Trafficking in Trademarks: Setting Boundaries for the Uneasy Relationship Between "Property" Rights and Trademark and Publicity Rights

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TRAFFICKING IN TRADEMARKS: SETTING BOUNDARIES FOR THE UNEASY RELATIONSHIP BETWEEN “PROPERTY” RIGHTS AND TRADEMARK AND PUBLICITY RIGHTS

by
Sheldon W. Halpern*

INTRODUCTION: TRADEMARKS AND INTELLECTUAL PROPERTY

Trademark law isn’t fun anymore. Until quite recently, trademark law was something of a refreshing outlier in the overheated world of intellectual property theory. Most observers¹ did not become exercised over the social implications or cultural consequences of trademark law; after all, it was just about money and about who was in the best position to profit from the exploitation of certain words, phrases, pictures and the like in connection with the sale of goods or services. Unlike copyright, which is predicated on at least a modicum of creativity, and unlike the novelty-centered field of patent law, trademark, a kind of hybrid afterthought, is a marketing construct, whose justification cannot be found in the improvement of culture or society. As I’ve suggested elsewhere, while affecting the pocket, trademark problems generally do not touch the soul of society.² The result was that one could simply enjoy the sometimes interesting, sometimes foolish, sometimes creative, and sometimes just plain silly problems presented in trademark litigation. For the teacher and for the student, if not for the practitioner, it was, really, just fun. The continuing efforts of the Mattel corporation to protect the virtue and reputation of Barbie,³ for example, while producing interesting legal analysis, also produces chuckles.

For good or ill, these carefree days are fast fading into the past. Commentators (including me) point to the explosive growth of trademark law.⁴ Modern trademark law, born in the 1946 Lanham Act⁵ as a federal remedial device for enforcing

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² Id.


⁴ See, e.g., Halpern, Confusion, supra; Mark A. Lemley, The Modern Lanham Act and the Death of Common Sense, 108 YALE L.J. 1687 (1999)(“Courts protect trademark owners against uses that would not have been infringements even a few years ago and protect as trademarks things that would not have received such protection in the past”).

common law “unfair competition” claims, has, with help from its judicial midwives, spread and expanded much like kudzu; it has transformed, or morphed, from “a simple subset of the law of unfair competition to a multifaceted remedial scheme, and “trademark theory” has become a popular source of legal scholarship.

As the Supreme Court sees it, the principal function of “classic” trademark law had been the protection of the consuming public from being defrauded by one person’s use of another’s trademark—and thus the centrality of the issue of the likelihood of the consuming public being “confused” as to the source or origin of the goods or services to which the trademark related. It has been argued that a more accurate historical justification for trademark law focuses on the producer, rather than the consumer of the goods, and is directed toward preventing the diversion of trade by means of unauthorized use of one producer’s trademark by another, competing producer—and thus the centrality of locating trademark law as a subset of the broader law of unfair competition. In either case, the relationship of trademark law to the fundamental structure of “intellectual property” law is, at best, tenuous and incidental. Neither of these teleological constructs involves matters of originality, creativity, or novelty, the indicia of intellectual activity underlying intellectual property. Only at the simplest level of abstraction—the intangible nature of trademark rights—do we find commonality supporting the joinder of copyright, patent, and trademark.

6 Moseley v. V Secret Catalogue, Inc., 537 U.S. 418 at 428 (2003)(Traditional trademark law “was largely codified in the Trademark Act of 1946 (Lanham Act)).

7 For a review of the early development of trademark law at the federal level, see David S. Welkowitz, The Supreme Court and Trademark Law in the New Millennium, 30 WM. MITCHELL L. REV. 1659 (2004).

8 Halpern, Confusion, supra note 1; Mark P. McKenna, The Normative Foundations of Trademark Law, 82 NOTRE DAME LAW REVIEW 1839, 1897 (2007)(“Courts, with some help from Congress, significantly broadened trademark law during the twentieth century.”)


10 Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23 (2003).


12 McKenna, supra.
But joined they are, however mismatched, and “trademark” necessarily is part of the triumvirate of basic intellectual property constructs. We therefore must ultimately deal with the “property” aspects of trademark rights, a not unusual situation in the law as application of a label requires us to rationalize that label. Accordingly, we find theoretical discussion of the function of trademark law often framed in Chicago-school law and economics terms as an instrument of consumer efficiency; a means of limiting transaction costs, as the trademark, in serving as a shorthand descriptor of the source and quality of goods and services eliminates the need for deeper consumer investigation in making purchasing decisions.\(^\text{13}\) As the Supreme Court observed:

[Trademark law,] by preventing competitors from copying “a source-identifying mark,” “reduce[s] the customer's costs 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.”\(^\text{14}\)

So long as trademark disputes were limited to those between competing offerors of goods and services, the debate over whether trademark law is to be considered consumer-centered or producer-centered,\(^\text{15}\) while interesting, did not carry serious consequences. Similarly, in the context of disputes limited to business competitors, it doesn’t terribly much matter whether one considers “use” or “confusion” the linchpin of trademark law,\(^\text{16}\) as both of those factors will inevitably be part of a determination of liability. So, too, within that limited context, it did not terribly much matter how one rationalized the “property” nature of trademark rights. The problem, of course, is that modern trademark disputes, particularly those that have arisen since the advent of the Internet, are not limited to the traditional “unfair competition” context.


The fundamental purpose of a trademark is to reduce consumer search costs by providing a concise and unequivocal identifier of the particular source of particular goods. The consumer who knows at a glance whose brand he is being asked to buy knows whom to hold responsible if the brand disappoints and whose product to buy in the future if the brand pleases. This in turn gives producers an incentive to maintain high and uniform quality, since otherwise the investment in their trademark may be lost as customers turn away in disappointment from the brand.

See Lemley, supra note 4 (“Most economists today view trademarks as valuable aids to efficient markets”).


Preservation of the trademark as a means of identifying the trademark owner’s products ... serves an important public purpose. It makes effective competition possible in a complex, impersonal marketplace by providing the means through which the consumer can identify products which please him and reward the producer with continued patronage. Without some such method of product identification, informed consumer choice, and hence meaningful competition in quality, could not exist.

\(^{15}\) Compare McKenna, supra note 8, and Dinwoodie & Janis, supra note 9

\(^{16}\) Compare Dinwoodie & Janis, supra note 9 and Dogan & Lemley, supra note 9.
Whether the differences are in degree or in kind, the internet provided a challenge to traditional trademark constructs. At the simplest level, the internet could be viewed as one of a variety of media, so that the trademark related questions arising from use by one of another's mark in connection with the offering of goods or services on an internet website could be dealt with as a “classic” infringement situation, in which the specific medium is irrelevant and the dispute would be determined by application of traditional trademark principles. Thus, a website offering jewelry while prominently displaying the classic Tiffany color, would be vulnerable to a trademark infringement claim from Tiffany; in considering such a claim, the fact that the use of the mark occurred in the context of a website rather than a print advertisement would be immaterial, and the dispute would be determined by considering the strength and validity of the Tiffany color as a mark and the likelihood of consumer confusion. Similarly, if the Tiffany color were used to draw the web-surfer further into the site, where confusion might be dissipated, the “initial interest confusion” problem\textsuperscript{17} could be assessed without significant reference to the internet as the medium.

But the internet as a medium has provided the setting for unorthodox, or at least unanticipated uses of trademarks in ways quite different from those underlying traditional infringement claims. For example, both Dogan & Lemley and Dinwoodie & Janis, with their conflicting approaches, provide examples of the kinds of issues presented in this untraditional context (such as the use of meta-tags and embedded matter in search engines and an expansive approach to what is “initial interest confusion”).\textsuperscript{18} This in turn has given rise to complex questions of the nature of trademark law as a remedial device.

The response to the peculiarly internet-based problems created by internet domain names that are identical with or confusingly similar to trademarks is particularly interesting. The advent of “cybersquatting,” the registration as a domain name of another's trademark (e.g., cocacola.com), created a challenge to traditional trademark constructs that, after a period of confusion, was met by sui generic legislation. The paradigmatic case of cybersquatting involved registration of a theretofore unregistered domain name for the express purpose of pressuring the trademark owner to buy the name from the registrant.\textsuperscript{19} In this situation, and variants, the courts were faced initially with trying to fit the registrant's use of another's mark into the framework of “use,” “use in commerce” and “likelihood of confusion,” producing strained and unsatisfying (legally, if not morally) results; a brief attempt was made, after enactment of the Federal Trademark Dilution Act,\textsuperscript{20} to fit the

\textsuperscript{17} Compare Brookfield Communications v. West Coast Entertainment, 174 F.3d 1036 (9th Cir. 1999) and Gibson Guitar Corp. v. Paul Reed Smith Guitars, 423 F.3d 539 (6th Cir. 2005).

\textsuperscript{18} Supra, note 9.

