category of service providers and obligations. Moreover, these sectoral legal instruments also leave private companies to address the legality of content on their platforms. Before digging into what significant issues these new obligations and designations of power to private platforms create, it is necessary to understand how such sectoral instruments interact with the DSA.

---

117 *Id.* at art. 6(a)(1).
118 *Id.* at Recital 4.
119 *Id.* at art. 28b(7).
120 *See* TERREG, *supra* note 39, at art. 3–6.
121 *Id.* at Recital 22.
122 CDSMD, *supra* note 37, at art. 17(10) ("When discussing best practices, special account shall be taken, among other things, of the need to balance fundamental rights and of the use of exceptions and limitations.").
123 AVDSM, *supra* note 38, at Recital 47 ("[Video sharing platforms] should also be required to take appropriate measures to protect the general public from content that contains incitement to violence or hatred directed against a group or a member of a group on any of the grounds referred to in Article 21 of the Charter of Fundamental Rights of the European Union (the 'Charter').").
124 TERREG, *supra* note 39, at art. 5(1) ("A hosting service provider exposed to terrorist content as referred to in paragraph 4 shall, where applicable, include in its terms and conditions and apply provisions to address the misuse of its services for the dissemination to the public of terrorist content. It shall do so in a diligent, proportionate and non-discriminatory manner, with due regard, in all circumstances, to the fundamental rights of the users and taking into account, in particular, the fundamental importance of the freedom of expression and information in an open and democratic society, with a view to avoiding the removal of material which is not terrorist content."); *see also id.* at art. 5(3)(c) ("[Specific measures] shall be applied in a manner that takes full account of the rights and legitimate interest of the users, in particular users' fundamental rights concerning freedom of expression and information, respect for private life and protection of personal data").

While the DSA sets horizontal rules covering all types of illegal content and information society services in general, it does not replace sector-specific legislation.[125] Those sector-specific rules constitute a vertical regulation dimension and apply as *leges speciales*. In other words, while the DSA is content-agnostic and differentiates rules based on the size of the online intermediary rather than the type of content offered, sectoral regulation applies to specific types of content, such as copyright, audiovisual, or terrorist content.

The resulting complex regulatory environment means that the DSA will apply to sector-specific rules insofar as it contains rules that regulate matters not covered by those sectoral rules or specific rules on matters where sectoral rules leave a margin of discretion to the Member States.[126]

As noted, sector-specific legal instruments define a new category of service providers and introduce new obligations. For example, the CDSMD defined a new category of online content-sharing service providers, the updated AVDSM introduced the provisions pertaining to video sharing platforms, while the TERREG introduced new measures to prevent hosting services from being used for terrorist purposes.

Therefore, if the relevant information that the content service provider hosts relates to copyright, CDSMD applies. If the relevant information the provider hosts relates to audiovisual or terrorist content, the AVDSM or TERREG, respectively, apply. However, if the relative content relates to any other illegal information or content, the DSA applies. In other words, YouTube, for example, qualifies as OCSSP and VSP but also as VLOP and is subject to sectoral rules and DSA.

2. Collateral Censorship of the E.U. Content Moderation Approach

In the U.S., the law provides immunity for online intermediaries, precluding these companies from being held legally liable for any third-party content they host on their platforms.[127] For

125 *See* DSA, *supra* note 26, at Recitals 10–11.
126 *See* Quintais & Schwemer, *supra* note 73, at 204.
127 *See supra* notes 42–58 and accompanying text.

example, YouTube cannot be responsible when a user uploads a video promoting violence or posts a derogatory comment about someone on that platform.[128]

On the other hand, a change has gradually occurred in the E.U.'s attitude to digital regulation in recent years. Whether or not the platform is liable depends on a complex set of legislation, general, sectoral self-regulatory, and coregulatory norms. This new regime sets out a new environment for online intermediaries to design and carry out content moderation, leading to unintended implications for freedom of expression and the rule of law.

Unable to cope with the scale of content available, the E.U. decided to pass the hot potato to online intermediaries, thus shifting responsibility.[129] However, by imposing a new set of due diligence duties on online intermediaries to moderate illicit and harmful content, the platforms are expected to undertake extensive private content regulation. Moreover, this "[n]ew-school speech regulation often emphasizes ex ante prevention rather than ex post punishment, and complicated forms of public/private cooperation."[130] Indeed, certain aspects of the European content moderation amalgamation delegate public power to private online platforms.[131] This paper argues that this endangers freedom of expression. In general, combining broad provisions and algorithmic use will threaten free speech, mainly when it comes to content that is not illegal but is regarded as harmful,[132] and when it comes to marginalized users.

This Part analyzes how shifting the liability to online intermediaries has animated a new form of private law enforcement raising concerns. On one hand, online intermediaries are subject to increasingly broad and strict obligations to moderate content. On the other hand, they should undertake extensive private enforcement via algorithmic structure and practices, including

---

128 Bradford, *supra* note 56, at 43 ("No other law better captures the spirit of the American market-driven regulatory model than Section 230 of the Communications Decency Act (CDA) of 1996.").

129 *See, e.g.*, Eric Goldman & Jess Miers, *Why Can't Internet Companies Stop Awful Content?*, ARS TECHNICA, (Nov. 27, 2019, 5:45 AM), https://arstechnica.com/tech-policy/2019/11/why-cant-internet-companies-stop-awful-content/ (arguing that perfect moderation of illicit content is impossible).

130 Balkin, *supra* note 41, at 2306.

131 Hannah Bloch-Wehba, *Global Platform Governance: Private Power in the Shadow of the State*, 72 SMU L. REV. 27, 29 (2019) ("[P]latforms are acting as regulators or bureaucracies—implementing the favored policy solutions of executive and legislative branch actors—on a global scale.").

132 *See* Daphne Keller, *Lawful but Awful? Control Over Legal Speech by Platforms, Governments, and Internet Users*, U. CHI. L. REV. BLOG (June 28, 2022), https://lawreview.uchicago.edu/online-archive/lawful-awful-control-over-legal-speech-platforms-governments-and-internet-users.

concerning lawful content. While platforms frequently host harmful and illegal content, excessive removal can pose problems. Moreover, content moderation is a necessary condition of online platform services. Therefore, the wide range of obligations to rapidly remove illicit and harmful content may give rise to pervasive over-enforcement and online censorship.

3.1.Implications for Free Speech Leading to General Monitoring

The burden on platforms flowing from the obligations under the E.U.'s new approach regarding content moderation is now becoming increasingly demanding. Reconciling broad content moderation and free expression obligations is not an easy task. The Sisyphean aspect of the task is due to the volume of the content but also its scattered nature, including aspects of changing cultural values. Therefore, several areas of concern arise, such as how moderators judge illegal content, how their removal process functions, and due process questions in automated content moderation systems. Because there are so many variables, the platform's task is necessarily a Sisyphean one.

This section explores possible issues with free speech when platforms embark on a content moderation task. There are three risks to freedom of expression: content moderation may lead to general monitoring and over-blocking; use of algorithmic tools may lead to eliminating lawful content; content demotion and information bubbles, all intertwined with privatized justice and raising questions of due process.

As already noted, the DSA broadly defines content moderation. In addressing illegal content, platforms can delete content or user accounts, demonetize it, meaning it does not run with ads, or demote it, meaning it shows less prominently in algorithmic recommendations.[133] In addition, the DSA does not impose a general obligation on providers of intermediary services to monitor the information they transmit or store.[134]

---

133 DSA, *supra* note 26, at art. 3(t) ("'[C]ontent moderation' means the activities, whether automated or not, undertaken by providers of intermediary services, that are aimed, in particular, at detecting, identifying and addressing illegal content or information incompatible with their terms and conditions, provided by recipients of the service, including measures taken that affect the availability, visibility, and accessibility of that illegal content or that information, such as demotion, demonetisation, disabling of access to, or removal thereof, or that affect the ability of the recipients of the service to provide that information, such as the termination or suspension of a recipient's account . . . .").

134 *Id.* at art. 8.

Despite this general monitoring prohibition, sector-specific legislation introduced new proactive monitoring obligations for online intermediaries. As already explained, the OCSSPs must make the best efforts to implement any relevant solutions aiming to ensure the unavailability of specific unauthorized content. However, they need to remove the illegal content but also prevent future uploads.[135] European Commission guidance suggests a preventive *ex-ante* blocking even of lawful content might occur. While the CDSMD itself suggests that the cooperation between OCSSPs and rightsholders can only result in the blocking of manifestly infringing content,[136] the European Commission guidelines suggest that other content can also be subject to preventive blocking.[137] Certain content that the European Commission considers time-sensitive, such as pre released music or films or highlights of recent broadcasts of sports events, should be subject to *ex-ante* human review.[138] Even though the European Commission indicated that it "should not lead to a disproportionate burden on service providers," complying with *ex-ante* human review is burdensome.[139] If the platform needs to prevent future uploads, then the question is whether this can be done without general monitoring.

Linked to this, the design of the DSA indicates that the DSA could incentivize platforms to censor content excessively. As noted, the DSA establishes that platforms must have mechanisms allowing any individual or entity to notify them of the presence of content on their service that the individual or entity considers illegal content.[140] The actual "knowledge or awareness" is created upon receiving such notification, eliminating providers' liability shields.[141] This mechanism incentivizes platforms to remove content upon receiving an accusation of illegality since they must "expeditiously remove or disable access to the illegal content."[142] Otherwise, they face legal liability for the storage of illegal content.[143] Since anyone can flag any expression as illegal, creating actual knowledge or awareness on behalf of the platform to remove content, automatically

135 CDSMD, *supra* note 37, at Recital 66 ("Additionally, such online content-sharing service providers should also be liable if they fail to demonstrate that they have made their best efforts to prevent the future uploading of specific unauthorised works, based on relevant and necessary information provided by rightholders for that purpose.").
136 *Id.* at art. 17(7).
137 *Guidance on Article 17*, *supra* note 104.
138 *Id.*
139 *Id.*
140 *See* DSA, *supra* note 26, at art. 16(1).
141 *Id.* at art. 6(3).
142 *Id.* at art. 6(1)(b).
143 *Id.*

exposing it to liability, platforms are encouraged to over-block the content. Furthermore, the considerable fines they are exposed to, specially the VLOPs, do not alleviate this issue. Instead, they create an additional incentive to censor content and may produce unfavorable outcomes when evaluating the permissibility of the DSA's limitations on freedom of expression.

Likewise, the AVDSM and TERREG create similar risks. For example, the AVDSM requires video sharing platforms to take appropriate measures regarding content that is not solely illegal but also regarded as harmful.[144] Unlike illegal content, which necessarily includes law-infringing content, harmful content does not automatically violate the law. Subtleties characterize harmful but legal or "lawful but awful"[145] content, which is considered inappropriate or offensive for certain audience groups. As such, it does not automatically receive protection. Or, as Schauer famously put it, in the U.S. context, the "legal toleration of speech-related harm is the currency with which we as a society pay for First Amendment protection."[146] Therefore, the existing dichotomy of speech within the AVDSM presents significant challenges from a U.S. perspective. This issue is further compounded, especially considering that the scope of harmful content lacks clarity,[147] the DSA does not explain expressively what content is illegal,[148] and E.U legal landscape heterogeneity regarding the illegality of certain content.[149]

Similar issues exist with TERREG, which defines "terrorist content" extremely broadly covering "text, images, sound recordings and videos, as well as live transmissions of terrorist offences, that cause a danger of further such offences being committed."[150] Particularly important, the TERREG establishes that hosting providers must remove or turn off the content within one hour of receipt of a removal order.[151] Given the imminent complexity of such content, it is too

144 AVDSM, *supra* note 38, at art. 28(b).
145 *See* Keller, *supra* note 132.
146 Frederick Schauer, *Uncoupling Free Speech*, 92 COLUM. L. REV. 1321, 1322 (1992).
147 Sorbán, *supra* note 73, at 177 ("The scope of harmful content is the most difficult to define precisely, as the extent to which a particular type of content is considered harmful to a child in each jurisdiction depends largely on the cultural background, the ideology, but also on the prevailing scientific evidence on child psychology and development.").
148 DSA, *supra* note 26, at art. 3(h).
149 ALEXANDRE DE STREEL ET AL., ONLINE PLATFORMS' MODERATION OF ILLEGAL CONTENT ONLINE: LAW, PRACTICES AND OPTIONS FOR REFORM 16 (2020) (noting that illegal terrorist content, online hate speech, child pornography are regulated at national level).
150 TERREG, *supra* note 39, at Recital 11.
151 *Id.* at art. 3.

ambitious to expect platforms to carefully consider all the aspects before censoring the content in such a short timeframe.[152]

Moreover, some authors noted that E.U. laws typically include strict requirements of intent and likelihood of speech resulting in criminal action, which are absent from the definitions of "terrorist content" and its "dissemination to the public."[153] Therefore, significant uncertainty exists regarding what can be deemed terrorist content and dissemination, creating risks for journalistic content and political advocacy.[154] For example, TERREG might encourage platforms to remove content that may rebut the content instead of promoting it, like journalist works and opinions of political leaders who are quoting terrorist propaganda.[155]

Furthermore, TERREG establishes that when assessing whether any material constitutes terrorist content, "factors such as the nature and wording of statements, the context in which the statements were made and their potential to lead to harmful consequences in respect of the security and safety of persons" are relevant.[156] However, no standard European rules exist for criminalizing acts such as online hate speech.[157] Although deferring to national law definitions of illegal content allows us to consider cultural traditions of each Member State, it also raises significant legal issues.

Generally, platforms prefer to operate consistently in all markets, which is more straightforward and minimizes costs.[158] But it has two important implications.

First, platforms regulate speech in line with the most restrictive laws. For example, in the E.U. context, the German Network Enforcement Act (NetzDG) broadly criminalizes insults, which

---

152 *See, e.g.*, Conseil constitutionnel [CC] [Constitutional Court] decision No. 2020-801DC, June 18, 2020, (Fr.) (where the "Avia Law," which required online platforms to remove certain content within 24 hours was ruled unconstitutional by the France's Constitutional Court).

153 Joris Van Hoboken, *The Proposed EU Terrorism Content Regulation: Analysis and Recommendations with Respect to Freedom of Expression Implications, in* TRANSATLANTIC HIGH LEVEL WORKING GROUP ON CONTENT MODERATION ONLINE AND FREEDOM OF EXPRESSION 1, 6 (2019) (noting that the TERREG does "include some references to intent, although these are predominantly tautological references to the intent requirements in the underlying terrorist offenses instead of intent requirements related to the posting of content and the intended results thereof.").

154 *Id.*

155 *Id.*

156 TERREG, supra note 39, at Recital 11.

157 *See* De Streel et al., *supra* note 149.

158 Bradford, *supra* note 56, at 338 ("In practice, tech companies often forgo geoblocking and follow globally uniform rules for reasons that can range from technical or economic to social and cultural.").

could severely hamper free speech beyond Germany.[159] In accordance with the German Criminal Code, it could be illegal under NetzDG "'to call another person a 'jerk,' or even to use the informal du, or 'thou,'' to communicate a lack of respect for the recipient."[160] Related to this, the DSA encourages Member States to actively require platforms to act against illegal content.[161] When more stringent laws are invoked, risks appear because platforms prefer not to customize their content moderation for each country by applying geo-blocking technology.

Second, unlawful content in one Member State may often be removed not just across the E.U. but globally. In the past few years, the Court of Justice of the European Union (CJEU) has permitted national courts to use injunctions to impose rigorous obligations on platforms and oblige them to identify and delete content identical to those previously deemed illegal. Moreover, those decisions do not preclude adopting injunctions producing effects that extend worldwide.[162] For example, the CJEU found that Facebook was required to remove the defamatory post against Austrian politician Eva Glawischnig-Pieszek and to continue removing identical or equivalent content without territorial limitation.[163] Outcomes like that starkly contrast to the U.S. approach, which restricts public official's ability to sue for defamation.[164] In fact, in the U.S., politicians are assigned a range of epithets from "a jerk"[165] to "soulless zombie"[166] daily. Therefore, the E.U.'s tolerance for extraterritoriality sets a jeopardous precedent where courts in one country can influence what users in another country can or cannot see.

159 Netzwerkdurchsetzungsgesetz [NetzDG] [Network Enforcement Act], Sept. 1, 2017, BUNDESGESETZBLATT, Teil I [BGBL I] at 3352 (Ger.); *see also* STRAFGESETZBUCH [STGB] [Penal Code], §§ 185–200, https://www.gesetze-im-internet.de/englisch_stgb/englisch_stgb.html (Ger.) (including among other things, insult, malicious gossip and defamation directed at persons in political life).
160 Diana Lee, *Germany's NetzDG and the Threat to Online Free Speech*, MEDIA FREEDOM & INFO. ACCESS CLINIC (Oct. 10, 2017), https://law.yale.edu/mfia/case-disclosed/germanys-netzdg-and-threat-online-free-speech.
161 DSA, *supra* note 26, at art. 9.
162 *See* Case C-18/18, Eva Glawischnig Piesczek v. Facebook Ireland, ECLI:EU:C:2019:821, ¶¶49–50 (Oct. 3, 2019).
163 *Id.* at ¶ 50 (noting that the "E.U. law does not preclude such an injunction from producing effects worldwide").
164 *See* New York Times Co. v. Sullivan, 376 U.S. 254, 264–65 (1964).
165 Daniel White, *Jeb Bush: 'Donald Trump Is a Jerk',* TIME (Dec. 19, 2015, 3:44 PM), https://time.com/4156094/jeb-bush-donald-trump-jerk/.
166 Rachel Roberts, *Ted Nugent Calls President Joe Biden a "soulless zombie", Compares Him to Adolf Hitler*, GUITAR.COM (Sep.12, 2022), https://guitar.com/news/music-news/ted-nugent-calls-president-joe-biden-is-a-soulless-zombie-compares-him-to-adolf-hitler/.

3.2. Algorithmic Decision-Making

The speed and scale of online speech have transformed how speech is moderated. Human oversight alone can no longer support the sheer amount of online content. To handle the enormous traffic, digital platforms started developing automated techniques to perform qualitative determinations and classify content. In other words, platforms apply algorithmic filtering tools.[167]

Algorithmic content moderation refers to numerous statistical and computer science techniques, varying in complexity and effectiveness, which "aim to identify, match predict or classify some piece of content [based on] its exact properties or general features."[168] Indeed, Douek noted that adopting such tools has been increasing so much in the last couple of years that Professor Klonick's seminal article on content moderation from 2018 falls short when discussing automated moderation.[169]

With the technology development, platforms like Facebook, started increasingly collecting data and deploying algorithms to amplify content and increase user engagement.[170] Moreover, when governments pressure platforms to block or prevent certain content, they prevent specific uploads or adjust their algorithms to reduce their visibility.[171]

Article 17 of the CDSMD now requires the use of automated recognition and filtering tools for copyright content because the OCSSPs are now directly liable to remove content notified to them and prevent future uploads. This is widely acknowledged by scholars[172] and is confirmed by the

---

167 Klonick, *supra* note 19, at 1636 ("The vast majority of this moderation is an automatic process run largely through algorithmic screening without the active use of human decision-making.").
168 Robert Gorwa et al., *Algorithmic Content Moderation: Technical and Political Challenges in the Automation of Platform Governance*, 7 BIG DATA & SOC'Y, Feb. 28, 2020, at 1, 3 (2020).
169 Evelyn Douek, *Governing Online Speech: From "Posts-As-Trumps" to Proportionality and Probability*, 121 COLUM. L. REV. 759, 793 (2021).
170 *See* Mark Zuckerberg, *A Blueprint for Content Governance and Enforcement*, FACEBOOK (Nov. 15, 2018), https://www.facebook.com/notes/mark-zuckerberg/a-blueprint-for-content-governance-and-enforcement/10156443129621634 (explaining how moving to more proactive content moderation "has only started to become possible recently because of advanced in artificial intelligence . . . .").
171 *See generally* GABRIEL NICHOLAS, SHEDDING LIGHT ON SHADOWBANNING (2022); *see also* Hannah Bloch-Wehba, *Content Moderation as Surveillance*, 36 BERKELEY TECH. L.J. 1297, 13035 (2022) (explaining how governments may also convince or compel platforms to remove certain content without the end users knowing about it).
172 *See* Sebastian Felix Schwerner & Jens Schovsbo, *What Is Left of User Rights: Algorithmic Copyright Enforcement and Free Speech in the Light of the Article 17 Regime*, *in* INTELLECTUAL PROPERTY LAW AND HUMAN RIGHTS 569, 576 (Paul L.C. Torremans ed., 4th ed. 2020); Peter Mezei & Istvan Harkai, *Self-Regulating Platforms?: The Analysis of the Enforcement of End-User Rights in the Light of the Transposition of Article 17 of the CDSM Directive*, 7 PUB.

