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Are the First Amendment Protections Too Big for its Breeches?: Hemming the TDRA's Frayed Noncommercial Use Exception

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**ARE THE FIRST AMENDMENT’S PROTECTIONS TOO
BIG FOR ITS BREECHES?: HEMMING THE TDRA’S
FRAYED NONCOMMERCIAL USE EXCEPTION**

Nellie Amjadi*

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INTRODUCTION

Posters depicting a scandalously dressed woman line Belgian streets.¹ One such poster catches the attention of a passerby. His eyes are immediately drawn to her long, exposed legs and tall stilettos, prominently displaying red lacquered outsoles.² The iconic red-soled stilettos are easily recognizable as Christian Louboutin’s trademark.³

Upon further inspection, the man discovers that the poster actually depicts a provocative political advertisement, created and distributed in Belgium by the Flemish, anti-immigrant, far right-wing Vlaams Belang party.⁴ This Flemish group campaigns against the influx of Muslim immigrants in their “Women Against Islamisation” Campaign.⁵ The ad features former Miss Belgium and current senator, Anke Vandermeersch.⁶

Beside the image of [Vandermeersch] wearing the shoes, a key show[s] what it claim[s] [is] Islam’s view of a woman, as measured by the length of her skirt, from “sharia

1. See *infra* Appendix, Figure 1.

2. See Bianca London, *Christian Louboutin Wins Court Ruling Against Anti-Islam Group Who ‘Tarnished’ the Brand’s Image by Featuring Iconic Red-Soled Shoes in their Paraphernalia*, DAILY MAIL (Oct. 16, 2013, 7:43 AM), <http://www.dailymail.co.uk/femail/article-2462621/Christian-Louboutin-wins-court-ruling-anti-Islam-group-Women-Against-Islamisation.html>.

3. CHRISTIAN LOUBOUTIN, Registration No. 3,376,197; see also *Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.*, 696 F.3d 206, 212 (2d Cir. 2012) (“Louboutin’s trademark, which covers the red, lacquered outsole of a woman’s high fashion shoe, has acquired limited “secondary meaning” as a distinctive symbol that identifies the Louboutin brand.”).

4. *Designer Louboutin Wins Court Ban on Anti-Islam Ad*, AGENCE FRANCE-PRESSE (Oct. 14, 2013), available at <http://www.globalpost.com/dispatch/news/afp/131014/designer-louboutin-wins-court-ban-anti-islam-ad> (“The Flemish Interest party has suffered in the polls in recent years and regularly launches provocative media campaigns against what it calls the ‘Islamisation’ of Belgium.”).

5. *Id.*

6. *Id.*

compatible” at floor level to “whore” just above the knee and “stoning” at the top of the thigh.⁷

Not surprisingly, Louboutin requested the Antwerp Court in Belgium to issue an emergency “cease and desist” order against the Flemish group’s unauthorized use because it “tarnished his image.”⁸ Ms. Vandermeersch, the group’s spokesperson replied, “Are politicians still allowed to dress the way they want? A legal judgment on a dress code for politicians would be a surreal precedent.”⁹

Contrary to Ms. Vandermeersch’s belief, Louboutin was not concerned with her style of dress; rather, Louboutin did not want his brand to be associated with an anti-Islamic message.¹⁰ The court granted Louboutin’s request and ordered the removal of all the posters within twenty-four hours.¹¹ Post-injunction, the group tweeted a revised poster,¹² portraying the same political message, but with yellow soles.¹³ Thus, Louboutin succeeded in preserving his brand and reputation in Europe and the Flemish group continued to spread their message.

Louboutin might not fare as well in the United States. First, it is unlikely that a U.S. court would find the Flemish group infringed Louboutin’s trademark because consumers are unlikely to be confused as to the source or sponsorship of the posters.¹⁴ Second, this exact situation in the United States could not result in a successful tarnishment claim due to the noncommercial use exception,¹⁵ which allows unauthorized use of a registered trademark in noncommercial

7. *Louboutin Wins Lawsuit Against Anti-Islam Group*, HUFFINGTON POST (Oct. 14, 2013), http://www.huffingtonpost.com/2013/10/14/louboutin-lawsuit-anti-islam_n_4098593.html.

8. *Designer Louboutin Wins Court Ban on Anti-Islam Ad*, *supra* note 4.

9. London, *supra* note 2.

10. Economically, this makes sense. As Arabian Business reports, the luxury goods market in the Middle East is growing, fast. With projected sales of \$7.7 billion, the Middle East is among the ten largest luxury goods market in the world. Andy Sambridge, *MidEast Luxury Retail Market Worth \$7.7bn*, ARABIANBUSINESS.COM (July 13, 2013), <http://www.arabianbusiness.com/mideast-luxury-retail-market-worth-7-7bn-study-508678.html>.

11. *Louboutin Wins Lawsuit Against Anti-Islam Group*, *supra* note 7.

12. See *infra* Appendix, Figure 3.

13. *Louboutin Wins Lawsuit Against Anti-Islam Group*, *supra* note 7.

14. See discussion *infra* Part II.A.

15. Trademark Dilution Revision Act, 15 U.S.C. § 1125(c)(3)(C) (2012).

speech.¹⁶ This Comment will analyze why the noncommercial use exception excludes Louboutin from successfully bringing a cause of action for trademark protection and will argue why Congress should remove the exception from the dilution statute. To properly balance trademark and constitutional rights, courts should focus on two questions: (1) whether the unauthorized use is relevant to the message being communicated, and (2) whether the use presents a risk of economic harm through loss of goodwill to the trademark owner from association with the undesired speech.

