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## Big Boi, Dr. Seuss, and the King: Expanding the Constitutional Protections for the Satirical Use of Famous Trademarks

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# Big Boi, Dr. Seuss, and the King: Expanding the Constitutional Protections for the Satirical Use of Famous Trademarks

## **Keywords**

Trademark, Copyright, Trademark law, Copyright law, Constitutional law, Trademark Incorporation, Famous Marks, Second Circuit Test

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COMMENTS

BIG BOI, BARBIE, DR. SEUSS, AND THE  
KING: EXPANDING THE  
CONSTITUTIONAL PROTECTIONS FOR  
THE SATIRICAL USE OF FAMOUS  
TRADEMARKS

AARON F. JAROFF\*

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## INTRODUCTION

May 29, 2002, was a day that started like so many others for the average American commuter. Wake up, shower, eat breakfast, and perhaps glance at the stories in the morning's paper. But on this morning the shocking headline read "Congress Threatens to Leave D.C. Unless New Capitol is Built,"<sup>1</sup> certainly a surprising piece of journalism from the *New York Times* or *Washington Post*, but not from *The Onion*, one of today's most well-known satirical publications.<sup>2</sup> Since *The Onion's* humble beginnings as a "fake news" newspaper at the University of Wisconsin, it has rapidly found popularity and success on both the Internet and in print,<sup>3</sup> and is just one of the many examples of cultural satire that can be found in practically every available expressive medium.<sup>4</sup>

The majority of Americans who read *The Onion* article reporting that Congress was threatening to leave Washington unless a new Capitol was built<sup>5</sup> likely recognized it as a clear satire of both the penchant of sports teams to demand new stadiums and the potential fickleness of some of the fans who follow them.<sup>6</sup> However, this was not understood by the official news service of the People's Republic of China, which reported the story as fact after it was lifted from *The Onion's* website by a staff reporter.<sup>7</sup>

1. *Congress Threatens to Leave D.C. Unless New Capitol is Built*, THE ONION, May 29, 2002, <http://www.theonion.com/content/node/27828> [hereinafter *Congress Threatens to Leave D.C.*].

2. Geoff Keighley, *The Onion: Funny Site is No Joke*, CNN.COM, Aug. 29, 2003, <http://edition.cnn.com/2003/TECH/ptech/08/28/bus2.featur.onion.site/index.html>.

3. See *id.* (reporting the profitability and continued expansion of *The Onion*).

4. See Sam Schechner, *Press 'Play' for Satire*, WALL ST. J., Mar. 23, 2007, at W3 (noting that the satirical news genre occupied by *The Onion* and "The Daily Show" is becoming increasingly competitive).

5. *Congress Threatens to Leave D.C.*, *supra* note 1.

6. See, e.g., Jessica Kowal, *As Sonics Pack to Leave Town, Seattle Shrugs*, N.Y. TIMES, Nov. 13, 2006, at A20, available at <http://www.ihl.com/articles/2006/11/13/news/seattle.php> (discussing the possible move of the NBA's Seattle SuperSonics to Oklahoma City after Seattle voters rejected a ballot measure providing subsidies for a new arena); see also MAJOR LEAGUE (Mirage 1989) (lambasting the desire of owners to move sports teams to newer stadiums in profitable cities via a comedic movie about the threatened relocation of the Cleveland Indians baseball team).

7. Henry Chu, *Reeled in by a Spoof, Chinese Daily Shrugs Off Its Capitol Error*, L.A. TIMES, June 8, 2002, at A3.

While the article published by *The Onion* seemed harmless, and the confusion that it caused was merely amusing, it potentially ran afoul of trademark law, exposing the editors of the paper to a possible infringement action.<sup>8</sup> Trademark law is designed to protect the consumer against confusion in the marketplace by ensuring that goods and services are readily identifiable and not mistaken for other products.<sup>9</sup> Thus, because the satirical comment published by *The Onion* not only created consumer confusion, but also referenced possible trademarks such as the Capitol, C-SPAN, and Pac Bell,<sup>10</sup> it was left open to a potential infringement suit.<sup>11</sup> Although it would almost certainly be considered to be protected expression because of the political and editorial nature of its content,<sup>12</sup> the fact that the article could still be the subject of costly litigation demonstrates the uncertainty that currently surrounds the free use of trademarks in creative works.<sup>13</sup>

This uncertainty that exists in the world of trademarks stems largely from a distinction in copyright law between parody and satire that has been incorporated into trademark doctrine.<sup>14</sup> Copyright law has declared that a parody that borrows from a prior work is worthy of First Amendment protection, whereas a satire is not.<sup>15</sup> Lower courts in search of a workable standard for trademark parody and satire have since adopted and applied this framework,<sup>16</sup> a worrisome

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8. See *infra* notes 172–174 and accompanying text (explaining why an infringement suit against *The Onion*, while possible, would be unlikely to succeed).

9. See *infra* Part I.A (explaining the traditional roles of trademark law and the basis for infringement actions based on consumer confusion).

10. *Congress Threatens to Leave D.C.*, *supra* note 1.

11. Symbols such as the Capitol can be considered trademarks under the Lanham Act as codified in the definition of a trademark in 15 U.S.C. § 1127 (2006).

12. See Harriette K. Dorsen, *Satiric Appropriation and the Law of Libel, Trademark, and Copyright: Remedies Without Wrongs*, 65 B.U. L. REV. 923, 924–25 (1985) (noting the powerful historical significance of satire as a political force deserving of protection). Even courts that are the most restrictive of trademark speech have held that editorial content in traditional media is given constitutional protection. See *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) (observing that the court’s decision to prohibit the use of a trademark to make a satirical comment on a t-shirt does not affect the defendant’s ability to “present an editorial parody in a book, magazine, or film” under the First Amendment).

13. See discussion *infra* Part II.A (examining four cases involving trademark satire and parody, three of which found that the defendants’ work was not protected and was instead unlawful infringement).

14. See *infra* Part I.B (tracing the development of the parody/satire distinction and its inclusion into trademark law).

15. The Supreme Court determined parody to be that which needs to use an earlier work in order to make a comment directly on that work, while satire does not share the same need, as it comments on larger aspects of society. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580–81 (1994). For a full discussion on the *Campbell* case and the parody/satire distinction, see discussion *infra* Part I.B.

16. See, e.g., *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813 (2d Cir. 1999) (reasoning that the *Campbell* distinction must be applied in a case involving

development that only serves to limit the creative uses of trademarks, which should be constitutionally recognized as free speech. This continued reliance on copyright law is detrimental because copyright is primarily focused on protecting artists from infringement and rewarding them for their expressions,<sup>17</sup> making it reasonable to limit the lawful borrowing of their works to parody. Conversely, trademark law protects the consumer, and companies that register trademarks are engaging the public in a dialogue that is more akin to commercial speech, which the Supreme Court has held subject to additional regulation, unlike the more traditional forms of political or creative expression.<sup>18</sup> Therefore, while copyright law protects an artist who has participated in the highest form of First Amendment speech, trademarks are a more commercial embodiment of speech that only ensures that the consuming public is free of confusion. These divergent goals separate trademark and copyright, and so while copyright perhaps needs the distinction between parody and satire to prevent unlawful infringement, it is a burdensome limitation in trademark law that only serves to potentially chill otherwise valid speech like the stories found on the pages of *The Onion*.

This Comment seeks to remove the tension that the parody/satire distinction creates in trademark law by proving that the principles behind trademark protection allow famous marks to be more widely used in expressive satiric works. This can be easily accomplished if courts expand the test established by the Second Circuit that balances the interests of the consumer in avoiding confusion with those of the public in promoting free speech. Part I examines the definition of a trademark, the distinction between parody and satire in copyright law and its application to trademark infringement cases, and finally explains the current form of the Second Circuit balancing test.

Part II begins with an illustration of the inherent limitations of the Second Circuit test as currently applied through an examination of

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trademark parody); *see also infra* Part I.B (tracing the origins of the parody/satire distinction and its inclusion into trademark law).

17. *See infra* notes 150–155 (examining the goals of copyright law and the protections that it provides).

18. *See* Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y., 447 U.S. 557, 563 (1980) (concluding that because commercial transactions have long been subject to regulation, the First Amendment grants “lesser protection to commercial speech than to other constitutionally guaranteed expression”). In regulating commercial speech, the state does not have to identify and enact the least restrictive statute, but rather need only find a “fit” between the legislature’s ends and the means chosen to accomplish those ends.” Bd. of Trs. of SUNY v. Fox, 492 U.S. 469, 480 (1989) (citation omitted). Thus, while there are still many constitutional safeguards that ensure some protection for commercial speech, it is one of the more regulated forms of speech.

four examples from recent case law. Part II then continues by explaining the justifications for protecting the expressive satire of famous trademarks: the nature and goals of trademark law, especially when compared to that of copyright in light of the parody/satire distinction, and the way that established trademarks are inexorably intertwined with modern society. Part III establishes why the expansion of the Second Circuit test to include the expressive satire of famous trademarks is desirable<sup>19</sup> through an application of the expanded test to the previous examples of satire and parody. Finally, this comment concludes by showing that it is indeed possible to permit the use of famous trademarks in the time-honored setting of satire while still protecting trademark owners against the misappropriation of their marks.

## I. BACKGROUND

### A. *Definition of a Trademark and Classic Infringement*

According to the Lanham Act, which regulates the registration and use of trademarks, a trademark is defined as any “word, name, symbol, or device” that is used to “identify and distinguish . . . goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods.”<sup>20</sup> Trademarks have been used in commerce for as long as humans have engaged in the act of trading, buying, and selling goods.<sup>21</sup> Thus, such marks have always been, and continue to be, important facets of economic transactions, as they allow consumers to quickly and easily identify the quality and origin of products.<sup>22</sup> In the United States, businesses used common law to protect such marks until the first federal trademark law was enacted by Congress in 1870.<sup>23</sup> Although it was quickly determined that this early statute was unable to keep pace with the

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19. That is, so long as the defendant’s work is not in direct competition with the plaintiff’s trademark. *See infra* note 200 (explaining how the expanded test would still protect against infringement when the newer, or junior, mark is used by a defendant in direct competition with the older, or senior, mark).

20. 15 U.S.C. § 1127 (2006).

21. *See* 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 5:1 (4th ed. 2007) (discussing the origins of symbols as trademarks); *see also* Sidney A. Diamond, *The Historical Development of Trademarks*, 65 TRADEMARK REP. 265, 270–71 (1975) (noting that ancient lamps have been found bearing marks used to indicate source of origin and that approximately 1000 different potters’ marks were used during the Roman Empire).

22. ROBERT P. MERGES ET AL., INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 617 (4th ed. 2006).

23. *Id.* at 618.

demands of a growing commercial society,<sup>24</sup> it was not until 1946 that the modern form of trademark regulation came into being with the passage of the Lanham Act.<sup>25</sup> Envisioned as a necessary response to the failures of prior trademark legislation, the Lanham Act did not move swiftly from its birth to eventual passage.<sup>26</sup> Indeed, it took years for supporters of the Lanham Act to overcome concerns that it created monopoly rights for companies and favored large corporations. Eventually, however, the overriding need for a standardized system of trademark registration and protection triumphed.<sup>27</sup>

Companies use trademarks to ensure that their goods are distinct from those of their competitors and are recognized by the consumer as being of a certain quality.<sup>28</sup> Thus, trademarks permeate modern society. Some trademarks have gone beyond their original purpose of identifying the source of products, and instead provide a new and evolving vocabulary that elevates them to the status of a celebrity or cultural icon.<sup>29</sup> As such, famous trademarks are often used by those

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24. See 1 MCCARTHY, *supra* note 21, § 5:3 (explaining that early federal trademark laws were not able to cope with the expanding use of marks, as registrations were perpetual and the owner was not required to maintain the mark's stature as an actual trademark). The original 1870 federal trademark law was held unconstitutional by the Supreme Court as a violation of the Copyright and Patent Clause of the Constitution. See *The Trade-Mark Cases*, 100 U.S. 82, 94 (1879) (finding that a trademark, unlike an expression or invention protected by a copyright or patent, contains no element of discovery). The Copyright and Patent Clause is the source of Congress's power to establish both copyright and patent regulations. See U.S. CONST. art. I, § 8, cl. 8 (granting Congress the right "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries").

25. The most recent enactment of the Lanham Act is codified beginning at 15 U.S.C. § 1051. Unlike copyright and patent law, and due to the *Trade-Mark Cases*, statutory trademark regulations are grounded in the power given to Congress by the Commerce Clause. See 1 JEROME GILSON, *GILSON ON TRADEMARK PROTECTION AND PRACTICE* § 1.04 (release no. 39, 1998) (citing the various legal grounds for trademark protection). The Commerce Clause permits Congress "[t]o regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes." U.S. CONST. art. I, § 8, cl. 3.

26. The Lanham Act traces its origins to 1920, more than twenty years before it was signed into law. 1 MCCARTHY, *supra* note 21, § 5:4. While it was originally introduced in 1938, the intervening events of World War II caused the passage of the Lanham Act to be delayed until after the war came to an end. *Id.*

27. See *id.* (acknowledging the concerns of the Justice Department that the Lanham Act would hamper their antitrust efforts at the time).

28. See *id.* § 3:2 (listing the four functions of trademarks as (1) identifying and distinguishing the goods of a seller, (2) signifying that the goods are coming from a single source, (3) showing that all of the goods with the mark are of an equal quality, and (4) allowing for efficient use in advertising).

29. See Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 965 (1993) (observing that certain trademarks have "worked their way into the English language"). Judge Kozinski sits on the United States Court of Appeals for the Ninth Circuit, is a leading commentator in trademark law, and wrote the majority opinion in *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002). See generally Steven

who are not the true owner of the mark.<sup>30</sup> When a mark is borrowed in this fashion, the owner of the trademark turns to the statutory protections of the Lanham Act, which bars any unauthorized use of a mark that is likely to cause consumer confusion.<sup>31</sup>

There are two ways that the owner of a trademark can seek damages for unlawful infringement under federal law: the traditional likelihood of confusion analysis<sup>32</sup> or by invoking the newer remedies provided by the Federal Trademark Dilution Act of 1996 (“FTDA”).<sup>33</sup> While the enactment of the FTDA both revolutionized trademark law and raised concerns regarding its potentially devastating impact on free speech,<sup>34</sup> this comment will focus solely on the effects that the original basis for trademark infringement—the consumer’s likelihood of confusion—has on satirical expressions.