\textsuperscript{19} Panavision International, L.P. v. Toeppen, 141 F.3d 1316 (9th Cir. 1998).

\textsuperscript{20} Lanham Act §43(c), 15 U.S.C. §1125(c).
cybersquatting scenario into the somewhat more hospitable “dilution” environment. Again, it was clear that the shapes of the pegs and the holes were significantly different and the matter was essentially settled by special purpose legislation and a more robust internet practice. In short, it became apparent that the problems were not, at their root, “trademark” problems, but something qualitatively different, to be dealt with by means of other, albeit special purpose, constructs.

Although the “solution” to theses essentially non-trademark internet-based problems appears to have been found in sui generis legislation, it is instructive that the initial attempt to deal with them was by a protean application of trademark constructs. It was enticing to use these constructs, as the issues arose in the context of continually broadening trademark protection, both with respect to marks registered under the Lanham Act and to marks for which protection is sought as unregistered marks under section 43(a) of the Act. The response to these developments was a renewed focus on the nature of trademark itself, driven by concern that the law had moved radically from recognition of a simple subset of the law of unfair competition, a limited “right appurtenant” to the sale of goods or services, to recognition of some form of stand-alone instrument, embodying a property-like interest akin to copyright or similar interests having an independent value. Whether from a property perspective, a consumer perspective, or a producer perspective, and whether one focuses on “use” or on “confusion,” there is consensus that “modern trademark law differs fundamentally from its traditional counterpart in its understanding of what a trademark does and how it adds value.”

What is left unsaid, even with this consensus, is how we are to define, quantify and to what extent, if at all, protect, that “value.” In short, what boundaries are to be set for this redefined concept? Much as with related concerns over the “commodification” of personality that has colored (if not distorted) debate over the analogous right of publicity, discussion of whether a trademark is or is not a form of “property” and whether “propertization” of trademarks is a bad thing for the well-being of society, is interesting and important to the formulation of policy; they

23 Halpern, Confusion, supra note 1, at 239-41.
24 “Courts traditionally saw a trademark as little more than a vehicle through which consumers could match products with their producers.” McKenna, supra note 8, at 1843.
25 Id.
26 See, infra, note 125.
27 A truly awful word. See, e.g., Lemley, supra note 4, at 1693-94.
28 Cf. id., at 1696:
[P]ropertizing trademarks comes at a rather significant cost to society. Sometimes that cost takes the form of lost opportunities: Important political and social commentary and works of art may
however do not move us forward significantly in the necessary search for meaningful boundaries in defining trademark rights as such. The reality is that the trademark owners, the branding enterprises, will inevitably seek to expand the strength, power and scope of trademarks.\(^9\) Such expansion may be harmful to consumers, in possibly limiting choices, or beneficial to consumers in minimizing the possibility of “confusion” and maximizing consumer efficiency. Our concern should not be whether there is some abstract virtue—or some inherent vice—in an expansive approach to trademark. Rather, the issue is keeping trademark law (and its analogues, such as the right of publicity) consistent with the constitutional and peculiarly American approach to matters affecting this corner of “intellectual property” rights and particularly with the way in which boundaries are set in the context of de facto monopoly power. Which brings us to the United States Supreme Court.

**CONSTITUTIONAL BOUNDARIES**

Between 2000 and 2004 the Supreme Court decided five trademark and trademark related cases: *Wal-Mart,\(^{30}\) TrafFix,\(^{31}\) Moseley,\(^{32}\) Dastar,\(^{33}\) and *KP Permanent.\(^{34}\) As I have suggested elsewhere, these cases, while facially quite unrelated and distinct, produced a set of opinions which "sweep majestically (if a bit absentmindedly as to what's left in their wake) into the policy debate over the proper scope of trademark law and its interaction with intellectual property law. Whether one agrees or disagrees with the individual determinations, the ambitious objectives of these cases is impressive."\(^{35}\)

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\(^{33}\) *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003)("origin" for purposes of Lanham Act §43(a)).

\(^{34}\) *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 125 S.Ct. 542 (2004)(interpreting "fair use" as a trademark infringement defense).

\(^{35}\) Halpern, *Confusion*, supra note 1 at 271.
At the core of these opinions—decided not long after the Court had signaled an expansive approach to trademark law—36 is the Court’s clear concern with constitutional balance, a determination that trademark law, whatever its underpinnings, not be used in a manner that can subvert the constitutionally limited monopolies of copyright and patent law and the scope of permissible public use. Thus, the Wal-Mart and TrafFix opinions do not simply place serious limits on the use of trademark law to protect product design;37 they also, by implication in Wal-Mart and more directly in TrafFix, attempt to inhibit the prospect of trademark law impinging on the boundaries and limitations of patent law:

[In Wal-Mart ... we were careful to caution against misuse or over-extension of trade dress. We noted that “product design almost invariably serves purposes other than source identification.”

Trade dress protection must subsist with the recognition that in many instances there is no prohibition against copying goods and products. In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying. As the Court has explained, copying is not always discouraged or disfavored by the laws which preserve our competitive economy. Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U. S. 141, 160 (1989). Allowing competitors to copy will have salutary effects in many instances.38

Unstated here, although more explicitly stated in Wal-Mart, is that the “salutary effects” to which Justice Kennedy refers are to be found in consumer benefits.39 As Justice Scalia put it in Dastar,40 “[t]he words of the Lanham Act should not be stretched to cover matters that are typically of no consequence to purchasers.”41

36 See Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159, 162 (1995)(upholding the registerability of color while noting that the Lanham Act “describes the universe of things that can qualify as a trademark in the broadest of terms”); Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992) (holding, essentially, that “trade dress” is not to be treated under standards of protection different from those applicable to other kinds of marks and that the law can recognize “inherently distinctive” trade dress).

37 In Wal-Mart, in a brief, unanimous opinion, the Court adopted a categorical rule to the effect that product design, as a matter of law, cannot be “inherently distinctive,” but can be protected only upon a showing that the design has acquired secondary meaning. 529 U. S. at 215. In TrafFix, the Court, while formulating a more stringent test of nonfunctionality for trade dress, held that the existence of an expired utility patent whose claims include the features for which trademark protection is sought creates a strong presumption of functionality, placing a “heavy burden” on the trademark claimant. 532 U.S. at 29.


40 Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23 (2003).

41 Id. at 32-33.
What makes the Court's discussion of permissible copying of particular interest is Justice Kennedy's reference to the Court's 1989 *Bonito Boats* opinion, introducing a theme that was more fully developed in the later *Dastar* opinion. *Bonito Boats* was the culmination of a series of Supreme Court opinions, starting in the 1960s, attempting to clarify issues of federal preemption arising from state-based actions predicated on copying of useful articles. Beginning with the companion *Sears* and *Compco* cases, moving through the divisions in the Court a decade later in *Goldstein* and *Kewanee*, to an apparent reconciliation yet another decade later with *Bonito Boats*, the Court grappled with the complex problems of federal/state relationships and the conflicting concerns of federal exclusivity and supremacy with respect to the constitutionally recognized federal power over patents.

Notwithstanding the preemption context of these opinions, *TrafFix* and, in more explicit detail, *Dastar* used them as a springboard for delineating firmer boundaries, if not higher walls, to contain and inhibit an expansive trademark jurisprudence. Where *TrafFix* was concerned with preventing trademark constructs from crossing the boundaries of patent law, the *Dastar* Court acted to ensure that trademark law (in the form of Lanham Act § 43(a)) not trespass upon the limiting principles of copyright law. The concern over these boundaries is not predicated on some form of logical purity; rather it arises from the different constitutional bases for the exercise of congressional power with respect to patents and copyrights, on the one hand, and trademark on the other. While Congress is given explicit power, under article 1 section 8 of the Constitution, to act with respect to copyright and patent, congressional power with respect to trademarks is not express but rather is inferred from the general power of Congress to act with respect to interstate and foreign commerce. Both the express grant of power as to copyright and patent and the constitutional temporal limitation on that power contemplate a vigorous and complementary public domain, a constantly growing area in which the public is free to copy those works which either do not qualify for copyright or patent protection or whose protection has expired; conversely, trademark rights, which derive from the use “in commerce” of a mark that is distinctive in identifying the source or origin of goods or services, will endure, even perpetually, so long as they remain so distinctive. To the extent that trademark rights might serve to expand or extend copyright or

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42 Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23 (2003).
48 See In re Trade-Mark Cases, 100 U.S. 82 (1879).
49 “Limited times” in article 1 section 8.
patent rights, the complementary constitutional balance is seriously impaired. As the Court said in *Dastar*:

The right to copy, and to copy without attribution, once a copyright has expired, like "the right to make [an article whose patent has expired]—including the right to make it in precisely the shape it carried when patented—passes to the public." *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964); *see also Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 121-122 (1938). "In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying." *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001). The rights of a patentee or copyright holder are part of a "carefully crafted bargain," *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-151 (1989), under which, once the patent or copyright monopoly has expired, the public may use the invention or work at will and without attribution. Thus, in construing the Lanham Act, we have been "careful to caution against misuse or over-extension" of trademark and related protections into areas traditionally occupied by patent or copyright. *TrafFix*, 532 U.S., at 29.  