CJEU. As noted, in *Eva Glawischnig-Piesczek v. Facebook Ireland Limited*, the CJEU decided that the national courts can oblige platforms to identify and delete comments identical to those previously deemed illegal.[173] More recently, in Poland's request for the annulment of Art. 17 (4) (b) and (c) of the CDSMD based on the concern that the OCSSPS will heavily rely on algorithms to evade liability, which could affect a user's freedom of speech, the CJEU stated that the use of automatic filtering technologies in copyright context is inevitable.[174]

Importantly, these decisions can have profound implications on other types of content when used to assess the legal framework of the DSA and other sector-specific legislation. For example, as already noted, platforms are encouraged to take proactive measures regarding illegal and harmful audiovisual content.[175] These measures include reducing the dissemination of terrorist content[176] and mitigating other systemic risks.[177] Therefore, the moderation occurs *ex-post* and *ex-ante*.

Ex ante content moderation happens before the publication of the content and is carried out automatically by algorithmic filtering.[178] However, it does not sum up to "pushing the button to prevent A from punching B."[179] Instead, it "works by blocking entire categories of speech acts" and is more like "pushing a button to block all assaults rather than a specific one."[180] From this perspective, it is easy to understand that content moderation profoundly impacts the freedom of users to upload and share content. "Speech becomes less the circulation of ideas and opinions among autonomous individuals and more a collection of measurable data and network connections that companies and governments use to predict social behavior and nudge end users."[181] In dealing

GOVERNANCE, ADMIN. & FIN. L. REV. 109, 112 (2022); Willemijn Kornelius, *Prior Filtering Obligations After Case C-401/19: Balancing the Content Moderation Triangle: A Comparative Analysis of the Legal Implications of Case C-401/19 for Filtering Obligations Ex Ante and the Freedom of Expression in Europe*, 14 J. INTELL. PROP. INFO. TECH. & ELEC. COM. L. 123, 123 (2023).

173 *See supra* notes 162–63.

174 Case C-401/19, Poland v. Parliament & Council, ECLI:EU:C:2022:297, ¶ 54 (Apr. 26, 2022).

175 AVDSM, *supra* note 38, at art. 28(b).

176 TERREG, *supra* note 39, at art. 5.

177 DSA, *supra* note 26, at art. 35.

178 Pablo Ibáñez Colomo, *Whatever Happened to the 'More Economics-Based Approach'?*, 11 J. EUR. COMPETITION L. & PRAC. 473, 473 (2020) (discussing the growing shift from the so-called "more economic approach" to *ex-ante* intervention against big digital platforms in the European legal community).

179 Vincent Chiao & Alon Harel, *Content Moderation Online: Regulation* Ex Ante *Versus* Ex Post, 2023 U. ILL. L. REV. 1587, 1592 (2023).

180 *Id.*

181 Jack M. Balkin, *Free Speech Versus the First Amendment*, 70 UCLA L. REV. 1206, 1214 (2023).

with this measurable data, three risks emerge with respect to free expression: elimination of lawful content, information bubbles, and content demotion.

3.2.1. Lawful Content Censorship

To answer whether platforms act against free expression while moderating content, we must know whether they remove lawful material. Lack of clarity and linguistic vagueness do not necessarily help form a homogeneous understanding of the relevant terms and concepts of new E.U. legislation.[182] However, whether users enjoy free expression also depends on the platforms' algorithms. So, whether the algorithms currently being used by platforms can differentiate between lawful and unlawful content is crucial.

The CJEU emphasized that algorithmic solutions must appropriately discriminate between lawful and unlawful content.[183] Although obliging platforms to carefully use algorithmic technologies, the CJEU needed to explain where to find those technological solutions to correctly distinguish unlawful from lawful content. Therefore, specific assessments, to a certain degree, depend on the Member States.

Nevertheless, algorithmic bias is a pervasive and well-documented problem in content moderation.[184] When Shaun King, a prominent American activist who uses online platforms to promote social justice, including the Black Lives Matter movement, posted hate mail he received that included vulgar slurs, Meta took down his post, not recognizing at first that it was shared to condemn the attack.[185] Similarly, it has been argued that platforms tend to take down informative content when it is written in Arabic.[186] In a society like Europe, where the memory of what

---

182 *See, e.g.*, Pamela Samuelson, *Pushing Back on Stricter Copyright ISP Liability Rules*, 27 MICH. TECH. L. REV. 299, 323 (2021) ("[W]ith such vague terminology at the outset, it will be difficult for many U.S. companies to know whether the Article 17 mandates apply to them.").

183 Case C-401/19, Poland v. Parliament & Council, ECLI:EU:C:2022:297, ¶ 85 (Apr. 26, 2022).

184 *See generally* VIRGINIA EUBANKS, AUTOMATING INEQUALITY: HOW HIGH-TECH TOOLS PROFILE, POLICE, AND PUNISH THE POOR (2017); Solon Barocas & Andrew Selbst, *Big Data's Disparate Impact*, 104 CALIF. L. REV. 671 (2016); Jon Kleinberg et al., Discrimination in the Age of Algorithms, 10 J. LEGAL ANALYSIS 1 (2018); Joy Buolamwini & Timnit Gebru, *Gender Shades: Intersectional Accuracy Disparities in Commercial Gender Classification*, 81 PROC. MACH. LEARNING RSCH. 1, 6–11 (2018); Melany Amarikwa, *Social Media Platforms' Reckoning: The Harmful Impact of TikTok's Algorithm on People of Colo*r, 29 RICH. J.L. & TECH. 69 (2023).

185 Richard Allan, *Hard Questions: Who Should Decide What is Hate Speech in an Online Global Community?*, META NEWSROOM (Jun 17, 2017).

186 Daphne Keller, *Internet Platforms: Observations on Speech, Danger, and Money*, HOOVER INST. (Aegis Series Paper No. 1807, 2018), https://www.hoover.org/sites/default/files/research/docs/keller_webreadypdf_final.pdf.

happened at the Bataclan Theater in Paris in 2015 is still alive and where there are still attacks attributed to Islamist extremism,[187] arbitrary censorship could disproportionally target Arabic speakers and Muslims. And more than that, it can eliminate millions of people's access to certain viewpoints, deepening existing stereotypes, biases, and social inequities.

Additionally, the efficacy of algorithmic tools is increasingly questioned, as these systems often struggle to comprehend content and nuances inherent in various forms of expression.[188] These incompetencies range from politically complex determinations, such as whether the author of certain content is a journalist or a verified news outlet, to more complex in the purely legal sense.[189] For example, what is "lawful," "lawful but awful," "hate speech," or "terrorist content" is legally relevant but also depends on context. Of course, there is certainly more easily recognizable content, such as Holocaust denial or inciting genocide, but most content is not so clear cut.

Likewise, there are similar issues when it comes to copyright. Copyright law allows third-parties unlicensed use of copyright-protected works in certain circumstances, "including when someone has drawn expression from an earlier work in order to parody it, quoted from an earlier work in preparing a new work on the same subject, published a photograph as part of a news story."[190] However, algorithms can hardly grasp the subtleties of language and context separating quoting and parody-based derivative content from illicit copyright content reproductions.[191]

---

187 Jason Burke, *Attacks Across Europe Put Islamist Extremism Back in Spotlight*, THE GUARDIAN (Oct. 17, 2013), https://www.theguardian.com/world/2023/oct/17/attacks-across-europe-put-islamist-extremism-back-in-spotlight.

188 Matteo Fabbri, *Self-determination Through Explanation: An Ethical Perspective on the Implementation of the Transparency Requirements for Recommender Systems Set by the Digital Services Act of the European Union*, *in* PROCEEDINGS OF THE 2023 AAAI/ACM CONFERENCE ON AI, ETHICS, AND SOCIETY 6 (2023) ("Algorithmic recommendations, instead, are not content- but context-specific: the content of their output can vary widely depending on the user, but they are directed by a defined aim within a particular context, i.e. maximizing user engagement in a social media platform."); *see also* Keller, *supra* note 186 ("[N]o reputable experts suggest that filters are good enough to be put in charge of deciding what is illegal in the first place.").

189 *See* Courtney C. Radsch, *The Politics of Labels: How Tech Platforms Regulate State Media, in* 2020 ANNUAL REPORT: DYNAMIC COALITION ON THE SUSTAINABILITY OF JOURNALISM AND NEWS MEDIA 37, 45-49 (Daniel O'Maley et al., eds., 2020), https://www.intgovforum.org/en/filedepot_download/7733/2399.

190 Pamela Samuelson, *Unbundling Fair Uses*, 77 FORDHAM L. REV. 2537, 2539 (2009).

191 *See e.g.*, Maayan Perel & Niva Elkin-Koren, *Accountability in Algorithmic Copyright Enforcement*, 19 STAN. TECH. L. REV. 473, 486 (2016) ("Unlike automated enforcement mechanisms that essentially detect strictly defined unlawful activities, such as red light crossing, algorithmic copyright enforcement often involves implementation of flexible legal standards. Many of the most serious issues in copyright law involve discretion, including determining the degree of "originality" required to establish copyrightability; deciding what amounts to "substantial similarity" to establish infringement; or considering what constitutes "permissible use" under fair use. Resolving these flexible issues largely requires a qualitative process of assessment and balancing that ought to be decided on a case-by-case basis.");

As a Directive, CDSMD needs to be transposed into the national laws of Member States. Many Member States closely followed the wording of the CDSMD, while Germany, followed by Austria, enacted a different model.[192] Facing the difficulties of *ex ante* algorithmic content moderation, German legislators introduced the concept of "uses presumably authorized by law," which are not to be blocked automatically.[193] In other words, there is a presumption that certain content is lawful if it meets cumulative criteria: 1. the use must be less than 50% of the original protected work, 2. the user must combine the parts of the work with other content, 3. the use must be minor (non-commercial use of fewer than 15 seconds of audiovisual works, 160 characters of text, or 125 kbyte of visual arts files).[194] If it generates significant revenue or exceeds these thresholds, the user must flag it as covered by the exception.[195]

The German approach still does not reflect the fact that copyright law is not so clear cut. Not covered by these cumulative requirements, there can still be uses covered by exemptions and limitations not covered by these quantitative thresholds. For example, Article 17 of the CDSMD does not provide definite instructions on how parody creative content should be protected in the context of algorithmic content moderation tools.[196]

This is important not just because any content available on OCSSPs becomes a potential liability subject, but because configurationally, parodies are derivative work. Parodies make fun of a thing by copying enough of it. Therefore, "the author of a parody knows his or her subject well; however, the parodist does not need to affect a pretension of ignorance. In fact, the parodist makes his or her familiarity with the original work obvious."[197] Thus, considering the context is necessary for the protection of parodies to be effective in practice. However, scholars are alert to the danger of frequent false positives.[198]

---

see also Séverine Dusollier, *The 2019 Directive on Copyright in the Digital Single Market: Some Progress, a Few Bad Choices, and an Overall Failed Ambition*, 57 COMMON MKT. L. R. 979, 1018 (2020) (noting that current algorithms tools are still incapable of assessing legitimate use of copyrighted materials such as fair use).

192 Matthias Leistner, *The Implementation of Art. 17 DSM Directive in Germany - A Primer with Some Comparative Remarks*, 71 GRUR INT'L, 909, 909–10 (2022).

193 *Id.* at 910.

194 *Id.* at 916.

195 *Id*.

196 Paulius Pakutinskas, *Algorithmic Parody Protection in the European Union: CDSM Directive and DSA Regulation Perspective*, 16 BALTIC J. OF L. & POL. 79, 84 (2023).

197 Roger J. Kreuz & Richard M. Roberts, *On Satire and Parody: The Importance of Being Ironic*, 8 METAPHOR & SYMBOLIC ACTIVITY 97, 103 (1993).

198 *See* Douek, *supra* note 20, at 549–50 (explaining the substantial cost of false positives).

Equally important, new technologies designed to improve content moderation mainly focus on wide-speaking languages. However, let's take Spanish as an example. Although it is a language spoken in much of America and Spain, among other countries, each territory and even region has its variations and countless unique words. Likewise, some words are used in different Spanish-speaking regions but do not have the same meaning in all of them. For most Spanish speakers, a "fresa" is a red fruit. However, in Mexico, this word refers to the superficial, egocentric young person from a wealthy family, which is why it has a negative connotation. In contrast, in some parts of Colombia, it refers to a homosexual person. Similarly, in most countries where Spanish is spoken, "chucho" is a term used to refer to a dog, especially if it is a mixed breed. However, in Argentina, it means "cold," in Chile, "jail," and in Mexico, an intelligent and competent person.

Even more problematic are less widely spoken languages. Online platforms have less economic incentive to invest in content moderation technologies for those languages.[199] Considering the linguistic diversity in the E.U., this could be highly problematic.[200]

Algorithmic censorship could reach even more significant proportions when it comes to the AVDSM because platforms must adopt measures regarding illegal and harmful content.[201]

3.2.2. Content demotion and information bubbles leading to censorship

Algorithmic content moderation includes both deletion and demotion decisions, as well as broader configuration choices with regard to content management and presentation. In simple terms, demotion refers to the situation in which the content is not being removed, but it is difficult to find it in the search option, or it is no longer being recommended. For example, YouTube stated that content demotion reduces the recommendations and spread of "[c]ontent that comes close to-- but doesn't quite cross the line of--violating the Community Guidelines . . . ."[202]

---

199 *See Policy Advisory Opinion on Meta's Cross-Check Program,* OVERSIGHT BD. (Dec. 6, 2022), https://www.oversightboard.com/wp-content/uploads/2024/10/512630074120983.pdf (noting unequal treatment among its users).

200 *See, e.g.*, Delia Marinescu, *Facebook's Content Moderation Language Barrier*, NEW AM. (Sep. 8. 2021), https://www.newamerica.org/the-thread/facebooks-content-moderation-language-barrier/ (noting that Meta's algorithmic resources for European languages like Romanian are very limited).

201 *See supra* notes 144-149 and accompanying text.

202 *The Four Rs of Responsibility, Part 2: Raising Authoritative Content and Reducing Borderline Content and Harmful Misinformation,* YOUTUBE (Dec. 3, 2019), https://blog.youtube/inside-youtube/the-four-rs-of-responsibility-raise-and-reduce/.

Similarly, Meta acknowledged employing content demotion towards several categories of context, such as content borderline to the community standards, unsafe reporting about suicide, content posted by repeated violators of their policies, and content indicating suspicious virality.[203] The above is indicative that significant legal uncertainty remains regarding borderline content. Promoting or demoting a particular user's content translates into promoting or restricting her freedom of speech.

Notably, the DSA specifically includes suspending a user's account and removing, disabling, or demoting user content.[204] More importantly, the DSA applies to content that is unlawful or contrary to the platforms' terms and conditions. [205] It raises crucial issues, considering that demotion techniques are applied even to the content, which is not illegal *per se* but is borderline. In addition, E.U. content moderation legislation often lacks clarity and imposes significant fines, increasing the incentives to eliminate borderline content.

Moreover, algorithm-driven content management and content presentation configuration on online platforms have come under increased criticism in recent years. According to the "filter bubbles" theory, algorithmic tools provide content that fits users' personal preferences.[206] Because the users are only exposed to the narratives they are likely to agree with, it ultimately leads to communities where users mutually reinforce each other's points of view.[207] Therefore, concerns include the selective display of information, but scholars also highlighted considerations for users' privacy and self-determination[208] and abuse of commercial power.[209]

---

203 *Types of Content We Demote*, META TRANSPARENCY CTR. (Updated Oct. 16, 2023) https://transparency.fb.com/es-la/features/approach-to-ranking/types-of-content-we-demote/.

204 DSA, *supra* note 26, at art. 3(t).

205 DSA, *supra* note 26, at art. 14.

206 ELI PARISER, THE FILTER BUBBLE: WHAT THE INTERNET IS HIDING FROM YOU 91 (2011) (explaining that "because the filter bubble hides things invisibly, we're not as compelled to learn about what we don't know.").

207 *Id* at 84 ("First, the filter bubble surrounds us with ideas with which we we're already familiar (and already agree), making us overconfident in our mental frameworks. Second, it removes from our environment some of the key prompts that make us want to learn".).

208 Sarah Eskens, *The Personal Information Sphere: An Integral Approach to Privacy and Related Information and Communication Rights,* 71 J. ASS'N FOR INFO. SCI. & TECHNOLOGY. 1116, 1124 (2020).

209 PHILIP M. NAPOLI, SOCIAL MEDIA AND THE PUBLIC INTEREST: MEDIA REGULATION IN THE DISINFORMATION AGE 160 (2019); Michelle Hampson, *Smart Algorithm Bursts Social Networks' "Filter Bubbles"*, IEEE SPECTRUM (Jan. 21, 2021), https://spectrum.ieee.org/finally-a-means-for-bursting-social-media-bubbles (noting that filter bubbles create higher levels of user engagement because they are directly related to profit maximizing algorithms).

In its recommender system transparency provision, DSA establishes that online platforms must explain in their terms and conditions "the main parameters used in their recommender systems, as well as any options for the recipients of the service to modify or influence those main parameters."[210] While the DSA emphasizes the relevance of options for the service recipients, it does not explain how those options adjust to fundamental rights. In other words, it does not adequately address the underlying polarization issues.[211]

Consequently, it has been underlined that the DSA "reinforces precisely the kind of *filter bubbles* that have given rise to concerns about recommenders in the first place."[212]

The resulting algorithmic over-blocking, filtering, and demotion do not resemble a system of free speech rights. Likewise, from the platform's perspective, in case of any doubt, removing legitimate content is less costly than exposing themselves to the risk of maintaining illegal content. It may lead to blocking content before it is posted rather than waiting for it to receive a user notification. At the same time, it sets a negative precedent by signaling that those over-removals are needed and proportionate.

There are already findings that, in the E.U., online creators censor themselves by not publishing certain content or adjusting it in advance. Many artists' anticipation of platform punishments directly influences their ability to interact with the public.[213]

210 DSA, *supra* note 26, at art. 27.

211 Natali Helberger et al., *Regulation of News Recommenders in the Digital Services Act: Empowering David Against the Very Large Online Goliath*, INTERNET POL. REV. (Feb. 26, 2021), https://policyreview.info/articles/news/regulation-news-recommenders-digital-services-act-empowering-david-against-very-large.