To determine whether the unauthorized use of a trademark rises to the level of infringement, section 1114 of the Lanham Act states that if the use is “likely to cause confusion,” then it is unlawful.<sup>35</sup> Thus, if the consumer will be confused as to the source of a product, good, or service when confronted with the established (“senior”) mark and the newer (“junior”) mark, courts will find that the junior mark infringes upon the senior.<sup>36</sup> In the absence of a clear Supreme Court ruling on the issue, each circuit has developed its own set of factors to evaluate

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M. Cordero, Note, *Cocaine-Cola, The Velvet Elvis, and Anti-Barbie: Defending the Trademark and Publicity Rights to Cultural Icons*, 8 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 599 (1998) (arguing that freedom of expression demands more protection for the appropriation of trademarks that have become cultural icons).

30. See Dorsen, *supra* note 12, at 939 (noting that trademarks are a “natural target” of those who wish to comment on our national culture); Sarah Mayhew Schlosser, Note, *The High Price of (Criticizing) Coffee: The Chilling Effect of the Federal Trademark Dilution Act on Corporate Parody*, 43 ARIZ. L. REV. 931, 959 (2001) (determining that holders of famous trademarks, such as large companies, are “inevitably involved in public debate,” and so their trademarks are naturally drawn into this debate as well).

31. 15 U.S.C. § 1114 (2006).

32. *Id.*

33. 15 U.S.C.A. § 1125(c) (Supp. 2007). The dilution remedies provided by the FTDA allow the holder of a famous trademark to secure injunctive relief when an unauthorized use “impairs the distinctiveness” of the mark or causes it harm due to an unfavorable or lewd association. *Id.* This permits the holders of such marks to control their use even when no source of origin confusion exists. See Schlosser, *supra* note 30, at 933–34 (discussing how the FTDA provides relief regardless of competition, likelihood of confusion, or bad faith).

34. See, e.g., Michael K. Cantwell, *Confusion, Dilution and Speech: First Amendment Limitations on the Trademark Estate: An Update*, 94 TRADEMARK REP. 547, 548 (2004) (arguing that the FTDA does not adequately protect First Amendment issues because it abandons the societal interest of guarding against consumer confusion).

35. 15 U.S.C. § 1114(1)(a)–(b) (2000).

36. See *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 354 (9th Cir. 1979) (finding infringement because the junior trademark (“Sleekcraft”) would create source of origin confusion when compared to the senior mark (“Slickcraft”).)

when consumer confusion exists.<sup>37</sup> However, these different factors are all variations of the same basic test,<sup>38</sup> and are well illustrated by the Ninth Circuit in *AMF Inc. v. Sleekcraft Boats*.<sup>39</sup> The *Sleekcraft* court recognized eight factors that contribute to the examination of a likelihood of confusion: (1) the strength of the trademark, (2) the proximity in nature of the goods being sold, (3) the similarities of the trademarks, (4) evidence of actual confusion, (5) the marketing channels used, (6) the type of good and the degree of care exercised by the consumer, (7) the defendant's intent in using the mark, and (8) the likelihood of expansion of the product lines.<sup>40</sup> In any trademark infringement claim, a court will use similar factors to determine whether the defendant has infringed upon the plaintiff's mark. Although courts have applied this likelihood of confusion analysis to trademark infringement cases that involve parody and satire,<sup>41</sup> courts and commentators alike have discussed the fact that the test was originally designed only for commercial situations and not those that raise First Amendment concerns.<sup>42</sup> Despite this limitation, because the likelihood of confusion test continues to underscore the analysis of satire and parody in trademark cases, it must remain in the background of any discussion of free speech and trademark rights.

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37. Compare *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (listing eight variables in the confusion analysis: (1) strength of the mark, (2) degree of similarity, (3) proximity of the two products being sold, (4) likelihood of the two product lines coming into competition, (5) actual confusion, (6) the defendant's good faith, (7) quality of the products, and (8) sophistication of the buyer), with *SquirtCo v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980) (finding only six factors to consider: (1) strength of the mark, (2) degree of similarity, (3) proximity of the goods, (4) intent of the defendants, (5) evidence of actual confusion, and (6) conditions of the purchase).

38. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21 cmt. a (1995) (stating that any factor relevant in determining likelihood of confusion is valid, despite the fact that "[n]o mechanistic formula or list can set forth in advance the variety of factors" that can be used); MERGES, ET AL., *supra* note 22, at 714 (observing that while the factors in each circuit can be different, the final tests are similar in substance).

39. 599 F.2d 341 (9th Cir. 1979).

40. *Id.* at 348-49.

41. See *infra* notes 75-87 and accompanying text (noting the Eighth Circuit's general application of the likelihood of confusion standard in such cases despite claiming to apply a test balancing the interests of consumer confusion and free expression).

42. See *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group*, 886 F.2d 490, 495 n.3 (2d Cir. 1989) (acknowledging that the Second Circuit's *Polaroid* likelihood of confusion test for confusion "is at best awkward in the context of parody" because it was developed in commercial situations); Cantwell, *supra* note 34, at 580-81 (noting that the traditional confusion analysis tests were "developed from cases involving purely commercial exploitation").

B. *The Campbell Distinction in Copyright Law and the Process of Its Incorporation into Trademark*

In the copyright case of *Campbell v. Acuff-Rose Music, Inc.*,<sup>43</sup> the Supreme Court articulated what it saw as the distinction between parody and satire. The conflict in *Campbell* arose when the rap group 2 Live Crew wrote an unauthorized parody of the well-known Roy Orbison song “Oh, Pretty Woman” by copying elements of the original work, including the opening bass riff and many of the lyrics.<sup>44</sup> In an opinion for the unanimous Court, Justice Souter held that the 2 Live Crew rap was protected as fair use under the Copyright Act because it was a transformative parody that commented on the original Orbison song.<sup>45</sup>

Although the Court’s final holding was important for free speech rights in copyright, the section of the opinion relevant to satire and parody in trademark law is merely dicta in which Justice Souter examined the nature of the two forms of criticism.<sup>46</sup> Parody, according to the Court, “needs to mimic an original to make its point,” and so in parody it is necessary to use “elements of a prior author’s composition to create a new one that, at least in part, comments on that author’s works.”<sup>47</sup> Thus, parody is a protected form of expression because of the need to borrow from the original piece.<sup>48</sup>

Conversely, satire “has no critical bearing on the substance or style of the original composition” and “can stand on its own two feet, and so requires justification for the very act of borrowing.”<sup>49</sup> Satire is different from parody because it is a comment on something other than the borrowed work, such as society as a whole, whereas parody is

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43. 510 U.S. 569 (1994).

44. *Id.* at 588. Compare ROY ORBISON, *Oh, Pretty Woman*, on OH, PRETTY WOMAN (Monument Records 1964) (“Pretty Woman, walking down the street/Pretty Woman, the kind I like to meet . . . . Pretty Woman, don’t walk on by/Pretty Woman, don’t make me cry/Pretty Woman, don’t walk away . . . .”), with 2 LIVE CREW, *Pretty Woman*, on AS CLEAN AS THEY WANNA BE (Luke Records 1989) (“Pretty woman walkin’ down the street/Pretty woman girl you look so sweet . . . . Big hairy woman all that hair ain’t legit . . . . Two timin’ woman that takes a load off my mind/Two timin’ woman now I know the baby ain’t mine . . .”).

45. See *Campbell*, 510 U.S. at 583 (finding that the song commented on the “naiveté of the original” with “degrading taunts, a bawdy demand for sex, and a sigh of relief from paternal responsibility”).

46. *Id.* at 580–82.

47. *Id.* at 580–81.

48. *Id.*; see also *Hustler Magazine v. Falwell*, 485 U.S. 46, 57 (1988) (ruling that a political caricature of Jerry Falwell was an “ad parody” worthy of protection as free expression).

49. *Campbell*, 510 U.S. at 580–81.

only an imitation of an earlier work.<sup>50</sup> Therefore, satire is not given the same amount of protection as parody, and is often found to infringe on a valid copyright.<sup>51</sup> While Justice Souter did potentially allow for the protection of satire by writing that loose parody and forms of satire could be permitted when there is little risk of market substitution,<sup>52</sup> lower courts have not recognized this small window and continue to favor parody alone as protected speech.<sup>53</sup>

The distinction between parody and satire was in no way universally accepted before it was adopted by the Court in *Campbell*, and literary definitions of the terms differ from what was espoused by Justice Souter.<sup>54</sup> Indeed, the notion that there was no set understanding of parody and satire before *Campbell* is clearly illustrated by the fact that courts used the words interchangeably in the past.<sup>55</sup> However, despite

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50. See 6 MCCARTHY, *supra* note 21, § 31:156 (reading *Campbell* as saying that parody makes fun of the original work directly while satire uses the work as a vehicle to comment on a “societal folly”); see also BLACK’S LAW DICTIONARY 1149 (8th ed. 2004) (defining parody as a “transformative use of a well-known work for the purposes of satirizing, ridiculing, critiquing, or commenting on the original work, as opposed to merely alluding to the original to draw attention to the later work”). Compare *Campbell*, 510 U.S. at 580, 581 n.15 (citing AMERICAN HERITAGE DICTIONARY 1317 (3d ed. 1992)) (characterizing “parody as a ‘literary or artistic work that imitates the characteristic style of an author or a work for comic effect or ridicule’”), with *id.* (citing 14 OXFORD ENGLISH DICTIONARY 500 (2d ed. 1989)) (noting that “satire has been defined as a work ‘in which prevalent follies or vices are assailed with ridicule’”).

51. See 6 MCCARTHY, *supra* note 21, § 31:156 (recognizing that parody can be protected as fair use under copyright, whereas satire cannot); cf. *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1267–68 (11th Cir. 2001) (accepting the defendant’s fair use argument in a copyright infringement action because the book in question was a clear parody of “Gone With The Wind” and not a more general satiric comment on the society of the American South during the Civil War).

52. See *Campbell*, 510 U.S. at 581 n.14 (hinting that satire could be protected with less justification than normally required if it is unlikely to serve as a substitute for the original work in the marketplace).

53. See *SunTrust*, 268 F.3d at 1268 (applying the language of *Campbell* to declare that parody can be a protected form of criticism, whereas satire cannot); Bruce P. Keller & Rebecca Tushnet, *Even More Parodic than the Real Thing: Parody Lawsuits Revisited*, 94 TRADEMARK REP. 979, 984 (2004) (observing that most post-*Campbell* cases have ignored Justice Souter’s footnote fourteen reasoning, instead relying on the “easier wholesale parody/satire distinction”).

54. See, e.g., Christopher J. Brown, Comment, *A Parody of a Distinction: The Ninth Circuit’s Conflicted Differentiation Between Parody and Satire*, 20 SANTA CLARA COMPUTER & HIGH TECH. L.J. 721, 734–35 (2004) (outlining the various literary definitions of parody and noting that some have argued that parody need not make a comment on the original work).

55. See *Rogers v. Koons*, 960 F.2d 301, 309–10 (2d Cir. 1992) (defining both parody and satire as when an artist “for comic effect or social commentary, closely imitates the style of another artist and in so doing creates a new art work that makes ridiculous the style and expression of the original”); *Berlin v. E.C. Publ’ns, Inc.*, 329 F.2d 541, 545 (2d Cir. 1964) (explaining that parody and satire “deserv[e] substantial freedom” as entertainment and social criticism); *Pac. & S. Co. v. Duncan*, 572 F. Supp. 1186, 1195 (N.D. Ga. 1983) (acknowledging that satire and parody are forms of fair use); see also Dorsen, *supra* note 12, at 923, 925 (describing parody as a form of

the many opinions on what exactly constitutes a satire or a parody, the definitions formed in *Campbell* are, for all practical purposes, those that must be used within the legal world.

Because *Campbell* was a copyright case, there was no requirement that the dicta defining parody and satire should apply to trademark infringement cases. However, commentators were quick to note that because some similarities exist between copyright and trademark law, the *Campbell* distinction may apply to both fields.<sup>56</sup> This initial suggestion was rapidly adopted by judges in lower courts across the country who used Justice Souter's definitions from *Campbell* to hold that parodies that comment directly on a senior trademark could be protected as free expression if there is no consumer confusion, whereas the satirical use of a mark could not.<sup>57</sup> Therefore, courts have held that trademark parodies are less likely to confuse consumers because they target the original work, as opposed to satires, which use the mark as a conduit for a comment on society, thus potentially inviting an increased amount of confusion.<sup>58</sup>

*C. The Second Circuit Test: A Foundation for Balancing the Interests in Free Expression with Those of Consumer Confusion*

Even before the parody/satire distinction from *Campbell*, courts attempted to reconcile the protections of the First Amendment with trademark law's watchful eye against consumer confusion, the most prominent effort being that of the Second Circuit in two cases from 1989, *Rogers v. Grimaldi*<sup>59</sup> and *Cliffs Notes, Inc. v. Bantam Doubleday Dell*

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satire and later referring to satire as what would now be considered parody in the post-*Campbell* world).

56. See 6 MCCARTHY, *supra* note 21, § 31:156 (acknowledging the possible analogy between trademark and copyright law regarding the parody and satire dicta of *Campbell*); Gary Myers, *Trademark Parody: Lessons From the Copyright Decision in Campbell v. Acuff-Rose Music, Inc.*, 59 LAW & CONTEMP. PROBS. 181, 204 (1995) (arguing that the logic of *Campbell* can be applied to trademark infringement because of the nature of the two areas and the need for clear boundaries in trademark law).

57. See *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813 (2d Cir. 1999) (declaring that any discussion of trademark parody must be considered in light of the *Campbell* copyright ruling); *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 199–200 (5th Cir. 1998) (acknowledging the authority of *Campbell* in ruling that a comment on society was a satire and not granted protection); *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997) (citing *Campbell* to find infringement where Dr. Seuss' style was not the object of the comment made by the infringing work).