Consistent with this need to recognize and secure the boundaries among trademark, copyright, and patent, the *Dastar* court held that "origin," for purposes of the Lanham Act, refers to the source of the physical "goods," and not to the underlying intellectual interests embodied in those goods:

In sum, reading the phrase "origin of goods" in the Lanham Act in accordance with the Act's common-law foundations (which were not designed to protect originality or creativity), and in light of the copyright and patent laws (which were), we conclude that the phrase refers to the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in those goods. ... To hold otherwise would be akin to finding that § 43(a) created a species of perpetual patent and copyright, which Congress may not do.  

These opinions, with their strong emphasis on the constitutional and policy distinctions among trademark, copyright, and patent law, and their express desire to honor and recognize these distinctions, provide the basis for balancing and setting boundaries for trademark and related rights. The problem of balance emerges most clearly in considering the trademark implications arising from transactions involving the mark itself, merchandising the trademark. Trafficking in the mark, as the source of value for the consumer, lies at the clearest interface between trademark and "property" rights. The analysis here gives us the opportunity more clearly to articulate trademark boundaries, while serving as well to create a principled basis for similarly bounding the analogous right of publicity.


51 Id. at 35.
A. Making Law I: “Right You Are If You Think You Are.”

The dress code in law schools being what it is, it is not at all unusual to find students in class wearing baseball caps or sweaters or articles of adornment carrying logos of sports teams or of academic institutions. In my trademark class, I will regularly ask the student wearing a New York Yankees cap (i.e., a cap with the “NY” monogram on it) whether he or she thought that the vendor who sold the cap did so under a license from the New York Yankees or, if not, whether the New York Yankees should be able to assert a trademark infringement claim against that vendor. Almost invariably, the student, and the vast majority of the class, will argue that, of course, the Yankees (or the Red Sox or Notre Dame University or any of the other entities or institutions whose mark is so displayed) should be able to control the use and marketing of their logo.

The students will readily concede that, in buying the hat, the purchaser doesn’t care who made it; nor does the purchaser really believe that the Yankees manufactured it or even were in any way involved in the manufacture. Nevertheless, the students will argue that the unlicensed vendor is wrongfully capitalizing on the purchaser’s desire to show affinity with or loyalty to the team and that the law therefore must be protective of the goodwill embodied in the logo and require a license from the trademark owner. As a general matter, the law is responsive to that kind of concern, as it recognizes, expressly in section 43(a) of the Lanham Act with respect to unregistered marks, and by implication with respect to registered marks under section 32, that an infringement action generally may be sustained upon a showing of unauthorized use of a trademark in a manner that creates a likelihood of confusion not only as to the source or origin of goods or services but also as to “affiliation, connection or association” or “sponsorship or approval.”

Therefore, since it is assumed that the law must protect the trademark owner here (whether because of that owner’s efforts, creativity, or otherwise), it is reasonable for consumers to assume that the vendor must have been licensed in order to transact business. That is, the students suggest that, because the public generally believes that the law requires that one who sells an item embodying another’s

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52 For detailed review and critique of the general area of trademark “merchandising,” see Dogan & Lemley, supra note 29 and Denicola, supra note 11.

Once a plaintiff’s mark or trade dress is found to be protectible, liability for trademark and trade-dress infringement hinges upon whether a likelihood of confusion exists in the minds of potential consumers as to the source, affiliation, or sponsorship of the defendant’s product or service due to the use of the allegedly infringing marks or trade dress.

54 “Perceptions of business practices, however dim or inaccurate, also may generate assumptions regarding sponsorship.” Denicola, supra note 11 at 612.
trademark may do so only with permission, an unauthorized sale will create a likelihood of confusion in the consuming public, if not as to the actual source or origin of the product, then as to sponsorship, permission, approval or authorization. It is in short, a bizarre syllogism: if enough people believe that the law grants trademark owners rights as to certain uses, then the law grants trademark owners rights as to those uses—a strange revisitation of Pirandello’s Right You Are if You Think You Are. Again, the syllogism is not based on a proposition of law arising out of consumer “confusion” as to sponsorship; there is little independent reason to assume such sponsorship absent some external factor, such as an “official” designation. Rather, the assumption of sponsorship arises out of consumer assumptions as to the state of the law! As one commentator put it:

In this system, rights are bounded only by consumer understanding: If consumers believe the Yankees logo on a hat suggests the Yankees endorsed the maker of the hat, then the Yankees have the right to control that use.

And the available evidence suggests that consumers believe names and creative content, some of which can be protected as trademarks, are subject to substantial control. Assuming consumer beliefs about the use of marks or logos on merchandise even roughly approximates this evidence, modern law has essentially no choice but to respond.

But is “modern law” really without choice here? Certainly, as a general matter, consumer belief as to what a mark signifies is a central part of trademark law; the ubiquity of consumer survey evidence in trademark litigation demonstrates the importance of determining consumer reaction to a mark; but not, however, consumer understanding of the law. What the “consumers believe” in the context of merchandising of the mark itself is not some consensus as to the reality of commercial behavior; it is not the same kind of “belief” that informs the question of whether a mark has obtained secondary meaning, or whether there may be consumer confusion as to the source of a product. Rather than consumer belief, what we have here is something more elliptical and self-referential, consumer assumption (or misapprehension) as to what the law requires, giving rise to a “belief” as to what must have happened, which in turn gives rise to a legal construct that then conforms to that assumption! The difficulty with the liability scenario is not that liability is predicated on likelihood of confusion as to sponsorship or endorsement, but rather that the perceived need for authorization, for sponsorship or endorsement, arises from the consumers’ assumption about the law itself and the perceived consequently unlawful nature of the activity. In short, if a “merchandising” right is to be recognized under

55 See, e.g., Dogan & Lemley, supra note 29 at 477 (referring to “the widespread belief that [for example,] team-related jerseys are officially licensed by the NFL”).

56 Luigi Pirandello, Così è, se vi pare! (1917).

57 “[Liability] rests ... on the often fortuitous circumstance that a particular consumer population is prone to inaccurate assumptions.” Denicola supra note 11 at 613.

58 McKenna, supra note 8 at1911-12.

59 As Dogan & Lemley suggest, supra note 29 at fn. 101, “this confuses a belief about what the
these circumstances, then, realistically, such recognition cannot be predicated on the "fact" of consumer confusion as to origin or sponsorship of the objects of sale.

To a fair extent, the underlying consumer assumption about the state of the law seems to reflect the coupling of the existence of a lucrative market with an uncritical aversion to "free riding." Certainly, merchandising of the trademark itself is a large, highly profitable business.60 Quite apart from the ubiquitous market in professional sports related materials, licensing of collegiate trademarks has exploded to the point that these marks have become substantial assets of the educational institutions.61 There is no question that, in terms of marketplace reality, there is serious "value" in certain trademarks. That perceived value, in turn, causes the students, in my example, to characterize the unlicensed vendor of the cap as opportunistically capitalizing on or exploiting someone else's efforts (i.e., the matrix of associations, positive and negative, conjured up by the Yankees logo) and assume that such conduct cannot be lawful. The fact of "value," and the possibility of its opportunistic exploitation, does not, however, automatically translate into creation of an independent right.

"Free riding" is a relativistic concept, without a real moral core. As Justice Kennedy observed in TrafFix, "copying is not always discouraged or disfavored."62 While the term is normally used pejoratively in referring to the unauthorized appropriation of someone else's goodwill, the courts have made it clear that the "free rider" is not necessarily an evildoer. Absent special and exceptional circumstances, plagiarism, in the sense only of the taking of another's ideas, generally is not actionable.63 Nor, of course, is copying of matter in the public domain. Similarly, one

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60 See Dogan & Lemley, supra note 29, noting that sports and college related trademark marketing generated more than $20 billion in revenues in 2003.