Part I of this Comment gives background information about United States trademark laws and an overview of First Amendment jurisprudence.¹⁷ Part II will demonstrate the existing law's failure to protect mark owners from harmful unauthorized uses, illustrated by Louboutin's suit, which if brought in the United States, would likely not result in an injunction.¹⁸ Lastly, Part III will propose a change to the existing federal trademark statute, which will provide trademark owners a just result compatible with trademark and First Amendment objectives.¹⁹

I. BACKGROUND

A. *United States Trademark Law*

Trademark law addresses two policies.²⁰ First, it promotes the public's interest in receiving truthful, relevant information regarding the source of goods and services in the marketplace.²¹ Second, it protects trademark owners'

16. See discussion *infra* Part II, for an explanation of the likely result in U.S. courts under current law.

17. See *infra* Part I.

18. See *infra* Part II.

19. See *infra* Part III.

20. S. REP. NO. 79-1333, at 3-5 (1946) ("The purpose underlying any trademark statute is twofold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats.").

21. See *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003) ("Federal trademark law . . . by preventing competitors from copying a 'source-identifying mark,' 'reduce[s] the customer's costs of shopping and making purchasing decisions' . . ." (quoting *Qualitex Co. v. Jacobson Prods.*

business goodwill²² from economic and reputational harm that stems from consumer confusion as to source, or dilution by blurring or tarnishment.²³

Federal trademark law, enacted by Congress in 1946, establishes a “statutory framework for the registration and protection of trademarks for goods and services.”²⁴ Named the Lanham Act,²⁵ the law defines a trademark as any word, name, symbol, or device, or any combination thereof, used by a person to distinguish and indicate the source of his or her goods.²⁶ Provided the mark creates a “distinct commercial impression” on the viewer or listener²⁷—one that primarily distinguishes the goods of one person from the goods of others—it may be registered.²⁸

The Lanham Act provides registered trademark owners

Co., 514 U.S. 159, 163–64 (1995)).

22. See Marlene B. Hanson & W. Casey Walls, *Protecting Trademark Goodwill: The Case For a Federal Standard of Misappropriation*, 81 TRADEMARK REP. 480, 485–95 (1991), for an excellent discussion on the importance of protecting trademark goodwill.

23. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995) (“[T]he law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product.”); see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992) (“Protection of trade dress, no less than of trademarks, serves the Act’s purpose to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.” (quoting *Park N’ Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 198 (1985) (citations and internal quotations omitted))).

24. *Serbin v. Ziebart Intern. Corp., Inc.*, 11 F.3d 1163, 1164 (3d Cir. 1993).

25. 15 U.S.C. §§ 1051–1127 (2000 & Supp. 2006). The Lanham Act is the federal statute regulating trademark rights. See SIEGRUN D. KANE, TRADEMARK LAW: A PRACTITIONER’S GUIDE § 1:2.1, at 1–9 to 1–11 (4th ed. 2005). See also *Qualitex*, 514 U.S. at 162.

26. 15 U.S.C. § 1127. Marks indicating the source of services are also protected under the Lanham Act, but for the purposes of this paper I will refer to service marks as trademarks. Lanham Act § 3, ch. 540, 60 Stat. 429 (1946) (codified as amended at 15 U.S.C. §1053 (2012)).

27. *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 29 (1st Cir. 2008).

28. MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:10 (4th ed. 2014). “Designs (e.g. Nike Swoosh Design), product shapes (e.g. the shape of the Coca-Cola bottle), slogans (e.g. Nike’s “Just do it”), sounds (e.g. the NBC chimes), colors (e.g. green gold color for dry cleaning pads), and even smell (e.g. a floral fragrance serving as a trademark for sewing thread), are all recognized and protected as trademarks.” See also Uche U. Ewelukwa, *Article: Comparative Trademark Law: Fair Use Defense in the United States and Europe—The Changing Landscape of Trademark Law*, 13 WIDENER L. REV. 97, 100 (2006) (citations omitted).

with the “exclusive right to use the registered mark in commerce on or in connection with the goods or services specified,”²⁹ subject to certain “legal or equitable defense[s] or defect[s].”³⁰ The Lanham Act provides three causes of action for registered marks.³¹ Section 32 provides registered mark owners a cause of action for the “exclusive right to use” articulated in section 33(a).³² Section 43(a) provides registered and unregistered marks with a cause of action for any false designation of origin, false description, or false or misleading representation of fact that is likely to lead to consumer confusion.³³ Additionally, section 43(c) provides, in part, for injunctive relief against dilution by blurring or tarnishment.³⁴

1. *Likelihood of Confusion Under the Lanham Act*

Under the Lanham Act, a registered mark owner may protect their trademark from unauthorized use in connection with goods or services.³⁵ The unauthorized use must be in commerce and likely to cause consumer confusion as to source or sponsorship.³⁶ If both infringement criteria are met, the trademark owner may be compensated with damages³⁷ or injunctive relief.³⁸

The Lanham Act sets forth two main requirements in order to bring an infringement cause of action against an unauthorized use.³⁹ The “use in commerce” requirement functions primarily as a jurisdictional nexus, allowing Congress to regulate under the Commerce Clause.⁴⁰ Courts generally find this requirement satisfied because it “does not

29. 15 U.S.C. § 1115.

30. *Id.* See *infra* note 48 for a list of defenses.