58. See 6 MCCARTHY, *supra* note 21, § 31:153 (emphasizing that in a traditional trademark infringement suit, as opposed to one involving a dilution claim, labeling the defendant's work a parody is "merely a way of phrasing the traditional response that customers are not likely to be confused as to source, sponsorship, or approval.").

59. 875 F.2d 994 (2d Cir. 1989).

*Publishing Group, Inc.*,<sup>60</sup> both of which dealt with the misappropriation of famous marks. *Rogers* addressed a claim of trademark infringement made by Ginger Rogers, who gained fame as Fred Astaire's on-screen partner in a variety of Hollywood musicals.<sup>61</sup> Rogers sued claiming that the Fellini film "Ginger and Fred," a fictional story of two Italian dancers who imitate the style of Rogers and Astaire, infringed on the trademark right in her name by inferring that she was associated with the film.<sup>62</sup> In its analysis, the Second Circuit first noted that titles of creative works demand more First Amendment protection than names of normal commercial products because they contain an expressive element.<sup>63</sup> Because of this increased protection, the traditional infringement test does not apply, and instead infringement under the Lanham Act should be found "only where the public interest in avoiding consumer confusion outweighs the public interest in free expression."<sup>64</sup>

Turning to the case at hand, the *Rogers* court found that when titles are involved, the unauthorized use of a trademark will be permitted as long as the title has some artistic relevance to the underlying work and does not "explicitly mislead[] as to the source or content of the work."<sup>65</sup> Therefore, because the title "Ginger and Fred" was relevant to the film and did not indicate that Rogers was involved in its production, the borrowing of her name was found to be a permitted use of the trademark under the First Amendment.<sup>66</sup>

The Second Circuit was quickly presented with a chance to expand the logic from its *Rogers* decision when it decided *Cliffs Notes*, a case that dealt with a parody of the famous series of study guides.<sup>67</sup> Here the object of the infringement action was the cover of a humor magazine that borrowed Cliffs Notes' distinctive yellow and black striped cover design in a book mocking three lesser-to-unknown novels.<sup>68</sup> In its examination, the court noted that, much like titles, a

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60. 886 F.2d 490 (2d Cir. 1989).

61. *Rogers*, 875 F.2d at 996.

62. *Id.* at 996-97.

63. *See id.* at 998 (explaining that titles are "of a hybrid nature" because they combine the promotion of the product with the expression of the creator, and thus their artistic and commercial elements are "inextricably intertwined").

64. *Id.* at 999. While the Second Circuit purported to adopt this test generally, it has not been fully accepted by other courts, and has been limited to titles. *See Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 776 (8th Cir. 1994) (finding consumer confusion in a satirical advertisement); *infra* Part II.A (addressing the limitations of the Second Circuit test).

65. *Rogers*, 875 F.2d at 999.

66. *Id.* at 1000-01.

67. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 886 F.2d 490, 492 (2d Cir. 1989).

68. *Id.*

parody requires increased protection because it contains expressive elements that go beyond ordinary commercial labeling.<sup>69</sup> Thus, as in *Rogers*, the Second Circuit once again sought to balance the public's interest in free expression with that of avoiding consumer confusion and moved quickly to a discussion of the parodic nature of the defendant's work.<sup>70</sup>

Although *Cliffs Notes* was decided before the Supreme Court's distinction between parody and satire in *Campbell*, the Second Circuit's definition of protected parody is quite similar to what was eventually adopted by Justice Souter.<sup>71</sup> The court in *Cliffs Notes* argued that parodies require increased protection because they are an artistic expression in which there is a "need to evoke the original work."<sup>72</sup> As such, the defendant's work was found to be a parody. While the court noted that there will always be an increased risk of confusion when an artistic expression such as parody is involved, the risk in *Cliffs Notes* was sufficiently outweighed by the public's interest in promoting the commentary that healthy parody provides.<sup>73</sup> Thus, while *Cliffs Notes* did take the important step of expanding the *Rogers* test to the realm of parody, it did not take the balancing as far as possible because it was limited to what is now understood as parody in the wake of *Campbell*.

If the Second Circuit can be considered progressive for developing the *Rogers* and *Cliffs Notes* balancing test, then it stands squarely opposite from the Eighth Circuit, which has led the charge to restrict the appropriation of trademarks, even in expressive contexts.<sup>74</sup> Perhaps the most notable instance of this rigid application of trademark law came in *Mutual of Omaha Insurance Co. v. Novak*,<sup>75</sup> where a designer borrowed the insurance company's logo and name to create a "Mutant of Omaha" post-apocalyptic line of t-shirts.<sup>76</sup> In

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69. *Id.* at 495. While not explicitly addressing titles, the infringement action in *Cliffs Notes* dealt with the cover of the parodic work, which is sufficiently similar to a title to lend comparison. See *id.* at 494 (rejecting the argument that *Rogers* is irrelevant because it specifically addressed titles).

70. *Id.* at 495.

71. See *id.* at 495–96 (“[A] literary work is parody if, taken as a whole, it pokes fun at its subject.”); *supra* notes 47–48 and accompanying text (explaining Justice Souter’s definition of parody).

72. *Cliffs Notes*, 886 F.2d at 495. This language is almost identical to that of *Campbell*, which explained that parody “needs to mimic an original to make its point.” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580–81 (1994).

73. *Cliffs Notes*, 886 F.2d at 495.

74. See Myers, *supra* note 56, at 200 (contending that the Eighth Circuit has applied a strict test that frequently finds infringement, “often in cases of legitimate parody”).

75. 836 F.2d 397 (8th Cir. 1987).

76. *Id.* at 398.

the resulting infringement suit, the court heavily emphasized the property rights that Mutual of Omaha possessed in its trademarks and found that when “alternate avenues” of expression exist there is little protection for the defendant’s chosen forum of a t-shirt.<sup>77</sup> The court noted that the decision was limited to this one “avenue” of particularly commercial expression—t-shirts—and that, much like in the rights of real property, the defendant could take his parody elsewhere to convey his message.<sup>78</sup> This reasoning, when combined with a finding of consumer confusion, led the court to hold that the t-shirts constituted unlawful infringement.<sup>79</sup>

At no point in its decision did the *Mutual of Omaha* court attempt to balance the interests of the public in free expression with that of avoiding consumer confusion.<sup>80</sup> However, this was not the case in *Anheuser-Busch, Inc. v. Balducci Publications*,<sup>81</sup> in which the Eighth Circuit did at least pay lip service to the Second Circuit’s balance by announcing an application of the *Cliffs Notes* standard;<sup>82</sup> yet, in the end, this was nothing more than a smokescreen that hid a traditional likelihood of confusion analysis.<sup>83</sup> *Balducci* involved a humor magazine that borrowed several trademarks belonging to Anheuser-Busch to comment on the effects of a recent oil spill in a river that

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77. See *id.* at 402 (citing *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567 (1972)) (finding that First Amendment rights yield to property rights when the same expression can be accomplished in another medium, such as a book or magazine).

78. See *id.* (reasoning that because there are many other ways to disseminate his message, neither the defendant nor the public were denied speech rights or benefits). But see *Cantwell*, *supra* note 34, at 562 (noting the criticism of the *Mutual of Omaha* court and the “alternative avenues” test for its “false analogy between real property and intellectual property” and reliance on *Lloyd Corp.*); Robert C. Denicola, *Trademarks As Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 206 (1982) (asserting that if the only injury to a trademark arises from a defendant’s expression of ideas, then simply citing *Lloyd Corp.* to say alternate avenues exist is not sufficient to satisfy the demands of the First Amendment). In *Lloyd Corp.*, the Supreme Court held that protesters could be barred from real property (a shopping mall) if their protest could be undertaken elsewhere with a similarly effective result. 407 U.S. at 567.

79. *Mutual of Omaha*, 836 F.2d at 403.

80. See *id.* at 399 (identifying the likelihood of confusion test as the appropriate method of analysis).

81. 28 F.3d 769 (8th Cir. 1994).

82. See *id.* at 776 (citing *Cliffs Notes* to say that it is appropriate to balance the public interests in free expression against those of consumer confusion).

83. See *id.* at 774–75 (determining that confusion existed between the alleged parody and the senior trademark); see also Myers, *supra* note 56, at 201 (discussing how the Eighth Circuit’s “strict application of the likelihood of confusion test” would result in liability for all but the most “heavy handed parody”); Mark V.B. Partridge, *Trademark Parody and the First Amendment: Humor in the Eye of the Beholder*, 29 J. MARSHALL L. REV. 877, 884–85 (1996) (explaining that the court in *Balducci* did not apply any kind of heightened standard addressing free speech, and only concerned itself with First Amendment protections after confusion had been found).

provided some of the brewery's water supply.<sup>84</sup> After finding that there was both potential and actual confusion,<sup>85</sup> the court quickly disposed of the protections offered by the Second Circuit balancing test and determined that the work did not convey the message that it was a parody.<sup>86</sup> In so doing, the court found that the defendant's work was not worthy of protection because the failure to acknowledge that it was not sponsored by Anheuser-Busch led to an unacceptable amount of confusion, a conclusion undoubtedly reached after the court's initial infringement analysis.<sup>87</sup>

The two approaches to trademark infringement in the context of parody adopted by the Second and Eighth Circuits are at the extremes of the doctrine and offer an interesting comparison when examining the scope of the field as it exists today.<sup>88</sup> However, while the Second Circuit test is the most expansive in its protection of the expressive uses of trademarks, it is by no means a safe haven for free speech, especially where satire is concerned.

## II. THE DIFFERENCES BETWEEN TRADEMARK AND COPYRIGHT LAW DEMAND AN EXPANSION OF THE SECOND CIRCUIT TEST TO PROTECT THE SATIRICAL USE OF FAMOUS MARKS

The desire to grant increased protection to those who use trademarks to create expressive satires commenting on society goes well beyond the simple wish to expand the reach of the First Amendment, and is instead grounded in substantive law. Part A of this section explains why the current standard for weighing consumer confusion against free expression falls short of protecting satire as defined by *Campbell* via a discussion of four recent circuit court cases. Part B then argues that expanded protection for satire is justified because of the varying natures and divergent goals of copyright and trademark law. Finally, Part C concludes by contending that famous trademarks should be allowed in satirical expressions because they are a part of the society on which the satire seeks to comment.

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84. *Balducci*, 28 F.3d at 772.

85. *Id.* at 774–75.

86. *Id.* at 777.

87. *Id.*; see Partridge, *supra* note 83 (noting the high standard for protection imposed by the court in *Balducci* and its reliance on the likelihood of confusion test).

88. See Myers, *supra* note 56, at 193–200 (comparing the more restrictive Eighth Circuit test that focuses heavily on likelihood of confusion with the more forgiving Second Circuit test that affords more weight to free expression); Partridge, *supra* note 83, at 882–86 (tracing the development of the different tests).

A. *Limitations on the Second Circuit Balancing Test*

Simply put, the Second Circuit balancing test is incomplete when considering the full scope of protection that should be given to those who use famous trademarks in an expressive work. This section explains the two major limitations of the test: its continued reliance on the parody/satire distinction from copyright and the misguided emphasis that it places on the titles of parodic works. First, because the Second Circuit's balancing analysis only protects what was eventually defined as parody by *Campbell*,<sup>89</sup> it forces courts to apply the distinction between protected parody and unprotected satire, a difference that can be almost impossible to discern.<sup>90</sup> Second, the test in its current form only applies to the titles<sup>91</sup> of works that have been identified as parodies under *Campbell*.<sup>92</sup> Thus, the Second Circuit balancing test, even when it is truly applied and not simply mentioned in passing,<sup>93</sup> does not protect satire as understood in

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89. See *supra* note 71 and accompanying text (noting that, although the Second Circuit test was established in *Rogers* and *Cliffs Notes* before Justice Souter's *Campbell* ruling, those cases have practically the same definition of parody that was used by the Supreme Court).

90. Indeed, some commentators have argued that the parody/satire distinction has caused cases with similar fact patterns to result in drastically different rulings. See Brown, *supra* note 54, at 738–42 (comparing the two Ninth Circuit cases of *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997), and *Mattel v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002), to determine that had the Ninth Circuit applied the logic from its holding in *Dr. Seuss* to *Mattel*, the defendants' song would not have been a permitted parody, and conversely, that had the logic of *Mattel* been applied to *Dr. Seuss*, the book in question would have been allowed as free expression). For a full discussion of *Dr. Seuss* and *Mattel*, see *infra* notes 105–111, 124–131 and accompanying text.

91. See Partridge, *supra* note 83, at 887 (noting that other courts have declined to apply *Rogers* in different situations because it was limited to titles of works); *supra* notes 61–66 and accompanying text (discussing the origins of the balancing test in *Rogers* and its application in that case to the title of a movie).

92. See *supra* notes 67–73 and accompanying text (explaining the application of the test to parodies in *Cliffs Notes*, in which the court defined parody in the same way that the Supreme Court would in the later *Campbell* decision).

93. For instance, in *Balducci*, the court referenced the Second Circuit test when purporting to balance the public interest in free expression with that of avoiding consumer confusion, but barely did any actual balancing, having already found confusion between the two marks. *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 775–76 (8th Cir. 1994). Thus, the finding of confusion before the court had done an examination of the parodic or satiric nature of the work acted as a presumption against free expression when the balancing test was later applied. See Cantwell, *supra* note 34, at 581 (arguing that the approach in *Balducci* “risks undermining First Amendment protections” and that its balancing test consisted only of the observation that the “First Amendment does not protect parodies that are confusing”). The example of *Balducci* shows how the Second Circuit test can be misapplied and focus an inordinate amount of attention on likelihood of confusion at the expense of a proper examination of the defendant's right to free expression. For a better approach, see *Lyons Partnership v. Giannoulas*, 179 F.3d 384 (5th Cir. 1999), which first found parody and then used this as a factor that influences all other elements in a likelihood of confusion analysis. However, in the ideal approach

*Campbell*.<sup>94</sup> The exclusion of satire results in lawyers protecting their clients against trademark infringement claims by attempting to classify every creative work as a parody,<sup>95</sup> a process that leads to uncertainty regarding which expressions will be offered protection and which will be subject to liability.