61 As one commentator noted in 2004, "The prevalence of collegiate licensing has skyrocketed in recent years. Today, approximately three hundred colleges and universities actively license the use of their names and registered trademarks. What began with a primitive licensing arrangement at the University of California at Los Angeles (UCLA) in the 1930s has blossomed into a multi-billion dollar industry." C. Knox Withers, Sine Qua Non: Trademark Infringement, Likelihood of Confusion, and the Business of Collegiate Licensing, 11 JIPL 421, 434 (2004).


who duplicates precisely the otherwise unprotected scent of, let us say, Chanel No. 5 perfume, and sells the resulting product, correctly labeled and accurately advertised as identical to the scent of Chanel No. 5, is certainly “free riding,” but has not violated trademark or any other rights of the competitor, even while “exploiting” the Chanel mark in so doing.64

Disapproval of the copyist’s opportunism may be an understandable first reaction, but this initial response to the problem has been curbed in deference to the greater public good. By taking his free ride, the copyist, albeit unintentionally, serves an important public interest by offering comparable goods at lower prices. On the other hand, the trademark owner, perhaps equally without design, sacrifices public to personal interests by seeking immunity from the rigors of competition.65

If one eliminates the opprobrium from “free riding,” then the shaky edifice supporting the application of trademark law to merchandising of the mark itself, built on an ephemeral assumption of what the law is, starts to collapse. In short, I would suggest that the assumption that the law requires consent of the trademark owner to merchandising of the mark itself, flows from “disapproval of the copyist’s opportunism,” rather than from a factual understanding of the world of merchandise licensing. Perhaps clarity can come from a re-framing, without the moral opprobrium: one who buys a logo-bearing item (a cap or mug or t-shirt, that is bought in order to show loyalty or affinity to the mark owner) from a vendor displaying an “official” sign, affirmatively stating sponsorship or affiliation between the vendor and the mark owner, may justifiably believe that such affiliation exists, so that the vendor who falsely makes such a statement would clearly be creating a likelihood of confusion as to “sponsorship.” On the other hand, if the consuming public were to believe that the law does not require a vendor selling such items to procure the consent of the trademark owner, then an unlicensed vendor, who does not make an affirmative statement of “official” sponsorship or affiliation, would not be creating a likelihood of confusion as to sponsorship.

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64 See, e.g., Smith v. Chanel, 402 F.2d 562 (9th Cir. 1968).
65 Id. at 569.
66 “[T]he world is full of free riding.” Dogan & Lemley, supra note 29 at 480; Wendy J. Gordon, On Owning Information: Intellectual Property and the Restitutionary Impulse, 78 VA. L. REV. 149, 167 (1992) (a culture could not exist if all free riding were prohibited within it).
67 But cf. Dogan & Lemley, supra note 29 at 478, suggesting that “the importance of competition counsels in favor of a narrower remedy even in these cases”).
Framed in those terms, on what basis, if at all, may liability be imposed? If one accepts both the intrinsic merchandising value of the mark and the tenuous relationship between recognition of an enforceable “merchandising right” and traditional trademark concepts, then how should the problem be addressed? It is not enough that the mark has “value,” as the fact of “value” per se does not generate a right. That is, the fact of “value” (or “interest,” or “injury”) may support a policy argument that there should be an appropriate right or remedy, but the ultimate policy decision is multi-faceted; the existence of “value” or similar interest is a necessary predicate to a policy determination but is not itself a sufficient basis for it.

B. Making Law II: The Troubles of Job’s Daughters:

The case law, such as it is, begins in 1975, with the strained Fifth Circuit analysis in Boston Hockey, which held that the unauthorized sale of “patches” containing logos of professional hockey teams infringed the teams’ trademarks. The court conceded that there was no customer confusion as to the source of the patches themselves, but, focusing on the teams as the intellectual “source” of the logos, found the unauthorized sale unlawful. Here, the court recognized that its decision would “slightly tilt the trademark laws from the purpose of protecting the public to the protection of the business interests of plaintiffs.”

Not surprisingly, given the shakiness of the rationale, the opinion drew sharp criticism and it was adamantly rejected by the Ninth Circuit in the 1980 Job’s Daughters opinion. Rejecting a trademark infringement claim for the unauthorized sale of rings bearing the logo of the plaintiff sororal organization, the court found Boston Hockey’s reasoning not only unpersuasive but misguided in that it “transmogrifies this narrow protection into a broad monopoly.” Noting that “our reading of the Lanham Act and its legislative history reveals no congressional design to bestow such broad property rights on trademark owners,” the court found the Boston Hockey “tilt” “not slight but an extraordinary extension of the protection heretofore afforded trademark owners.”

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68 Lemley, supra note 4, at 1706:
People buy products like hats and tee-shirts because they have the logo emblazoned on them. This is a rather striking reversal of the normal role of trademark law. Rather than identifying the good with a particular manufacturer, and thereby guaranteeing its quality, the identifier is itself the product. [T]he logo stands alone as a thing that customers value in and of itself.

69 Boston Professional Hockey Association v. Dallas Cap & Emblem Mfg., Inc., 510 F.2d 1004 (5th Cir.1975).

70 Id., 510 F.2d at 1011.

71 International Order of Job's Daughters v. Lindeburg & Co., 633 F.2d 912 (9th Cir.1980).

72 Id. 633 F.2d at 919.

73 Id. 633 F.2d at 918.

74 Id. 633 F.2d at 919.
Subsequent cases divided (and even the Fifth Circuit had some reservations). Perhaps the most interesting of these opinions is the Tenth Circuit's United States v. Giles. This was a criminal prosecution for sale of "counterfeit goods." The defendant sold patches consisting of trademarked logos, that purchasers could affix to products identified with the trademark owner (e.g., a "Coach" tag to be attached to a handbag). The court held that the criminal statutory provision relating to "counterfeit" goods "does not forbid the mere act of trafficking in counterfeit labels which are unconnected to any goods." While the criminal provisions, and standards for liability are of course different from the ordinary trademark infringement action, what is of interest here is the court's conclusion that, at least for purposes of the criminal statute, the logo itself (as embodied in the patch) was not "goods." Sharply criticizing Boston Hockey, ("the [Fifth Circuit there] relied upon a novel and overly broad conception of the rights that a trademark entails") the court, in language to be echoed by the Supreme Court in Dastar, concentrated on the laws' boundaries: since "a trademark is easily conceived of as an abstract symbol or design which is carried by the tangible goods at issue, [w]e will not stretch the trademark statute into an area more appropriate to copyright law.

The odd resultant question is whether any of this judicial analysis mattered, as the market apparently remained strangely unaffected by the vicissitudes of the courts. While the competing Boston Hockey/Job's Daughters split exemplifies the state of the law itself, and there appears to be both a vociferous condemnation of the Boston Hockey rationale, and an almost direct rejection of it by the Dastar discussion of

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In this Circuit, marks that are exploited only for their functional value and not to confuse the public receive no protection under unfair competition laws. Functionality in this context means that consumers desire the mark for its intrinsic value and not as a designation of origin. ... When a mark without copyright protection is exploited for its intrinsic functional value, Congress has implicitly determined that society's interest in free competition overrides the owner's interest in reaping monopoly rewards.


76 KFC v. Diversified Packaging Corp., 549 F.2d 368 (5th Cir. 1977).

77 213 F.3d 1247 (10th Cir. 2000).

78 Id. 213 F.3d at 1251.

79 "Mr. Giles' conduct did not confuse any consumer about the origin of goods because there were no goods involved in the transaction." Id. 213 F.3d at 1252.

80 Id. 213 F.3d at 1250.

81 Id. 213 F.3d at 1247, 1253.

82 "The Boston Hockey decision ... effectively precluded the unauthorized merchandising of famous trade symbols without the inconvenience of an explicit analysis." Denicola, supra note 11 at 607; see, e.g., Dogan & Lemley, supra note 29 at 478, who "conclude that there is no..."
“origin,” the public perception of a stand-alone merchandising right appears unchanged and the large financial engine for which it serves as the base charges forward. “[T]rademark owners, competitors, and perhaps even consumers act as though the merchandising theory is a fait accompli.”

Such a fait accompli, if it exists, is all the more remarkable in light of the virtual absence of serious congressional or judicial attention to the inherent policy question, what Robert Denicola, more than twenty years ago, described as “the persistent failure to address the central question—is it sensible to recognize a monopoly in the merchandising value of famous trade names and symbols?” Although the market reality, noted above, appears firm, as does the public acceptance of the right, the limited judicial approach to this matter, with its almost active avoidance of an attempt to articulate policy, is at best equivocal.