212 *Id.* ("Effectively involving users in platform governance, however, requires a nuanced insight into how their personal goals relate to public values, and how the control mechanisms can be designed in such a way that they will be used productively. The DSA avoids these issues by leaving it up to platforms to decide what options, if any, users are given.").

213 Daria Dergacheva & Christian Katzenbach, *"We Learn Through Mistakes": Perspectives of Social Media Creators on Copyright Moderation in the European Union*, SOC. MEDIA + SOC'Y 1, 9 (2023).

4. Important Lessons from E.U. Content Moderation Approach

My argument has been principally explanatory and diagnostic. Based on existing content moderation approaches, one could say that these fluctuate "between the chaos of too much freedom and the sterility of too much control."[214] The E.U. approach exemplifies the latter.

This paper has explained how the DSA and the *leges speciales* are changing content moderation practices, the digital governance, and the protection of freedom of speech. Additionally, it has explained how those will have potentially global ramifications. Furthermore, this paper has also explained how the E.U. approach to content moderation increasingly fails to protect the values it seeks to promote. However, an important question remains—what normative lessons follow from these understandings?

Although digital intermediaries are going to be important actors in sterilizing speech, the E.U. has played an essential role in providing incentives that encourage this sterilization. These incentives have three key characteristics: first, legal instruments need more clarity and substance before the procedure; second, shifting the liability to online intermediaries leads to private enforcement of fundamental rights; and third, abundant rules create complexity.

4.1. Lack of Clarity and "Procedure Before Substance" Approach

The E.U. approach is too broad because its emphasis on procedural rules encourages platforms to generally monitor, over-block, or demote content and try to root out a broad range of content that neither meets the legal definition of illicit content nor is harmful. It happens because E.U. legal instruments contend overly vague definitions, incentivizing platforms to go overbroad in moderating content, especially considering the significant fines they are subject to. Worst of all, online intermediaries now have incentives and an increased legitimacy to discipline users for perceived speech transgressions without bothering to examine whether they are linked to copyright infringement, audiovisual infringement, or are inciting terrorism in purpose or effect.

214 James Grimmelmann, *The Virtues of Moderation*, 17 YALE J.L. & TECH. 42, 42 (2015).

At the same time, although it seems contradictory, the E.U. content moderation approach is too narrow because the focus on procedure has led to a neglect of detrimental consequences for free speech. In what is denominated as the "DSA's procedure before substance approach,"[215] the emphasis on unwanted content obscures and diverts any discrimination efforts from the more fundamental patterns of infrastructural designs and algorithmic bias that often underlie and foster collateral censorship.

Importantly, freedom of expression is a dynamic force that shapes social and institutional environments. As such, it is not always discriminatory or harmful and serves various positive purposes in society. Whether its purpose leads to discovering the truth,[216] assuring individual self-fulfillment,[217] or cultural democracy,[218] freedom of speech does not exist without contrasting opinions. Still, it does not mean that online free speech is always benign because it is not. It is hard to deny that many people suffer different harms on online platforms.

However, the research suggests that different strategies are needed to solve these problems. For example, some scholars have argued that because of the systematically inaccurate understanding, what most intending to reform content moderation "achieve is accountability theater rather than accountability itself."[219] Others have argued that the most optimal approach would be to focus on the industrial organization of digital media and their business models.[220]

Likewise, it is argued that the fundamental rights framework is inappropriate to address structural inequalities in content moderation.[221] In other words, correcting the definition of "content moderation," "terrorist content," dichotomy of illegal and harmful speech in audiovisual

215 Pietro Ortolani, *If You Build It, They Will Come, The DSA's "Procedure Before Substance" Approach,* VERFBLOG (Nov. 7, 2022), https://verfassungsblog.de/dsa-build-it/.

216 *See generally* Eugene Volokh, *In Defense of the Marketplace of Ideas/Search for Truth as a Theory of Free Speech Protection*, 97 VA. L. REV. 595 (2011).

217 Thomas I. Emerson, *Towards a General Theory of the First Amendment*, 72 YALE L.J. 877, 879–80 (1963).

218 Jack M. Balkin, *Cultural Democracy and the First Amendment*, 110 NW. U. L. REV. 1053, 1061 (2016) (defining "cultural democracy" as the people's ability to participate in the cultural forms that constitute them as individuals).

219 Douek*, supra* note 20, at 533.

220 *See generally* Jack M. Balkin, *To Reform Social Media, Reform Informational Capitalism*, *in* SOCIAL MEDIA, FREEDOM OF SPEECH, AND THE FUTURE OF OUR DEMOCRACY 101, 121–22 (Lee C. Bollinger & Geoffrey R. Stone, eds., 2022); Liu et al., *Implications of Revenue Models and Technology for Content Moderation strategies*, 41 MARKETING SCI. 1, 3–4 (2022).

221 *See generally* Rachel Griffin, *Rethinking Rights in Social Media Governance: Human Rights, Ideology and Inequality*, 2 EUR. L. OPEN 30 (2023).

context, and other open-ended concepts, such as "main purpose," "large amount," is not enough, so long as our understanding of illicit content is rooted in an idea of individual unacceptable speech, rather than being considered as an inherent manifestation of more considerable algorithmic fairness and bias on data sets. In fact, what the DSA, together with the *leges speciales* demonstrates is that defining content broadly enough to cover all content that we do not want to see online without also expanding the investigation to examine whether the alleged content is linked to more significant risks, we run the risk of encouraging platforms to ban borderline speech, in addition to prohibiting lawful content in many instances.

More recently, Cohen explained that numerous scholars from neighboring fields, including privacy law, media and election regulation, and information governance, have noted that it makes much more sense for content governance to pay attention to how such processes are designed.[222] More relevantly, in the U.S. context, design-based strategies to constrain the platform's business models "are much likelier to survive restrictive free speech review in the courts than more content-focused mandates would be" she noted.[223]

4.2. E.U. Legislator Imposes the Burden on Private Entities to Safeguard Fundamental Rights

It is more than just a lack of clarity and substantive guidance that will contribute to over-blocking and collateral censorship. In both the DSA and each of the *lex specialis*, private online intermediaries should address the legality of online content, including fundamental rights.

This development is a response to the excessive load of content that platforms must moderate, and this delegates to online intermediaries jurisdiction over most matters that previously have given rise to civil action. However, this paper will not go into arguing what dangers the privatization of public adjudicative functions entails. This paper leaves this subject for another day and limits its focus on intermediary incentives within this framework.

222 Julie E. Cohen, *Infrastucturing the Digital Public Sphere*, 25 YALE J.L. & TECH. 1, 12 (2023).
223 *Id.* at 13.

As this paper already noted, content moderation is a critical component of online intermediaries because it creates a market for their services. [224] But, once content moderation is in the hands of online intermediaries, they include their own considerations when shaping the law. This trend has been already denominated as the "managerialization of law" and has been documented in different legal contexts.[225] One of its potential risks is the spread of, and deference to, unsuccessful diversity practices.[226] Ironically, then, a legal framework based on the protection of fundamental rights online will contribute to a new ongoing rationale for sterilizing online speech.

Therefore, another lesson that the E.U. content moderation approach teaches us is that when a legal system shifts the liability for addressing the legality of online content to private parties, it may give them enormous power to implement a content moderation structure in the name of fulfilling with online fundamental rights that have been practically abandoned.

Moreover, it can disincentivize online intermediaries to invest in technology to improve the functioning of the algorithmic tools. We already know that "[c]hoices about the design of algorithmic systems, often made for business or technical reasons, will effectively regulate the ways in which this technology interacts with human values."[227] Likewise, at a more technical level, it has been shown that the developers of these algorithmic systems consider benefits and costs when training them. This means they finish the training when the expected benefits are equal to or less than the training costs.[228]

Furthermore, considering that VLOPs are responsible for identifying and responding to systemic risks, and are being exposed to considerable fines, it is hardly credible that they would invest in improving algorithmic infrastructure when this creates significant costs. This is important for two reasons.

---

224 *See, e.g.*, Cristopher Meek et al., *The Learning-Curve Sampling Method Applied to Model-Based Clustering*, 2 J. MACH. LEARNING RSCH. 397, 399–401 (2002).

225 Andrew D. Selbst, *An Institutional View of Algorithmic Impact Assessments*, 35 HARV. J. L. & TECH. 117, 163–64 (2021) (noting that "managerialization of law" tendencies are observed in algorithmic and privacy law context).

226 Lauren B. Edelman et al., *Diversity Rhetoric and the Managerialization of Law*, 106 AM. J. SOC. 1589, 1589 (2001) ("The managerial conception of diversity adds a variety of nonlegal dimensions of diversity (e.g., personality traits) to the legally protected categories like race and sex, and it disassociates diversity from civil rights law.").

227 Alicia Solow-Niederman, *Administering Artificial Intelligence*, 93 S. CAL. L. REV. 633, 682 (2020).

228 *See* Meek et al., *supra* note 224, at 397.

First, VLOPs have the most resources to invest in improving algorithmic tools. Second, smaller platforms tend to align their practices with their bigger counterparts, which they presume to be sound design and effective.[229] As Gillespie argues "[t]his kind of institutional plagiarism is fine, but it means that if we think not about the sixty biggest platforms but about the next six thousand smaller ones, the consistencies would be much more striking than the differences."[230] In this context, the Brussels effect could become a Brussels tsunami.

4.3. Too Many Cooks Spoil the Broth

From the point of view of an online intermediary that must comply with the norms coming from the new E.U. content moderation approach, the system seems quite complex, if not fractured. A horizontal system, together with the abundant sector-specific rules, creates complexity, especially when we add to this the issues on which those instruments leave the Member States the possibility of adopting specific measures at national levels. Considering all this, it is unclear to what extent the new E.U. approaches can provide legal certainty regarding online freedom of expression.

The lesson this leaves us with is that the more significant and varied the regulatory burdens become, the more online intermediaries are encouraged to moderate content excessively to the detriment of free speech rights.

Moreover, as previously noted, online intermediaries may find it too expensive and challenging to create content moderation and recommendation systems that apply only to a particular territory.[231] Once a restrictive regime becomes the most dominant at a micro level, it will spill over into a broader geographic territory. It ultimately lets more restrictive states override laws and traditions from those who are less restrictive. So, the most restrictive regimes within the E.U. will guide and affect speech, including speech by American citizens.

229 *See, e.g.*, TARLETON GILLESPIE, CUSTODIANS OF THE INTERNET 71 (2018).
230 *Id.* at 72.
231 *See supra* notes 158 *et seq.*

Although the E.U. is a unique governance hybrid,[232] it leaves us great lessons for a federal system like that of the U.S. An increase in state laws on content moderation risks escalating conflicts and undermining freedom of expression online.

Some conservative states in the U.S., namely Florida and Texas, have enacted laws prohibiting online platforms from engaging in viewpoint discrimination.[233] On the other hand, some liberal states, like California and New York, have enacted laws to promote more content moderation.[234]

As more states continue to enact content moderation laws, which will necessarily vary in the spectrum of obligations for online intermediaries, this will impose considerable costs on intermediaries. In response, they will begin to excessively moderate content until more restrictive laws override the laws of less restrictive states. Therefore, the U.S. can learn from the E.U. content moderation approach that any attempt to regulate content moderation in the U.S. must occur at the federal level rather than the state level.

5. Conclusion

Despite various new rules on content moderation in the new E.U. approach, significant legal uncertainty persists due to the rules' vagueness and the reliance on algorithmic tools, which will pave the way for the sterilization of discourse through the borders.

The global impact of the DSA is likely to demand further research on several aspects of its implementation and intersection with other existing and future enforcement structures under other related E.U. laws applicable to intermediary service providers. For instance, the DSA introduces rules closely related to other areas of law, such as data protection or consumer protection, which are not covered here. Therefore, the interest in the new E.U. digital legislation will likely continue.

---

232 *See generally* John Loughlin, *The 'Hybrid' State: Reconfiguring Territorial Governance in Western Europe*, 10 PERSP. ON EUR. POL. & SOC'Y 51 (2009).

233 *See* Act of May 24, 2021, ch. 32, 2021 Fla. Laws 503 (codified as amended at FLA. STAT. §§ 106.072, 287.137, 501.2041, 501.212 (2022)); Act of Sept. 9, 2021, ch. 3, 2021 Tex. Gen. Laws 2d Sess. 3904 (codified at TEX. BUS. & COM. CODE ANN. §§ 120, 321 (2021); TEX. CIV. PRAC. & REM. CODE ANN. § 143A.001-.008 (2023)).

234 *See* California Age-Appropriate Design Code Act, ch. 320, 2022 CAL. STAT. 4916 (sec. 2, § 1798.99.31 effective July 1, 2024) (to be codified at CAL. CIV. CODE § 1798.99.28-.40); Act of June 6, 2022, ch. 204, 2022 N.Y. LAWS 1176 (codified at N.Y. GEN. BUS. LAW § 394-ccc (2023)).

Part III

Internet Infrastructure and Content Moderation in the Shadows*

1. Introduction

Current debates on content moderation primarily focus on the role of online platforms such as Facebook or YouTube.[1] Online platforms are in the spotlight because they can "screen, rank, filter, and block user-generated content"[2] on a massive scale.[3] While the current discourse on content moderation is predominantly centered on the activities of online platforms, it is crucial to recognize the equally important, yet often overlooked, role of infrastructure-level moderation. This less visible form of moderation operates within the layers of "basic internet services,"[4] including internet domain name registries and registrars. These entities, integral to the Domain Name System (DNS), ensure the smooth routing of online traffic by providing digital addresses and ways of

---

* This paper is published in *Colorado Technology Law Journal*. *See Internet Infrastructure and Content Moderation in the Shadows*, 23 COLO. TECH. L.J. 261 (2025).

1. *See generally* James Grimmelmann, *The Virtues of Moderation*, 17 YALE J.L. & TECH. 42 (2015); Jack M. Balkin, *Free Speech in the Algorithmic Society: Big Data, Private Governance, and New School Speech Regulation*, 51 U.C. DAVIS L. REV. 1149 (2018); Kate Klonick, *The New Governors: The People, Rules, and Processes Governing Online Speech*, 131 HARV. L. REV. 1598 (2018).

2. *See* Hannah Bloch-Wehba, *Automation in Moderation*, 53 CORNELL INT'L L.J. 41, 42 (2020) ("'[C]ontent moderation' —the set of practices that online platforms use to screen, rank, filter, and block user-generated content.").

3. *See, e.g.*, Maddy Osman, *Wild and Interesting Facebook Statistics and Facts*, KINSTA (July 19, 2024), https://kinsta.com/blog/facebook-statistics/ [https://perma.cc/XY5M-4AZD] (noting how in just one minute "510,000 comments are posted, 293,000 statuses are updated, 4 million posts are liked, and 136,000 photos are uploaded" on Facebook).

4. *See* Jack Balkin, *Free Speech is a Triangle*, 118 COLUM. L. REV. 2011, 2038 (2018) ("[B]asic internet services [include] . . . . [d]omain name services, which include registrars that register domain names (such as GoDaddy), registries that run top-level domains (such as Verisign), and DNS providers that resolve domain names (such as Cloudflare and Google).").

finding them.[5] In 2020, the relevance of DNS was recognized by the EU's Cybersecurity Strategy for the Digital Decade.[6]

Since the recognition of DNS's role in content moderation, the concept of "meta-moderation or second-order moderation"[7] is gaining more scholarly attention.[8] This shift in focus on who should moderate content prompts us to consider questions such as whether domain name registrars should do more to remove online hate speech[9] or misogyny,[10] or whether they should stay out of moderating content entirely. In other words, should domain name registrars police website content or maintain a strict focus on the stability of the technical infrastructure so that users' web page queries and emails are routed to the precise servers? This is the question at the heart of the infrastructure content moderation debate, a debate that will significantly impact content moderation research in the following years.

Some legal scholars view this question as a "rapidly evolving part of the content moderation ecosystem,"[11] while others are more skeptical. For instance, Jack Balkin, a constitutional law professor at Yale Law School and the founder and director of Yale's Information Society Project—a center focused on studying law and new information technologies—has argued that basic internet

5. *See* Marshall Brain et al., *How Domain Name Servers (DNS) Work*, HOWSTUFFWORKS (Mar. 7, 2024), https://computer.howstuffworks.com/dns.htm [https://perma.cc/TME9-PJH7] (explaining DNS functions).

6. *See The EU's Cybersecurity Strategy for the Digital Decade*, EUROPEAN COMMISSION (Dec. 16, 2020), https://digital-strategy.ec.europa.eu/en/library/eus-cybersecurity-strategy-digital-decade-0 [https://perma.cc/KZF7-AFLF].

7. Christoph Busch, *Regulating the Expanding Content Moderation Universe: A European Perspective on Infrastructure Moderation*, 27 UCLA J.L. & TECH. 32, 37 (2022).

8. *See* JENNA RUDDOCK & JUSTIN SHERMAN, WIDENING THE LENS ON CONTENT MODERATION, at i (Am. U. Wash. Coll. L. 69th ed., 2021) ("But Facebook is not the internet, and focusing almost exclusively on the companies behind these high-profile social media platforms means that the majority of the internet is often left out of the conversation about how to effectively combat harmful content online while also protecting fundamental rights and civil liberties."); *See generally* Annemarie Bridy, *Notice and Takedown in the Domain Name System: ICANN's Ambivalent Drift into Online Content Regulation*, 74 WASH. & LEE L. REV. 1345 (2017); Nicholas Nugent, *Masters of Their Own Domains: Property Rights as a Bulwark Against DNS Censorship*, 19 COLO. TECH. L.J. 43 (2021).

9. Catherine Shu, *Far-right Social Network Gab Goes Offline After GoDaddy Tells it to Find Another Domain Registrar*, TECHCRUNCH (Oct. 28, 2018, 10:28 PM), https://techcrunch.com/2018/10/28/far-right-social-network-gab-goes-offline-after- godaddy-tells-it-to-find-another-domain-registrar [https://perma.cc/8A5R-HQK9]

10. Matt Binder, *Incels.me, a Major Hub for Hate Speech and Misogyny, Suspended by .ME Registry*, MASHABLE (Nov. 20, 2018), https://mashable.com/article/incels-me-domain-suspended-by-registry [https://perma.cc/8XHR-BK4F].

11. Busch, *supra* note 7.

services should not engage in content moderation.[12] Balkin also warned us that "new school speech regulation" will be directed at infrastructure, not the speakers.[13] Similarly, Laura DeNardis, Endowed Chair in Technology, Ethics, and Society at Georgetown University, years ago warned about the potential misuse of DNS and its cooption for purposes utterly unrelated to its initially constructed technical functions.[14]

This paper asserts that the warnings from Balkin and DeNardis are well-founded and align in the realm of infrastructure-level content moderation. In elucidating this alignment, this paper makes two significant contributions. First, it provides a comprehensive examination of the DNS ecosystem. Second, it delineates two distinct ways in which government actors seek to coopt DNS architecture for content moderation, both through policy influence within the multistakeholder community and through regulation.

As Balkin noted, "the regulation and surveillance of speech require an infrastructure."[15] What infrastructure is better than the one with "the power of virtual life and death"[16] like the DNS?