This uncertainty exists not only in the abstract world of law reviews and classrooms, but also in a variety of circuit court cases. While *The Onion* was lucky in that none of the potential parties brought suit for trademark infringement after the confusion created by its faux headline, others have not been so fortunate. Indeed, there have been trademark infringement cases involving everything from the estates of Dr. Seuss<sup>96</sup> and Elvis Presley<sup>97</sup> to the music of the Danish pop band Aqua<sup>98</sup> and the rap group OutKast.<sup>99</sup> In what is a clear illustration of the imperfections of the Second Circuit test, only one of these cases resulted in the use of the trademark in question being deemed protected speech.<sup>100</sup>

The Second Circuit test is limited to the protection of *Campbell* parody, and as commentators have explained, the “distinction between parody and satire is in the eye of the presiding judge;”<sup>101</sup> a notion that was clearly on display in two cases that illustrate the line separating protected trademark parody and banned trademark satire: *Dr. Seuss Enterprises v. Penguin Books USA, Inc.*<sup>102</sup> and *Elvis Presley Enterprises v. Capece*.<sup>103</sup> These cases are noteworthy because, while the courts did not expressly use the Second Circuit test, they applied a similar balancing test weighing free expression and consumer

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to examining a work’s use of a trademark, the time at which a parody or satire is found would not be dispositive.

94. See *supra* notes 49–51 and accompanying text (noting that a satire under *Campbell* is something that can stand alone and is a comment on a larger aspect of society, as opposed to parody that targets the original work).

95. See Keller & Tushnet, *supra* note 53, at 984 (asserting that the distinction between parody and satire “is far too malleable in the hands of a capable practitioner or judge” and is thus subject to creative lawyering). Compare *Dr. Seuss*, 109 F.3d at 1401 (holding a work borrowing Dr. Seuss’ style to mock the O.J. Simpson trial was satire unworthy of protection), with *Brown*, *supra* note 54, at 740 (arguing that the work in *Dr. Seuss* can be considered a parody).

96. *Dr. Seuss*, 109 F.3d 1394.

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

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

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

100. See *Mattel*, 296 F.3d at 901 (holding that the use of the Barbie trademark was permitted because it was the subject of a parodic song).

101. Keller & Tushnet, *supra* note 53, at 990.

102. 109 F.3d 1394 (9th Cir. 1997).

103. 141 F.3d 188 (5th Cir. 1998).

confusion, and in both instances the satiric nature of the defendants' work resulted in a finding of confusion and infringement.<sup>104</sup>

Shortly after the O.J. Simpson murder trial, an author and illustrator collaborated to publish *The Cat NOT in the Hat!*, a book mocking the trial through the use of various trademarks belonging to the estate of Dr. Seuss.<sup>105</sup> After disposing of the initial copyright claim,<sup>106</sup> the Ninth Circuit discussed the *Campbell* distinction and found the defendants' book to be a satire because it was neither transformative nor did it comment on the original work of Dr. Seuss.<sup>107</sup> The court continued by listing examples of prior trademark infringement cases in which courts have upheld an injunction against a defense of free expression and found that this case was similar because the claimed parody did not extinguish consumer confusion.<sup>108</sup> Specifically, the court noted that the defendants used the Dr. Seuss mark to draw attention to their own work without any attempt to distinguish the source of the target from the source of the parody.<sup>109</sup> Therefore, because the use of the trademarks from *The Cat in the Hat* fell under the *Campbell* definition of satire and potentially created consumer confusion,<sup>110</sup> the court barred publication of the satiric work.<sup>111</sup>

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104. See *Id.* at 198–99 (conceding that parody is an important factor in analyzing confusion, but using *Campbell* to find that the defendant's expression was a satire unworthy of protection in any kind of balance); *Dr. Seuss*, 109 F.3d at 1403, 1405 (identifying likelihood of confusion as the appropriate test, but also acknowledging that, had the defendants' work been a true parody, it would have been a factor that influenced the court's analysis).

105. See *Dr. Seuss*, 109 F.3d at 1396–97 (noting that Dr. Seuss "owns the common law trademarks to the words 'Dr. Seuss' and 'Cat in the Hat,' as well as the character illustration of the Cat's stove-pipe hat," all of which were borrowed by the defendants).

106. The case also involved a substantial copyright infringement claim, in which the court found both that there had been violations of the Copyright Act and that there was no valid fair use defense available because the book was a satire that borrowed the style of Dr. Seuss to ridicule the Simpson trial rather than the original work. *Id.* at 1401.

107. *Id.*

108. See *id.* at 1405–06 (citing *Gucci Shops, Inc. v. R.H. Macy & Co.*, 446 F. Supp. 838 (S.D.N.Y. 1977) (granting an injunction against a manufacturer prohibiting it from producing "a diaper bag with green and red bands and the wording 'Gucchi Goo,' allegedly poking fun at the well-known Gucci name and the design mark") and *Nabisco Brands, Inc. v. Kaye*, 760 F. Supp. 25 (D. Conn. 1991) (granting summary judgment in favor of the manufacturer of "A.1." steak sauce where a competing company developed a meat sauce called "A.2"))).

109. The *Dr. Seuss* court compared its case to *Hard Rock Café Licensing Corp. v. Pacific Graphics, Inc.*, 776 F. Supp. 1454 (W.D. Wash. 1991), in which the defendant borrowed the well-known Hard Rock Café logo and slogan in order to draw attention to his sale of t-shirts. See *id.* at 1405–06.

110. The court in *Dr. Seuss* used the eight factor *Sleekcraft* likelihood of confusion test, but found that, due to the preliminary injunction against publication, many of the factors could not be determined. However, the opinion did hold that the "Cat in

Only one year after the Ninth Circuit ruling in *Dr. Seuss*, the Fifth Circuit decided a similar case that only confirmed the fact that any current balancing test is restricted to parody. In *Elvis*, a 1960s-themed restaurant called “The Velvet Elvis” was sued by Elvis Presley Enterprises for trademark infringement because of the name of the restaurant, the décor, and the advertising methods used.<sup>112</sup> Although the court in *Elvis* acknowledged that a parody claim is relevant when considering the factors in a likelihood of confusion analysis,<sup>113</sup> it was, much to the disappointment of patrons of “The Velvet Elvis,” also quick to turn to *Campbell dicta*<sup>114</sup> and find that the restaurant was an unprotected satire because it targeted the society of the 1960s and “[did] not even attempt to parody the celebrity of Elvis Presley.”<sup>115</sup> Therefore, because the restaurant was a comment on 1960s society, it did not “require the use of [Elvis’] marks because it d[id] not target Elvis Presley.”<sup>116</sup> After the determination that the use of the senior Elvis marks was a satire, it became easy for the court to find a likelihood of consumer confusion because of the similarity and proximity of the marks,<sup>117</sup> seniority of the Elvis trademark, and evidence of actual confusion.<sup>118</sup> As a result, “The Velvet Elvis” infringed upon the marks held by the estate of Elvis Presley, and even though Elvis was undoubtedly a part of the culture of the 1960s,<sup>119</sup> a

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the Hat” mark was similar to the character used in the defendants’ book and that the senior mark was used solely to capture consumer attention. *Id.* at 1404–05.

111. *Id.* at 1406.

112. See *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 192 (5th Cir. 1998) (describing the interior of the restaurant as having photographs, statues, velvet paintings of Elvis, vinyl furniture, beaded curtains, a menu serving “Love Me Blenders,” and advertisements featuring Elvis’ name and image); Jenny Karambelas, *Epilogue: Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188 (5th Cir. 1998), 9 DEPAUL-LCA J. ART & ENT. L. & POL’Y 223, 223 (1998) (describing the additional menu items as peanut butter and banana sandwiches, which were a favorite of Elvis’, and another sandwich known as “Your Football Hound Dog”).

113. *Elvis*, 141 F.3d at 194.

114. See *id.* at 199 (interpreting *Campbell* as holding that a defendant’s work needs to reference the original in order to be called parody under copyright law and determining that the “same need to conjure up the original exists when a parody targets a trademark”).

115. *Id.* at 200.

116. *Id.*

117. See *id.* at 202 (recognizing that Elvis Presley Enterprises had planned to open a worldwide chain of restaurants).

118. See *id.* at 200–05 (applying the factors from the likelihood of confusion test to find that the defendant’s use of the mark was unlawful).

119. See Nicholas C. Jollymore, *Expiration of the Right of Publicity—When Symbolic Names and Images Pass into the Public Domain*, 84 TRADEMARK REP. 125, 125 (1994) (contending that Elvis is synonymous with the Rock-and-Roll movement).

1960s-themed restaurant was barred from using his name or likeness to satirize the values of the era.<sup>120</sup>

*Dr. Seuss* and *Elvis* serve to demonstrate that, even under the Second Circuit test—largely considered to be the most likely to permit the expressive use of trademarks<sup>121</sup>—satire remains unprotected. However, beyond the limitation of the parody/satire distinction, the Second Circuit test only protects titles that are deemed relevant to an underlying parodic work, a fact best demonstrated through a comparison of *Mattel v. MCA Records, Inc.*<sup>122</sup> and *Parks v. LaFace Records*,<sup>123</sup> two cases with seemingly inconsistent results. *Mattel* involved the toy company's trademark in Barbie, a "symbol of American girlhood . . . who graces the aisles of toy stores throughout the country and beyond,"<sup>124</sup> which was borrowed by the band Aqua. The song in question, "Barbie Girl," poked fun at the famous doll through lyrics such as "I'm a Barbie girl, in the Barbie world/Life in plastic, it's fantastic" and "Come on, Barbie, let's go party, ah ah ah yeah."<sup>125</sup> In its analysis, the Ninth Circuit found that the work was a parody because it targeted the Barbie mark itself.<sup>126</sup> The court first acknowledged the problems that can occur when the traditional likelihood of confusion test is applied to marks that "enter our public discourse and become an integral part of our vocabulary" like that of Barbie.<sup>127</sup> The court then abandoned the likelihood of confusion test altogether and cited the balancing test used by the Second Circuit in *Rogers*<sup>128</sup> to find that, because the use of the mark "Barbie" in the title was relevant to the underlying parodic work, there was no infringement in either the song or its title.<sup>129</sup> While there was language in the *Mattel* decision that could potentially be

120. See *Elvis*, 141 F.3d at 207 (reversing the lower court decision in favor of "The Velvet Elvis" and entering judgment for Elvis' estate).

121. See Myers, *supra* note 56, at 200 (finding that the test used by the Second Circuit in *Cliffs Notes* is more "attuned to the particular concerns that arise in parody cases" than those used by other circuits); *supra* Part I.C (comparing the test of the Second Circuit to the more restrictive approach used by the Eighth Circuit).

122. 296 F.3d 894 (9th Cir. 2002).

123. 329 F.3d 437 (6th Cir. 2003).

124. *Mattel*, 296 F.3d at 898.

125. AQUA, *Barbie Girl*, on AQUARIUM (MCA Records 1997).

126. See *Mattel*, 296 F.3d at 901 (distinguishing this case from the earlier Ninth Circuit case of *Dr. Seuss* because it did not borrow the Barbie mark solely to get attention, but instead to target the trademark for ridicule). For a full discussion on *Dr. Seuss*, see *infra* notes 105–111 and accompanying text.

127. See *Mattel*, 296 F.3d at 900 (explaining that the *Sleekcraft* test "fails to account for the full weight of the public's interest in free expression" when a trademark has acquired an expressive meaning apart from identifying source of origin).

128. See *id.* at 901–02 (applying the logic of *Rogers* to hold that titles which borrow famous marks are permitted if they concern the underlying work).

129. *Id.* at 902.

used to increase protection for satire,<sup>130</sup> in the end the court returned to the familiar ground of *Campbell* and the Second Circuit test, granting Aqua a reprieve but containing any discussion of trademark satire to the limited world of *Rogers* and *Cliffs Notes*.<sup>131</sup>

If *Mattel* can be seen as the correct application of the Second Circuit balance, then *Parks v. LaFace Records*<sup>132</sup> demonstrates both the unpredictability and limitations of the title component of the test. *Parks* involved the rap duo OutKast and their popular song *Rosa Parks*,<sup>133</sup> which became the subject of a trademark infringement action when Rosa Parks filed suit against the group alleging that there was potential confusion regarding her endorsement of the song.<sup>134</sup> The Sixth Circuit, much like the Ninth Circuit in *Mattel*, deemed the traditional likelihood of confusion test to be inappropriate,<sup>135</sup> and instead advocated the test established in *Rogers* and used in *Mattel*, claiming that only that test can correctly weigh the interests of free expression and consumer confusion.<sup>136</sup> However, in the application of the Second Circuit test, the court did not hesitate to find that the lyrics of the OutKast song contained “absolutely nothing that could conceivably, by any stretch of the imagination, be considered, explicitly or implicitly, a reference” to Rosa Parks or the civil rights movement, and therefore the title had no relevance to the underlying work and was an infringement on the trademark Rosa Parks held in her name.<sup>137</sup> Thus, both because there was no connection between the title of the song and its content and because

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130. The court hinted at increased First Amendment protection by explaining that the owner of a trademark does not have unlimited rights, especially when the public has given the mark “a meaning beyond its source-identifying function.” *Id.* at 900. Thus, it seems that to the Ninth Circuit when a trademark has become so famous that it “fill[s] in gaps in our vocabulary and add[s] a contemporary flavor to our expressions,” it can be used in ways that go beyond the realm of consumer confusion and make traditional infringement analysis irrelevant. *Id.*

131. *See id.* at 901–02 (repeating the logic of *Campbell* in saying that when an artistic work targets, as opposed to borrows, a senior mark, it is granted additional First Amendment protection, and applying the *Rogers* test to find that the use of the Barbie mark was relevant to the underlying song).

132. 329 F.3d 437 (6th Cir. 2003).

133. The song contains lyrics such as “everybody move to the back of the bus” and “she got off the bus.” OUTKAST, *Rosa Parks*, on AQUEMINI (LaFace Records 1998). The group OutKast is comprised of the rappers known as Andre 3000 and Big Boi.