There is certainly a manifest need for dealing with the societal, policy question of whether there should be express legal recognition of commercial rights in a trademark itself, what we have called a merchandising right. So too, there are strong arguments to be made on that policy level. Thus, while Denicola proposes a form of recognition, Dogan & Lemley argue strongly against recognition of a merchandising right (an argument epitomized by their related argument against recognition of the trademark owner's claims where the mark is not being used on unrelated goods but is used on “knock-offs” of the trademark owner's products under circumstances in which the consumer is quite aware of the counterfeit nature of the seller’s activities). Nevertheless, in a significant sense, this policy debate, however interesting, has limited utility in the context of trademark law. That is, while the merchandising question usually involves use, in the form of direct trafficking, of a trademark, if there is to be, however limited or circumscribed, recognition of this kind of right, that recognition needs to have a more substantial basis than interpretation of trademark principles. In short, much as with the problem of attempting to fit the cybersquatting and related problems into a “trademark” framework, we must ultimately recognize that, however we collectively may resolve the policy question, such resolution must be done outside the parameters of trademark law. Once the circular nature of the “sponsorship confusion” is understood, then the trademark underpinnings for recognition of a merchandising right disappears; that is, the “merchandising” issue is outside the necessary boundaries of trademark law and if

83 See note 51, supra, and accompanying text
84 Dogan & Lemley, supra at 506.
85 Denicola, supra note 11 at 605.
86 Id.
87 Dogan & Lemley, supra, at 478 et seq.
88 Id. at 489-93.
any stand-alone rights are to be recognized, that recognition must be sui generis; outside of the “trademark” monopoly, some tertium quid.89

C. Making Law III; The Analogous Problem of the Right of Publicity

1. Context: The Nature of the Right of Publicity

The “merchandising right” issue has its analog at the state level—statutory and common-law—in the right of publicity and in the struggle of the courts to find appropriate boundaries for that troublesome and confusing construct. It is generally understood that that which we call the right of publicity began with a brief 1953 Second Circuit opinion90 by Judge Jerome Frank (one of the founders of the legal realist movement) holding that a celebrity91 has a right to damages and other relief for the unauthorized commercial appropriation of the celebrity’s persona and that such a right is independent of a common-law or a statutory right of privacy. By 1953, the courts and the legislatures of the various states had come to recognize a “right of privacy,” in the sense of a personal, subjective interest in anonymity. The task for Judge Frank in Haelan was to separate and differentiate this new “right of publicity” from its ties to the earlier right of privacy.94

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91 For present purposes, the right of publicity is considered peculiarly celebrity based, arising only in the case of an individual who has attained some degree of notoriety or fame. See Rogers v. Grimaldi, 875 F.2d 994, 1003-04 (2nd Cir.1989)(“The common law right of publicity, where it has been recognized, grants celebrities an exclusive right to control the commercial value of their names and to prevent others from exploiting them without permission”). Although commentators disagree over whether “celebrity” is a necessary element of the cause of action or relates only to the extent of damages sustained, in practice that debate is largely academic. See, e.g., Martin Luther King, J., Ctr. for Social Change, Inc. v. American Heritage Prods., Inc., 296 S.E.2d 697, 702 (Ga. 1982). See also Tim Frazer, Appropriation of Personality — A New Tort?, 99 LAW Q. REV . 281, 308 (1983). But cf. Roberta Rosenthal Kwall, Is Independence Day Dawning for the Right of Publicity?, 17 U.C. DAVIS L. REV. 191, 202-03 (1983) (advocating recognition of a “universal” right of publicity).


New York’s [privacy statute] protects a person’s feelings and right to be let alone, ... interests also protected in California, Illinois, and Georgia. Relief is available under the applicable privacy law only for acts that invade plaintiffs’ privacy and consequently bruise their feelings. Chief Justice Bird’s analysis of the California statute in Lugosi v. Universal Pictures, 25 Cal.3d 813, 842 n. 23, 603 P.2d 425, 443 n. 23, 160 Cal.Rptr. 323, 341 n. 23 (1979) (Bird, C.J., dissenting), makes clear that its primary purpose, like that of common law privacy, is to protect the feelings and privacy of the “little man.”

94 See generally, Sheldon W. Halpern, THE LAW OF DEFA MATION, PRIVACY, PUBLICITY AND MORAL RIGHT: CASES AND MATERIALS ON PROTECTION OF PERSONALITY INTERESTS, Ch. 3.
This separation was predicated on recognition of the decidedly different and purely economic interests in the commercial value of persona. Judge Frank's focus was on what has since been described as "the marketable product [consisting of] the ability of a person's name or likeness to attract the attention and evoke a desired response in a particular consumer audience. That response is a kind of good will or recognition value generated by that person. ... While this product is concededly intangible, it is not illusory."

The *Haelan* decision became the foundation for what is now a widely recognized state common law or statutory right, whose independence from whatever privacy-based roots it might have had is generally acknowledged. Thus, Section 46 of the Third Restatement of the Law of Unfair Competition expressly acknowledges the independent right of publicity:

**Appropriation of the Commercial Value of a Person's Identity: The Right of Publicity.** One who appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade is subject to liability for [monetary and injunctive] relief.

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95 As the Tenth Circuit observed many years later, "publicity rights ... are meant to protect against the loss of financial gain, not mental anguish." Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 976 (10th Cir. 1996).


98 In California, it is both a common law and a statutory right. See e.g., Abdul-Jabbar v. General Motors Corp., 85 F.3d 407, 414 (9th Cir. 1996).

99 For a comprehensive examination of the right of publicity, its relation to the other interests, and a detailed examination of the state and federal, common-law and statutory treatment of the subject, see generally J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY (2d Ed. 2000). Judge Frank's opinion in *Haelan* is unequivocal in its assumption of that the New York Court of Appeals would recognize a common law right of publicity distinct from its statutory privacy right. It is, of course, rather ironic that when the New York court finally addressed the question, some thirty years later, it held to the contrary ("Since the 'right of publicity' is encompassed under the Civil Rights Law as an aspect of the right of privacy, which ... is exclusively statutory ..., the plaintiff cannot claim an independent common-law right of publicity. Stephano v. News Group Publications, Inc., 474 N.E.2d 580, 583 (N.Y. 1984), leaving New York as a prominent exception to the generally recognized proposition concerning the separate status of the right of publicity.

The historical development of the right of publicity, its relation to the right of privacy, its emergence as an independent right, and the maturation and general recognition of that right have been fully described elsewhere.\footnote{This now fully mature state-based right is recognized generally either by specific statute or by state common law as protecting the economic interest in an individual’s persona. As noted above, for practical purposes, the right is celebrity based: for good or ill, the phenomenon of celebrity generates commercial value. As opposed to that of the “private” person, the celebrity’s persona carries with it what has been termed an associative value, the perceived ability to confer value on that which might be associated with the celebrity; i.e., the right of publicity “does not protect one’s name per se; rather, it protects the value associated with that name.”}{103}

We accept, as a matter of course, that celebrity will frequently carry with it a marketable component separate from those activities which initially produced the status itself. Thus, for example, there is a difference between the value that a successful golf professional such as Tiger Williams gives to an instructional video about golf and the merchandising value that use of his name imparts to a line of T-shirts. It is that latter iteration of the economic value of a persona that informs the right of publicity. However socially useful or detrimental this marketing attribute of celebrity may be,

\[\text{[i]t would be difficult for any court ... to be unaware of the manner in which celebrities exploit the public’s recognition of their name and image. ... There are few every day activities that have not been touched by celebrity merchandising. ... These endorsements are of great economic value to celebrities and are now economic reality.}^{104}\]

The issue of “value,” as the Ninth Circuit has observed, is not a function of merit or desert; rather, it is simply a matter of market place reality:

\text{Television and other media create marketable celebrity identity value. Considerable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit. The law protects the celebrity’s sole right to exploit this value whether the celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof.}^{105}


\footnote{“At its heart, the value of the right of publicity is associational.” McFarland v. Miller, 14 F.3d 912, 919 (3d Cir. 1994). \textit{See generally}, Halpern, \textit{supra} note 92.}{102}

\footnote{Matthews v. Wozencraft, 15 F.3d 432, 437 (5th Cir. 1994); Comedy III Productions, Inc. v. Gary Saderup, Inc., 25 Cal.4th 387, 403, 106 Cal.Rptr.2d 126, 139, 21 P.3d 797, 807 (2001)(“the right of publicity is essentially an economic right”).}{103}

\footnote{Tennessee ex rel. Presley Int’l Memorial Found. v. Crowell, 733 S.W.2d 89, 94 (Tenn. Ct. App. 1987).}{104}

\footnote{White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1399 (9th Cir. 1992), \textit{cert. denied}, 508}{105}
Of course, as discussed supra, the simple assertion of economic reality, understanding that something has value, does not lead inexorably to the conclusion that the law must protect that value. The emergence and maturation of the right of publicity reflects an American societal determination, through the courts and the legislatures, that the individual’s interest in the associative value of his or her persona merits legal protection. When the court observes, as above, that “the law protects” the interest, it articulates the policy determination made by the courts and various state legislatures to provide that legal recognition. (That determination is by no means universal, as jurisdictions outside of the United States continue to struggle with the fundamental policy determination whether that marketplace reality justifies legal recognition of the interest; suffice it to say that the American model has become increasingly popular.\textsuperscript{106})