31. See 15 U.S.C. §§ 1115, 1125(a), 1125(c).

32. *Id.* §§ 1114, 1115(a). The Lanham Act is codified at 15 U.S.C. §§ 1051–1127 and is also referred to in its parallel number scheme: Lanham Act §§ 1–45.

33. 15 U.S.C. § 1125(a).

34. *Id.* § 1125(c)(1).

35. See *id.* § 1114(1)(a).

36. *Id.*

37. *Id.* § 1117(a).

38. *Id.* § 1116(a).

39. See *id.* § 1114.

40. U.S. CONST. art. 1, § 8, cl. 3; see also *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 92–93 (2d Cir. 1997); *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 679 (9th Cir. 2005).

require any actual *sale* of goods and services.”⁴¹ The element is satisfied if the mark is placed on the goods, their containers, the associated display, affixed on the tags or labels, “or if the nature of the goods makes such placements impracticable then on documents associated with the goods or their sale, and the goods are sold or transported in commerce”⁴²

The second requirement, “likelihood of confusion,” requires a more demanding analysis than the former. Courts must decide whether the unauthorized use will confuse consumers as to source or sponsorship of a mark.⁴³ Federal courts analyze a number of factors to be considered in determining whether the use is likely to confuse.⁴⁴ In *AMF, Inc. v. Sleekcraft Boats*, the Court of Appeals for the Ninth Circuit articulated the following factors for the likelihood of confusion evaluation: (1) strength of the mark, (2) proximity of the goods, (3) similarity of the marks, (4) evidence of actual confusion, (5) marketing channels used, (6) type of goods and the degree of care likely to be exercised by the purchaser, (7) defendant’s intent in selecting the mark, and (8) the likelihood of expansion of the product lines.⁴⁵ Courts weigh each factor differently depending on the circumstance.⁴⁶ Typically, the weight given to any factor is determined by how applicable that factor is to the given marks.⁴⁷

2. *Statutory and Common Law Defenses to Trademark Infringement*

Trademark law provides alleged infringers with several defenses.⁴⁸ An unauthorized user can assert such defenses

41. *Kremer*, 403 F.3d at 679.

42. 15 U.S.C. § 1127.

43. *Id.* § 1114(1)(a).

44. “While the list of factors followed by the courts all owe their origin to the 1938 Restatement of Torts, each of the 13 federal circuit courts of appeals has developed its own version of the list and each appears to be jealous of its own formulation of factors.” MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:30 (4th ed. 2014).

45. *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979).

46. *Brookfield Commun. v. West Coast Entm’t Corp.*, 174 F.3d 1036, 1054 (9th Cir. 1999) (“Some factors are much more important than others, and the relative importance of each individual factor will be fact specific.”).

47. *Id.*

48. Some defenses not discussed in this paper include functionality, fraud in obtaining registration or incontestable status, abandonment, misrepresentative

even when the mark owner successfully proves likelihood of confusion and the other elements of a prima facie case of infringement.⁴⁹ One such statutory defense, codified in section 33(b)(4) of the Lanham Act, is the fair use defense.⁵⁰ To demonstrate fair use, an unauthorized mark user must demonstrate that the mark was used descriptively, in good faith, and other than as the mark.⁵¹ For example, the well-known electronic retailer's registered mark BEST BUY cannot bar all uses of "best buy" because "best buy" is descriptive—it describes the price and quality of a product.⁵²

Common law nominative fair use is also available to infringers in some jurisdictions.⁵³ Unlike statutory fair use, described above, nominative fair use requires the accused infringer to use the mark in its secondary, trademark sense.⁵⁴ The Ninth Circuit, in holding that the use of a popular boy band's trademark in public opinion polls without their permission was permitted because the use qualified as a nominative fair use, articulated the following test for nominative fair use:

First, the product or services in question must be one not readily identifiable without use of the trademark; second, only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and third, the user must do nothing that would, in

use of the mark by the trademark owner, prior use of the mark by a defendant, antitrust violations by the trademark owner, and equitable principles. See Lanham Act § 33(b), 15 U.S.C. § 1115(b); see also, Ewelukwa, *supra* note 28, at 128 n.221.

49. KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111, 124 (2004).

50. 15 U.S.C. § 1115(b)(4).

51. See generally Kelly-Brown v. Winfrey, 717 F.3d 295 (2d Cir. 2013) (holding unauthorized mark users did not establish a fair use defense under Lanham Act Section 33(b)(4) because they did not demonstrate that their use was other than as a mark, was descriptive, or was used in good faith).

52. Best Buy Warehouse v. Best Buy Co., Inc., 751 F. Supp. 824, 826 (W.D. Mo. 1989), *aff'd*, 920 F.2d 536 (8th Cir. 1990).

53. See Carl Regelmann, *Trademark Nominative Fair Use: The Relevance of the "New Kids on the Block Factors" After the Supreme Court KP Permanent Make-Up v. Lasting Impression Decision*, 16 DEPAUL-LCA J. ART & ENT. L. 1, 8–9 (2005); see also Peter M. Brody & Alexandra J. Roberts, *What's In a Domain Name? Nominative Fair Use Online After Toyota v. Tabari*, 100 TRADEMARK REP. 1290, 1299–1318 (2010) (explaining federal circuit court treatment of the nominative fair use doctrine).