134. *Parks*, 329 F.3d at 441.

135. *See id.* at 448–49 (reasoning that the traditional test does not adequately protect First Amendment interests).

136. *Id.* at 450 (recognizing that the *Mattel* method can “balance the public interest in avoiding consumer confusion with the public interest in free expression”).

137. *Id.* at 453. The court did acknowledge that the song repeatedly contained the phrase “move to the back of the bus” but determined that this had to be considered in the context of the overall lyrics of the song, which had nothing to do with Rosa Parks. *Id.* at 452. The court also noted that the defendants admitted that the use of the name “Rosa Parks” was only symbolic. *Id.*

the work was not defended as a parody,<sup>138</sup> the use of the “Rosa Parks” trademark constituted unlawful infringement,<sup>139</sup> leaving OutKast with few options but to settle out of court.<sup>140</sup>

*Parks* provides a clear example of the confusion that can result from the application of the Second Circuit test in its current form. The Sixth Circuit noted that the test from *Rogers* and *Cliffs Notes* protecting titles of parodies would fail in *Parks* because “it cannot be said that the title *Rosa Parks* is clearly relevant to the lyrics of the song.”<sup>141</sup> However, it is easy to see how the lyrics, which mention moving to the back of the bus, conversing with a woman on a bus, and advocate changing society, are indeed relevant to the name Rosa Parks.<sup>142</sup> Thus, in this case, it seems that the judges perhaps did not quite grasp the potential subtleties of this particular song and its title when they overlooked the cultural significance of asking someone to move to the back of the bus, a request that necessarily invokes Rosa Parks.<sup>143</sup> Therefore, the fact that the Second Circuit test concerns itself only with the titles of what a court deems to be a parody can lead to unpredictable results based largely on the skill of the lawyer and the disposition of the judge, an unwelcome development when dealing with the First Amendment.

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138. See *id.* at 456 (acknowledging the First Amendment protections of parody but saying that there has been no attempt to justify the song as a parody or satire in the present case). But see *infra* note 211 (arguing that courts should be free to protect parody or satire regardless of whether that specific issue has been raised by defendants).

139. *Parks*, 329 F.3d at 459.

140. See David Shepardson & Joe Menard, *Parks Settles OutKast Lawsuit*, THE DETROIT NEWS, Apr. 15, 2005, at C1, available at <http://www.detroitnews.com/2005/metro/0504/16/D01-151386.htm> (reporting that the group has settled the suit with Rosa Parks after a six year legal battle).

141. *Parks*, 329 F.3d at 456.

142. The song included phrases like “everybody move to the back of the bus,” “got to her station here’s my destination/she got off the bus, the conversation lingered in my head for hours,” “we stabbing every city,” and “damn we the committee gone burn it down.” OUTKAST, *supra* note 133.

143. Indeed, the Sixth Circuit panel relied on a “translation” of the song’s chorus submitted by the plaintiff that read: “[b]e quiet and stop the commotion. OutKast is coming back out [with new music] so all other MCs [mic checkers, rappers, Master of Ceremonies] step aside. Do you want to ride and hang out with us? OutKast is the type of group to make the clubs get hyped-up/excited.” *Parks*, 329 F.3d at 452. The original lyrics of the song are as follows: “Ah ha, hush that fuss/Everybody move to the back of the bus/Do you wanna bump and slump with us/We the type of people make the club get crunk.” OUTKAST, *supra* note 133. The judges’ need for a translation seems to demonstrate a general lack of understanding of the lyrics of the song in question and of the rap genre in general. Of course, that is not to say that all judges misinterpret or misunderstand rap lyrics. See *United States v. Murphy*, 406 F.3d 857, 859 n.1 (7th Cir. 2005) (correcting the court reporter while rightly assuming that in the context of the case the term “hoe,” as in a gardening tool, actually meant “ho,” which is “a staple of rap vernacular as, for example, when Ludacris raps ‘You doin’ ho activities with ho tendencies’”).

Cases such as *Dr. Seuss, Elvis, Mattel*, and *Parks* demonstrate that the Second Circuit balancing test is limited to both the *Campbell* definition of parody and to the titles of such works. As a result, many commentators have argued for an expanded understanding of parody that contradicts Justice Souter instead of simply endorsing protection for trademark satire. For example, one such proposal sought to amend the Lanham Act to include a parody defense,<sup>144</sup> a situation that is both unlikely<sup>145</sup> and does not offer protection to the full breadth of the satire defined by *Campbell*.<sup>146</sup> Others have called for solutions as diverse as adding new factors to the likelihood of confusion analysis<sup>147</sup> to fashioning a completely new test,<sup>148</sup> however, in each case protection is either restricted to parody or the definitions embraced by the Supreme Court in *Campbell* are simply ignored.<sup>149</sup> Thus, the current Second Circuit test not only has a tendency to be manipulated and misapplied, but also encourages myopic solutions that serve only to either limit protection to parody at the expense of satire or to disregard the standard set in *Campbell*. It is then easy to see that while the Second Circuit test is a solid foundation for expanding trademark rights, it does not go far enough because it still excludes satire from the scope of protection.

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144. See Kelly L. Baxter, *Trademark Parody: How to Balance the Lanham Act with the First Amendment*, 44 SANTA CLARA L. REV. 1179, 1208–09 (2004) (calling for an explicit parody defense and defining parody as a work that conveys the message and is either the original or a parody).

145. While the Lanham Act has indeed been amended in the past, the most notable example of this was the FTDA, which served to enhance the ability of trademark owners to control their marks, and thus aid powerful companies and the economy, as opposed to expanding free expression. See *supra* notes 33–35 and accompanying text (comparing infringement actions under the FTDA, which increase a company's power to bring suit, with traditional likelihood of confusion cases). For a discussion on how parody and satire cases are influenced by market considerations, see generally Michael A. Einhorn, *Miss Scarlett's License Done Gone!: Parody, Satire, and Markets*, 20 CARDOZO ARTS & ENT. L.J. 589 (2002).

146. Although an amendment to the Lanham Act would, of course, serve to bypass the Court's ruling in *Campbell*, the likelihood of such a law passing is so small that it is best to work within the parameters set by Justice Souter and the Court.

147. See Emily Adelman, Note, *Trademark Parodies: When is it OK to Laugh?*, 6 J. MARSHALL REV. INTELL. PROP. L. 72, 86–89 (2006) (suggesting a removal of factors such as the sophistication of consumers and the strength of the plaintiff's mark while adding new elements that take into account the differences between the mark and the parody, the existence of a disclaimer, and the proximity between the message and the trademark itself).

148. See Brown, *supra* note 54, at 748 (calling for a parody to be protected as free expression so long as it can be considered an "ironic refunctioning of a prior work").

149. See Adelman, *supra* note 147, at 88 (limiting her discussion of the factors to be added to the likelihood of confusion test to the context of parody, rather than expanding it to satire); Brown, *supra* note 54, at 748 (abandoning the distinction between parody and satire from *Campbell* altogether in favor of the ironic refunctioning test).

B. *The Nature and Purpose of Trademark Law Allows for the Protection of Expressive Satire*

The first justification for the expansion of the Second Circuit test lies in the differences between trademark and copyright law. As discussed above, *Campbell*, which established the current distinctions between parody and satire, dealt solely with copyright law, and it was the decision of lower courts alone to import this distinction into trademark. However, copyright law is fundamentally different from trademark law because of the scope of rights being protected.<sup>150</sup> For example, in copyright law the owner of a valid copyright<sup>151</sup> has an exclusive set of rights<sup>152</sup> designed to reward the owner, and the owner alone, for his or her expressive creation.<sup>153</sup> This is different from trademark law, which, although it does reward the owner of the trademark for establishing a well-known mark,<sup>154</sup> primarily serves the public by ensuring that no consumer confusion exists.<sup>155</sup>

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150. See 1 MCCARTHY, *supra* note 21, § 6:14 (noting that the rights protected in copyright are vastly different than those in trademark). There is a “bundle” of exclusive rights protected in copyrights, but trademark rights are based on the likelihood of confusion. *Id.*

151. See 17 U.S.C. § 102(a)–(b) (2000) (declaring that any “original work[] of authorship fixed in any tangible medium of expression” can be copyrighted so long as it is not an idea, but rather an expression of that idea); see also *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346–47 (1991) (explaining that an original work is an independent creation with a modicum of creativity); *Baker v. Seldon*, 101 U.S. 99, 102–03 (1879) (finding that ideas are protected under patent law and not under copyright law, which was designed to further only creative expression).

152. See 17 U.S.C. § 106 (2000) (granting only the owner of a copyright the power to reproduce, prepare derivative works, distribute copies, perform, display, or perform via recording the work during the time during which the copyright is held). *But see* 2-8 MELVILLE NIMMER, NIMMER ON COPYRIGHT § 8.01 (release no. 72, 2007) (noting that there are general limitations on the rights held by copyright owners, such as if the allegedly infringing work was created by another independently, with no knowledge of the older work).

153. See 17 U.S.C. § 201 (stating that the initial author or authors of a work possess the copyright of that work, but that it may be transferred during the life of protection); see also 1-5 NIMMER, *supra* note 152, § 5.01 (noting the distinction between works created prior to the effective date of the current Copyright Act, for which protection begins at publication, with those created after the Act took effect in 1978, for which protection begins immediately after the work is fixed in a tangible medium).

154. See, e.g., *Zatarain's, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 794 (5th Cir. 1983) (granting trademark protection, and the right to sue for infringement, to a company that invested so much time and money into the otherwise meaningless phrase “Fish-Fri” that consumers had endowed the phrase with secondary meaning, thus giving it a source-designating function that made it a trademark).

155. See 1 MCCARTHY, *supra* note 21, § 2:33 (finding that trademark law has the dual purpose of protecting the public by ensuring that we are aware of the origin of products while also protecting the investment a company makes in developing good will for its trademark and product line); MERGES ET AL., *supra* note 22, at 716 (identifying consumer confusion resulting from the similarity of two marks as the “central problem at which trademark law is aimed”); 1 GILSON, *supra* note 25, § 1.03

This difference in protection separates trademark law from copyright law.<sup>156</sup> While the interests of a trademark or copyright holder are protected in that they can both guard their mark or work against infringement, this right is only tangentially protected in trademark, where the true focus is on the protection of the public against confusion, and not on the personal benefit of the owner of the mark.<sup>157</sup> Indeed, when a company brings suit for trademark infringement, the right being protected is “the right of the public to be free of confusion,” and so it is the public who is being represented in court, albeit via the company that owns the mark.<sup>158</sup> This has led commentators to argue that a trademark holder is not bringing suit for harm to reputation in the defamatory sense when it alleges confusion, but rather only in the sense that there is harm to the mark’s “ability to distinguish one product from another.”<sup>159</sup> Quite simply, consumer protection and trademark protection are one in the same, which makes trademark different from other forms of more traditional intellectual property law.<sup>160</sup> Thus, while copyright, with its focus on the rights of the creator, might need to include actions against defendants who produce *Campbell* satire in the scope of their infringement actions, in trademark law, which examines the rights of the general public, this only serves to silence what would otherwise be valuable speech.

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(acknowledging that trademarks are vital to consumers because they guarantee “freedom of choice by assuring that [the public is] not confused or deceived by an array of similar” marks).

156. See 1 MCCARTHY, *supra* note 21, § 6:13 (distinguishing trademark law from copyright law because trademarks can traditionally be copied as long as there is no consumer confusion, whereas copyrights can never be legally reproduced without the consent of the owner). *But see* Myers, *supra* note 56, at 204 (giving copyright law’s protection of the author’s creative expression equal weight with that of trademark law’s protection of the owner’s “commercial good will”).

157. See 1 MCCARTHY, *supra* note 21, § 2:33 (confirming that the protection of a company’s trademark is “merely a facet of consumer protection” because the consumer’s state of mind is paramount in any infringement suit, despite the fact that the public is not a direct participant); 2 GILSON, *supra* note 25, § 5.01 (“The fundamental aim of trademark law is to avoid . . . consumer confusion about the source or products or services.”). That the emphasis on the consumer’s state of mind is the dominant concern of the court in a trademark suit is confirmed by the fact that the traditional trademark infringement analysis is the likelihood of confusion test. See *supra* notes 35–40 and accompanying text (discussing the likelihood of confusion test and the illustrative *Sleekcraft* factors).

158. Dorsen, *supra* note 12, at 942 (quoting *James Burrough Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 274 (7th Cir. 1976)); see 1 MCCARTHY, *supra* note 21, § 2:33 (concluding that, in a trademark infringement action, the company bringing suit is really acting as a proxy for the general public).

159. See Dorsen, *supra* note 12, at 942.

160. See, e.g., 1 MCCARTHY, *supra* note 21, § 2:33 (concluding that the law of trademarks has its foundation not solely in the property right of the holder, but rather also in “the right of the consuming public to be told the truth” about the products that they are buying).

Beyond the differences in the nature and goals of trademark and copyright law lies a distinction that is inherent to the kinds of speech involved in each field. Authors and artists who obtain a valid copyright have expressed themselves in a creative way that is undoubtedly given the full protection of the First Amendment.<sup>161</sup> Therefore, it is only fair that they be afforded a wide amount of defenses to guard against infringement. However, the use of trademarks in marketing campaigns, while potentially creative, is still nevertheless done for the sole purpose of selling a product, and nothing more.<sup>162</sup> A trademark is thus much closer to commercial speech, and because commercial speech can be regulated in a way that expression cannot, it is given less protection in the realm of the First Amendment.<sup>163</sup> As a result of the difference between the expressive speech of copyright and the commercial speech of trademark, those who wish to borrow marks in order to satirize society in a creative way should be free to do so because they are engaging in discourse that the Supreme Court has held to be of a higher value than the commercial speech originally used by the trademark's owner.<sup>164</sup>

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161. See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 362 (1991) (finding that only a modicum of creativity in the original work is necessary in order for it to qualify for copyright protection); *Baker v. Seldon*, 101 U.S. 99, 102–03 (1879) (declaring that copyright law is the correct forum for the protection of expressions). *But see* *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003) (noting that although copyright owners have free speech protection, that protection still permits “fair use” of the ideas in the copyrighted material by the public).