It is said that the "DNS defines a central authority for the [i]nternet."[17] To understand the value of the DNS, we should first know that the internet is a global collection of interconnected computer networks that allows communication using unique numerical Internet Protocol (IP) addresses.[18] Because those IP addresses are hard to memorize, human-friendly domain names were invented.[19] DNS "provides a way of associating alphanumeric names, which are easier for humans to use, with

---

12. Jack M. Balkin, *How to Regulate (and Not Regulate) Social Media*, 1 J. FREE SPEECH L. 71, 73 (2021) ("For basic internet services the regulatory answer is pretty simple: non- discrimination. Let the bits flow freely and efficiently. Don't engage in content regulation at this level.").

13. *See* Balkin, *supra* note 4, at 2015 (explaining how new school speech regulation is directed at infrastructure and not the speakers).

14. Laura DeNardis, *Hidden Levers of Internet Control: An Infrastructure-Based Theory of Internet Governance*, 15 INFO. COMM. & SOC'Y 720, 720-38 (2012).

15. Jack M. Balkin, *Old-School/New-School Speech Regulation*, 127 HARV. L. REV. 2296, 2297 (2014).

16. Hans Klein, *ICANN and Internet Governance: Leveraging Technical Coordination To Realize Global Public Policy*, 18 INFO. SOC'Y 193, 197 (2002) (describing internet naming space).

17. *Id.* at 196.

18. *See* Off. Depot, Inc. v. Zuccarini, 596 F.3d 696, 698 (9th Cir. 2010) ("Every computer connected to the Internet has a unique Internet Protocol ('IP') address.").

19. *See* Acad. of Motion Picture Arts & Scis. v. Network Sols. Inc., 989 F. Supp. 1276, 1281 n.1 (C.D. Cal. 1997) ("An IP number is four groups of digits separated by decimal points, for example, '013.917.114.41.' These IP numbers are converted into a more user-friendly, letter based format called a 'domain name' by specialized computers called 'domain name servers.'"); *See also Office Depot, Inc.*, 596 F.3d at 698 ("Every computer connected to the Internet has a unique Internet Protocol ('IP') address.").

the numerical addresses that designate every location on the [i]nternet."[20] For example, DNS translates a more familiar www.google.com into a hard-to-memorize IP address, 173.194.33.174. In this translation process, DNS creates a chokepoint that can be used to control what is and is not accessible online based on its hierarchical design.[21] As such, DNS provides a channel to sanction internet users and can serve as an essential resource in controlling online content. Denial of access to domain names is equivalent to expulsion from the internet. Merely registering a domain name is not enough to make it truly functional. When a user enters a domain name, a DNS query is sent to the registry operator for the corresponding IP address. Without proper DNS resolution, the domain is useless.[22]

Notably, DNS governance and administration are overseen by a California-based non-profit organization, the Internet Corporation for Assigned Names and Numbers (ICANN).[23] This makes ICANN an attractive focus for those who want more content monitoring on the internet.

This paper seeks to enrich the ongoing discourse through two significant contributions. First, this paper introduces the latest European developments to the ongoing debate. The E.U.'s Digital Services Act (DSA)[24] stands as a pioneering example of "new-school speech regulation," and is striving to leverage privately owned internet infrastructure for its regulatory purposes. While the DSA primarily focuses on online platforms, it has been argued that it could become the world's most significant attempt to moderate online content.[25] However, its effects on moderation at the level of internet infrastructure are frequently overlooked. This paper seeks to explore that dimension.

---

20. NAT'L RSCH. COUNCIL, SIGNPOSTS IN CYBERSPACE: THE DOMAIN NAME SYSTEM AND INTERNET NAVIGATION, NATIONAL ACADEMIC PRESS vii (2005).

21. *See* Stefan Bechtold, *Governance in Namespaces*, 36 LOY. L.A.L. REV. 1239, 1267 (2003) (noting that the DNS is not a monolithic system, but organized network of databases organized hierarchically).

22. Klein, *supra* note 16, at 195 ("In a manner of speaking, the name space is the Internet. In order to exist on the Internet, a computer must be listed in the name space. Without a listing (without a domain name and an IP number) a computer cannot be found by others. Removal of a computer's listing from the name space constitutes a kind of banishment, for a computer disappears from the list of addressable computers. Whatever entity controls the name space database effectively controls the Internet.").

23. ICANN, https://www.icann.org/en/beginners [https://perma.cc/FH3T-LF7E] (last visited Feb. 9, 2025).

24. Council Regulation 2022/2065, 2002, O.J. (L 277) 1 [hereinafter DSA].

25. *See generally* Dawn Carla Nunziato, *The Digital Services Act and the Brussels Effect on Platform Content Moderation*, 24 CHI. J. INT'L L. 115 (2023); *See also* Anupam Chander, *When the Digital Services Act Goes Global*, 38 BERKELEY TECH. L.J. 1067, 1072-74 (2023) (explaining how a number of mechanisms might globalize the DSA).

It argues that a more thorough examination reveals that the DSA tries to coopt DNS and expand content moderation practices to include internet infrastructure. The potential impact of the DSA's cooption of DNS is not to be underestimated, as it could lead to a fundamental shift in how internet online content is regulated and monitored. While the DSA is shifting the narrative towards basic internet infrastructure, unknowns remain regarding the DSA's applicability to DNS services. The DSA does not provide clear classifications regarding which "intermediary services" categories may apply to various DNS services. This ambiguity raises important questions about effectively maintaining and providing essential DNS services while ensuring legal certainty. Moreover, protecting and enhancing freedom of information and expression and other fundamental rights is crucial. These issues become increasingly urgent as some DNS registrars also provide separate hosting services. It remains unclear whether they fall under the scope of the DSA. Addressing these questions is essential for navigating the evolving landscape of digital services and maintaining the integrity of our online freedoms.

History shows that the U.S.-based ICANN has previously made drastic changes to avoid considerable fines from an E.U. legislative act. For example, ICANN has restricted the amount and type of data about internet domain name holders to ensure adequate legal compliance with the E.U. General Data Protection Regulation (GDPR).[26] With the introduction of the E.U.'s DSA, we may soon witness ICANN making more transformative changes to adapt to the evolving regulatory landscape.

Second, this paper addresses policy efforts within ICANN related to content moderation. ICANN's position has been described as ambivalent but hesitant to moderate content generally.[27] However, these descriptions omit the significant impact of government efforts to achieve content moderation through influencing policy within the multistakeholder community. Even though ICANN sits atop the DNS governance hierarchy, its multistakeholder bureaucracy is complex and

26. *See* Tara M. Aaron, *Availability of WHOIS Information After the GDPR—Is it Time to Panic?*, 108 TRADEMARK REP. 1129, 1133 (2018) (describing the effects of the GDPR on WHOIS database for checking domain name availability or to discover the contact information of a domain name holders).

27. *See* Sebastian Felix Schwemer et al., *Liability Exemptions of Non-Hosting Intermediaries: Sideshow in the Digital Services Act?*, 8 OSLO L. REV. 4, 15 (2021). *See also* Aaron, *supra* note 26, at 1336-40 (noting that although ICANN resisted direct involvement in content moderation activities, it accommodated right holders by altering its contracts with DNS intermediaries to support a system of domain name cancellation about which right holders complained).

intricate, and governmental representatives are often involved with its policy.[28] This paper explains how ICANN has suffered from internal pressures to moderate content through its sophisticated contractual framework.

More recently, in June 2024, the ICANN Board decided that its bylaws do not allow it to enforce any contractual commitments that involve content regulation.[29] This paper argues that ICANN's decision is correct. Since ICANN holds a prominent position in the global DNS, placing ICANN at the center of online content moderation policymaking could be dangerous for free speech online.

This paper is organized into three major Parts. Part 2 explains how the E.U. is shifting the narrative around core infrastructural intermediaries within the DSA framework. Part 3 provides an overview of the DNS ecosystem and its relevant components, whose nature was not clarified by the European legislator. Part 4 explains the demands within ICANN to moderate content and how ICANN has freed itself from them. Moreover, it clarifies why internet infrastructure represents a gray zone within the DSA, in addition to raising serious questions about the effectiveness of remedies by DNS intermediaries. In other words, this Part explains why shifting content moderation towards internet infrastructure would set a dangerous precedent. Finally, this paper concludes that whereas the internet's infrastructure layer might be appealing for content moderation purposes, DNS should steadfastly focus on the stability of the technical infrastructure and refrain from content moderation.

2. DSA and infrastructure layer of the internet

The E.U. legal framework regulating online intermediaries has undergone significant changes in recent years. In a departure from previous content moderation initiatives, which focused on

---

28. *See generally* OLGA CAVALLI & JAN AART SCHOLTE, *The Role of States in Internet Governance at ICANN*, *in* POWER AND AUTHORITY IN INTERNET GOVERNANCE: RETURN OF THE STATE? 37 (Blayne Haggart et al. eds., 2021) (examining the role of the state in governance of global internet infrastructure at the ICANN, with particular attention for the Government Advisory Committee).

29. *See Approved Resolutions of | Regular Board Meeting |8 June 2024*, ICANN, (June 11, 2024), https://www.icann.org/en/board-activities-and-meetings/materials/approved-resolutions-regular-meeting-of-the-icann-board-08-06-2024-en [https://perma.cc/6MEB-GMCH]

specific types of content,[30] the DSA takes a broad, horizontal approach encompassing a wide spectrum of online intermediaries.[31] The geographic reach of the DSA is extensive,[32] and it defines content broadly,[33] including "lawful but awful" content, which refers to content that is not illegal but is considered harmful or offensive.[34] Intermediary services can delete content or user accounts or disable access to it when moderating content.[35]

In addition, many provisions of the DSA are vague.[36] The DSA refrains from drawing a clear line between legal and illegal content. Instead, it defines several liability exemptions, illustrating when an online intermediary service provider cannot be held liable regarding third-party content. Those liability exemptions are based on an intermediary's functions as merely transmitting,[37]

---

30. *See, e.g.,* Directive 2019/790, of the European Parliament and of the Council of 17 April 2019 on Copyright and Related Rights in the Digital Single Market, 2019 O.J. (L 130) 92 (focusing on copyright content); Regulation 2021/784, of the European Parliament and of the Council of 29 April 2021 on Addressing the Dissemination of Terrorist Content Online, 2021 O.J. (L 172) 79 (focusing on terrorist content); Directive 2018/1808, of the European Parliament and of the Council of 14 Nov. 2018 Amending Directive 2010/13, on the Coordination of Certain Provisions Laid Down by Law, Regulation, or Administrative Action of Member States Concerning the Provision of Audiovisual Media Services, 2018 O.J. (L 303) 69 (focusing on audiovisual content).

31. DSA, *supra* note 24, at art. 3(g) (defining a "intermediary service" as one of the following information society services: "(i) a 'mere conduit' service, consisting of the transmission in a communication network of information provided by a recipient of the service, or the provision of access to a communication network; (ii) a 'caching' service, consisting of the transmission in a communication network of information provided by a recipient of the service, involving the automatic, intermediate and temporary storage of that information, performed for the sole purpose of making more efficient the information's onward transmission to other recipients upon their request; (iii) a 'hosting' service, consisting of the storage of information provided by, and at the request of, a recipient of the service.").

32. DSA, *supra* note 24, at art. 2(1) ("This Regulation shall apply to intermediary services offered to recipients of the service that have their place of establishment or are located in the Union, irrespective of where the providers of those intermediary services have their place of establishment.").

33. DSA, *supra* note 24, art. 3(t) ("'[C]ontent moderation' means the activities, whether automated or not, undertaken by providers of intermediary services, that are aimed, in particular, at detecting, identifying and addressing illegal content or information incompatible with their terms and conditions, provided by recipients of the service, including measures taken that affect the availability, visibility, and accessibility of that illegal content or that information, such as demotion, demonetization, disabling of access to, or removal thereof, or that affect the ability of the recipients of the service to provide that information, such as the termination or suspension of a recipient's account.").

34. Martin Senftleben et al., *How the European Union Outsources the Task of Human Rights Protection to Platforms and Users: The Case of User-Generated Content Monetization*, 38 BERKELEY TECH. L.J. 933, 976-77 (2023); *See also* Daphne Keller, *Lawful but Awful? Control Over Legal Speech by Platforms, Governments, and Internet Users*, U. CHI. L. REV. BLOG (June 28, 2022), (explaining "lawful but awful" content in more detail).

35. DSA, *supra* note 24, at art. 3(t).

36. Martin Husovec, *Rising Above Liability: The Digital Services Act as a Blueprint for the Second Generation of Global Internet Rules*, 38 BERKELEY TECH. L.J. 884, 901 (2023) (noting that the DSA is the "mix of very specific procedural rules and vague aspirational regulatory expectations" and that "many expectations are purposely vague.").

37. DSA, *supra* note 24, at art. 4(1) ("Where an information society service is provided that consists of the transmission in a communication network of information provided by a recipient of the service, or the provision of access to a communication network, the service provider shall not be liable for the information transmitted or accessed, on condition that the provider: (a) does not initiate the transmission; (b) does not select the receiver of the transmission; and (c) does not select or modify the information contained in the transmission.").

caching,[38] and hosting.[39] This is an important aspect regarding content because the DSA has a tiered system of obligations: in addition to the general obligations that apply to all intermediary services, additional obligations are assigned to specific categories of intermediary services. For example, while all providers of intermediary services from outside the E.U. must designate a legal representative in one of the E.U. Member States,[40] only hosting services are required to put mechanisms in place to allow any individual or entity to notify them of the presence of information considered to be illegal on their services.[41]

The DSA's inclusion of internet infrastructure within its scope is another significant departure from earlier initiatives. Nevertheless, the devil is in the details. Those seeking evidence of sweeping shifts in the newly adopted E.U. approach will not find proof in any of the articles. But the evidence is in the recitals, and this does not necessarily diminish its significance. It is worth noting that the European Court of Justice often uses recitals to resolve ambiguity in related legislative provisions.[42]

The DSA's recitals acknowledge the growing complexity of the online ecosystem, noting that "new technologies have emerged that improve the availability, efficiency, speed, reliability,

---

38. DSA, *supra* note 24, at art. 5(1) ("Where an information society service is provided that consists of the transmission in a communication network of information provided by a recipient of the service, the service provider shall not be liable for the automatic, intermediate and temporary storage of that information, performed for the sole purpose of making more efficient or more secure the information's onward transmission to other recipients of the service upon their request, on condition that the provider: (a) does not modify the information; (b) complies with conditions on access to the information; (c) complies with rules regarding the updating of the information, specified in a manner widely recognised and used by industry; (d) does not interfere with the lawful use of technology, widely recognized and used by industry, to obtain data on the use of the information; and (e) acts expeditiously to remove or to disable access to the information it has stored upon obtaining actual knowledge of the fact that the information at the initial source of the transmission has been removed from the network, or access to it has been disabled, or that a judicial or an administrative authority has ordered such removal or disablement.").

39. DSA, *supra* note 24, at art. 6(1) ("Where an information society service is provided that consists of the storage of information provided by a recipient of the service, the service provider shall not be liable for the information stored at the request of a recipient of the service, on condition that the provider: (a) does not have actual knowledge of illegal activity or illegal content and, as regards claims for damages, is not aware of facts or circumstances from which the illegal activity or illegal content is apparent; or (b) upon obtaining such knowledge or awareness, acts expeditiously to remove or to disable access to the illegal content.").

40. DSA, *supra* note 24, at art. 13(1) ("Providers of intermediary services which do not have an establishment in the Union but which offer services in the Union shall designate, in writing, a legal or natural person to act as their legal representative in one of the Member States where the provider offers its services.").

41. DSA, *supra* note 24, at art. 16(1) ("Providers of hosting services shall put mechanisms in place to allow any individual or entity to notify them of the presence on their service of specific items of information that the individual or entity considers to be illegal content. Those mechanisms shall be easy to access and user-friendly and shall allow for the submission of notices exclusively by electronic means.").

42. *See e.g.*, *P. Moskof AE v. Ethnikos Organismos Kapnou*, Case C-244/95, 1997 E.C.R. I-6445 (responding to a question about whether a provision was transitory).

capacity and security" of internet services.[43] Such services establish and facilitate the proper functioning of the internet, including "domain name system (DNS) services, top-level domain name registries, [and] registrars."[44] This inclusion of the DNS marks a significant change, particularly when compared to recent E.U. regulations on content moderation that explicitly exclude "providers of domain name systems (DNS)" from their scope of application.[45] The impact of this policy shift is profound, underscoring the importance of these changes.

Notably, the DSA only mentions internet infrastructure services in the context of benefiting from the liability exemption rules. "[S]ervices establishing and facilitating the underlying logical architecture and proper functioning of the internet, including technical auxiliary functions,"[46] can benefit from the liability exemption rules "to the extent they constitute a mere 'conduit,' 'caching' or 'hosting' service," which should be assessed on a case-by-case basis.[47]

Although this approach seems simplistic, there still appears to be a large area of legal uncertainty. This approach does not account for the DNS's technical conditions, nor does it define the DNS and its components. Before considering the DSA's negative impact on the DNS ecosystem in Part 4, Part 3 will highlight the DNS's actual functions.

3. Functions of the DNS

DNS is a hierarchical system that plays a vital role in the internet ecosystem. It translates unique numerical IP addresses into unique alphabetical domain names, simplifying the process for end users to remember and enter these names into their connected devices.[48] Put differently, DNS facilitates the exchange of online content. It is also a critical component in email and online communication.[49] Any website, email, or internet communication on any device that connects to

---

43. DSA, *supra* note 24, at recital 28.

44. *See* Regulation 2021/784 of the European Parliament and of the Council of 29 April 2021 on Addressing the Dissemination of Terrorist Content Online [hereinafter TERREG].

45. *Id.*

46. DSA, *supra* note 24, at recital 28.

47. DSA, *supra* note 24, at recital 29.

48. *See Office Depot, Inc.*, 596 F.3d at 698.

49. *See e.g.,* Jennifer Mingus, *E-mail: A Constitutional (and Economical) Method of Transmitting Class Action Notice*, 47 CLEV. ST. L. REV. 87, 97 (1999) ("The domain, like a street address, tells the e-mail provider exactly which computer to deliver an e-mail message to.").

the web—from computers and phones to gaming systems and cars—typically relies on a domain name.[50]

Three key observations shed light on the DNS architecture. First, the DNS ecosystem is hierarchical. ICANN ensures the effective and coordinated management of this system. This makes ICANN a prime target for content monitoring by governments and censorship advocates.[51] Second, while DNS is a key facilitator of online communication and content exchange, it does not directly handle the flow of content.[52] Third, ICANN is almost exclusively a private entity.[53]

These observations are crucial in understanding DNS control over online activities. Because the DSA encompasses a large ecosystem of different actors that maintain the technical infrastructure, intermediaries' roles in addressing content moderation obligations depend on both the type of content and the technical services they provide. Therefore, understanding what DNS does and does not do becomes fundamental.

3.1. Technical overview of the DNS Hierarchical Functions

Understanding a domain name and its components is crucial for comprehending the DNS. Most domain names consist of three parts, each separated by a period, such as "http://www.google.com."[54] The hierarchy levels of a domain name are read from right to left.[55] Therefore, the first segment of a domain is the Top-Level Domain (TLD)

---

50. *See e.g., How DNS and Email Work Together,* CONSTELIX DNS (Nov. 15, 2021), .https://dnsmadeeasy.com/resources/the-interplay-between-dns-and-email-an-essential-guide-for-dns-professionals [https://perma.cc/X9PR-SNZA]

51. MILTON L. MUELLER, NETWORKS AND STATES: THE GLOBAL POLITICS OF INTERNET GOVERNANCE 197 (2010) ("More governments and censorship advocates have begun to think that blocking or 'filtering' techniques [using the DNS] could recreate the kind of control they once had over traditional territorial media."); *See also* Allen R. Grogan, *ICANN is Not the Internet Content Police,* ICANN (June 12, 2015), https://www.icann.org/en/blogs/details/icann-is-not-the-internet-content-police-12-6-2015-en [https://perma.cc/BL4S-SXQZ] (explaining how some members of the internet community advocated that ICANN should assume greater responsibility for policing online content).