54. New Kids on the Block v. News America Publ'g, Inc., 971 F.2d 302, 308 (9th Cir. 1992).

conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.⁵⁵

Nominative fair use is also recognized in the Second,⁵⁶ Third,⁵⁷ Fifth,⁵⁸ and Eighth Circuits,⁵⁹ but the Sixth Circuit expressly rejects nominative fair use as a substitute for the multi-factor likelihood of confusion analysis.⁶⁰

3. *Federal Trademark Dilution*

The federal trademark dilution statute gives a famous mark owner the ability to enjoin unauthorized use of its famous marks if the use is “likely to cause dilution by blurring or dilution by tarnishment.”⁶¹ Trademark dilution, unlike trademark infringement, does not require consumer confusion.⁶² Instead dilution “protect[s] the trademark owners from an appropriation-of, or free-riding-on the substantial investments . . . made in their mark.”⁶³ Congress enacted the Federal Trademark Dilution Act (“FTDA”),⁶⁴ codified in section 43(c) of the Lanham Act, in 1995 and revised it in 2006. The 2006 revision, called the Trademark Dilution Revision Act (“TDRA”),⁶⁵ overruled the Supreme

55. *Id.*

56. *See* *Chambers v. Time Warner, Inc.*, 282 F.3d 147, 156 (2d Cir. 2002) (acknowledging the district court’s application of the Ninth Circuit’s nominative fair use test to support its dismissal of an infringement complaint).

57. *See* *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 228 (3d Cir. 2005) (reversing the district court’s injunction and remanding for analysis under the majority’s articulated two-part nominative fair use test).

58. *See* *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 546 (5th Cir. 1998) (formulating a test for nominative fair use which includes an analysis of likelihood of confusion).

59. *See* *Calvin Klein Cosmetics Corp. v. Lenox Laboratories*, 815 F.2d 500, 503 (8th Cir. 1987); *see also* *Brody & Roberts*, *supra* note 53, at 1312–13 (“The Eighth Circuit has generally adhered to the principle of nominative fair use without formulating any specific test.”).

60. *See* *PACCAR Inc. v. TeleScan Techs., LLC*, 319 F.3d 243, 256 (6th Cir. 2003) (rejecting nominative fair use analysis as substitute for traditional multi-factor analysis of likelihood of confusion).

61. 15 U.S.C. § 1125(c)(1) (2000 & Supp. 2006).

62. *Id.*

63. *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 903 (9th Cir. 2000) (internal quotations omitted).

64. Federal Trademark Dilution Act of 1995, Pub. L. No. 104–98, § 3, 109 Stat. 985, 985 (1996) (codified as amended at 15 U.S.C. § 1125(c) (2012)).

65. Trademark Dilution Revision Act of 2006, Pub. L. No. 109–312, 120 Stat. 1730, 1731–33 (2006).

Court's holding in *Moseley v. V Secret Catalogue*⁶⁶ that "actual dilution" must be shown.⁶⁷ The TDRA changed the standard from "causes dilution" to "likely to cause dilution."⁶⁸ Alongside clarifying issues involving fame and commercial use, the TDRA also articulated two specific types of dilution: dilution by blurring and dilution by tarnishment.⁶⁹

The TDRA defines dilution by blurring as an "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark."⁷⁰ To determine dilution by blurring, the TDRA instructs courts to consider factors such as similarity, distinctiveness, exclusive use by the famous mark owner, recognition, defendant's intent, and actual association between defendant's mark and the famous mark.⁷¹ Dilution by tarnishment is important to trademark owners because it protects the trademark owner's considerable investment in ensuring that consumers maintain positive associations with the trademark.⁷² Use of a trademark in a negative context, such as in the context of sexual activity,⁷³ obscenity, or illegal activity,⁷⁴ is contrary to that goal.⁷⁵

A requirement for bringing a dilution cause of action under the TDRA is fame.⁷⁶ Under the TDRA, "a mark is famous if it is widely recognized by the general consuming

66. 537 U.S. 418, 433 (2003).

67. *Id.* ("The relevant text of the [Federal Trademark Dilution Act] . . . unambiguously requires a showing of actual dilution, rather than a likelihood of dilution."), *superseded by statute*, Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, § 2, 120 Stat. 1730, 1731-32 (2006).

68. Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, § 2, 120 Stat. 1730 (2006).

69. *Id.*

70. 15 U.S.C. § 1125(c)(2)(B).

71. *Id.*

72. *Adidas Am., Inc. v. Payless Shoesource, Inc.*, 546 F. Supp. 2d 1029, 1060 (D. Or. 2008) (citing *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1012 (9th Cir. 2004)).

73. *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 392 (6th Cir. 2010) (holding that "Victor's Little Secret" when used to sell sexual toys, videos, and similar soft-core pornographic products tarnished the famous mark VICTORIA'S SECRET).

74. *Navajo Nation v. Urban Outfitter, Inc.*, 935 F. Supp. 2d 1147, 1168 (D.N.M. 2013) (citing *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 507 (2d Cir. 1996)).

75. *Moseley*, 605 F.3d at 384-85.

76. 15 U.S.C. § 1125(c)(1).

public of the United States as a designation of a source of the goods or services of the mark's owner."⁷⁷ Several factors help determine whether a mark is famous.⁷⁸ These include the mark's advertising, the amount, volume, geographic extent of goods or services sold under the mark, actual recognition of the mark, and when and how the mark was registered.⁷⁹ Courts often deny relief when a mark is found to be insufficiently famous.⁸⁰ "Some examples of marks that have been found to be insufficiently famous marks under the TDRA are: CHARLOTTE for clothing and accessories; JARRITOS for soft drinks; SUNSHINE IN A BOX for sunlamps; [and] the University of Texas 'longhorn logo . . .'"⁸¹ Examples of famous marks include "NIKE; PEPSI; eBAY, the adidas 'Three-Stripe Mark' for shoes; and Louis Vuitton 'Monogram Multicolore Mark' for handbags."⁸² "Courts have also assumed—without deciding—that the following marks are sufficiently famous under the TDRA: DIANE VON FURSTENBERG for dresses, STARBUCKS for coffee, and VICTORIA'S SECRET for lingerie."⁸³

4. Exclusions and Defenses to Dilution under the TDRA

The TDRA exempts certain unauthorized uses from a dilution cause of action.⁸⁴ The exclusions, described in further detail in Part III, are: fair uses, including comparative advertising, parodies, criticisms, or comments on the famous mark owner's goods or services;⁸⁵ news reporting and commentary;⁸⁶ and noncommercial uses.⁸⁷ These exemptions are intended to preserve First Amendment speech

77. *See id.* § 1125(c)(2)(A).