162. This is distinguished from an act like selling a book, which has commercial aspects that are secondary to the primary goal of the creation of an expressive work. Trademarks are closer to speech that can be described as “commercial intercourse between a seller hawking his wares and a buyer seeking to strike a bargain,” and so should be given less First Amendment protections. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 781 (1976) (Rehnquist, J., dissenting).

163. Indeed, states have more leeway to regulate commercial speech than they do to control such controversial expressions as flag burning or lewd parody. See *Texas v. Johnson*, 491 U.S. 397, 420 (1989) (striking down a Texas law prohibiting flag burning as an unconstitutional restriction on expression); *Hustler Magazine v. Falwell*, 485 U.S. 46, 57 (1988) (finding that an arguably obscene parody of Jerry Falwell was protected as free speech even though it was a false statement of fact); *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 565 (1980) (holding that commercial speech can be regulated if it passes a four-part test designed to ensure that the speech is not unreasonably interfered with).

164. See *Bolger v. Youngs Drug Prods. Co.*, 463 U.S. 60, 64–65 (noting that commercial speech receives less First Amendment protection than non-commercial speech). The notion that there is a two-tiered system of speech, one of high value worthy of almost full protection, and one of a lesser value that can be regulated, stems from the seminal free speech case *Chaplinsky v. New Hampshire*, 315 U.S. 568 (1942), which held that there is a class of speech that includes the “lewd and obscene, the profane, the libelous, and the insulting or ‘fighting’ words” that can be restricted without cause for constitutional concern. *Id.* at 572–73.

Despite this wide array of differences between trademark and copyright law, there are those who believe that the fields are so similar that it is possible to use their logic interchangeably,<sup>165</sup> a view that certainly encouraged applying *Campbell* dicta to trademark. In support of this proposition, the success with which copyright law has addressed free speech questions is cited as a helpful guide for trademark.<sup>166</sup> However, simply because copyright has had a somewhat more consistent approach to fair use<sup>167</sup> and some blending between the two fields of law has already occurred<sup>168</sup> does not mean that the fundamental differences between copyright and trademark can be ignored. Indeed, although a unified body of copyright and trademark law would be appealing, it remains that copyright favors only the owner of the copyright itself, while trademark protects the public at large, a fact that was acknowledged by the original proponents of the Lanham Act and that cannot be overlooked today.<sup>169</sup>

The varying purposes of trademark and copyright law make it dangerous to drag the *Campbell* distinction too far into trademark doctrine, a process that unfortunately is well on its way. While it is possible that the distinction between parody and satire is beneficial and straightforward in copyright,<sup>170</sup> it has no place in trademark

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165. See Michael B. Weitman, Note, *Fair Use in Trademark in the Post-KP Permanent World: How Incorporating Principles from Copyright Law Will Lead to Less Confusion in Trademark Law*, 71 BROOK. L. REV. 1665, 1688–92 (2006) (arguing that there are similar motivations behind copyright and trademark protection and that both areas of law serve basically the same purpose).

166. See D.V.L. Mastrullo, Comment, *Trademark Parody Litigation and the Lanham Act: Fitting a Square Peg in a Round Hole*, 54 U. CIN. L. REV. 1311, 1326–27 (1986) (proposing that trademark adopt a fair use analysis like that of copyright because of the similarities between the two bodies of law and the way in which it has been applied in copyright).

167. See Weitman, *supra* note 165, at 1696 (determining that copyright law uses a more comprehensive test to investigate fair use, one that, if adopted by trademark law, will bring more consistency to the field).

168. See *id.* at 1699 (announcing that some judges have begun combining copyright and trademark law in certain dilution actions).

169. See 1 MCCARTHY, *supra* note 21, § 5:4 (noting that supporters of the Lanham Act stressed that trademark rights are different from those of copyright and patent because they are not an exclusive grant of protection).

170. See Weitman, *supra* note 165, at 1699–1700 (lauding copyright law for its consistent and successful handling of parody cases through the doctrine of fair use). *But see* Keller & Tushnet, *supra* note 53, at 984 (stressing that the many practical problems that the *Campbell* distinction has caused in copyright law should serve to caution against its extension into trademark law); Adriana Collado, Note, *Unfair Use: The Lack of Fair Use Protection for Satire Under § 107 of the Copyright Act*, 9 J. TECH. L. & POL'Y 65, 66 (2004) (arguing that the distinction between satire and parody limits free speech and is “contrary to the goal of copyright law”). In fact, courts may be beginning to rethink the *Campbell* distinction even in copyright law. See *Blanch v. Koons*, 467 F.3d 244, 254–55 (2d Cir. 2006) (permitting borrowing of a copyrighted image as fair use because the defendant demonstrated a “genuine creative rationale”

because of the entity being protected.<sup>171</sup> For instance, in the previously-discussed example of satire from *The Onion*, any potential suit would have to come from the owner of one of the trademarks mentioned in the article.<sup>172</sup> However, any possible harm that was caused as a result of the article was most likely incurred by the Chinese public and not American consumers, whom the courts would be trying to protect.<sup>173</sup> Therefore, it seems clear that in this example of satire it would be foolish for a court to find *The Onion* liable for trademark infringement based on likelihood of confusion,<sup>174</sup> and it would be more appropriate to hold that the expressive, satirical work was protected as free expression.

When examining an expressive satire that allegedly infringes on a famous trademark, courts should be free to extend and apply the currently limited Second Circuit balancing test because it is the duty of the courts in trademark law to protect the interests of the consuming public. Courts hearing trademark cases, as opposed to copyright,<sup>175</sup> are best suited to protect the interests of the public by balancing the desire to avoid consumer confusion with the arguably more important right to freedom of speech.<sup>176</sup> Thus, the balancing test of the Second Circuit should not only apply to parody and titles, but also to the expressive satires of famous trademarks. While this

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for the borrowing, even though the court admitted that the potentially infringing work was satire under the *Campbell* definition). For a full discussion on parody and satire in copyright law, see generally 4-13 NIMMER, *supra* note 152, § 13.05(C).

171. See *supra* notes 156-160 and accompanying text (noting that copyright protects the rights of the owner alone, but trademark law protects primarily the public and the owner only tangentially).

172. See *Congress Threatens to Leave D.C.*, *supra* note 1 (using such trademarks as “the Capitol,” “Pac-Bell,” and “C-SPAN” as well the as the names of various politicians).

173. See Chu, *supra* note 7 (describing the defensive tone that the editor of the Chinese news service took when confronted with questions about how the satirical article worked its way into the newspaper).

174. This is distinguished from infringement actions based on the FTDA, which imposes liability for the unauthorized borrowing of famous trademarks even if there is no evidence of confusion. 15 U.S.C. § 1125(c) (2000); see Cordero, *supra* note 29, at 616 (explaining that dilution can occur without a showing of consumer confusion); Schlosser, *supra* note 30, at 933-94 (interpreting the FTDA to permit infringement solely for lessening the capacity of the mark to distinguish between goods, regardless of a likelihood of consumer confusion).

175. In copyright law the owner of the copyright in question brings suit solely on his or her behalf to protect an exclusive set of rights. See 17 U.S.C. § 106 (2000) (listing the rights granted to a copyright holder).

176. Indeed, while there are no constitutional protections guarding against product confusion, the First Amendment guarantees the right to free speech and expression. See U.S. CONST. amend. I (“Congress shall make no law . . . abridging the freedom of speech . . .”).

might result in slightly more confusion,<sup>177</sup> it is a small price to pay for the overdue First Amendment recognition of satire in this context.

*C. Famous Trademarks Are Part of Society and Any Comment on Society Should Be Free to Borrow Those Marks*

The second justification for expanding the balancing test employed by the Second Circuit to include expressive satire relates to the desire of businesses and individuals who hold trademarks to make their mark famous.<sup>178</sup> Trademark owners thrust their marks into the national spotlight, and so they should not be surprised when such marks are used in satirical comments that mock society as a whole.<sup>179</sup> Indeed, as the court in *Mattel* explained, sometimes there is simply no other way to identify goods such as aspirin or Rolls-Royce, and so if a satirist wants to describe those brands while targeting society, he is forced to use their trademarks.<sup>180</sup> This represents the more general trend of trademarks being used not to identify a product, but rather to express an idea or point of view,<sup>181</sup> a situation that should trigger increased First Amendment protection.<sup>182</sup> To this end, Judge Kozinski has noted that when trademark owners thrust a mark on the public through “well-orchestrated campaigns intended to burn them into our collective consciousness,” the owners must then relinquish control over the trademark as a consequence of seeking such exposure because the mark has taken on symbolic meaning as part of society at large.<sup>183</sup>

The protection of satirical expression, however, is not derived solely from the desire of trademark owners to saturate the public

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177. See *supra* text accompanying note 58 (conceding that satirical comments are potentially more confusing than parodies because they target broad aspects of society, as opposed to one particular work).

178. See Cantwell, *supra* note 34, at 555 (declaring that the goal of trademark owners to have the public readily identify their goods is obvious from the amount of money invested in cultivating a business’s mark).

179. *Id.* (arguing that businesses that hold their mark out as an integral part of society should accept the risk of some form of public ridicule in return).

180. See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) (reasoning that the *Sleekcraft* test fails to account for situations where there is no other way to describe a product or mark that, as in the case of Rolls Royce, “has taken on an expressive meaning apart from its source-identifying function”).

181. See Weitman, *supra* note 165, at 1695 (asserting that societal trends have caused trademarks to represent a symbol, “status or fashion” beyond the original source identifying role).

182. See Denicola, *supra* note 78, at 207 (“When the trademark is utilized as a vehicle for the communication of ideas . . . constitutional interests can no longer be ignored.”).

183. Kozinski, *supra* note 29, at 975. Judge Kozinski goes on to assert that, after trademark has become embedded in public discourse, the paramount concern in any balancing test must be the public’s right to make use of the mark. *Id.*

consciousness, because this intent alone does not secure trademark protection.<sup>184</sup> Rather, it is public support and acknowledgment that both make a trademark well-known and provide judicial recognition and protection to the mark.<sup>185</sup> In areas of law similar to trademark, in which legal protection for names and symbols is conditioned upon consumer recognition,<sup>186</sup> commentators have reasoned that, because the public is the source of power, the public should also be free to use these symbols at will.<sup>187</sup> The same line of thought can easily be applied to trademark law.<sup>188</sup> Therefore, the public is not only being protected by trademark law, but is also granting protection to trademarks. It only follows that the public should then be able to use such marks in expressive satirical comments on society.<sup>189</sup>

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184. The only types of trademarks that are given immediate protection are those that are inherently distinctive. See 2 MCCARTHY, *supra* note 21, § 11:4 (listing marks that are “arbitrary and fanciful” (those that are arbitrarily applied to their product or are simply made up) and suggestive (those that are not merely descriptive and so require some sort of inference to lead the consumer to the product) as inherently distinctive); 1 GILSON, *supra* note 25, § 2.01 (explaining that trademarks that are held to be fanciful, arbitrary, and suggestive receive automatic protection because they are inherently distinctive). Secondary meaning is required for all other types of potential trademarks, including those that simply describe their product. 2 MCCARTHY, *supra* note 21, § 11:1.

185. This is especially true of trademarks that are not inherently distinctive and require the consuming public to endow the mark with secondary meaning. See 2 MCCARTHY, *supra* note 21, § 15:5 (noting that the primary element of secondary meaning is the consumer association between the otherwise descriptive term and the particular product, which in turn makes the term a trademark deserving of protection); 1 GILSON, *supra* note 25, § 2.09 (finding that a trademark attains secondary meaning when there becomes an “association in the public mind between a product and its source”); cf. Jollymore, *supra* note 119, at 126–27 (asserting that it is public usage that gives symbolic meaning to names and images of famous celebrities, which then allows them to be protected by the right of publicity).

186. One example of protection being based on fame is the state law right of publicity, which protects a celebrity’s image and persona if it has marketable value. See MERGES ET AL., *supra* note 22, at 883–84 (explaining that the right of publicity developed with mass advertising and consumer culture).

187. See Cordero, *supra* note 29, at 655 (supporting increased protection for the fair use of cultural icons in both commercial and entertainment purposes because society has given these symbols their iconic status); Jollymore, *supra* note 119, at 154 (concluding that when the public recognition of celebrities becomes so high that they become a symbol, their right of publicity protection should expire and their persona should become a free part of the public domain).

188. See Schlosser, *supra* note 30, at 964 (arguing that owners of corporate trademarks suing under the FTDA should have to prove actual malice because their mark is akin to a public figure). *But see* Bryan M. Gallo, Note, *Barbie’s Life in Plastic: It’s Fantastic for First Amendment Protection—Or Is It?* *Mattel, Inc. v. MCA Records, Inc.*, 295 F.3d 894 (9th Cir. 2002), 29 U. DAYTON L. REV. 405, 420–21 (2004) (stressing that labeling a trademark a cultural icon, and thus granting it the qualities of a generic mark that can be used at will, can unnecessarily weaken trademark rights by finding fair use every time parody is claimed).

189. Cf. Jollymore, *supra* note 119, at 130 (reasoning that when the public makes a celebrity persona a symbol it should become part of the common vocabulary because “[a] symbol, after all, belongs to all of us.”).

Finally, when the public recognizes a trademark as famous, the mark will undoubtedly be used in public discourse.<sup>190</sup> It is often impossible to make a comment on society without referencing trademarks, and so satirists necessarily have to use marks that are embedded in our culture in order to successfully express a message.<sup>191</sup> Similarly, popular culture would be lost without the availability of trademarks to be borrowed for creative expressions.<sup>192</sup> Even though many uses of famous marks go unpunished, as recent cases like *Dr. Seuss* demonstrate, the public's right to use its choice of trademarks when making a satirical comment has not been fully recognized by the courts,<sup>193</sup> even when the defendants are borrowing marks that have become intertwined with our culture.<sup>194</sup>

When a trademark has become so famous that it is used in the public discourse and is a true part of society,<sup>195</sup> the traditional likelihood of confusion test can no longer be applied to defendants who use the mark in an expressive satire. If a trademark influences how we think and speak about the world, then there is simply no other way to express certain ideas other than via the use of the mark.<sup>196</sup> Therefore, it would be an unreasonable limitation on free speech to enjoin the use of a trademark if there is no other way to

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190. See Schlosser, *supra* note 30, at 962 (insisting that some trademarks have become so intertwined with society that they "have come to symbolize broad social themes as well as their particular products and corporations").