52. *See* Nugent, *supra* note 8, at 55 (noting that "no content ever flows through the DNS itself, whether website, email, video, chat, or other content.").

53. *See e.g.,* Tobias Mahler, Generic top-level domains: A study of transnational private regulation 16-39 (2019) (explaining the diminishing influence of the US government over the DNS and ICANN's evolution to a global private regulatory regime outside traditional categories of domestic or international law).

54. *Office Depot, Inc.*, 596 F.3d at 698 ("The hierarchy of each domain name is divided by periods.").

55. *Id.*

(http://www.google.com), while the second part (http://www.google.com) is a Second-Level Domain (SLD).[56]

Additionally, DNS intermediaries, with their technical expertise, play a pivotal role in enabling internet communications. They are responsible for registering,[57] renewing,[58] and resolving domain names,[59] functions crucial for the smooth operation of the internet.

DNS is a multi-step process that begins with domain name registration. Registries and registrars are necessary for domain name registrations, and they have different but complementary tasks.

A domain name registry is an authoritative master database of the TLDs.[60] It typically has a technical role and "keep[s] the master database of all domain names registered in each top-level domain (TLD) and generate[s] the 'zone file' that allows computers to route internet traffic to and from TLDs anywhere in the world."[61]

Meanwhile, registrars provide domain name registration services to the public based on an accreditation agreement with the relevant registry.[62] Therefore, the registry serves as the "wholesaler," managing the master database of all domain names, while the registrar serves as the "retailer," providing domain name registration services to the public based on an accreditation agreement with the relevant registry.[63] In practice, registries such as Verisign[64] manage TLDs,

---

56. The acronym "www" compacts the initials of the "World Wide Web" and the acronym "http" means a transmission protocol based on "Hypertext Transfer Protocol" which allows the transfer of files that are part of the global network. Their significance is out of scope for this study.

57. *Registering Domain Names,* ICANN (2/13/2025), https://www.icann.org/resources/pages/register-domain-name-2017-06-20-en [https://perma.cc/K73Y-3UTS].

58. *About Renewing a Domain Name*, ICANN (2/13/2025) https://www.icann.org/resources/pages/how-2013-05-03-en [https://perma.cc/S7UH-329C].

59. Martin Pramatarov, *What is Domain Name Resolution*, CLOUDNS (Oct. 30, 2024), https://www.cloudns.net/blog/domain-name-resolution/ [https://perma.cc/9PDD-P5WM].

60. *See ICANN Acronyms and Terms*, ICANN, https://www.icann.org/en/icann-acronyms-and-terms?nav-letter=r&page=1 [https://perma.cc/Q57B-7HTC].

61. *See Welcome Registry Operators*, ICANN, https://www.icann.org/resources/pages/registries/registries-en [https://perma.cc/RC49-2NP5].

62. *See ICANN Acronyms and Terms*, ICANN, https://www.icann.org/en/icann-acronyms-and-terms/registrar-en [https://perma.cc/H8TC-TDN8].

63. *What is a domain name registrar*?, CLOUDFLARE, What is a domain name registrar? | Cloudflare ("A registrar is like a dealership for domain names, and the registry is like the manufacturer. The registrar facilitates the transactions and provides support services, while the registry is in charge of producing and delivering the goods.").

64. *See Who We Are*, VERISIGN (2025), https://www.verisign.com [https://perma.cc/Z5PQ-H3PH].

while registrars such as GoDaddy, [65] sell SLDs. As such, registrars generally do not host content and may be considered "mere conduit" intermediaries, according to the DSA. However, in practice, many registrars also provide hosting and other services.[66]

Notably, registries[67] and registrars[68] enter into an accreditation agreement with ICANN. Contracts between ICANN and registries for TLDs include the terms of the registries' contracts with domain name registrars. These registry-registrar agreements specify key terms of registrar-domain name registrant contracts.[69]

As for the content, ICANN decides permissible TLDs.[70] Some TLDs are industry-specific and help clearly define a site's purpose, such as ".app," often used by web developers and technology companies, or ".blog," popular among bloggers and content creators.[71]

Moreover, some scholars have noted "the initial grant of a domain name is usually content-based, if only because two applicants cannot have the same domain name."[72] However, once a domain name has been registered, the DNS should not refuse to resolve it because of the content appearing on a site or a chosen domain name.[73]

---

65. *See Domains,* GODADDY, https://www.godaddy.com/en-in/offers/godaddy [https://perma.cc/2BQQ-AKZ6].

66. *See, e.g.*, *Domains & Hosting*, IONOS, https://www.ionos.com/domains/domain-names?transaction_id=10254d606e14142ad3078d14c57108&itc=RP0VPYCQ-XIDLQ6-0Q1429E&ac=OM.US.USt02K418213T7073a&affiliate_id=6810&utm_source=Forbes+Marketplace+US&utm_medium=affiliate&utm_campaign=AFF-US-DOM-CTLD-6810-----&utm_content= [https://perma.cc/KV8T-X3VL]; *See also Web Hosting*, GODADDYINDIA, https://www.godaddy.com/en-in/hosting/web-hosting [https://perma.cc/W3JL-2RDY].

67. *See Generic Top-Level Domain (gTLD) Registry Agreements*, ICANN, https://www.icann.org/en/registry-agreements [https://perma.cc/X5LA-NPHV].

68. *See Registrar Accreditation Agreement (RAA) & Related Materials*, ICANN, https://www.icann.org/resources/pages/registrars/registrars-en [https://perma.cc/AV86-VZVZ].

69. *See Signposts in Cyberspace: The Domain Name System and Internet Navigation*, NAT'L RESEARCH COUNCIL OF NAT'L ACAD., at 136-38 (2005) (explaining the relationship between registries, registrars, registrants and the ICANN).

70. *See* A. Michael Froomkin, *Almost Free: An Analysis of ICANN's 'Affirmation of Commitments,'* 9 J. ON TELECOMM. & HIGH TECH. L. 187, 211 (2011) ("ICANN can make visible and usable--or nearly invisible and largely useless-TLDs such as .com or .ibm.").

71. *See*, *e.g.*, Jelena Laketić, *Trademarks on the Blockchain: NFT Domains and Collisions*, 30 MICH. TECH. L. REV. 1, 19 (2024) ("The general idea is that having all these different domains can help internet users communicate information about websites through their domain names more appropriately."). For the full list of TLDs, *see List of Top-Level Domains*, ICANN, https://www.icann.org/resources/pages/tlds-2012-02-25-en [https://perma.cc/BMC7-9PXN].

72. Balkin, *supra* note 4 at 2039.

73. *Id.*

3.2. No Content Flows Through DNS

Once users have registered domain names, they can communicate with each other. This communication, facilitated by the DNS infrastructure, is a multistep process.

In this process, the plain language web address (e.g., ebay.com or berkeley.edu) is translated into an IP by a recursive DNS server, retrieving the relevant information and then sending it back to the initial requester.[74] Importantly, DNS name servers that resolve DNS queries lack visibility into how the requesting computer uses the returned IP address, let alone the content provided by the host at that address.[75]

Therefore, the function of DNS infrastructure is not to provide content, but a letter-based format-to-IP address translation system to locate content. It operates in a non-intrusive manner, often called the "phonebook" of the internet, allowing people to quickly look up domains.[76]

Notably, courts in Europe have recognized these characteristics of the DNS before the adoption of the DSA. A Swedish District Court[77] and a Court of Appeal[78] ruled that the registry only has an administrative role and acts in the public interest and is thus not obligated to check the legality of website content.

Because of its technical characteristics neither registries, registrars, nor DNS resolvers can intervene in individual content on a website. Their only capability is to suspend a domain name.[79]

---

74. Moses Musinde, *How DNS Works?*, MEDIUM (Jan. 12, 2023), https://medium.com/@musinde/how-dns-works-95f2a510eb36 [https://perma.cc/35SV-FSEU].

75. *See*, *e.g.*, Jeremy Malcom et al., *Fighting Neo-Nazis and the Future of Free Expression*, ELEC. FRONTIER FOUND. (Aug. 17, 2017), https://www.eff.org/deeplinks/2017/08/fighting-neo-nazis-future-free-expression [https://perma.cc/89TP-SKT8] ("Domain name registrars have even less connection to speech than a conduit provider such as an ISP, as the contents of a website or service never touch the registrar's systems. Registrars' interests as speakers under the First Amendment are minimal.").

76. *See e.g.,* Mark Grabowski, *Should the U.S. Reclaim Control of the Internet? Evaluating ICANN's Administrative Oversight Since the 2016 Handover*, NEB. L. REV. BULL. Aug. 6, 2018 at 3 ("ICANN acts as the phonebook of the Internet by assigning and matching domain names with IP addresses."); Cf. Adam Thierer, *Soft Law in U.S. ICT Sectors: Four Case Studies*, 61 JURIMETRICS 79, 91 (2020) ("The DNS is often conceptualized as the internet's phonebook, but it is actually more sophisticated than that analogy suggests.").

77. *See* Tingsratt [TR] [Stockholm District Court] 2015-05-19 B 6463-13 (Swed.).

78. *See* Hovratt [HovR] [Svea Court of Appeal], 2016-05-12, B 5280-15 (Swed.).

79. *See generally Understanding Domain Name Suspension: Causes and Restoration Methods*, MEDIUM (Apr. 10, 2024), https://medium.com/@wewphosting/why-domains-get-suspended-and-how-to-restore-them-0bc2421d8a2e [https://perma.cc/H9K3-R6RN].

When a domain name is suspended, it means that when a user types it into her website browser, it will not resolve or bring the user to the website, essentially making the website invisible on the internet.[80] However, domain names should not be suspended, for example, based on allegations of political advocacy, nor should they target journalistic content. Such actions can easily lead to censorship of online content.

3.3. DNS is Private

Internet infrastructure, including the DNS, is primarily held in private hands. Since the US Department of Commerce relinquished its control over ICANN in 2016, allowing the transition to a global multi-stakeholder governance model, ICANN has become almost entirely private.[81] Even though ICANN is still U.S.-based, the private censorship alone does not raise constitutional concerns in the US, as the Supreme Court has consistently ruled that the First Amendment applies only to government actions.[82] The First Amendment, in this context, acts as a negative right, protecting private entities from undue interference by public authorities.[83]

However, the status of private entities in relation to freedom of expression is a significant area where the U.S. approach differs from E.U. standards. Unlike the U.S., the E.U. adopts a different approach to freedom of expression. In the E.U., positive obligations are responsibilities for states to proactively contribute to freedom of expression, instead of merely refraining from intervention.[84] In this context, the E.U.'s DSA presents a particularly concerning approach compared to the US system, potentially leading to unforeseen risks and challenges. To the extent that the DSA promotes

---

80. *Id.*

81. *See Stewardship of IANA Functions Transitions to Global Internet Community as Contract with U.S. Government Ends*, ICANN (Oct. 1, 2016), https://www.icann.org/en/announcements/details/stewardship-of-iana-functions-transitions-to-global-internet-community-as-contract-with-us-government-ends-1-10-2016-en [https://perma.cc/735T-7CR2]; *See also ICANN's Historical Relationship with the U.S. Government,* ICANN, https://www.icann.org/en/history/icann-usg [https://perma.cc/D624-9LLY].

82. *See* Christopher S. Yoo, *Free Speech and the Myth of the Internet as an Unintemediated Experience,* 78 GEO. WASH. L. REV. 697, 699 (2010) ("Under current law, the First Amendment only restricts the actions of state actors and does not restrict the actions of private actors."); *See also* ERWIN CHEMERINSKY, CONSTITUTIONAL LAW: PRINCIPLES AND POLICIES 569 (7th ed. 2023) ("The Constitution applies to government at all levels- federal, state and local- and to the actions of government officials at all levels. The Constitution, however, generally does not apply to private entities or actors.").

83. *See generally* David P. Currie, *Positive and Negative Constitutional Rights*, 53 U. CHI. L. REV. 864 (1986).

84. *See* Jelena Laketić, *Sterilized Speech: The U.S. Impacts of E.U. Digital Service Rules*, 73 CLEV. ST. L. REV. 1005, 1015 (2025).

content moderation within the infrastructure layer of the internet, states should play an active role in this process.

Some scholars already argued that governments could potentially coerce or co-opt private entities to aid in speech regulation and surveillance, thereby identifying speakers and sites that the government seeks to monitor, regulate, or shut down.[85]

Notably, the DSA framework draws on fundamental rights.[86] However, the DSA has its flaws. On the one hand, content moderation is defined broadly.[87] On the other hand, scholars have noted that many provisions are vague.[88] Moreover, there are 664 million internet domains worldwide.[89] To handle the enormous traffic, DNS intermediaries would have to develop automated techniques to perform determinations and classify content to make qualitative assessments, even when they are meant to be content agnostic. In other words, they would need to rely on algorithmic filtering tools.[90] Following this approach, DNS intermediaries would undertake extensive private enforcement via algorithmic structure and practices.

However, broad provisions and vagueness generally do not mix well with algorithmic use. Algorithmic bias is a pervasive and well-documented issue in content moderation.[91] Therefore,

---

85. *See* Balkin, *supra* note 15, at 2298 ("To the extent that the government does not own the infrastructure of free expression, it needs to coerce or co-opt private owners to assist in speech regulation and surveillance — to help the state identify speakers and sites that the government seeks to watch, regulate, or shut down.").

86. DSA, *supra* note 24, at recitals 3, 9, 22, 36, 39-42, 47, 51-54, 63, 154-156

87. *Id.* at 42-44 (art. 3 (t)) ("'[C]ontent moderation' means the activities, whether automated or not, undertaken by providers of intermediary services, that are aimed, in particular, at detecting, identifying and addressing illegal content or information incompatible with their terms and conditions, provided by recipients of the service, including measures taken that affect the availability, visibility, and accessibility of that illegal content or that information, such as demotion, demonetization, disabling of access to, or removal thereof, or that affect the ability of the recipients of the service to provide that information, such as the termination or suspension of a recipient's account.").

88. *See e.g.*, Husovec, *supra* note 36. *See also* Andrea Palumbo, *A Medley of Public and Private Power in DSA Content Moderation for Harmful but Legal Content: An Account of Transparency, Accountability and Redress Challenges,* 15 J. INTELL. PROP. INFRO. TECH. & ELEC. COM. L. 246, 250 (2024) (noting that the scope of application of some articles and some key terms are vague).

89. *How Many Domains Are There? Us & Worldwide (2025 Stats)*, HOSTINGADVICE.COM (Jan. 31, 2024), https://www.hostingadvice.com/how-to/how-many-domains-are-there [https://perma.cc/F4RC-PZSS].

90. *See* Kate Klonick, *supra* note 1 at 1636 ("The vast majority of [content]… moderation is an automatic process run largely through algorithmic screening without the active use of human decisionmaking.").

91. *See e.g.* Solon Barocas & Andrew Selbst, *Big Data's Disparate Impact*, 104 CALIF. L. REV. 671, 684 (2016) ("Even a dataset with individual records of consistently high quality can suffer from statistical biases that fail to represent different groups in accurate proportions."); Danielle Keats Citron & Frank Pasquale, The Scored Society: Due Process for Automated Predictions, 89 WASH. L. REV. 1, 4 (2014) ("Because human beings program predictive algorithms, their biases and values are embedded into the software's instructions. . . ."); Jon Kleinberg et al., *Discrimination in the Age of Algorithms*, 10 J. LEGAL ANALYSIS 1, 4 (2018) ("The reliance on data does not provide

content moderation at the DNS level can be disproportionate and affect access to content and services.

4. Problems with Infrastructure Content Moderation

As noted, intermediaries at the internet's core structure are much further away from content than their hosting and online platform counterparts. However, the technical ease with which domain name suspension can be accomplished is a significant factor that attracts those who support core infrastructural intermediaries to join the content moderation game.

Furthermore, ICANN's central control of the DNS has the potential to significantly restrict or enhance certain content. This is possible through the power to award or deprive TLD or regulate the performance of domain name registrants or registries, thereby influencing the internet's content landscape.

With its significant role in ensuring the stable and secure operation of the internet's addressing systems, ICANN has consistently resisted pressure to moderate legal content directly. However, even though it sits atop the DNS governance hierarchy, ICANN has not punished some registrars and registry operators for abstaining from moderating content, even when it includes offensive, but legal content.[92] This Part will explain that, more recently, there has been increasing momentum to regulate online content through the DNS, even within ICANN's multistakeholder governance frameworks. It is crucial to be mindful of the potential for misuse of power by private domain name actors. Because these entities have the ability to ban users from the internet based on the expressive content of their websites, they could inadvertently create tools of censorship.[93] These tools could

---

algorithms a presumption of truth; the data they are fed can be biased, perhaps because they are rooted in past discrimination…"). *See also* Joy Buolamwini & Timnit Gebru, *Gender Shades: Intersectional Accuracy Disparities in Commercial Gender Classification*, 81 PROC. MACH. LEARNING RSCH. 1, 6–11 (2018).

92. *See generally* Bridy, *supra* note 8 (explaining the content moderation enforcement program between the Motion Picture Association of America (MPAA) and two registry operators, Seattle-based Donuts and Abu Dhabi-based Radix). *See also* Nugent, *supra* note 8, at 73 (noting that many registrars included so-called "morality clauses" in their acceptable use policies prohibiting registrars from engaging in certain content and explaining how some of those restrictions are not defined and lack standards).

93. Manel Medina, *Governmental Censorship of the Internet: Spanish vs. Catalans Case Study*, 68 LIBRARY TRENDS 561, 568 (2020) ("[T]he Catalan government denounced the abuses and censorship in relation to Internet access committed by Spanish authorities, with the seizing or blocking of more than two hundred web pages related to the self-determination referendum on Catalonia.").

be exploited to suppress other viewpoints or causes, such as political dissent, social activism, or minority rights advocacy.[94]

Moreover, given the speed and scale of online content, and the number of registered domain names, content moderation would become a burdensome and costly task. Therefore, it is beneficial for the E.U. to transfer the substantial costs of online content moderation to online intermediaries.[95] Its tiered system of obligations emphasizes that risk should be allocated to the actor who is considered best suited to avoid it.[96] From the E.U. perspective, ICANN could reduce these costs because it plays crucial role in allocating IP address space to registries, assigning protocol identifiers, and managing global TLD systems. This transition represents what Balkin called "complicated forms of public/private cooperation"[97] and marks a notable shift in intermediary regulation from liability to responsibility. Both phenomena bring significant, negative consequences, which are detailed in the following sections.

4.1. States Coopting DNS Within Multistakeholder Community

ICANN's central control of the DNS, if not carefully managed, could lead to the misuse of this sophisticated ecosystem for content regulation. ICANN's bylaws serve as a crucial check on its contracting power. The bylaws expressly state that "ICANN shall not regulate (i.e., impose rules and restrictions on) services that use the Internet's unique identifiers or the content that such services carry or provide…"[98] This provision is a key safeguard against the potential misuse of the DNS in content moderation.