2. The Right of Publicity and Trademark

The economic reality of a marketable associative value of the personae of some people both distinguishes the right of publicity from privacy rights and establishes its kinship with trademark rights. In essence, as discussed infra, both are forms of “appurtenant” rights. It is not a mere coincidence that recognition of the independent nature of the right of publicity is found in the American Law Institute’s Restatement of the Law of Unfair Competition, displacing its earlier home in the Restatement of Torts. So too, it is not mere coincidence that as the right of publicity has matured, it has been increasingly connected to trademark rights. As a matter of practice, it is quite common to couple allegations of violation of the right of publicity with claims for trademark infringement under the Lanham Act, either as registered marks (when the plaintiff’s name has in fact been registered), or as unregistered marks under section 43(a).\textsuperscript{107} Although “as a general rule, a person’s image or likeness cannot function as a trademark,\cite{15 USC §§1114, 1125(a); ETW Corp. v. Jireh Publishing, Inc., 332 F.3d 915 (6th Cir. 2003); White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1399 (9th Cir. 1992), cert. denied, 508 U.S. 951, 113 S. Ct. 2443 (1993); Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992).\textsuperscript{108} ETW Corp. v. Jireh Publishing, supra, 332 F.ed at 922, 925.\textsuperscript{109} Id. at 924.\textsuperscript{108}} courts have recognized false endorsement claims under Section 43(a) of the Lanham Act where a celebrity’s image or persona is used in association with a product so as to imply that the celebrity endorses the product.\textsuperscript{108} To a fair extent, this use of Section 43(a) creates a federal variant of the state law right of publicity claim.\textsuperscript{109}

\textsuperscript{106}See Huw Beverley-Smith, The Commercial Appropriation of Personality 2002 (discussing activities in the United Kingdom and other jurisdictions relating to their versions of the right of publicity). “[t]o American lawyers, the whole project [i.e., the United Kingdom inquiry into the extent to which to recognize these rights] may have a vaguely nineteenth-century feel, as the English courts continue to debate whether to recognise interests that the US courts have recognised and protected in various forms for over a century.” Id. at xi.


The federal variant is, to be sure, not a true analogue. For the Section 43(a) claim, as with any trademark claim, the allegedly wrongful use must create a “likelihood of confusion” with respect to the source, origin, or endorsement or sponsorship of goods or services. In the classic right of publicity situation, the appropriation of the associative value of the persona would normally give rise at least to confusion as to "endorsement" of the user's goods or services.\textsuperscript{110} But such "endorsement" confusion, while often present, is not essential to the publicity claim, if one can otherwise demonstrate that the value of the persona has been associated with the offending product. "Although publicity rights are related to laws preventing false endorsement, they offer substantially broader protection."\textsuperscript{111} In any event, the kinship between the federal trademark construct and the widely recognized state law right is evident and the experience with each may usefully inform the process of creating appropriate boundaries for each.

3. The Boundaries Inherent in the Right of Publicity

The right of publicity involves a communicative tort; it necessarily implicates speech and therefore raises First Amendment concerns. The interconnection between publicity rights and First Amendment rights to free expression has caused a fair amount of judicial anguish and accompanying complexity in dealing what would otherwise seem to be a rather simple issue. As the comments to the Restatement (Third) of Unfair Competition note, “[t]he right of publicity as recognized by statute and common law is fundamentally constrained by the public and constitutional interest in freedom of expression.”\textsuperscript{112} This constraint is part of the very nature of the right, however, as any claim must be based on the commercial appropriation of identity; news, information, even entertainment uses, by the very definition of the right, are outside its scope. Thus, while using a celebrity as the subject of a book, or a play, or magazine or newspaper articles, usually involves a measure of gain for the author or publisher, such entertainment or newsworthy uses are beyond the reach of the right of publicity.\textsuperscript{113} The broad “newsworthiness” shelter\textsuperscript{114} that insulates many

\textsuperscript{110} Id.

\textsuperscript{111} Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 967 (10th Cir. 1996): Suppose, for example, that a company, Mitchell Fruit, wanted to use pop singer Madonna in an advertising campaign to sell bananas, but Madonna never ate its fruit and would not agree to endorse its products. If Mitchell Fruit posted a billboard featuring a picture of Madonna and the phrase, “Madonna may have ten platinum albums, but she's never had a Mitchell banana,” Madonna would not have a claim for false endorsement. She would, however, have a publicity rights claim, because Mitchell Fruit misappropriated her name and likeness for commercial purposes. Publicity rights, then, are a form of property protection that allows people to profit from the full commercial value of their identities. Id. at 967-68. See also Abdul-Jabbar v. General Motors Corp., 85 F.3d 407 (9th Cir.1996).

\textsuperscript{112} Restatement (Third) of the Law of Unfair Competition §46, Comment c (1995).

\textsuperscript{113} As well as direct statutory formulation in many jurisdictions. See, McCarthy, supra note 99.


\textsuperscript{115} The newsworthiness limitation “is one of constitutional dimension ... controlled by federal
uses of an individual's identity from right of privacy claims is no less applicable to the right of publicity, and has been the means by which the courts have consistently defined the ambit of constitutionally protected dissemination of ideas. As the Restatement of the Law of Unfair Competition makes clear, the right of publicity does not ordinarily extend to "the use of a person's identity in news reporting, commentary, entertainment, or in works of fiction or nonfiction or in advertising that is incidental to such uses." As I have suggested elsewhere:

The right of publicity does not reach beyond the interest it is designed to protect, i.e., the associative value, the hard economic commercial value of an individual's identity, and thus is limited to commercial exploitative uses. It is this exploitative appropriation of a property interest, and not simply a formulaic approach to commercial speech, that precludes First Amendment protection for the appropriator. As a result, for the most part, First Amendment policy considerations have little impact on the avowedly commercial appropriation of identity, the classic right of publicity case.

In short, despite some judicial indulgence in a kind of deconstructive critique of the right itself, as properly understood, the right of publicity is not inconsistent with newsworthy, entertainment, critical, satirical, or parodic uses. A television program that simply provides information about an athlete's achievements would not implicate the right of publicity, whereas such implication would arise from a television advertisement that uses that information about an athlete to call attention to and to frame the advertiser's commercial advertising; the liability arises not simply from the


116 See Halpern, supra note 94, §2.5 ("Newsworthiness" may be found in the plaintiff's status as a "public figure" or in the legitimate public interest in the subject matter. However it arises, it confines the right of privacy). See, e.g., Freihofer v. Hearst Corp., 65 N.Y.2d 135 (1985).

117 Halpern, supra, note 94, §3.3(B).


120 Halpern, supra note 101, at 868.

121 Cf. the rather labored analysis in Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959 (10th Cir. 1996); see also, C.B.C. Distribution and Marketing, Inc. v. Major League Baseball Advanced Media, L.P., 505 F.3d 818 (8th Cir. 2007).

122 Thus for example, the court in Cardtoons, supra, noted: "Because celebrities are an important part of our public vocabulary, a parody of a celebrity does not merely lampoon the celebrity, but exposes the weakness of the idea or value that the celebrity symbolizes in society." Cardtoons, L.C. v. Major League Baseball Players Ass'n, 95 F.3d 959, 972 (10th Cir. 1996).

123 As the Comments to the Restatement of Unfair Competition put it: "The use of a person's identity primarily for the purpose of communicating information or expressing ideas is not generally actionable as a violation of the person's right of publicity." Restatement (Third) of the Law of Unfair Competition §47, Comment c (1995)
mere fact of using the athlete's name, but in doing so in a manner that associates the athlete with the product.\textsuperscript{124}

Despite the occasional commentary viewing the right of publicity with alarm,\textsuperscript{125} except perhaps at the margins, the right easily coexists with the First Amendment.

Even at the margins, as with related trademark issues, the courts have been quite ready to recognize and address appropriate First Amendment concerns. As the Second Circuit observed in \textit{Rogers v. Grimaldi},\textsuperscript{126} involving both trademark and right of publicity claims arising out of the use of a well-known actress' name in the title of a motion picture:

Because overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict. ... We believe that in general the Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.\textsuperscript{127}

So too, a sophisticated, nuanced approach, predicated on an understanding of the associative, appurtenant nature of the right of publicity can obviate apparent problems. For example, in \textit{Rogers}, Judge Newman observed that the use of the name of the actress Ginger Rogers in the phrase “Fred and Ginger,” as part of the title of a motion picture about the travails of an Italian dance team, was not an appropriation of her name, or exploitation of the value of her name. Rather, her “name” was used in an iconic sense, a kind of shorthand in which the phrase “Fred and Ginger” did not refer so much to the specific people (Fred Astaire and Ginger Rogers) as it did to the form of elegant ballroom dancing that they had come to represent.\textsuperscript{128} That is, some aspect of a celebrity may transcend his or her own persona and become evocative of a more general, if not generic concept involving use of language rather than use of persona. The inappropriateness of the right of publicity in such a situation is self-evident. Although much may be said in favor of categorical rules under appropriate circumstances,\textsuperscript{129} in dealing with the interface between language and persona, the

\textsuperscript{124}Abdul-Jabbar v. General Motors Corp., 85 F.3d 407 (9th Cir.1996).