191. See Einhorn, *supra* note 145, at 604 (noting that satirists cannot always find suitable alternative works for their social criticisms if they are constantly under threat of suit).

192. For a detailed list of trademarks that have been used in popular culture, including works such as Kurt Vonnegut Jr.'s "Breakfast of Champions" and Prince's "Little Red Corvette" see Judge Kozinski's dissent in *White v. Samsung Electronics America, Inc.*, 989 F.2d 1512, 1513 n.6 (9th Cir. 1993).

193. See *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997) (finding that the use of the writing style and trademarks of Dr. Seuss and "The Cat in the Hat" were not protected because the defendants' work was a satirical comment on the O.J. Simpson murder trial).

194. See Brown, *supra* note 54, at 742 (pointing out that "The Cat in the Hat" is a part of the cultural heritage of the United States).

195. Cf. Cordero, *supra* note 29, at 644 (defining a cultural icon as a person or trademark that has acquired symbolic significance beyond any source-identifying function). The FTDA states that a famous trademark is one that is "widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." 15 U.S.C.A. § 1125(c)(2)(A) (West 2006). The Act goes on to note four factors that can be used to determine whether a mark has attained the required level of recognition. See *id.* (listing (1) the duration, extent, and reach of advertising, (2) the amount, volume, and reach of sales of products under the mark, (3) the actual recognition of the mark, and (4) whether the mark is officially registered).

196. See Kozinski, *supra* note 29, at 974 ("[O]ur vision of the world and of ourselves is shaped by the words we use and by the images that fill our fantasies. The words and images of trade are an important part of this panorama."); *supra* notes 180-182 and accompanying text (explaining that sometimes the public is forced to use a trademark to express a particular idea).

express what the mark itself represents, even where there is risk of confusion.<sup>197</sup> A better approach for free speech would be the natural expansion of the Second Circuit balancing test to include the expressive satire of famous marks, a solution that would reward the public for elevating the stature of a trademark by allowing for a more reasonable approach to fair use.<sup>198</sup>

### III. APPLICATION OF AN EXPANDED SECOND CIRCUIT TEST

A reexamination of the four cases cited earlier clearly demonstrates why an expansion of the Second Circuit balancing test<sup>199</sup> to include protections for the expressive satire of famous trademarks would result in more vibrant free expression while still protecting against infringement.<sup>200</sup> The theories and goals of trademark law make it unique in that courts have the ability to both ensure a stable marketplace while also allowing for satirical expressions when the benefit to the public outweighs any potential confusion. Thus, when confronted with a satirical work that seems destined to be silenced at the hands of *Campbell*, courts should be cognizant of the fact that trademark law aims to protect the public, and if the public will not be irreparably hurt, then the expression should be allowed.

While each of the cases discussed demonstrates why an expanded balancing test would appropriately broaden the opportunities for

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197. See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) (identifying the conflict between the First Amendment and trademark rights that occurs when the mark in question has “enter[ed] our public discourse and become an integral part of our vocabulary”).

198. Cf. *Cantwell*, *supra* note 34, at 583–84 (arguing for the increased protection of trademark parody because trademark owners are similar to public figures and so they should expect some amount of ridicule); *Schlosser*, *supra* note 30, at 963–64 (declaring that trademark parody must be held to the same First Amendment standards as criticisms of public figures because both marks and public figures are involved in contemporary discourse).

199. See discussion *supra* Part I.C (describing the balancing test developed by the Second Circuit in *Grimaldi* and *Cliffs Notes*).

200. For instance, the use of an existing trademark outside of a parodic or satiric expression and in direct commercial competition with the senior mark would remain prohibited. See *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812–13 (2d Cir. 1999) (rejecting a parody claim because the mark was used solely to promote the defendant’s motorcycle repair business, which was in direct competition with that of Harley-Davidson); *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 337–38 (E.D. Pa. 1996) (finding that the use of the trademark that the plaintiff possessed in his image on a CD was not expressive because the album did not contain any original works by the defendant). However, it is possible that the expanded test would result in increased protection for defendants where previously an injunction would have been granted. See *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1187, 1191, 1193 (E.D.N.Y. 1972) (prohibiting the sale of a poster with the phrase “Enjoy Cocaine” written in the famous “Enjoy Coca-Cola” script because there was a likelihood of confusion, despite the assertion that it was meant to be a satirical comment).

trademark satire, it is *Parks v. LaFace Records*<sup>201</sup> that best illustrates why this expansion is indeed necessary. When Rosa Parks refused to give up her seat on a bus in 1955 Alabama, it was impossible to predict the eventual ramifications of such a simple act of courage and defiance.<sup>202</sup> It was also equally impossible to foresee the role that Mrs. Parks would play in trademark law. By bringing suit against OutKast, Mrs. Parks provided a perfect example of how trademark infringement suits based on likelihood of confusion has gone awry.<sup>203</sup> Trademark law, designed to protect the consumer against product confusion,<sup>204</sup> was used in *Parks* solely because the plaintiff did not like the use of her name in the title of an expressive work,<sup>205</sup> a far cry from the original goal of trademark infringement litigation.<sup>206</sup>

It could easily be argued that OutKast should have received protection under the title test established by the Second Circuit in *Rogers and Cliffs Notes*.<sup>207</sup> However, the extent to which the use of the mark “Rosa Parks” would be protected is even clearer under an expanded test. The song *Rosa Parks* includes not only lyrics that reference the southern part of the United States,<sup>208</sup> but also a harmonica solo in a distinctly Southern style.<sup>209</sup> Furthermore, it is

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201. 329 F.3d 437 (6th Cir. 2003).

202. See DAWN BRADLEY BERRY, THE FIFTY MOST INFLUENTIAL WOMEN IN AMERICAN LAW 169 (1996) (noting that Rosa Parks did not intend to “start a movement” when she refused to give up her seat, but was just “tired of social injustice”).

203. Indeed, there is evidence in all areas of trademark law of a trend away from traditional confusion analysis and towards one that favors only the owners of the mark at the expense of the public. See Denicola, *supra* note 78, at 159 (observing that the historic emphasis on deception and confusion in trademark infringement has begun to be replaced by judicial findings of misappropriation even where no likelihood of confusion exists); Jesse A. Hofrichter, Note, *Tool of the Trademark: Brand Criticism and Free Speech Problems with the Trademark Dilution Revision Act of 2006*, 28 CARDOZO L. REV. 1923, 1959 (2007) (reasoning that recent amendments to the FTDA are “[i]n synch with the general trend of trademark law moving away from [a] focus on protecting consumers and towards protection of trademark holders”).

204. See I GILSON, *supra* note 25, § 1.03[3] (writing that one of the primary purposes of trademark law is consumer protection, and in infringement suits courts are sensitive to the impact of possible confusion on the consumer).

205. See Shepardson & Menard, *supra* note 140 (citing the unauthorized use of Mrs. Parks’ name as the reason for the suit).

206. An example of a more traditional infringement suit occurs when a senior mark is misappropriated only to promote a product in direct competition with that trademark. See, e.g., *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 45 (2d Cir. 1994) (finding infringement when the defendant borrowed the plaintiff’s famous green Deere logo to promote MTD’s competing line of tractors).

207. See *supra* notes 142–143 and accompanying text (explaining how the title of the song *Rosa Parks* could, despite the conclusions of the Sixth Circuit, be seen as relating to the lyrics of the song and thus be granted protection).

208. The song mentions “A-T-L, Georgia,” a reference to the Georgia roots of Big Boi and Andre 3000. *OUTKAST*, *supra* note 133.

209. *Id.*; see S.H. Fernando, Jr., *Review: OutKast: Aquemini*, ROLLING STONE, Sept. 4, 1998, <http://www.rollingstone.com/reviews/album/193280/aquemini> (noting both

unquestioned that Rosa Parks was a monumental figure in the history of the American South and the struggle for integration.<sup>210</sup> Thus, when the Southern flavor of the song is combined with the titular reference to Rosa Parks, it becomes easy to see the connection between Rosa Parks herself and the potential comment that the song is making on Southern culture and the struggle for Civil Rights. Regardless of the original intent of the artists,<sup>211</sup> the song *Rosa Parks* can be understood as an expressive satire that makes light of the integration movement, or perhaps memorializes it, through modern music. While the court in *Parks* purported to use the Second Circuit balancing test,<sup>212</sup> it focused solely on its own limited appreciation of the relationship between the title and the underlying work<sup>213</sup> and gave only a cursory examination of parody or satire.<sup>214</sup> If the correct standard of an expanded balancing test had been used, then the song would have been a protected form of satire because Rosa Parks is an integral part of political discourse<sup>215</sup> whose likeness should be permitted to be used because of the public's interest in satirical expression.

*Parks* is not the only instance in which defendants who created expressive works would have benefited from an expanded balancing test that adequately protects all forms of satire. As previously discussed, the court in *Dr. Seuss* found that the defendants' work was a satire, rather than a parody, because it did not directly ridicule the

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that the "folksy harmonies of 'Rosa Parks' announce OutKast's distinctive style of Southern boogie," as well as the overall Southern feel of the album).

210. See *Parks v. LaFace Records*, 329 F.3d 437, 442–43 (6th Cir. 2003) (tracing the chronology of Rosa Parks' role in the Civil Rights Movement during the 1950s and 60s, beginning with her refusal to give up her seat to a white passenger on a Montgomery, Alabama bus).

211. The defendants in *Parks* admitted only a symbolic use of Parks' name and did not raise a parody or satire defense. *Id.* at 452, 456. However, if the expanded balancing test protects the public's interest in free expression, the courts, who are guardians of the public's rights in trademark law, should be free to find parody or satire wherever it may exist. *Cf.* *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 583 (1994) (inferring a variety of possible meanings from 2 Live Crew's parody of the Roy Orbison song "Oh, Pretty Woman").

212. See *Parks*, 329 F.3d at 450 (determining that the appropriate method of analysis is to weigh the public interest in free expression against that of avoiding consumer confusion).

213. See *id.* at 452–59 (addressing whether or not the title was relevant to the underlying work and whether it was misleading to the consuming public).

214. *Id.* at 456.

215. It is simply easier for OutKast to title the song "Rosa Parks" than "Historical Female African-American from Montgomery, Alabama Who Refused to Get Up on a Bus for a White Man." As Judge Kozinski has noted, when trademarks serve to fill these kinds of gaps in our language, they should be protected. Kozinski, *supra* note 29, at 973–74; *cf.* Schlosser, *supra* note 30, at 962 (concluding that the FTDA fails to adequately protect public discourse when it holds defendants liable for using famous trademarks in public discussions).

style of *The Cat in the Hat*.<sup>216</sup> The court applied the traditional likelihood of confusion test to the satirical work and issued a preliminary injunction against publication.<sup>217</sup> In quickly running through an examination of the *Sleekcraft* factors, the *Dr. Seuss* court concluded that the senior marks<sup>218</sup> were famous and that the infringing marks were very close in similarity and proximity, factors that weighed against the defendants.<sup>219</sup> Yet, even if conceding that the defendants' work was not transformative and would cause confusion,<sup>220</sup> the facts of this case would not only be considered a protected use of trademarks under an expanded balancing test, but also serve to demonstrate the difference between the levels of infringement protection needed in copyright and trademark law.

*Dr. Seuss* presented copyright issues that the Ninth Circuit was able to address fairly quickly because the borrowed work was substantially similar to the original, and therefore, as discussed earlier, there was no valid parody claim under *Campbell*.<sup>221</sup> However, simply because the estate of Dr. Seuss had legitimate infringement claims under copyright does not mean that it should prevail under trademark law, which should be more forgiving of defendants who borrow famous marks to comment on society. In performing an expanded balancing test, a court would first find that the senior trademarks at issue in *Dr. Seuss* were undoubtedly famous.<sup>222</sup> Furthermore, the defendants' work was expressive and not in direct competition with the marks held by Dr. Seuss Enterprises because it used lewd language not

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216. *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997). The court also found that "there [was] no effort to create a transformative work with 'new expression, meaning, or message.'" *Id.* (quoting *Campbell*, 510 U.S. at 578).

217. *Id.* at 1403–06.

218. The marks in question were "The Cat in the Hat" and the pseudonym "Dr. Seuss." *Id.* at 1404.

219. The defendants used the phrases "Dr. Juice" and "The Cat NOT in the Hat!" *Id.*

220. Many commentators have expressed their discontent with the rigid application of the satire/parody distinction in *Dr. Seuss*. See, e.g., Eric J. Schwartz & Matt Williams, *Joking Aside: Recent Copyright Cases Reexamine the Distinction Between Satire and Parody in Determining Fair Use*, L.A. LAW, May 2007, at 33, 37 (noting that some, including Judge Kozinski, have suggested that a new standard should be imposed for satire and parody in copyright). Others, however, have accepted the standard and simply argued that the work in *Dr. Seuss* was indeed a parody. See Brown, *supra* note 54, at 740–42 (illustrating the ways in which the defendants poke fun at the storyline of "The Cat in the Hat" through the use of the Simpson murder trial).

221. *Dr. Seuss*, 109 F.3d at 1403.

222. See Brown, *supra* note 194, at 742 (finding that "The Cat in the Hat" is an integral part of American culture). The court in *Dr. Seuss* also admitted that the marks in question "are widely recognized trademarks." 109 F.3d at 1404.

appropriate for Dr. Seuss' typical audience.<sup>223</sup> This lack of direct competition would favor free expression because consumers would not likely be confused by the two works or think that Dr. Seuss was responsible for the defendants' publication.<sup>224</sup> Finally, the defendants' work could be considered a comment on either society's obsession with the O.J. Simpson trial or the criminal justice system,<sup>225</sup> making it a satire commenting on society that is worthy of protection. Thus, by disregarding the copyright distinction, a court employing an expanded balancing test could freely hold that the trademarks used in *Dr. Seuss* were such a large part of public discourse and created so little confusion that the interest in free expression outweighed the need to protect consumers, even though the challenged work was a satire.