78. *See generally* Barton Beebe, *A Defense of the New Federal Trademark Antidilution Law*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1143, 1157–65 (2006) ("This is a new formulation that provides guidance to the courts on how famous a mark must be to qualify for anti-dilution protection, something that the FTDA failed to do.").

79. 15 U.S.C. § 1125(c)(2)(A)(i)–(iv).

80. *See* Sarah Burstein, *Dilution by Tarnishment: The New Cause of Action*, 98 TRADEMARK REP. 1189, 1217 (2008).

81. *See id.* at 1217 and accompanying footnotes.

82. *See id.* at 1218 and accompanying footnotes.

83. *See id.*

84. 15 U.S.C. § 1125(c)(3).

85. *Id.* § 1125(c)(3)(A).

86. *Id.* § 1125(c)(3)(B).

87. *Id.* § 1125(c)(3)(C).

rights.⁸⁸

B. Levels of Speech Protection Under the First Amendment

In pertinent part, the First Amendment states that “Congress shall make no law . . . abridging the freedom of speech”⁸⁹ The First Amendment renders unconstitutional state action that prohibits or unduly burdens First Amendment speech rights.⁹⁰ Any law that regulates speech based on its content and discriminates as to either viewpoint or subject matter⁹¹ is presumptively unconstitutional, and consequently must meet a rigorous strict scrutiny standard.⁹² To regulate speech based on content, the state must show the law is narrowly tailored to achieve a compelling governmental interest using the least restrictive means.⁹³

Overbroad and vague regulations must also meet strict scrutiny because these regulations have the ability to chill protected speech.⁹⁴ In overbreadth cases “the possible harm to society in permitting some unprotected speech to go unpunished is outweighed by the possibility that protected speech of others may be muted”⁹⁵ Vague regulations chill speech because of the speaker’s uncertainty as to what is

88. MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:90 (4th ed. 2014).

89. U.S. CONST. amend. I.

90. U.S. CONST. amend. I; *see* *R.A.V. v. City of St. Paul*, 505 U.S. 377, 382 (1992) (“The First Amendment generally prevents government from proscribing speech or even expressive conduct, because of disapproval of the ideas expressed.” (citations omitted)).

91. *Consol. Edison Co. v. Public Serv. Comm’n*, 447 U.S. 530, 537 (1980) (“The First Amendment’s hostility to content-based regulations extends not only to restrictions on particular viewpoints, but also to prohibition of public discussion of an entire topic.”).

92. *See R.A.V.*, 505 U.S. at 382; *see also Consol. Edison*, 447 U.S. at 540 (“Where a government restricts the speech of a private person, the state action may be sustained only if the government can show that the regulation is a precisely drawn means of serving a compelling state interest.”).

93. *Sable Comm’ns of Cal., Inc. v. F.C.C.*, 492 U.S. 115, 126 (1989) (“The Government may, however, regulate the content of constitutionally protected speech in order to promote a compelling interest if it chooses the least restrictive means to further the articulated interest.”).

94. *City of Chi. v. Morales*, 527 U.S. 41, 60–62, 64 (1999).

95. *Broadrick v. Okla.*, 413 U.S. 601, 612 (1973).

protected or unprotected under the regulation.⁹⁶ Both overbroad and vague regulations are unconstitutional and are struck by courts.⁹⁷

There are certain areas of speech that, while subject to heavier regulation, implicate less risk of deterring speech. For example, false or deceptive advertising is not protected speech because of its detriment to society.⁹⁸ Another type of less-protected speech is commercial speech⁹⁹—speech that “does no more than propose a commercial transaction.”¹⁰⁰ Commercial speech regulations are subject to a less rigorous standard articulated by the United States Supreme Court in *Central Hudson Gas & Elec. Corp. v Public Service Comm’n.*¹⁰¹ the regulation must “directly advance[] a substantial governmental interest” and “not [be] more extensive than is necessary to serve that interest.”¹⁰² The policy reason permitting heavier regulations on commercial speech is that the economic incentives in making commercial speech reduce any potential chilling effects of a regulation.¹⁰³

Applied to trademark law, the First Amendment allows purely commercial speech to be regulated by the TDRA.¹⁰⁴ However, the TDRA does not regulate noncommercial speech for fear that it “would allow trademark owners to suppress or inhibit discussion about them . . . [and] would thus represent an impermissible burden on free speech.”¹⁰⁵

96. *Morales*, 527 U.S. at 59–60 (declaring an ordinance prohibiting loitering “in one place with no apparent purpose” as vague for definiteness and clarity).

97. *See id.* at 64.

98. *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.* 425 U.S. 748, 769–70 (1976).

99. *Id.* at 771–72.

100. *Id.* at 762.

101. 447 U.S. 557, 557 (1980).