\textsuperscript{126}875 F.2d 994 (2nd Cir.1989).

\textsuperscript{127}Id. at 998.

\textsuperscript{128}Id. at 1001:

As Fellini explains in an affidavit, Rogers and Astaire are to him “a glamorous and care-free symbol of what American cinema represented during the harsh times which Italy experienced in the 1930s and 1940s.” In the film, he contrasts this elegance and class to the gaudiness and banality of contemporary television, which he satirizes.

idea of “name” is much too flexible to give rise to a categorical rule supplanting analysis. 130

The scope of a rule is often ... limited by its rationale. Or, to make the same
point differently, one way of going astray in legal analysis is to focus on the
 semantics of a rule rather than its purpose. 131

To Shakespeare’s question, “what’s in a name?,” the lawyer looking at a trademark of
publicity claim might well respond “it depends on the circumstances.”

Such a circumstantial analysis (applied to the image evoked by Vanna White)
might well have been used to avoid the controversial result in the Ninth Circuit’s
White v. Samsung opinion. 132 A nuanced analysis of publicity claims would recognize
that use of a name or image or other indicia of persona does not per se implicate the
right of publicity, that a contextual analysis of the use is necessary in order to
determine if there has been an appropriation of the associative value of the persona.
That analytic model, rather than a categorical conclusion, provides one of the
requisite boundaries that allows a robust right of publicity to exist easily with free
expression. We should consider merchandising and the right of publicity within the
context of these boundaries, just as we must consider merchandising and trademark
rights within the context of the proper boundaries of trademark law.

4. Publicity and “Merchandising Rights:
Perhaps the most interesting boundary, albeit one that seems counterintuitive,
concerns a kind of “merchandising” right, analogous to the attempt to create
independent rights in a trademark itself (discussed supra). Briefly, I believe that the
right of publicity, if fully understood as an appurtenant, associative right, is

130 Compare Peaceable Planet v. Ty Inc., 362 F.3d 986, cert. denied 543 U.S. 869 (7th Cir.
2004), involving the name “Niles” for a toy stuffed camel, in which Judge Posner refused to apply
a categorical rule with respect to trademark distinctiveness and “names” merely because the mark
at issue could also serve as a person’s name.

131 Id., 362 F.3d at 989-90.

132 White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1396 (9th Cir. 1992), cert. denied, 113
S. Ct. 2443 (1993). The case involved a Samsung advertisement for a videocassette recorder that
pictured a robot, dressed in a wig, gown, and jewelry “consciously selected to resemble [Vanna]
White’s hair and dress. The robot was posed next to a game board which is instantly recognizable
as the Wheel of Fortune game show set, in a stance for which White is famous.” 971 F.2d at 1396.
As I noted elsewhere:

In this context, it is arguable that the defendants did not so much appropriate Vanna White’s
identity as they used it to evoke the subject (i.e., the Wheel of Fortune game show) with which
she has been associated. ... Arguably, it is not Vanna White, but a role she has come to
epitomize, that was the subject of the advertisement. One may well claim that for purposes of
Wheel of Fortune or a similar game show, Vanna White has become “generic,” her name and
general “dressed-up” appearance a shorthand way of referring to a type, so that any other woman,
similarly dressed and performing a similar act, even if otherwise totally unlike White, might be
described as being another “Vanna.” ... The defendants used the White stereotype, but not
necessarily to evoke her. The “generic” defense was rejected by the White majority, but without
serious analysis of its specific application to the facts there.

Halpern, supra note 101, at 864-65.
Inapplicable to commercial use of the persona itself independent of an association with another person or another’s goods or services. In short, just as a trademark, per se, is not an independent form of property and trademark law, as properly understood, should not be construed to embrace a separate merchandising right in a trademark, the right of publicity, that associative economic construct, is not an independent form of property in persona and therefore it similarly should not be construed to embrace an independent merchandising right.

Before the right of publicity emerged from its privacy moorings, and was simply, and erroneously, considered the “appropriation branch” of the right of privacy, it was assumed that, just as with the right of privacy, any trafficking in anyone’s image for commercial purposes gave rise to a claim (within the statutory or common law limitations). In the context of the right of privacy, a clearly commercial public dissemination of an individual’s image, without consent, will support a privacy claim by the person pictured. The only serious issue in privacy litigation in those circumstances would be whether the otherwise commercial use could be saved by some reasonable tie to “newsworthiness.” Accordingly, in that privacy context, our concern is solely with the public and commercial dissemination of the image—association with the person disseminating that image or with any goods or services would be irrelevant. Thus, when Time, Inc., as the owner of the well known Eisenstadt photograph, The Kissing Sailor, attempted, many years after the initial (and clearly newsworthy) publication of the photo, to offer copies of the photo for sale to the public, the court had little difficulty upholding a cause of action by the pictured “sailor” for violation of his right of privacy.

On superficial analysis, it seems quite logical to transfer this privacy-based proposition to the right of publicity. Thus, there was no question, under Georgia law, that if Dr. Martin Luther King’s right of publicity were descendible, his estate would have a claim against one who sold, without consent, statuettes of Dr. King. The Georgia Supreme court, certifying to the federal court, recognized the descendibility and consequently the viability of the cause of action for violation of the late Dr. King’s “right of publicity.” Similarly, the estate of Elvis Presley has vigorously pursued right of publicity claims against those purporting to sell Presley photos or

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133 See Titan Sports, Inc. v. Comics World Corporation, 870 F.2d 85 (2d Cir. 1989).
134 See, e.g., Messenger v. Gruner + Jahr Printing and Publishing, 94 N.Y.2d 436 (2000);
136 Mendonsa v. Time, Inc., 678 F. Supp. 967 (D.R.I. 1988). Alfred Eisenstadt took the photograph of an unnamed sailor kissing a nurse in celebrating the end of World War II in 1945 and it was contemporaneously published in Life magazine as part of the news story.
137 Id.
memorabilia. More recently, right of publicity claims were brought against the sale of lithographs and T-shirts bearing drawings of the images of the Three Stooges and serigraphs and lithographs of a painting of the professional golfer, Tiger Woods. As discussed below, the courts in these cases assume the applicability of the common law or statutory rights of publicity to the defendants' use of the images. The issue in the litigation, rather, was whether the court should construct a complex "fair use" or first amendment "exception" to the right.

In the Three Stooges case (Comedy Central v. Saderup), the California Supreme Court, while ultimately holding for the plaintiff (the assignee of the Stooges' publicity rights) sought to "resolve a conflict" between the right of publicity and the first amendment and to "to develop a test that will unerringly distinguish between forms of artistic expression protected by the First Amendment and those that must give way to the right of publicity." It proposed borrowing the "fair use" construct of "transformative use" from the United States Supreme Court's copyright opinion in Campbell v. Acuff-Rose Music, Inc. The court found the Campbell inquiry into whether a work is "transformative" to be necessarily at the heart of any judicial attempt to square the right of publicity with the First Amendment.

When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain directly trespassing on the right of publicity without adding significant expression beyond that trespass, the state law interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist. ... On the other hand, when a work contains significant transformative elements, it is not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity.

We ask, in other words, whether a product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness.


144 Comedy III Productions, Inc. v. Gary Saderup, Inc., supra, 25 Cal.4th at 404, 106 Cal.Rptr.2d at 139-140, 21 P.3d at 808.
In sum, when an artist is faced with a right of publicity challenge to his or her work, he or she may raise as affirmative defense that the work is protected by the First Amendment inasmuch as it contains significant transformative elements or that the value of the work does not derive primarily from the celebrity's fame.\textsuperscript{145} Concluding that the defendant's drawings, however skillful they might be, were simply appropriative of the images without any transformative effects, the court held for the plaintiff.\textsuperscript{146}

In \textit{ETW}, the divided Sixth Circuit panel concluded that the painting at issue "has substantial informational and creative content which outweighs any adverse effect on ETW's market and that [the] work does not violate Woods's right of publicity."\textsuperscript{147} The court then expressly adopts the Ninth Circuit's \textit{Comedy III} "transformative use" model and, holding that the defendant's image of Tiger Woods in the \textit{Masters of Augusta} painting\textsuperscript{148} sold by defendant was sufficiently "transformative," concludes that "Woods's right of publicity must yield to the First Amendment."\textsuperscript{149}

These judicial approaches to merchandising the persona itself, much like merchandising a trademark itself, are at best needlessly complex and, more seriously, less than helpful in providing a consistent and predictable set of limits on the right of publicity. Thus, while two members of the \textit{ETW} panel found the painting "transformative" and protected, the third vigorously dissented and called for summary judgment for the plaintiff on the right of publicity claim; the dissent, while also adopting the \textit{Comedy III} framework, found nothing "transformative" in the defendant's work ("it is difficult to discern any appreciable transformative or creative contribution in Defendant's prints so as to entitle them to First Amendment protection").\textsuperscript{150}

\textsuperscript{145} \textit{Id.} at 405-407, 106 Cal.Rptr.2d at 140-142, 21 P.3d at 808-810.