Despite this restriction, it would be a fallacy to say DNS intermediaries have not stepped in on content moderation. The truth is that several existing registry contracts have already started to regulate content.[99] Recently, scholars warned about DNS intermediaries moderating copyright

---

94. *See* Froomkin, *supra* note 70 at 211 ("…ICANN can make visible and usable—or nearly invisible and largely useless—TLDs such as .com or. ibm.").

95. See e.g., Tarleton Gillespie, *Platforms are Not Intermediaries*, 2 GEO. L. TECH. REV. 198, 198 (2018) ("Content moderation is such a complex and laborious undertaking, it is amazing that it works at all…").

96. *See* DSA, *supra* note 24 at 44-45, 48, 50-51 (art. 4(1), 5(1), 6(1), 11, 16.

97. Balkin, *supra* note 15, at 2306.

98. *See* Article 1, §1.1(c), ICANN, https://www.icann.org/resources/pages/governance/bylaws-en/#article1 [https://perma.cc/88PV-HDTL] (bylaws as amended Nov. 17, 2023).

99. *See e.g.*, Nugent *supra* note 8 at 73-80 (explaining how certain DNS intermediaries restricted some legal content).

content,[100] offensive content, and hate speech.[101] Some DNS intermediaries have also developed cooperation agreements to implement "trusted notifiers" systems for the purpose of reporting abusive content.[102]

While commentators have vehemently criticized this "private censorship,"[103] the question remains of how this has been made possible. Especially considering ICANN's limited mission focused on the DNS's functionality and its commitment to not using the DNS to regulate content, the existence of private censorship is concerning.[104] The answer to this puzzle lies in the significant influence of national governments within ICANN a factor that often goes unnoticed but plays a crucial role in shaping the organization's decisions.

4.1.1. Registry Voluntary Commitments

ICANN's complex bureaucracy consists of advisory committees, supporting organizations, working groups, review teams, and task forces.[105] Therefore, the policy specifications come from the multistakeholder community in a process representing a broad set of stakeholders.

Recognizing that restricted use of TLD space was detrimental to entities' ability to create digital identities and "paving the way for an expansion of domain name choice and opportunity," ICANN's Board occasionally expands the number of TLDs.[106] In 2012, during a round of TLD additions, Public Interest Commitments (PICs) emerged now called "Registry Voluntary

---

100. *See* Bridy, *supra* note 8 at 1347 ("Although ICANN has continued to resist direct involvement in copyright enforcement activities, it accommodated right holders in 2013 by altering its contracts with DNS intermediaries to support a system of extra-judicial, notice-driven sanctions.").

101. *See* Nugent, *supra* note 8 at 45-47.

102. *See* Bridy*, supra* note 8, at 1371-73.

103. Corynne McSherry et al., *Private Censorship Is Not the Best Way to Fight Hate or Defend Democracy: Here Are Some Better Ideas*, ELECTRONIC FRONTIER FOUNDATION (Jan. 30, 2018), https://www.eff.org/es/deeplinks/2018/01/private-censorship-not-best-way-fight-hate-or-defend-democracy-here-are-some [https://perma.cc/9KGX-VFMH]; *See also* Mitch Stoltz, *MPAA May Like Donuts, but They Shouldn't Be the (Copyright) Police*, ELECTRONIC FRONTIER FOUNDATION (Feb. 10, 2016), https://www.eff.org/deeplinks/2016/02/mpaa-may-donuts-they-shouldnt-be-copyright-police [https://perma.cc/DM27-TGVQ] ("Taking away a website's domain name means interrupting all of the speech that takes place on that site. It creates a much greater danger of censorship than suppressing individual pages or files.").

104. *See* Article 1, §1.1(c) *supra* note 98.

105. *See* Emily M. Weitzenboeck, *Hybrid Net: The regulatory framework of ICANN and the DNS*, 22 INT'L J. L. & INFO. TECH. 49, 50 (2014) (discussing ICANN's complex structure).

106. *See Biggest Expansion in gTLDs Approved for Implementation*, ICANN (June 26, 2008), https://www.icann.org/en/announcements/details/biggest-expansion-in-gtlds-approved-for-implementation-26-6-2008-en [https://perma.cc/66XV-JEGZ].

Commitments."[107] Developed to appease ICANN's Governmental Advisory Committee (GAC), which represents the voice of national governments,[108] these require the registry operator to abide by the commitments it made in its application and may also include specific commitments tailored to the TLDs. The problem is that these are not just registry policies of a technical nature.

As Milton Mueller argued, Registry Voluntary Commitments are complex and diverse because they could be about anything.[109]

> A registry hoping to avoid objections from religious conservatives could promise to banish all blasphemy. A registry hoping to enter the China market could tack on a commitment never to allow any websites that mention the June 4 Tiananmen Square incident, or never allow any reference to the Hong Kong protests. A registry seeking to avoid objections from [the] intellectual property lobby could promise to give copyright owners special powers to monitor or take down domains.[110]

Likewise, the more open DNS intermediaries are to moderating certain content, the more categories of content intermediaries will be under pressure to moderate.[111] In this context, the platforms' experience may serve as a warning. It is documented that once the platforms began voluntarily cooperating with E.U. regulators to remove terrorist propaganda, the scope of prohibited material expanded to other categories including "expression that does not violate existing European law."[112]

---

107. *Public Interest Background*, ICANN, https://atlarge.icann.org/topics/public-interest/background [https://perma.cc/UAN5-XKDD] (last visited March 26, 2025). *See also Public Interest Commitments, Registry Voluntary Commitments, and Community Registration Policies*, ICANN, 2 n. 3 https://itp.cdn.icann.org/en/files/policy-development/topic-9-rvcs-pics-14-02-2025-en.pdf [https://perma.cc/62J2-FB7G] ("In the Registry Agreements between ICANN and existing registry operators from the 2012 round of the New gTLD Program, the terms "Registry Voluntary Commitments" and "RVCs" did not exist and instead, the term "specific public interest commitments" was used (the terms "voluntary PICs" and "private PICs" were also used informally in the past).").

108. *ICANN Governmental Advisory Committee (GAC)*, ICANN, https://gac.icann.org [https://perma.cc/6XWH-ZH8P] (last visited March 24, 2025).

109. *See* Milton Mueller, *The Big Question Facing ICANN's Contractual Governance Regime,* INTERNET GOVERNANCE PROJECT (June 15, 2023), https://www.internetgovernance.org/2023/06/15/the-big-question-facing-icanns-contractual-governance-regime [https://perma.cc/6CYS-JZPL].

110. *Id.*

111. *See* Bridy, *supra* note 8, at 1361.

112. Danielle Keats Citron, *Extremist Speech, Compelled Conformity, and Censorship Creep*, 93 NOTRE DAME L. REV. 1035, 1039 (2018); *see also* Balkin, *supra* note 4, at 2040 ("Once the telecommunications system, the DNS system, and the system of electronic payments begin blocking, censoring, or discriminating against certain speakers, nation-states will attempt to piggyback on their technical capabilities. As we have seen, state pressure on infrastructure owners to surveil, block, and filter content creates predictable problems of collateral censorship and privatized prior restraint.").

Moreover, the effort to regulate content through the DNS is not only gaining momentum but also becoming increasingly organized. The ICANN's Governmental Advisory Committee (GAC) openly supports increased contract obligations to moderate content.[113] GAC even goes a step further aiming to make Registry Voluntary Commitments a contractual obligation by incorporating them into the registry contract and having them enforced by the ICANN.[114]

Through utilizing a sophisticated contractual structure in which the registries commit voluntarily to running their registration policies in a certain way and simultaneously contracting with ICANN to run the registry in a certain way, the GAC argues that ICANN will not be involved in content moderation.

However, considering ICANN's responsibilities to act in the public interest, this argument carries a notable weight. In GAC's words, it "does not amount to ICANN regulating content, merely enforcing an undertaking of specific, objective and measurable processes and procedures, that a registry operator has promised to implement specifically to enforce their RVC."[115] Instead, supported by the SubPro PDP Working Group,[116] GAC suggested an independent third party monitor and evaluate the registry operator's compliance with a commitment to limit permissible content in SLD registrations.[117]

---

113. GOVERNMENTAL ADVISORY COMMITTEE, GAC COMMUNIQUÉ – WASHINGTON D.C., UNITED STATES OF AMERICA (2023), https://gac.icann.org/advice/communiques/icann77-washington-d-c-communique-zh.pdf [https://perma.cc/37YR-B7RP].

114. ICANN BUSINESS CONSTITUENCY, COMMUNITY CONSULTATION ON PICS/RVCS BOARD STATEMENT, (Feb. 23, 2024), https://cbu.memberclicks.net/assets/docs/positions-statements/2024/2024_02February_23_BC%20response%20to%20Board%20questions%20on%20RVCs%20and%20PICs.pdf [https://perma.cc/BK3A-HZVN]. .

115. *Id.* at 6.

116. *Id.* at 8.

117. ICANN | GNSO, FINAL REPORT ON THE NEW GTLD SUBSEQUENT PROCEDURES POLICY DEVELOPMENT PROCESS, 49–50 (Feb. 1, 2021), https://gnso.icann.org/sites/default/files/file/field-file-attach/final-report-newgtld-subsequent-procedures-pdp-02feb21-en.pdf#page=38 [https://perma.cc/V4WD-QEXW] ("To the extent that some registries will want to make voluntary commitments in response to public comments, Government Early Warnings, GAC Advice, etc., it is understood by the Working Group that having these commitments reflected in Registry Agreements even if they fall outside of ICANN's core mission is consistent with the Bylaws where neither ICANN itself nor any third party under ICANN's control is required to pass judgment on 'content'. In such cases, it is understood that using an independent third party as an arbiter to determine whether there has been a violation of the commitment would be consistent with ICANN's mission even if ICANN were ultimately required to rely on that third-party decision to enforce a pre-arranged contractual remedy, which could include sanctions and/or termination of the Registry Agreement.").

The crux is that the GAC initiative would transform ICANN into an enforcer of policies designed to regulate internet content and services. But, ICANN can enforce its contracts only if they are consistent with its mission limitations, and content moderation is certainly inconsistent with its bylaws.

4.1.2. ICANN's 80th meeting

In the above explained scenario, the registry operator would agree to remedy violations of content-restrictive commitments identified by the third-party monitor. ICANN would retain enforcement rights concerning the registry operator's failure to comply with the third party's directions. Therefore, if GAC or other influential players condition approval of domains on registries' promises to regulate the content of the domains, ICANN would have to enforce those commitments.

In the face of this challenge, the ICANN Board decided that its bylaws do not allow it to enforce contractual commitments involving content moderation.[118] The Board noted that even though Section 1.1(d)(v) provides for ICANN's "ability to enter into and enforce agreements," it does not shield it "from needing to critically evaluate the substance and impact of those agreements to ensure that the obligations contained in such agreements are reasonably necessary to enable ICANN to pursue its Mission of ensuring the stable and secure operation of the Internet's unique identifier systems." [119]

Moreover, regarding the proposed independent third-party monitor scenario, the Board noted that "the third party would serve as a finder of fact regarding the existence of a breach, but ultimately it would be ICANN – and not the third party – that would take enforcement action based on the registry operator's failure to remedy the violation…"[120]

With this decision, ICANN reinforced its role in internet infrastructure while protecting users' fundamental rights to freely express themselves. If ICANN were to enforce the commitments using

118. *See* ICANN, *Approved Resolutions | Regular Meeting of the ICANN Board*, (June 8, 2024), https://www.icann.org/en/board-activities-and-meetings/materials/approved-resolutions-regular-meeting-of-the-icann-board-08-06-2024-en [https://perma.cc/2LX2-UU5P].

119. *Id.*

120. *Id.*

its contractual compliance regime, it would be fully responsible for content moderation in circumvention of its bylaws. Such a large task could pose significant challenges leading to potential conflicts with its core mission.

4.2. DSA co-opting DNS

ICANN's Board made a significant decision in defending against internal government structures attempting to co-opt DNS for online content moderation. However, the potential impact of the DSA on DNS moderation remains the central concern. DNS service providers must be able to provide their services without excessive liability regimes, ensuring the public does not suffer from the chilling effects caused by uncertain policies. Yet, the DSA is lacking in several respects. It is not sufficiently specific and is potentially overbroad, not reflecting the technical functioning of the DNS and thus, opening the way to legal uncertainty and differing legal interpretations.

For instance, DSA is not specific regarding its scope of applicability to "[DNS] services, top-level domain name registries [and] registrars…"[121] In fact, it only mentions them but does not define them. This raises several questions as the DSA could potentially apply to ICANN's operations and other actors in the DNS ecosystem.

As previously noted, the DSA only mentions internet infrastructure services in the context of benefiting from the liability exemption rules.[122] Recital 28 says that DNS services should be included in the DSA's scope of application but only to the extent that they qualify as "intermediary services" defined in Article 3 (g).[123] However, no further clarification is given that could help classify DNS services within the intermediary services categories.

---

121. DSA, *supra* note 24, at recital 28.
122. DSA, *supra* note 24, at recitals 28, 29.
123. *See* DSA, *supra* note 24, at art. 3(g) (explaining that intermediary service "means one of the following information society services:

(i)a 'mere conduit' service, consisting of the transmission in a communication network of information provided by a recipient of the service, or the provision of access to a communication network;
(ii) a 'caching' service, consisting of the transmission in a communication network of information provided by a recipient of the service, involving the automatic, intermediate and temporary storage of that information, performed for the sole purpose of making more efficient the information's onward transmission to other recipients upon their request;
(iii) a 'hosting' service, consisting of the storage of information provided by, and at the request of, a recipient of the service.").

Moreover, the recital adds another layer of confusion and is further diluted because it indicates that services are only included "as the case may be."[124] Therefore, the DSA lacks clarification that could help classify DNS services within existing categories of intermediary services. This indicates that a thorough assessment of applicability for each DNS service is required.

Indeed, the DSA itself recognizes that its technical functionalities may evolve, and what constitutes a mere conduit service, a caching service, or a hosting service must be assessed on a case-by-case basis.[125] The need for clear and unambiguous regulation is crucial.

Likewise, it is not clear whether the DSA would exempt a registry or registrar from liability for the contents transmitted by a third party. If this were the case, the scenario would become even more complicated. As I have discussed in greater depth in another article, in the E.U., there is an important interplay between the DSA horizontal framework and sector-specific legislation.[126] The E.U. recently adopted several sectoral rules–the Directive on Copyright in a Digital Single Market (CDSM Directive),[127] the Audiovisual Media Services Directive (AVDM),[128] and the Terrorism Online Content Regulation (TERREG).[129] Therefore, intermediaries are expected to analyze multiple pieces of legislation to assess the legality of the content ranging from copyright and audiovisual to potential terrorism content. The lack of clarity in the DSA could lead to misinterpretations and potential issues in its application.

Furthermore, as already noted, the DNS ecosystem is complex. DNS can be seen as an address book of the internet consisting of a unique set of names through which domain name resolvers can direct users to the appropriate content online. However, the DNS ecosystem is not straightforward, it consists of various components, including domain name registries and registrars. Domain name

---

124. DSA, *supra* note 24, at recital 28.

125. DSA, *supra* note 24, at recital 29.

126. *See* Laketić*, supra* note 84, at 1020-1023.

127. *See generally* Directive 2019/790, of the European Parliament and of the Council 17 April 2019 on Copyright and Related Rights in the Digital Single Market and Amending Directives 96/9/EC and 2001/29/EC O.J (L 130) 92 [hereinafter CDSM].

128. *See generally* Directive 2018/1808, of the European Parliament and of the Council of 14 November 2018 Amending Directive 2010/13/EU on the coordination of certain provisions laid down by law, regulation or administrative action in Member States concerning the provision of Audiovisual media services [hereinafter AVDSM].

129. *See generally* Commission Regulation 2021/784 of the European Parliament and of the Council of 29 April 2021 on Addressing The Dissemination of Terrorist Content Online, 2021 O.J. (L. 172), 79 [hereinafter TERREG].

registrars act as intermediaries between the registrants—those who wish to secure a domain name—and the registries that maintain the databases of these domain names.

It is unclear whether domain name registrars, who play a crucial role in passing DNS requests from DNS registrants to the registries, should be considered mere conduit services under the DSA.

Similarly, a domain name registration involving both registries and registrars entails minimal information storage, which could be relevant to Article 6 on hosting activities. [130]

As if these aspects were not complex enough, this scenario could be further complicated. For example, to benefit from the liability exemptions, the service in question must be considered one of the intermediation services and an information society service.[131] An information society service is "any service normally provided for remuneration, at a distance, by electronic means and at the individual request of a recipient."[132] But the remuneration criterion introduces a layer of complexity. For instance, users paying registration and renewal fees for domain name services satisfy this criterion. However, not all DNS actors, such as server operators who do not charge for DNS queries, accept remuneration. Their lack of renumeration may exclude them from the definition of information society services, thereby limiting their access to liability exemptions.

Finally, the DSA, with its broad application, presents a complex terrain regarding its territorial applicability.[133] Content can be on one or more servers in the same country as the content provider and the content user. However, the provider and the user consuming the content may just as easily be in different jurisdictions, highlighting the global nature of the issue. Moreover, the content itself might be hosted in yet another geographical region with its own laws. This complexity underscores the critical need for a comprehensive legal solution to address the challenging issues of internet

---

130. *See* DSA, *supra* note 24, at art. 6(1). ("Where an information society service is provided that consists of the storage of information provided by a recipient of the service, the service provider shall not be liable for the information stored at the request of a recipient of the service, on condition that the provider:

(a) does not have actual knowledge of illegal activity or illegal content and, as regards claims for damages, is not aware of facts or circumstances from which the illegal activity or illegal content is apparent; or

(b) upon obtaining such knowledge or awareness, acts expeditiously to remove or to disable access to the illegal content.").

131. *See* DSA, *supra* note 24, at art. 4-6.

132. *See* DSA, *supra* note 24, at recital 5.

133. *See* DSA, *supra* note 24, at art. 2.

jurisdiction and extraterritoriality. ICANN, with its narrow technical mandate, is not equipped to resolve these issues.

4.3. Why DNS Should Not Engage In Content Moderation

Whether the push for content moderation stems from the internal dynamics of DNS governance or from external regulation, the push carries negative consequences. Balkin's argument, while not explicitly focused on the DNS system but on the broader internet infrastructure, highlights three key reasons why the internet infrastructure should steer clear of content moderation.[134] These reasons include a nontransparent and severe lack of due process, the potential harm to content that deserves protection, and the significance of these services for unpopular speakers, which emphasizes the potential impact of DNS content moderation on freedom of expression.[135]

Due process may be hindered by DNS involvement in content moderation. For example, Birdy believes that "privately administered blocking of entire Internet domains raises serious issues relating to transparency, fair process, and freedom of expression."[136]

Moreover, the technical aspects of how DNS works must be considered for a comprehensive understanding of the topic and these concerns. The DNS ecosystem is too remote from content to argue that it should play any role in policing online content.[137] We do not expect telephone companies to disrupt service based solely on their suspicion that a subscriber is engaged in illegal activity, or states to close roads on which trucks carry contraband.[138]

Because DNS intermediaries do not know about any illegal content, they would need to investigate how domain names are used. Likewise, because DNS intermediaries do not have control over the content, they can only suspend or cancel a domain name.

134. *See* Balkin, *supra* note 4, at 2038-39.

135. *Id.*

136. Bridy, *supra* note 8, at 1378. *See also* Nugent, *supra* note 8, at 68 ("[A]s private actors, registrars are not well-positioned to determine the legality of registrants' behavior.").