102. *Id.* at 564–66.

103. *Bates v. State Bar of Arizona*, 433 U.S. 350, 381 (1977) (“Since advertising is linked to commercial well-being, it seems unlikely that such speech is particularly susceptible to being crushed by overbroad regulations.”).

104. *Burnett v. Twentieth Century Fox Film Corp.*, 491 F. Supp. 2d 962, 974 (C.D. Cal. 2007).

105. Michael K. Cantwell, *Confusion, Dilution, and Speech: First Amendment Limitations on the Trademark Estate*, 87 TRADEMARK REP. 48, 67 (1997); *see also* L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 32–33 (1st Cir. 1987).

II. ANALYSIS OF UNAUTHORIZED TRADEMARK USE IN NONCOMMERCIAL SPEECH

Returning to the Louboutin case discussed above, the Flemish group's Anti-Islam poster weakens the trademark's reputation in the eyes of consumers, who likely identified the mark as accepting of all religions and races. Although it is possible some minimal amount of consumer confusion may result—and a competent attorney would bring an infringement action—Louboutin's injury is primarily due to consumers' newly-ingrained and likely subconscious negative associations with the mark. The poster's controversial comment on Islam may cause consumers to associate the luxury red-soled stilettos with the poster's negative political message. This association is detrimental because the mark is used in a way antithetical to the mark owner's presumptively positive uses. If the Flemish group distributed the poster in the United States, Louboutin's potential causes of action would be infringement and dilution by tarnishment. However, as this Comment will establish in Part II.A–Part III, both will fail.

A. *Trademark Infringement*

1. *Likelihood of Confusion*

Once an infringement claim is brought in the United States, courts determine infringement liability by analyzing whether the use is likely to confuse consumers.¹⁰⁶ The first factor is the strength of the mark. Louboutin has an arguably strong mark because the red soles have gained secondary meaning in the luxury shoe market;¹⁰⁷ however, colors are typically given narrow protection since a color is not inherently distinctive.¹⁰⁸ Therefore, a court could go either way—strong or weak—in determining the strength of the mark. Second, the proximity of the goods factor is unlikely to favor Louboutin because the Flemish group does not market or sell shoes. The third factor, similarity of the marks, will

106. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 120 (2004).

107. *Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.*, 696 F.3d 206, 226–27 (2d Cir. 2012).

108. *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 166 (1995).

likely favor Louboutin because the “sight, sound, and meaning” of the mark used in the Flemish group’s poster is in fact the same as Louboutin’s mark.¹⁰⁹

The other five factors are unfavorable, or at best, ambiguous. The fourth factor, actual confusion, cannot be determined without survey evidence or actual testimony.¹¹⁰ This evidence is not readily available. The fifth factor, similarity of marketing channels, is also ambiguous. On the one hand, Louboutin likely uses posters to market his brand and therefore this factor supports confusion. On the other hand, this factor is arguably irrelevant because regardless of the marketing channel used, the poster can be found on the Internet through a few key search terms and shared instantaneously through online news sources and forums.¹¹¹ The unauthorized use may become well known, if not viral.

The sixth factor, purchaser care and sophistication, will weigh against confusion. Louboutin’s shoes are expensive and therefore consumers will likely take more time and care in making a purchasing decision. These consumers are not likely to believe Louboutin would authorize his mark in the Flemish group’s tasteless poster.

The seventh factor, intent, is difficult to discern, but the Flemish group would likely successfully argue it used the Louboutin stilettos in good faith because it only used the mark for decorative purposes, not to confuse consumers. Finally, the eighth factor, likelihood of expansion, would also weigh against Louboutin because it is unlikely Louboutin will start a political group, like the Anti-Islam group, antagonizing a large sector of his consumer base.

Four of the eight *Sleekcraft* factors—proximity of the goods, degree of care likely to be exercised by the purchaser, defendant’s intent in selecting the mark, and likelihood of expansion—weigh against a likelihood of confusion. Moreover, three factors—strength of the mark, evidence of actual confusion, and marketing channels used—are either difficult to discern or just inapplicable to this unauthorized

109. *Sleekcraft*, 599 F.2d at 351.

110. See *Fortune Dynamics, Inc. v. Victoria Secret Stores Brand Mgmt, Inc.*, 618 F.3d 1025, 1035 (9th Cir. 2010).

111. *Playboy Enters. v. Netscape Commc’ns. Corp.*, 354 F.3d 1020, 1028 (9th Cir. 2001) (“Given the broad use of the Internet today . . . this factor merits little weight.”).

use. Therefore, a court would likely find no confusion and therefore no infringement by the Anti-Islam Campaign poster.

2. Trademark Infringement Defenses

Although analyzing the Flemish group's infringement defenses is moot because consumers are unlikely to be confused, this section will describe the First Amendment defense to infringement because it will play a key role in the proposal in Part III below. Trademark infringers engaging in noncommercial speech often raise the First Amendment as a defense to their unauthorized use. To balance First Amendment rights with those of the trademark owner, courts use the test set forth in *Rogers v. Grimaldi*.¹¹² The *Rogers* test requires courts to inquire into whether a mark's use is "artistically relevant" to the speech and whether the mark "explicitly mislead[s]" the public.¹¹³ Artistic relevance is satisfied when an unauthorized use of a mark is "not arbitrarily chosen just to exploit the publicity value of the [plaintiff's mark] but instead has genuine relevance [to the work]." ¹¹⁴ For example, in *Rogers*, the court held the title "Ginger and Fred," for a film that depicted two performers nicknamed Ginger and Fred, was artistically relevant to the work.¹¹⁵

If an expression is deemed artistically relevant, courts will then determine whether the use is "explicitly misleading" as to the source or content of the work.¹¹⁶ An explicitly misleading use leads the public to believe the mark owner "prepared or otherwise authorized" the use.¹¹⁷ Some examples of explicitly misleading uses are "Jane Fonda's Workout Book"—a label for a book unaffiliated with Jane

112. 875 F.2d 994 (2d Cir. 1989).