The protection that would be extended to the trademark satirists in *Dr. Seuss* under the application of the expanded balancing test would have also greatly aided the defendant in *Elvis*. As in *Dr. Seuss*, the name Elvis Presley is undoubtedly a famous trademark<sup>226</sup> and the use of his mark was an expressive comment on society, in this case that of America in the 1960s.<sup>227</sup> Thus, this satirical expression would have to be examined under the expanded balancing test. Conceding that there might be some confusion as to the actual sponsorship of the restaurant,<sup>228</sup> it seems clear that this would be outweighed by the public's right to use the mark in a satirical way. Because the overriding concern of trademark law is the protection of the public, the court should have recognized that, when attempting to lampoon

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223. While "The Cat in the Hat" is a celebrated children's book, "The Cat NOT in the Hat" included phrases such as "One Knife?/Two Knife?/Red Knife/Dead Wife" and was clearly not intended for a younger reading audience. *Dr. Seuss*, 109 F.3d at 1401.

224. The Ninth Circuit noted that no actual confusion could be found at the time of the case due to the injunction that had prevented distribution of the defendants' book. *Id.* at 1405.

225. The work in question ends with what the court called a "moral dilemma" and text that could easily be seen as questioning the result of the Simpson trial: "And then you have JUSTICE/Or maybe you don't... 'Cause if the Cat didn't do it?/Then who? Then who? ... Oh my! Oh Me!/The murderer is running free." *Id.* at 1402.

226. See Cordero, *supra* note 29, at 633 (observing that Elvis has gained even more fame after his death, and has subsequently transformed from "idol to icon" who is at the "center of a cultural obsession that ranges from impersonators and sightings, to candlelight vigils" at Graceland).

227. See *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 200 (5th Cir. 1998) (identifying "The Velvet Elvis" restaurant as a comment on the "faddish bars of the 1960s" that did not require the use of Elvis' marks because it did not target his celebrity).

228. See *id.* at 204 (finding that there was some evidence of actual confusion by consumers who assumed that the restaurant was associated with Elvis Presley and might have some of his merchandise for sale).

the 1960s,<sup>229</sup> of which Elvis was an integral part,<sup>230</sup> the use of Elvis' mark should be allowed because Elvis has come to symbolize more than just a single person.<sup>231</sup> Much like it is impossible to discuss luxury cars without using the Rolls Royce trademark,<sup>232</sup> a restaurant seeking to specifically mock the rock and roll consumer culture of the 1960s would be lost without being able to reference Elvis Presley, and thus the public necessity to use the mark would justify protection for the satire.<sup>233</sup>

Furthermore, the issue in *Elvis* is similar to that of *Parks* because both cases involved a celebrity trying to limit the use of his or her name and image. While the defendant's restaurant in *Elvis* is arguably different from the song in *Parks*, the interior decorations of a store can be just as expressive as a painting or other work of art.<sup>234</sup> Thus, any attempt by Elvis Presley Enterprises to limit the use of Elvis' name in an expressive work can be seen as a violation of the primary purpose of trademark law: protection of the consuming public, not of the mark's owner. In both *Parks* and *Elvis*, the plaintiffs raised the claim of potential and actual confusion,<sup>235</sup> and while this argument is

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229. The district court that was overruled in *Elvis* stated that the defendant was trying to mock "a time or concept from the sixties—the Las Vegas lounge scene, the velvet painting craze," and explained that the Elvis mark was "an integral part" of this comment. *Id.* at 200 (citing *Elvis Presley Enterprises, Inc. v. Capece*, 950 F. Supp. 783, 792 (S.D. Tex. 1996)).

230. See *Cordero*, *supra* note 29, at 633 ("[Elvis] was the major force behind the American rock-and-roll movement.").

231. See *Kozinski*, *supra* note 29, at 972–73 (arguing that when a trademark does more than simply identify a product's source, "allowing the trademark holder to restrict their use implicates our collective interest in free and open communication"); *cf.* *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 580–81, 585 (2d Cir. 1990) (finding that Babe Ruth, who "hardly needs an introduction" has become synonymous with baseball, and because the "National Pastime" is something that "belongs to all of us," there was no infringement when Ruth's image was used in a calendar); *Jollymore*, *supra* note 119, at 141 (arguing that when a celebrity image becomes a symbol the right to use his or her name should "pass into the public domain").

232. See *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002) ("How else do you say that something's 'the Rolls Royce of its class?'").

233. The use of the Elvis mark by "The Velvet Elvis" restaurant was not in direct competition with Elvis Presley Enterprises because no official Elvis restaurants had been opened at the time "The Velvet Elvis" was operating. *Elvis*, 141 F.3d at 202–03.

234. The Supreme Court has held that just because there is a commercial nature to a defendant's expression does not mean that he or she is barred from using a fair use defense such as parody or satire. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 584 (1994) (reasoning that if the commerciality of a work acted against fair use, then for-profit activities such as teaching, scholarship, research, and news reporting would be subject to infringement litigation). This view seems to contradict an earlier opinion of the Court, which held that the "fact that a publication was commercial as opposed to nonprofit is a . . . factor that tends to weigh against a finding of fair use." *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562 (1985).

235. See *Parks v. LaFace Records, Inc.*, 329 F.3d 437, 446 (6th Cir. 2003) (noting that Rosa Parks alleged that the title of the song "Rosa Parks" leads consumers to

more persuasive in *Elvis* because a consumer might reasonably believe that Elvis' estate was involved in running a restaurant, Elvis was not the only target of the defendant's satire.<sup>236</sup> Because the restaurant sought to comment on broad elements of the 1960s, Elvis would presumably not be the only celebrity image displayed, thus limiting the confusion. Therefore, much like in *Parks*, whatever negligible amount of confusion potentially existed in *Elvis* would be outweighed by the need for satirists to use a famous celebrity trademark to comment on the society in which that celebrity participated.

Finally, while the defendants prevailed in *Mattel* due to the application of the title aspect of the Second Circuit balancing test,<sup>237</sup> applying the expanded test would have provided the defendants additional freedom. Much like Rosa Parks, Elvis Presley, and *The Cat in the Hat*, Barbie is a famous trademark and cultural icon.<sup>238</sup> Indeed, Barbie has been used in numerous examples of popular culture beyond the Aqua song at issue in *Mattel*.<sup>239</sup> It is only reasonable then that the public be able to comment freely on the Barbie mark that it helped create.<sup>240</sup> It becomes clear that in an application of the expanded balancing test, the court would side with the interest in free expression, much as it did in the actual case.<sup>241</sup> However, instead of relying on the *Rogers* and *Cliffs Notes* test<sup>242</sup> that serves only to limit

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believe that she was affiliated with the group OutKast); *Elvis*, 141 F.3d at 193 (recognizing that the plaintiff claimed that there was a likelihood of confusion between its marks and those used by the defendant).

236. Even the Fifth Circuit, in ruling against the defendant, held that the restaurant was a "parody of the faddish bars of the sixties" and not limited to Elvis alone. *Elvis*, 141 F.3d at 200.

237. See *Mattel*, 296 F.3d at 901 (finding that the title "Barbie Girl" referenced the underlying song, and that the song was protected because it parodied the Barbie mark in a way consistent with the *Campbell* distinction).

238. See *id.* at 898 (noting that Barbie is a public figure who has been "labeled both the ideal American woman and a bimbo").

239. See DAVID BOWIE, *Young Americans*, on YOUNG AMERICANS (RCA Records 1975) (using the lines "Well, it ain't that Barbie doll/Her heart's been broken just like you have" in a song referencing teenage sex, pregnancy, guns, and pimps); JOHN HIATT, *The Wreck of the Barbie Ferrari*, on PERFECTLY GOOD GUITAR (A&M Records 1993) (describing the domestic disaster that is the life of Ken and Barbie using lyrics such as "They look like a family but they're really not at all," "As he loaded the chamber, her eyes got starry/It ain't the end of the world/It's just the wreck of the Barbie Ferrari," and "He finds them huddled by the toy box and splatters 'em all")..

240. This is inferred by the court in *Mattel*. See *Mattel*, 296 F.3d at 900 ("Once imbued with such expressive value, the trademark becomes a word in our language and assumes a role outside the bounds of trademark law."); see also Gallo, *supra* note 188, at 417 (interpreting the Ninth Circuit's decision as concluding that the public should be able to "enjoy the ability to comment on the trademark that it has helped to attain greatness").

241. *Mattel*, 296 F.3d at 902.

242. See *id.* (accepting the Second Circuit's test in *Rogers* as controlling and holding that the title "Barbie Girl" is relevant to the underlying work).

the possible protections of trademark satire, the court should have followed its prior reasoning<sup>243</sup> to its logical conclusion and found that the work was allowed because it was an expressive comment on Barbie and the society that she represents.<sup>244</sup> Finally, while the court in *Mattel* did not feel the need to address the likelihood of confusion test,<sup>245</sup> it is unlikely that there would be such a vast amount of consumer confusion that the court would decline to protect the public's right to free expression in any such balance.<sup>246</sup>

#### CONCLUSION

Satire is an expressive tool that writers and artists have used since the time of ancient Athens<sup>247</sup> to create works that do everything from entertain<sup>248</sup> to cause the downfall of powerful politicians.<sup>249</sup> There are many tangible benefits that flow from the power of satirical works<sup>250</sup>

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243. See *id.* at 900 (“[T]he trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function.”).

244. The court did find that the song directly targeted Barbie, and thus was a parody. *Id.* at 901. However, Barbie has come to represent so many things to so many people that any comment on her can also be seen as a statement about society in general. See Tamar Buchakjian, Comment, *Mattel, Inc. v. MCA Records, Inc.: Let's Party in Barbie's World—Expanding the First Amendment Right to Musical Parody of Cultural Icons*, 36 LOY. L.A. L. REV. 1321, 1323 (2003) (concluding that Barbie's popularity and overtly feminine figure have made her “celebrated as the prototypical woman and simultaneously blamed for creating unrealistic expectations of women”); Gallo, *supra* note 188, at 421 (noting the many meanings that the Barbie symbol has held and that she can be used to “describe[] a class of attributes referencing modern womanhood”).

245. See *Mattel*, 296 F.3d at 900 (reasoning that the traditional *Sleekcraft* likelihood of confusion test does not apply to cases where a mark has achieved an expressive meaning distinct from its original source-identifying function).

246. See *id.* at 902 (holding that the title “Barbie Girl” does not mislead the consumer, nor does the album suggest any association with Mattel). One glance at the lyrics of the song confirms that the average consumer would not think phrases such as “I’m a blond bimbo girl, in the fantasy world/Dress me up, make it tight, I’m your dolly” and “Kiss me here, touch me there, hanky-panky/You can touch, you can play if you say ‘I’m always yours,’/oh ooh” in connection with a Barbie doll would have originated with Mattel. AQUA, *supra* note 125.

247. Perhaps the best example of an ancient satirist is the comic poet Aristophanes, whose play *Ecclesiazusae* (*Assemblywomen*) used a humorous plot regarding a female take-over of the city to comment on the politics of the time. ARISTOPHANES, *Assemblywomen*, in *THREE PLAYS BY ARISTOPHANES* 143 (Jeffrey Henderson, trans. & ed., Routledge 1996). See generally JOSIAH OBER, *POLITICAL DISSENT IN DEMOCRATIC ATHENS: INTELLECTUAL CRITICS OF POPULAR RULE* 122–55 (1998) (discussing the dual comic and political nature of the play).

248. See Dorsen, *supra* note 12, at 923 (listing Shakespeare, Orwell, Woody Allen, and the writers of *Mad Magazine* as leading satirists).

249. Indeed, the cartoons of Thomas Nast are largely credited with leading to the demise of New York City's Boss Tweed and the Tammany Hall political machine of the second half of the 1800s. *Id.* at 925 n.9.

250. See Mastrullo, *supra* note 166, at 1311 (reasoning that, while humor is often not intended to be taken seriously, it can also carry the “sting of criticism and

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that make it in the best interest of society to have such expressions be protected by the courts.<sup>251</sup> This is especially true in trademark law, where it is the job of the judicial system to act on behalf of the public in a traditional likelihood of confusion trademark action. Simple ownership of a trademark cannot serve as a monopoly over the use of a word, symbol, or image, especially after public recognition and corporate marketing have made it a part of our national discourse.

Under the current standard in trademark law that relies on doctrine borrowed from copyright, many potential satirists could be deterred from using trademarks in their work out of fear of being sued. This not only creates an undesirable amount of uncertainty regarding potential litigation, but also silences free speech in the marketplace of ideas. When the Supreme Court endorsed the parody/satire distinction it was speaking only for copyright law, an area where authors need increased protection for their original works because of the creative nature of the speech. A trademark owner does not need these added protections because his or her mark was established primarily for public benefit, and so creativity and artistic integrity, while certainly important, are not the overriding concerns of the courts. Rather, when examining a trademark infringement case that deals with a claim of parody or satire, courts should look no further than a simple balance of the desire to avoid confusion with that of the need for free expression.

The fact that courts have begun to employ such a test when examining parody shows that a foundation for the protection of trademark satire is firmly in place. However, the Second Circuit balancing test does not go far enough because it is limited to titles and parodies in a way that leaves satire excluded from the security of First Amendment protection. The differences between the goals, protections, and types of speech involved in copyright and trademark law, when combined with the fact that famous trademarks have become a part of the national culture and public domain, justify granting the creative use of trademarks more protection than those that borrow copyrighted material. Indeed, it would only take a small step for a court to embrace trademark satire as worthy of constitutional protection, and all that is needed is the initiative that

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embarrassment from ridicule” that sometimes goes as far as to evoke “outrage and indignation instead of amusement and laughter”).

251. See Einhorn, *supra* note 145, at 603 (contending that the “gains to the general public from satire . . . seem greater than in parody” because it uses recognized symbols to “ridicule or criticize political institutions, cultural values, or media presentations”).

allows satire to take its natural position alongside parody as a valued form of First Amendment expression.