137. DeNardis, s*upra* note 14, at 619 (citing Nadel v. N.Y. Tel. Co., 170 N.Y.S.2d 95, 96–98 (N.Y. Sup. Ct. 1957)). *See also* MUELLER, *supra* note 51, at 201 ("A true 'technical coordinator' role implies that ICANN would be indifferent to any social goals other than its fundamental one of maintaining the global uniqueness of domain names and hence the interoperability, stability, and security of the domain name and addressing systems. This implies neutrality with respect to social outcomes unrelated to that basic mission.").

138. Nicholas J. Nugent, *The Five Internet Rights*, 98 WASH. L. REV. 527, 619 (2023).

However, the suspension of domain names presents a significant potential for collateral censorship, lacking transparency, notice, and due process.[139] Domain names play a crucial role in free expression and dissent, both internally through the website's content and externally through the diverse "suck sites" on the web (e.g., www.starbucked.com and donaldtrump.sucks). But there is a high risk to silencing political dissent and minority views.

There are also significant proportionality issues concerning the measures DNS actors can employ to moderate content. Unlike intermediaries that moderate individual profiles, DNS targets would not always be individual files or URLs but entire domains. Therefore, the precision of domain related measures is low and the risk of content over blocking is high. For example, suspension could affect all content to which a domain name points, which could be extremely broad. In one instance, the FBI shut down 84000 domain names while the target was just ten.[140]

Domain name intermediaries possess the capability to implement filtering technologies aimed at blocking access to websites linked to illegal activities. However, reliance on such filtering methods often leads to an excessively broad application. In practice, these filtering techniques frequently block all websites on an IP address. Implementing this method results in blocking a significant number of sites unrelated to the alleged wrongdoing.[141] This broad approach can lead to considerable disruption, adversely impacting legitimate users and services that play no part in the misconduct being addressed.

DNS content moderation becomes more complex when it comes to lawful but awful content.[142] In this scenario, what is tolerable or not permitted depends on context. Therefore, it is not an easy task for moderators. For instance, a moderator's viewing might be brief, leading to a potential error in their assessment. Furthermore, the moderator might not even be aware of the illicit content, as they might have been checking domain names for different purposes. Commentators have

---

139. *See* Balkin, *supra* note 4, at 2039.

140. Bridy, *supra* note 8, at 1378.

141. *See e.g.*, Derek E. Bambauer, *Cybersieves*, 59 DUKE L.J. 377, 397 (2009) ("Most, if not all, Internet filtering systems will be overbroad (blocking innocent content), underbroad (failing to block proscribed material), or both."). *See also* Ctr. for Democracy & Tech. v. Pappert, 337 F. Supp. 2d 606, 651 (E.D. Pa. 2004) (explaining how Verizon blocked hundreds of thousands of websites unrelated to the targeted child pornography when it used DNS filtering to block access to a sub-page of the Terra.es website. Some of the websites blocked never contained any child pornography, like a Spanish website for geological surveys).

142. *See e.g.*, Nugent, *supra* note 8, at 72 ("Where DNS governance becomes harder to justify is where DNS intermediaries seek to regulate legal content or conduct based solely on moral grounds.").

expressed concern about the insufficient due process protections often accompanying domain name suspensions.[143] Even if the moderator does her job properly, the sheer scale of domain names available for checking is enormous, underscoring the impracticality of the current system. As noted, algorithmic tools are not especially helpful, since algorithmic biases are pervasive and well documented.[144]

Finally, the effectiveness of content suspension via the DNS infrastructure must be considered. While DNS suspending means that most users will no longer get a valid IP address when looking up the domain name, it does not eliminate the content from the internet, it just removes the signpost.[145] When an internet user types a domain name into her website browser, it will not resolve to the website. Average internet users may not know they can circumvent this pitfall, but more sophisticated users will still know how to access the content.[146] This situation stresses the complexity and the challenges DNS ecosystems face because providers of illegal content can anticipate the suspension of domain names and take precautionary measures. For instance, they can register multiple domain names under different TLDs in different jurisdictions and let them resolve to the same IP address.[147] They might also use hyperlinks directly linking to the IP address, bypassing the DNS.[148] As a result, the efforts aimed at DNS moderation are disproportionate and not particularly effective.

5. Conclusion

Infrastructure and DNS play crucial roles in the functioning of the internet. ICANN, the steward of the DNS ecosystem, has withstood years of pressure to moderate content from within its multi-stakeholder community. Recently, its Board made a wise decision to uphold the integrity

---

143. *See e.g.*, Bridy, *supra* note 8, at 1385 ("Lack of transparency and due process in such programs will make them inherently vulnerable to inconsistency, mistake, and abuse and could transform the DNS into a potent tool for suppressing disfavored speech.").

144. *See generally* Barocas & Selbst, *supra* note 91; Kleinberg, *supra* note 91; Melany Amarikwa, *Social Media Platforms' Reckoning: The Harmful Impact of TikTok's Algorithm on People of Colo*r, 29 RICH. J. L. & TECH. 69 (2023).

145. *See e.g.*, Nugent, *supra* note 8, at 105 ("Unlike domain names, however, IP addresses, once procured, can be held perpetually. Address block holders need not renew their IP addresses or pay ongoing fees in order to maintain their blocks.").

146. Bridy, *supra* note 8, at 1381.

147. *See* COUNCIL OF EUROPEAN NATIONAL TOP-LEVEL DOMAINS, DOMAIN NAME REGISTRIES AND ONLINE CONTENT, 15 (2022).

148. *Id.*

of the internet by refusing to enforce registry voluntary commitments that involve content restrictions, providing reassurance about the direction of internet governance.

On the other hand, the E.U.'s DSA represents the world's most ambitious attempt to address illegal online content. Notably, it is the first regulation to implicate the steward of the internet's essential technical functions for content moderation. Vague and full of ambiguity, the DSA may be seeking content moderation methods where they are difficult to achieve, opening the way to inconsistency and mistakes. It could transform DNS into a potent tool for suppressing the speech of some internet users, including political dissent and minority views.

Bibliography

I. Table of Cases

United States Supreme Court

Board of Trustees of the State University of New York v. Fox, 492 U.S. 469 (1989).

Brown v. Entertainment Merchants Ass'n, 564 U.S. 786 (2011).

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

Delaware & Hudson Canal Co. v. Clark, 80 U.S. 311 (1871).

Hurley v. Irish-Am. Gay, Lesbian & Bisexual Grp., 515 U.S. 557 (1995).

Jack Daniel's Properties, Inc. v. VIP Products LLC, 599 U.S. 140 (2023).

Lugar v. Edmondson Oil Co., 457 U.S. 922 (1982).

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

New York Times Co. v. Sullivan, 376 U.S. 254 (1964).

Prestonettes, Inc. v. Coty, 264 U.S. 359 (1924).

Qualitex Co. v. Jacobsen Prods. Co., 514 U.S. 159 (1995).

Riley v. National Federation of the Blind, 487 U.S. 781 (1988).

United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90 (1918).

Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205 (2000).

United States Courts of Appeals and District Courts

Academy of Motion Picture Arts & Sciences v. Network Solutions Inc., 989 F. Supp. 1276 (C.D. Cal. 1997).

Arnold v. Treadwell, 642 F. Supp. 2d 723 (E.D. Mich. 2009).

Beanstalk Group v. AM General Corp., 283 F.3d 856 (7th Cir. 2002).

Black Dog Tavern Co. v. Hall, 823 F. Supp. 48 (D. Mass. 1993).

Bosley Medical Institute v. Kremer, 403 F.3d 672 (9th Cir. 2005).

Bronner v. Duggan, 249 F. Supp. 3d 27 (D.D.C. 2017).

Brown v. Electronic Arts, Inc., 724 F.3d 1235 (9th Cir. 2013).

Center for Democracy & Technology v. Pappert, 337 F. Supp. 2d 606 (E.D. Pa. 2004).

Clorox Co. v. Sterling Winthrop, Inc., 117 F.3d 50 (2d Cir. 1997).

E. & J. Gallo Winery v. Gallo Cattle Co., 967 F.2d 1280 (9th Cir. 1992).

E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095 (9th Cir. 2008).

ETW Corp. v. Jireh Publishing, Inc., 332 F.3d 915 (6th Cir. 2003).

Elvis Presley Enterprises, Inc. v. Capece, 141 F.3d 188 (5th Cir. 1998).

Ferrari S.P.A. Esercizio v. Roberts, 944 F.2d 1235 (6th Cir. 1991).

G. & C. Merriam Co. v. Saalfield, 198 F. 369 (6th Cir. 1912).

Gordon v. Drape Creative, Inc., 909 F.3d 257 (9th Cir. 2018).

Hormel Foods Corp. v. Jim Henson Productions, Inc., 73 F.3d 497 (2d Cir. 1996).

Jordache Enterprises, Inc. v. Hogg Wyld, Ltd., 828 F.2d 1482 (10th Cir. 1987).

L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26 (1st Cir. 1987).

Lamparello v. Falwell, 420 F.3d 309 (4th Cir. 2005).

Lever Bros. Co. v. Am. Bakeries Co., 693 F.2d 251 (2d Cir. 1982).

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

Louis Vuitton Malletier, S.A. v. My Other Bag, Inc., 156 F. Supp. 3d 425 (S.D.N.Y. 2016).

Marshak v. Green, 746 F.2d 927 (2d Cir. 1984).

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

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

Mutual of Omaha Ins. Co. v. Novak, 836 F.2d 397 (8th Cir. 1987).

Nabisco, Inc. v. PF Brands, Inc., 191 F.3d 208 (2d Cir. 1999).

Office Depot, Inc. v. Zuccarini, 596 F.3d 696 (9th Cir. 2010).

Parks v. LaFace Records, 329 F.3d 437 (6th Cir. 2003).

PETA v. Doughney, 263 F.3d 359 (4th Cir. 2001).

Seale v. Gramercy Pictures, 949 F. Supp. 331 (E.D. Pa. 1996).

Smith v. Wal-Mart Stores, Inc., 537 F. Supp. 2d 1302 (N.D. Ga. 2008).

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

Twentieth Century Fox Television v. Empire Distribution, Inc., 875 F.3d 1192 (9th Cir. 2017).

Ty Inc. v. Perryman, 306 F.3d 509 (7th Cir. 2002).

University of Alabama Board of Trustees v. New Life Art, Inc., 683 F.3d 1266 (11th Cir. 2012).

VIP Prods. LLC v. Jack Daniel's Props., Inc., 953 F.3d 1170 (9th Cir. 2020).

Westchester Media v. PRL USA Holdings, Inc., 214 F.3d 658 (5th Cir. 2000).

European and International Jurisprudence

Eva Glawischnig-Pieszek v. Facebook Ireland Limited, Case C-18/18, ECLI:EU:C:2019:821 (2019).

Fuentes Bobo v. Spain, App. No. 39293/98 (Eur. Ct. H.R. 2000).

Landgericht Elberfeld (Odol Case), 25 Jurigtiche Wochemschrift 502 (Germany 1924).

P. Moskof AE v. Ethnikos Organismos Kapnou, Case C-244/95, 1997 E.C.R. I-6445 (1997).

Palomo Sanchez v. Spain, App. Nos. 28955/06 et al. (Eur. Ct. H.R. 2011).

Poland v. Parliament & Council, Case C-401/19, ECLI:EU:C:2022:297 (2022).

Svea Court of Appeal, 2016-05-12, B 5280-15 (Sweden).

II. Statutes and Legislative Materials

United States

Communications Decency Act (Section 230), 47 U.S.C. § 230 (1996).

Digital Millennium Copyright Act (DMCA), 17 U.S.C. § 512 (2012).

Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (1996).

Lanham Act, 15 U.S.C. §§ 1051-1141n (2012).

U.S. Const. amend. I.

European Union and Others

Audiovisual Media Services Directive (AVMSD), Directive 2018/1808, of the European Parliament and of the Council of 14 Nov. 2018 Amending Directive 2010/13, on the Coordination of Certain Provisions Laid Down by Law, Regulation, or Administrative Action of Member States Concerning the Provision of Audiovisual Media Services, 2018 O.J. (L 303) 69

Copyright in a Digital Single Market (CDSM) Directive, Directive 2019/790, of the European Parliament and of the Council of 17 April 2019 on Copyright and Related Rights in the Digital Single Market, 2019 O.J. (L 130) 92

Digital Services Act (DSA), Commission Regulation 2022/2065, of the European Parliament and of the Council of 19 October 2022 on a Single Market for Digital Services and amending Directive (Digital Services Act), 2000/31/EC, 2022 O.J. (L 277) 1

E-Commerce Directive, Directive 2000/31 of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market, O.J. (L 178).

General Data Protection Regulation (GDPR), Regulation (EU) 2016/679 of the European Parliament and of the Council of 27 April 2016 on the protection of natural persons with regard to the processing of personal data and on the free movement of such data, and repealing Directive 95/46/EC (General Data Protection Regulation) (Apr. 27, 2016), 2016 O.J. (L 119).

Network Enforcement Act (NetzDG), Netzwerkdurchsetzungsgesetz [NetzDG] [Network Enforcement Act], Sept. 1, 2017, BUNDESGESETZBLATT, Teil I [BGBL I] (Ger.)

Terrorist Content Online Regulation (TERREG), Regulation 2021/784, of the European Parliament and of the Council of 29 April 2021 on Addressing the Dissemination of Terrorist Content Online, 2021 O.J. (L 172) 79

III. Secondary Sources: Books and Journal Articles

Aaron, Tara M., *Availability of WHOIS Information After the GDPR—Is it Time to Panic?*, 108 TRADEMARK REP. 1129 (2018).

Akerlof, George A., *A Market for Lemons: Quality Uncertainty and the Market Mechanism*, 84 Q. J. ECON. 448 (1970).

Amarikwa, Melany, *Social Media Platforms' Reckoning: The Harmful Impact of TikTok's Algorithm on People of Color*, 29 RICH. J.L. & TECH. 69 (2023).

Austin, Graeme W., *Tolerating Confusion about Confusion: Trademark Policies and Fair Use*, 50 ARIZ. L. REV. 137 (2008).

Austin, Graeme W., *Trademarks and the Burdened Imagination*, 69 BROOK. L. REV. 827 (2004).

Balkin, Jack M., *Cultural Democracy and the First Amendment*, 110 NW. U. L. Rev. 1053 (2016).

Balkin, Jack M., *Free Speech is a Triangle*, 118 COLUM. L. REV. 2011 (2018).

Balkin, Jack M., *Free Speech in the Algorithmic Society: Big Data, Private Governance, and New School Speech Regulation*, 51 U.C. DAVIS L. REV. 1149 (2018).

Balkin, Jack M., *Free Speech Versus the First Amendment*, 70 UCLA L. REV. 1206 (2023).

Balkin, Jack M., *How to Regulate (and Not Regulate) Social Media*, 1 J. FREE SPEECH L. 71 (2021).

Balkin, Jack M., *Old-School/New-School Speech Regulation*, 127 HARV. L. REV. 2296 (2014).

Balkin, Jack M., *The Three Laws of Robotics in the Age of Big Data*, 78 OHIO ST. L.J. 1217 (2017).

Balkin, Jack M., *To Reform Social Media, Reform Informational Capitalism*, *in* SOCIAL MEDIA, FREEDOM OF SPEECH, AND THE FUTURE OF OUR DEMOCRACY 101 (Lee C. Bollinger & Geoffrey R. Stone, eds., 2022).

Bambauer, Derek E., *Cybersieves*, 59 DUKE L.J. 377 (2009).

Barocas, Solon & Selbst, Andrew, *Big Data's Disparate Impact*, 104 CALIF. L. REV. 671 (2016).

Bartholomew, Mark, *Advertising and the Transformation of Trademark Law*, 38 N.M. L. Rev. 1 (2008).

Bartholomew, Mark, *Trademark Morality*, 55 WM. & MARY L. REV. 85 (2013).

Bartholomew, Mark & Tehranian, John, *An Intersystemic View of Intellectual Property and Free Speech*, 81 GEO. WASH. L. REV. 1 (2013).

Bartow, Ann, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721 (2004).

Bechtold, Stefan, *Governance in Namespaces*, 36 LOY. L.A. L. REV. 1239 (2003).

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

Beebe, Barton, *The Suppressed Misappropriation Origins of Trademark Antidilution Law: The Landgericht Elberfeld's Odol Opinion and Frank Schechter's "The Rational Basis of Trademark Protection,"* INTELLECTUAL PROPERTY AT THE EDGE: THE CONTESTED CONTOURS OF IP 59 (Rochelle Cooper Dreyfus & Jane C. Ginsburg, eds, 2014).

Beebe, Barton, et al., *Testing for Trademark Dilution in Court and the Lab*, 86 U. CHI. L. REV. 611 (2019).

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

Beebe, Barton & Hemphill, C. Scott, *The Scope of Strong Marks: Should Trademark Law Protect the Strong More Than the Weak?*, 92 N.Y.U. L. REV. 1339 (2017).

Bloch-Wehba, Hannah, *Automation in Moderation*, 53 CORNELL INT'L L.J. 41 (2020).

Bloch-Wehba, Hannah, *Content Moderation as Surveillance*, 36 BERKELEY TECH. L.J. 1297 (2022).

Bloch-Wehba, Hannah, *Global Platform Governance: Private Power in the Shadow of the State*, 72 SMU L. REV. 27 (2019).

Bone, Robert G., *A Skeptical View of the Trademark Dilution Revision Act*, 11 INTELL. PROP. L. BULL. 197 (2007).

Bone, Robert G., *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099 (2004).

Bone, Robert G., *Schechter's Ideas in Historical Context and Dilution's Rocky Road*, 24 SANTA CLARA COMPUT. & HIGH TECH. L.J. 469 (2008).

Bradford, Anu, *The Brussels Effect*, 107 NW. U. L. REV. 1 (2012).

Bradford, Anu, *DIGITAL EMPIRES: THE GLOBAL BATTLE TO REGULATE TECHNOLOGY* (2023).

Bridy, Annemarie, *Notice and Takedown in the Domain Name System*, 74 WASH. & LEE L. REV. 1345 (2017).

Brown, Chris, *A Dilution Delusion: The Unjustifiable Protection of Similar Marks*, 72 U. CIN. L. REV. 1023 (2004).

Brauneis, Robert & Heald, Paul, *Trademark Infringement, Trademark Dilution, and the Decline in Sharing of Famous Brands: An Introduction and Empirical Study*, 59 BUFF. J. INT'L L. 141 (2011).

Buccafusco, Christopher, Heald Paul J. & Bu, Wen, *Testing Tarnishment in Trademark and Copyright Law: The Effect of Pornographic Versions of Protected Marks and Works*, 94 WASH. U. L. REV. 341 (2017).

Bunker, Matthew D., *Mired in Confusion: Nominative Fair Use in Trademark Law and Freedom of Expression*, 20 COMM. L. & POL'Y 191 (2015).

Buolamwini, Joy & Gebru, Timnit, *Gender Shades: Intersectional Accuracy Disparities in Commercial Gender Classification*, 81 PROC. MACH. LEARNING RSCH. 1 (2018).

Busch, Christoph, *Regulating the Expanding Content Moderation Universe: A European Perspective on Infrastructure Moderation*, 27 UCLA J.L. & TECH. 32 (2022).

Cavalli, Olga & Aart Scholte, JAN, *The Role of States in Internet Governance at ICANN*, *in* POWER AND AUTHORITY IN INTERNET GOVERNANCE: RETURN OF THE STATE? 37 (Blayne Haggart et al. eds., 2021).