113. *Id.* at 1000.

114. Louis Vuitton Mallatier [sic] S.A. v. Warner Bros. Entm't Inc., 868 F. Supp. 2d 172, 178 (S.D.N.Y. 2012) (quoting *Rogers*, 875 F.2d at 1001).

115. *Rogers*, 875 F.2d at 999–1000.

116. *See Rogers*, 875 F.2d at 1000; *see also* *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 901 (9th Cir. 2002) (adopting the *Rogers* test for artistic works); *Parks v. LaFace Records*, 329 F.3d 437, 458 (6th Cir. 2003) (adopting the *Rogers* test in the context of expressive works and citing Restatement (Third) of Unfair Competition § 47 cmt. c (1995)).

117. *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993).

Fonda—and Pepsi’s Blog on Human Rights—a blog unaffiliated with Pepsi.¹¹⁸ In both circumstances, the unauthorized user is overtly misrepresenting his product as authored or sponsored by Jane Fonda and Pepsi, respectively.

B. Trademark Dilution

“Dilution law is the antithesis of trademark law . . . because it seeks to protect the mark from association in the public’s mind with wholly unrelated goods and services.”¹¹⁹ Congress enacted the TDRA to prevent unauthorized uses that “seize upon the popularity of a trademark at the expense of the rightful owner and the public.”¹²⁰ Unlike infringement, dilution causes of action do not require a likelihood of confusion.¹²¹

1. Dilution by Tarnishment

Dilution by tarnishment allows a trademark owner to enjoin an unauthorized use that diminishes the value of its mark by placing the mark in an unsavory context.¹²² To bring a dilution by tarnishment claim, the TDRA first requires the mark to be famous.¹²³ A mark is famous “if it 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.”¹²⁴ The statute also lists a set of factors to help determine “whether a mark possesses the requisite degree of recognition.”¹²⁵ Those factors include:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.

118. *Rogers*, 875 F.2d at 1001.

119. *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 904 (9th Cir. 2000).

120. Trademark Dilution Revision Act of 2006, 152 CONG. REC. H6964 (daily ed. Sept. 25, 2006).

121. See discussion *supra* Part II.B; see also *San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 539 (1987) (“[E]ven if not confusing . . . [the mark] nevertheless may harm [mark owner] by lessening the distinctiveness and thus the commercial value of the marks.”) (citations omitted).

122. *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 903 (9th Cir. 2000) (internal quotations omitted).

123. 15 U.S.C. §1125(c)(1).

124. *Id.* § 1125(c)(2)(A).

125. *Id.*

- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 1905, or on the principle register.¹²⁶

For Louboutin, the fame requirement could potentially impede his access to dilution causes of action since the luxury shoe designer may only have “niche fame” within the fashion-knowledgeable consuming public not the general consuming public.¹²⁷ “Niche fame” is specifically excluded by the TDRA “to prevent courts from labeling a mark as ‘famous’ because it is well-known only in a local geographical territory or in a local product or service line.”¹²⁸ Nevertheless, since this may be a close call, a court will likely look to the TDRA’s factors to make this finding. First, the Louboutin brand has invested substantial amounts in advertising, media coverage, and demonstrated sales success.¹²⁹ Second, Louboutin sells about 240,000 pairs a year with revenues of approximately \$135 million in 2011,¹³⁰ but Louboutin’s recognition goes far beyond what these sales indicate due to its high degree of publicity. “The brand’s fame derives largely from the red outsole itself: interested consumers can instantly recognize the brand when they see a red-soled shoe gracing the red carpet or the pages of fashion publications.”¹³¹ Finally, Louboutin’s mark has been on the principal register since 2008.¹³² This factor analysis indicates that at least three of the four fame factors favor Louboutin’s wide degree of recognition.

In addition, a survey of luxury designer trademark case law supports a court’s determination that Louboutin’s mark is

126. 15 U.S.C. §1125(c)(2)(A).

127. See Haochen Sun, *Reforming Anti-Dilution Protection in the Globalization of Luxury Brands*, 45 *Geo. J. Int’l L.* 783, 806–07 (2014).

128. MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:105 (4th ed. 2014).

129. *Christian Louboutin S.A. v. Yves Saint Laurent America Holdings, Inc.*, 696 F.3d 206, 226 (2d Cir. 2012).

130. *Christian Louboutin S.A. v. Yves Saint Laurent America, Inc.*, 778 F. Supp. 2d 445, 448 (S.D.N.Y. 2011).

131. Emilie Winckel, Comment, *Hardly a Black-and-White Matter: Analyzing the Validity and Protection of Single-Color Trademarks Within the Fashion Industry*, 66 *VAND. L. REV.* 1015, 1030 (2013).