\textsuperscript{146} "we can discern no significant transformative or creative contribution. His undeniable skill is manifestly subordinated to the overall goal of creating literal, conventional depictions of The Three Stooges so as to exploit their fame." \textit{Id.} at 408, 106 Cal.Rptr.2d at 143, 21 P.3d at 811.

\textsuperscript{147} \textit{ETW Corp. v. Jireh Publishing, Inc.}, 332 F.3d 915, 937 (6th Cir. 2003).

\textsuperscript{148} As the court describes it:
In the foreground of Rush's painting are three views of Woods in different poses. In the center, he is completing the swing of a golf club, and on each side he is crouching, lining up and/or observing the progress of a putt. To the left of Woods is his caddy, Mike "Fluff" Cowan, and to his right is his final round partner's caddy. Behind these figures is the Augusta National Clubhouse. In a blue background behind the clubhouse are likenesses of famous golfers of the past looking down on Woods. \textit{Id.} at 918.

\textsuperscript{149} \textit{Id.} at 938.

\textsuperscript{150} \textit{Id.} at 959 (Clay, J., dissenting)
Post hoc determinations of what is “transformative” are inherently idiosyncratic. As the California Supreme Court itself points out in Comedy III, the copyright fair use analogy is an imperfect guide for use in analyzing the right of publicity.\textsuperscript{151} It is abundantly clear, from the complex, lengthy, and somewhat tortured exercises of the courts in dealing with the problem of marketing the persona itself, that the courts are uncomfortable. The attempt to engraft onto the right of publicity the highly nuanced copyright fair use construct in these circumstances, much as the related application of the copyright “first sale” doctrine to shelter re-sales of a celebrity image,\textsuperscript{152} reflects this discomfort; it is a recognition that the right of publicity does not really fit here. We must of course use the best tools available under the circumstances and quite often (as can be the case with categorical rules) predictability and consistency are not necessarily the optimal result. Certainly, the law, and many areas of intellectual property law in particular, must accommodate to uncertainty; living with post-hoc determinations and their consequence of limited predictability is often the optimal approach to some complex problems.\textsuperscript{153} But we should choose the path of uncertainty only where there is not a viable and more predictable alternative consistent with the underlying legal principles. It seems to me that with respect to the right of publicity analogue to “merchandising” rights, there is such an alternative, predicated on the inherent nature of the right of publicity.

Briefly, a sophisticated understanding of the right of publicity (as distinct from its privacy antecedent) as a right appurtenant, much like a trademark, whose function is to protect the interest in the economic associative value of a well known persona, leads to the conclusion that the right does not itself extend to exploitation of the persona standing alone. In Comedy III Judge Mosk expressly rejected the suggestion that, for right of publicity liability under the California statutes, the sale of the images themselves, as embodied in lithographs and T-shirts did not amount to the use of the images “on or in products” or merchandise, as required by California law; he found instead that

Saderup’s lithographic prints of The Three Stooges are themselves tangible personal property, consisting of paper and ink, made as products to be sold and displayed on walls like similar graphic art. Saderup’s T-shirts are likewise tangible personal property, consisting of fabric and ink, made as products to be sold and worn on the body like similar garments.\textsuperscript{154}

\textsuperscript{151} Comedy III Productions, Inc. v. Gary Saderup, Inc., 25 Cal.4th 387, 404, 106 Cal.Rptr.2d 126, 139, 21 P.3d 797, 807 (2001)(“ a wholesale importation of the fair use doctrine into right of publicity law would not be advisable”).

\textsuperscript{152} Allison v. Vintage Sports Plaques, 136 F.3d 1443 (11th Cir. 1998).

\textsuperscript{153} The copyright construct of fair use is certainly a prime example of that kind of necessary uncertainty; “the doctrine of fair use is the most troublesome in the whole law of copyright.” Dellar v. Samuel Goldwyn, Inc., 104 F.2d 661, 662 (2d Cir. 1939). See Pierre Leval, \textit{Toward a Fair Use Standard}, 103 Harv. L. Rev. 1105-07 (1990). Similarly, the courts have had to accommodate to the inherent unpredictability in applying the doctrine of “conceptual separability” to articles of industrial design. See, \textit{e.g.}, Brandir International, Inc. v. Cascade Pacific Lumber Co., 834 F.2d 1142 (2d Cir. 1987).

\textsuperscript{154} Comedy III Productions, Inc. v. Gary Saderup, Inc., 25 Cal.4th 387, 394-395, 106
The court here skimmed the surface of the question and could well have pursued it more deeply. The matter is reminiscent of that in the Tenth Circuit’s Giles opinion,155 with its holding that patches and labels bearing counterfeit trademarks are not “goods” for purposes of the criminal statute.156 If we start with the fundamental construct of associative value157 on which the right of publicity is predicated, then conceptually that right is not implicated absent circumstances in which the persona is associated with another’s product or service.158 Indeed, it is that association, the imparting of the economic value of the persona to something else, that lies at the heart of the separation of publicity rights from privacy rights and distinguishes this economic right. We do not need to resolve here the question whether a celebrity, someone who has chosen to be exposed regularly to the public, can assert traditional privacy rights.159 Nor is the general issue of rights under specific privacy statutes within the scope of the present discussion. The concern here is simply over the assertion of statutory160 or common law right of publicity claims in connection solely with the merchandising of the persona itself, as in ETW or Comedy III. If such claims are to be sustained, the rationale for doing so is inherently different from that upon which the right of publicity is based and therefore, they must be founded on something other than the right of publicity.

Realistically, in that context what is being sold is the image itself and not something else to which that image might lend value. The fact that the image is embodied tangibly in the paper of a lithograph or the fabric of a T-Shirt should no more, standing alone, implicate an association of the person depicted with the seller,


155 United States v. Giles. 213 F.3d 1247 (10th Cir. 2000).

156 See notes 77-81, supra, and accompanying text.

157 Supra, notes 102-106, and accompanying text.


We conclude that the district court properly determined that, as a matter of law, Vintage merely resells cards that it lawfully obtains. ...We think it unlikely that anyone would purchase one of Vintage's plaques for any reason other than to obtain a display of the mounted cards themselves. Although we recognize that the plaques that include a clock pose a closer case, we conclude that it is unlikely that anyone would purchase one of the clock plaques simply to obtain a means of telling time, believing the clock to be, for example, a “Hershisher Clock” or an “Allison Clock.”

159 Compare Bi-Rite Enterprises, Inc. v. Button Master, 555 F. Supp. 1188, 1198 (S.D.N.Y. 1983) (“as public figures, with their likenesses, names and images already in the public domain, [plaintiffs] have waived their rights to claim intrusions into their common law privacy rights”) and Ann-Margret v. High Society Magazine, Inc., 498 F. Supp. 401, 404 (S.D.N.Y. 1980) (“It is clear that a public figure does not, simply by virtue of his or her notoriety, lose all rights to privacy”).

160 Of course, there are many statutory variations on the right, with a plethora of specific limitations and exceptions; see generally McCarthy, supra note 99.
than the embodiment of the “Job’s Daughters” insignia in a signet ring implicates the trademark rights of the International Order of Job’s Daughters. 161

CONCLUSION:

APPLYING OCCAM’S RAZOR TO PRESERVE THE FUNDAMENTAL BALANCE

The approach to merchandising rights with respect both to trademarks and celebrity images has been needlessly complex and demands simplification. The Supreme Court, with its strong admonition to restore and recognize the balance among the different intellectual property constructs, has provided the broad framework within which such simplification can be realized. We start by recognizing that trademark rights are essentially appurtenant, conditional rights, rather than self-sustaining property rights. That leads to the conclusion that trademark law cannot be the vehicle for enforcing claims arising out of the merchandising of the mark itself, absent clear evidence of real (rather than spurious) consumer confusion as to source, origin, or sponsorship of goods or services. 162 In the same vein, the right of publicity, if properly understood and bounded, similarly is an appurtenant right, rather than an absolute exclusionary right in a name or image; that recognition accordingly precludes a publicity claim based solely on exploitation of the image itself without association with the user of the image. A focus on the fundamental nature of the underlying legal constructs of trademark law and of the cognate right of publicity allows application of a conceptual occam’s razor, a simplification that sets the proper boundaries and balance.


162 “The zeal to protect the full value of marks, and the feelings and economic interests that fuel it, ... cannot negate the fact that unfair competition law clearly requires confusion as to the source of goods before it will protect against the unauthorized use of a mark.” Bi-Rite Enterprises, Inc. v. Button Master, 555 F. Supp. 1188, 1194 (S.D.N.Y. 1983).