Chander, Anupam, *How Law Made Silicon Valley*, 63 EMORY L.J. 639 (2014).

Chander, Anupam, *When the Digital Services Act Goes Global*, 38 BERKELEY TECH. L.J. 1068 (2023).

Chemerinsky, Erwin, CONSTITUTIONAL LAW: PRINCIPLES AND POLICIES (7th ed. 2023).

Chiao, Vincent & Harel, Alon, *Content Moderation Online: Regulation* Ex Ante *Versus* Ex Post, 2023 U. ILL. L. REV. 1587 (2023).

Citron, Danielle Keats, *Extremist Speech, Compelled Conformity, and Censorship Creep,* 93 NOTRE DAME L. REV. 1035 (2018).

Citron, Danielle Keats & Pasquale, Frank, *The Scored Society: Due Process for Automated Predictions*, 89 WASH. L. REV. 1 (2014).

Cohen, Felix S., *Transcendental Nonsense and the Functional Approach*, 35 COLUM. L. REV. 809 (1935).

Cohen, Julie E., *Infrastructuring the Digital Public Sphere*, 25 YALE J.L. & TECH. 1 (2023).

Ibáñez Colomo, Pablo, *Whatever Happened to the 'More Economics-Based Approach'?*, 11 J. EUR. COMPETITION L. & PRAC. 473 (2020).

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

Currie, David P., *Positive and Negative Constitutional Rights*, 53 U. CHI. L. REV. 864 (1986).

DeNardis, Laura, *Hidden Levers of Internet Control: An Infrastructure-Based Theory of Internet Governance*, 15 INFO. COMM. & SOC'Y 720 (2012).

Desai, Deven R., *From Trademarks to Brands*, 64 FLA. L. REV. 981 (2012).

Dergacheva, Daria & Katzenbach, Christian, *"We Learn Through Mistakes": Perspectives of Social Media Creators on Copyright Moderation in the European Union*, SOC. MEDIA + SOC'Y 1 (2023).

De Streel, Alexandre et al., *ONLINE PLATFORMS' MODERATION OF ILLEGAL CONTENT ONLINE: LAW, PRACTICES AND OPTIONS FOR REFORM* (2020).

Dogan, Stacey L. & Lemley, Mark A., *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777 (2004).

Dogan, Stacey L. & Lemley, Mark A., *The Merchandising Right: Fragile Theory or Fait Accompli,* 54 EMORY L.J. 461 (2005).

Douek, Evelyn, *Content Moderation as Systems Thinking*, 136 HARV. L. REV. 526 (2022).

Douek, Evelyn, *Governing Online Speech: From "Posts-As-Trumps" to Proportionality and Probability*, 121 COLUM. L. REV. 759 (2021).

Dusollier, Séverine, *The 2019 Directive on Copyright in the Digital Single Market: Some Progress, a Few Bad Choices, and an Overall Failed Ambition*, 57 COMMON MKT. L. REV. 979 (2020).

Duvall, Mikhaila, *A Good Day to Be a Bad Spaniel: Broadening the Application of the Rogers Test*, 21 UIC REV. INTELL. PROP. L. 193 (2022).

Economides, Nicholas S., *The Economics of Trademarks*, 78 TRADEMARK REP. 523 (1988).

Edelman, Lauren B. et al., *Diversity Rhetoric and the Managerialization of Law*, 106 AM. J. SOC. 1589 (2001).

Emerson, Thomas I., *Towards a General Theory of the First Amendment*, 72 YALE L.J. 877 (1963).

Eskens, Sarah, *The Personal Information Sphere: An Integral Approach to Privacy and Related Information and Communication Rights,* 71 J. ASS'N FOR INFO. SCI. & TECHNOLOGY. 1116 (2020).

Eubanks, Virginia, *AUTOMATING INEQUALITY: HOW HIGH-TECH TOOLS PROFILE, POLICE, AND PUNISH THE POOR* (2017).

Fabbri, Matteo, *Self-determination Through Explanation: An Ethical Perspective on the Implementation of the Transparency Requirements for Recommender Systems Set by the Digital Services Act of the European Union*, *in* PROCEEDINGS OF THE 2023 AAAI/ACM CONFERENCE ON AI, ETHICS, AND SOCIETY (2023).

Farley, Christine Haight, *Why We Are Confused about the Trademark Dilution Law*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1175 (2006).

Friday, Kristen, *Does Dilution Make Trademarks into Unconstitutional Patents?*,12 J. CONTEMP. LEGAL ISSUES 180 (2001).

Froomkin, A. Michael, *Almost Free: An Analysis of ICANN's 'Affirmation of Commitments'*, 9 J. TELECOMM. & HIGH TECH. L. 187 (2011).

Gillespie, Tarleton, *CUSTODIANS OF THE INTERNET* (2018).

Gillespie, Tarleton, *Platforms are Not Intermediaries*, 2 GEO. L. TECH. REV. 198 (2018).

Goldman, Eric, *Why Section 230 Is Better than the First Amendment*, 95 Notre Dame L. Rev. Online 33 (2019).

Gordon, Wendy J., *Introduction, Symposium, Ralph Sharp Brown, Intellectual Property, and the Public Interest*, 108 YALE L.J. 1611 (1999).

Gorwa, Robert et al., *Algorithmic Content Moderation: Technical and Political Challenges in the Automation of Platform Governance*, 7 BIG DATA & SOC'Y (2020).

Grabowski, Mark, *Should the U.S. Reclaim Control of the Internet? Evaluating ICANN's Administrative Oversight Since the 2016 Handover*, NEB. L. REV. BULL. (2018).

Griffin, Rachel, *Rethinking Rights in Social Media Governance: Human Rights, Ideology and Inequality*, 2 EUR. L. OPEN 30 (2023).

Grimmelmann, James, *The Virtues of Moderation*, 17 YALE J.L. & TECH. 42 (2015).

Guggenberger, Nikolas, *Essential Platforms*, 24 STAN. TECH. L. REV. 237 (2021).

Hariman, Robert, *Political Parody and Public Culture*, Q.J. SPEECH 247, 260 (2008).

Horwitz, Ethan & Levi, Benjamin, *Fifty Years of the Lanham Act: A Retrospective of Section 43(a)*, 7 FORDHAM INTELL. PROP. MEDIA ENT. L.J. 59 (1996).

Husovec, Martin, *Rising Above Liability: The Digital Services Act*, 38 BERKELEY TECH. L.J. 884 (2023).

Husovec, Martin, *The Promises of Algorithmic Copyright Enforcement: Takedown or Staydown?*, 42 COLUM. J.L. & ARTS 53 (2018).

Kagan, Jared I. & Hush, Emily R., *Parody Chew Toys and the First Amendment*, 13 LANDSLIDE 22 (2021).

Kelly, David M. & Jordan, Lynn M., *Twenty Years of Rogers v. Grimaldi: Balancing the Lanham Act with the First Amendment*, 99 TRADEMARK REP. 1360 (2009).

Kim, Paul Edward, *Preventing Dilution of the Federal Trademark Dilution Act: Why the FTDA Requires Actual Economic Harm*, 150 U. PA. L. REV. 719 (2001).

Klein, Hans, *ICANN and Internet Governance: Leveraging Technical Coordination To Realize Global Public Policy*, 18 INFO. SOC'Y 193 (2002).

Kleinberg, Jon et al., *Discrimination in the Age of Algorithms*, 10 J. LEGAL ANALYSIS (2018).

Klieger, Robert N., *Trademark Dilution: The Whittling away of the Rational Basis for Trademark Protection*, 58 U. PITT. L. REV. 789 (1997).

Klonick, Kate, *The New Governors: The People, Rules, and Processes Governing Online Speech*, 131 HARV. L. REV. 1598 (2018).

Knab, Hannah*, Jack Daniel's Highlights the Second and Ninth Circuit's Divide on the Application of the Rogers Test*, 10 AM. U. BUS. L. REV. 517 (2022).

Kratzke, William P., *Normative Economic Analysis of Trademark Law*, 21 MEMPHIS ST. U. L. REV. 199 (1991).

Kreuz, Roger J. & Roberts, Richard M., *On Satire and Parody: The Importance of Being Ironic*, 8 METAPHOR & SYMBOLIC ACTIVITY 97 (1993).

Kornelius, Willemijn, *Prior Filtering Obligations After Case C-401/19: Balancing the Content Moderation Triangle: A Comparative Analysis of the Legal Implications of Case C-401/19 for Filtering Obligations Ex Ante and the Freedom of Expression in Europe*, 14 J. INTELL. PROP. INFO. TECH. & ELEC. COM. L. 123 (2023).

LaFrance, Mary, *No Reason to Live: Dilution Laws as Unconstitutional Restrictions on Commercial Speech*, 58 S.C. L. REV. 709 (2007).

Laketić, Jelena, *Trademarks on the Blockchain: NFT Domains and Collisions*, 30 MICH. TECH. L. REV. 1 (2024).

Landes, William & Posner, Richard, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* (2003).

Landes, William & Posner, Richard A., *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265 (1987).

Leistner, Matthias*, The Implementation of Art. 17 DSM Directive in Germany - A Primer with Some Comparative Remarks*, 71 GRUR INT'L, 909 (2022).

Lemley, Mark A., *Romantic Authorship and the Rhetoric of Property*, 75 TEX. L. REV. 873 (1997).

Lemley, Mark A., *The Modern Lanham Act and the Death of Common Sense*, 108 YALE J.L. 1687 (1999).

Liu et al., *Implications of Revenue Models and Technology for Content Moderation strategies*, 41 MARKETING SCI. 1 (2022).

Long, Clarisa, *Dilution*, 106 COLUM. L. REV. 1029 (2006).

Loughlin, John, *The 'Hybrid' State: Reconfiguring Territorial Governance in Western Europe*, 10 PERSP. ON EUR. POL. & SOC'Y 51 (2009).

Lunney, Glynn S. Jr., *Trademark Monopolies*, 48 EMORY L.J. 367 (1999).

Lux, Sarah, *Evaluating Trade Mark Dilution from the Perspective of the Consumer*, 34 U.N.S.W. L.J. 1053 (2011).

Magliocca, Gerard N., *One and Inseparable: Dilution and Infringement in Trademark Law*, 85 MINN. L. REV. 949 (2001).

McCarthy, J. Thomas, *Dilution of a Trademark: European and United States Compared*, 94 TRADEMARK REP. 1163 (2005).

McCarthy, J. Thomas, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* (5TH ED. 2019).

McGeveran, William, *The Trademark Fair Use Reform Act*, 90 B.U. L. REV. 2267 (2010).

McKenna, Mark P., *A Consumer Decision-Making Theory of Trademark Law*, 98 VA. L. REV. 67, 141 (2012).

McKenna, Mark P., *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839 (2007).

Meek, Cristopher et al., *The Learning-Curve Sampling Method Applied to Model-Based Clustering*, 2 J. MACH. LEARNING RSCH. 397 (2002).

Medina, Manuel, *Governmental Censorship of the Internet: Spanish vs. Catalans Case Study*, 68 LIBRARY TRENDS 561 (2020).

Meiners, Roger E. & Staaf, Robert J., *Patents, Copyrights and Trademarks: Property or Monopoly?* 13 HARV. J.L. & PUB. POL'Y 911 (1990).

Menell, Peter S. & Scotchmer, Suzanne, Intellectual Property Law, in 2 HANDBOOK OF LAW AND ECONOMICS (A. Mitchell Polinsky & Steven Shavell eds., 2007).

Mezei, Peter & Harkai, Istvan, *Self-Regulating Platforms?: The Analysis of the Enforcement of End-User Rights in the Light of the Transposition of Article 17 of the CDSM Directive*, 7 PUB. GOVERNANCE, ADMIN. & FIN. L. REV. 109 (2022).

Milgrom , Pau & J Roberts, John, *Price and Advertising Signals of Product Quality,* 94 J. POL. ECON. 796 (1986).

Mingus, Jennifer, *E-mail: A Constitutional (and Economical) Method of Transmitting Class Action Notice*, 47 CLEV. ST. L. REV. 87 (1999).

Napoli, Philip M., *Social Media and the Public Interest: Media Regulation in the Disinformation Age* (2019).

Netanel, Neil, *Applying Militant Democracy to Defend Against Social Media Harms*, 45 Cardozo L. Rev. 489 (2023).

Nicholas, Gabriel, *Shedding light on shadowbanning* (2022).

Nugent, Nicholas J., *The Five Internet Rights*, 98 Wash. L. Rev. 527 (2023).

Nugent, Nicholas, *Masters of Their Own Domains: Property Rights as a Bulwark Against DNS Censorship*, 19 Colo. Tech. L.J. 43 (2021).

Nunziato, Dawn Carla, *The Digital Services Act and the Brussels Effect on Platform Content Moderation*, 24 Chi. J. Int'l L. 115 (2023).

Palumbo, Andrea, *A Medley of Public and Private Power in DSA Content Moderation for Harmful but Legal Content: An Account of Transparency, Accountability and Redress Challenges*, 15 J. Intell. Prop. Infro. tech. & Elec. Com. L. 246 (2024).

Pakutinskas, Paulius, *Algorithmic Parody Protection in the European Union: CDSM Directive and DSA Regulation Perspective*, 16 Baltic J. of L. & Pol. 79 (2023).

Perel, Maayan & Elkin-Koren, Niva, *Accountability in Algorithmic Copyright Enforcement*, 19 Stan. Tech. L. Rev. 473 (2016).

Peukert, Alexander et al., *Eur. Copyright Soc'y – Comment on Copyright and the Digital Services Act Proposal*, 53 IIC-Int'l Rev. Intell. Prop. and Competition L. 358 (2022).

Port, Kenneth L., *The Commodification of Trademarks: Some Final Thoughts on Trademark Dilution*, 46 Hofstra L. Rev. 669 (2017).

Posner, Richard A., *When Is Parody Fair Use?*, 21 J. Legal Stud. 67, 75 (1992).

Prager, Eric A., *The Federal Trademark Dilution Act of 1995: Substantial Likelihood of Confusion*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 121 (1996).

Quintais , João Pedro & Schwemer, Sebastian Felix, *The Interplay Between the Digital Services Act and Sector Regulation: How Special Is Copyright?*, 13 EUR. J. RISK REGUL. 191 (2022).

Radin, Margaret Jane & Wagner, Polk, *The Myth of Private Ordering: Rediscovering Legal Realism in Cyberspace*, 73 CHI.-KENT L. REV. 1295 (1998).

Radsch, Courtney C., *The Politics of Labels: How Tech Platforms Regulate State Media, in* 2020 ANNUAL REPORT: DYNAMIC COALITION ON THE SUSTAINABILITY OF JOURNALISM AND NEWS MEDIA 37, (Daniel O'Maley et al., eds., 2020), https://www.intgovforum.org/en/filedepot_download/7733/2399.

Rierson, Sandra L.*, The Myth and Reality of Dilution*, 11 DUKE L. & TECH. REV. 212 (2013).

Roberts, Sarah I., BEHIND THE SCREEN: CONTENT MODERATION IN THE SHADOWS OF SOCIAL MEDIA (2019).

Samuelson, Pamela, *Pushing Back on Stricter Copyright ISP Liability Rules*, 27 MICH. TECH. L. REV. 299 (2021).

Samuelson, Pamela, *Unbundling Fair Uses*, 77 FORDHAM L. REV. 2537 (2009).

Schauer, Frederick*, Uncoupling Free Speech*, 92 COLUM. L. REV. 1321 (1992).

Schechter, Frank I., *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813 (1927).

Schwerner, Sebastian Felix et al., *Liability Exemptions of Non-Hosting Intermediaries: Sideshow in the Digital Services Act?*, 8 OSLO L. REV. 4 (2021).

Schwerner, Sebastian Felix & Schovsbo, Jens, *What Is Left of User Rights: Algorithmic Copyright Enforcement and Free Speech in the Light of the Article 17 Regime*, *in* INTELLECTUAL PROPERTY LAW AND HUMAN RIGHTS (Paul L.C. Torremans ed., 4th ed. 2020).

Selbst, Andrew D., *An Institutional View of Algorithmic Impact Assessments*, 35 HARV. J. L. & TECH. 117 (2021).

Seng, Daniel, *The State of the Discordant Union: An Empirical Analysis of DMCA Takedown Notices*, 18 VA. J.L. & TECH. 369 (2014).

Shufro, Zachary, *Based on a True Story: The Ever-Expanding Progeny of Rogers v. Grimaldi*, 32 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 391(2022).

Solow-Niederman, Alicia, *Administering Artificial Intelligence*, 93 S. CAL. L. REV. 633 (2020).

Sorbán, Kinga*, An Elephant in the Room—EU Policy Gaps in the Regulation of Moderating Illegal Sexual Content on Video-Sharing Platforms*, 31 INT. J.L. & INFO. TECH. 171 (2023).

Swann, Jerre B., *An Interdisciplinary Approach to Brand Strength*, 96 TRADEMARK REP. 943, (2006).

Thierer, Adam, *Soft Law in U.S. ICT Sectors: Four Case Studies*, 61 JURIMETRICS 79 (2020).

Tourkochoriti, Ioanna, *The Digital Services Act and the EU as the Global Regulator of the Internet,* 24 CHI. J. INT'L L. 129 (2023).

Tushnet, Rebecca, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507 (2008).

Urban, Jennifer M. et al., *Notice and Takedown in Everyday Practice,* U.C. BERKELEY PUB. L. & LEGAL THEORY RES. PAPER SERIES (2017).

Van Hoboken, Joris, *The Proposed EU Terrorism Content Regulation: Analysis and Recommendations with Respect to Freedom of Expression Implications, in* TRANSATLANTIC HIGH LEVEL WORKING GROUP ON CONTENT MODERATION ONLINE AND FREEDOM OF EXPRESSION (2019).

Van Loo, Rory, The *New Gatekeepers: Private Firms as Public Enforcers*, 106 VA. L. REV. 467 (2020).

Volokh, Eugene, *In Defense of the Marketplace of Ideas/Search for Truth*, 97 VA. L. REV. 595 (2011).

Walsh Charles J. & Klein Marc S., *From Dog Food to Prescription Drug Advertising: Litigating False Scientific Establishment Claims under the Lanham Act*, 22 SETON HALL L. REV. 389 (1992).

Weitzenboeck, Emily M., *Hybrid Net: The regulatory framework of ICANN and the DNS*, 22 INT'L J. L. & INFO. TECH. 49 (2014).

Welkowitz, David S., *Reexamining Trademark Dilution*, 44 VAND. L. REV. 531 (1991).

Wilkins, Mira, *The Neglected Intangible Asset: The Influence of the Trademark on the Rise of the Modern Corporation*, 34 BUS. HIST. 66, 87–88 (1992).

Wilman, Folkert, THE RESPONSIBILITY OF ONLINE INTERMEDIARIES FOR ILLEGAL USER CONTENT IN THE EU AND THE US (2020).

Wintermeyer, Wesley W., *Who Framed Rogers v. Grimaldi? What Protects Trademark Holders Against First Amendment Immunity for Video Games?*, 64 ALA. L. REV. 1243 (2013).

Wolff, John, *Non-Competing Goods in Trademark Law*, 37 COLUM. L REV. 582, 602 (1937)

Wright, David Jacob, *Explicitly Explicit: The Rogers Test and the Ninth Circuit*, 21 J. INTELL. PROP. L. 193 (2013).

Yoo, Christopher S.*, Free Speech and the Myth of the Internet as an Unintemediated Experience,* 78 GEO. WASH. L. REV. 697 (2010).