132. U.S. Registration No. 3,376,197.

famous because of his marketing strategies. In *Malletier v. Dooney & Bourke, Inc.*,¹³³ the court found that “Louis Vuitton’s Monogram Multicolore mark achieved a high level of fame in the broad fashion market” due to “widespread advertising, publicity, and sales of products bearing the Monogram Multicolore mark, and enjoyed a deluge of unsolicited media coverage and attention.”¹³⁴ Another court found the fame requirement satisfied for the highly-marketed luxury brand, Burberry.¹³⁵ Though luxury goods typically have niche fame, case law indicates that brands employing widespread marketing and advertising efforts meet the TDRA’s fame requirement.¹³⁶ Here, Louboutin spends approximately \$2 million each year on promotional activities.¹³⁷ Louboutin also engages in promotional activities such as cooperative advertising, loaning its shoes for highly publicized events, and unique collaborations, such as its 2009 collaboration with Mattel to celebrate BARBIE’s fiftieth anniversary.¹³⁸ Therefore, a court, relying on the TDRA’s fame factors and precedent, will likely find that Louboutin indeed meets the standard for fame.

Next, a court will determine whether Louboutin’s mark was likely to be tarnished through an “association . . . that harms the reputation of the famous mark.”¹³⁹ The poster harms Louboutin’s trademark by creating associations in the consumer’s mind with Islamic intolerance.¹⁴⁰ Uses such as the Flemish group’s unauthorized use diminish a trademark

133. 561 F. Supp. 2d 368 (S.D.N.Y. 2008).

134. *Id.* at 391 (internal quotations omitted).

135. *Burberry Ltd. v. Euro Moda, Inc.*, 2009 WL 1675080 at *12 (S.D.N.Y. 2009) (“Burberry has prominent advertising presence in the United States, placing advertisements of its products bearing the Burberry Marks in popular and widely circulated United States publications.”).

136. *See Sun, supra* note 127, at 807 (“Since the fame of a mark is essentially measured by advertising and marketing efforts made by the owner of the mark, these low-profile marketing strategies could make it difficult for the relevant luxury companies to prove the well-known status of their trademarks.”).

137. Brief for Plaintiffs-Counter-Defendants-Appellants and Special Appendix at 14, *Christian Louboutin S.A. v. Yves Saint Laurent America Holdings, Inc.*, 696 F.3d 206, 226 (2d Cir. 2012) (No. 11-3303-cv).

138. *Id.*

139. 15 U.S.C. § 1125(c)(2)(A).

140. *See* John D. Shakow, Note, *Just Steal It: Political Sloganeering and the Rights of Trademark Holders*, 14 J.L. & POLITICS 199, 208 (1998) (“Association with some political philosophies, when forced on a commercial actor, may well hurt the commercial prospects of the actor’s goods.”).

owner's ability to "reap the financial, reputation-related rewards associated with a desirable product."¹⁴¹ Continuous, unregulated association of a mark with divisive political speech considerably diminishes goodwill.¹⁴²

2. *Defenses to Dilution—The TDRA's Exceptions*

The TDRA has several defenses that exclude certain uses from a dilution cause of action. Under the TDRA, section 43(c)(3) states:

The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person's own goods or services, including use in connection with—

(i) advertising or promotion that permits consumers to compare goods or services; or

(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any noncommercial use of a mark.¹⁴³

The Flemish group's use will not fall under the exceptions in section 43(c)(3)(A) or (B). Under this set of facts, the trademark's use is not descriptive because it does not propose to describe or promote its own non-trademark related message.¹⁴⁴ A descriptive fair use cannot exist here because red soles do not have a primary meaning, or in other words, without Louboutin's secondary meaning red soles are just red soles.

Nor is the Flemish group's use nominative fair use because it does not depict or compare Louboutin's product to others.¹⁴⁵ The poster was political propaganda for Woman Against Islamisation, a group which provides neither goods nor services. A scenario where fair use could apply would be

141. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995)).

142. *See* Shakow, *supra* note 140, at 208.

143. 15 U.S.C. § 1125(c).

144. *Kelly-Brown v. Winfrey*, 717 F.3d 295, 308 (2d Cir. 2013)

145. 15 U.S.C. § 1125(c)(3)(A)(i).

if the poster's message described Louboutin stilettos' conformance or nonconformance to Islamic ideals.¹⁴⁶

Other fair use exclusions include parody, criticism, and commenting upon the mark.¹⁴⁷ The Flemish group's poster would not qualify as a parody. This is because it did not "imitate and then comically transform" Louboutin, its shoes, or its mark, in an ambiguous or complex meta-fictional way.¹⁴⁸ The poster also did not criticize or comment on Louboutin or his goods; instead the poster criticized Islamic beliefs and promoted xenophobia—neither having anything to do with Louboutin or its shoes. The statutory exclusion of news reporting and news commentary would similarly not apply because the Flemish group did not transmit information regarding Louboutin or his goods through the poster.

The last defense, noncommercial use, functions as a catch-all exception and will defeat Louboutin's dilution action. The group's message regarding Islam and the Islamisation of Belgium is political in nature and therefore likely to be political, noncommercial speech.¹⁴⁹ Under the TDRA, noncommercial speech is noncommercial use¹⁵⁰ and noncommercial use is exempted from dilution by tarnishment claims.¹⁵¹ This leaves a court with little choice but to dismiss Louboutin's dilution claim against the Flemish group and essentially deprives Louboutin of its ability to enjoin the Flemish group's use despite its nonconformity with any of the specific fair use exceptions. Because trademark owners cannot enjoin noncommercial uses, mark owners are subject to considerable economic harm.¹⁵²

146. See *New Kids on the Block v. News America Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992).

147. 15 U.S.C. § 1125(c)(3)(A)(ii).

148. Tyler T. Ochoa, *Dr. Seuss, The Juice and Fair Use: How the Grinch Silenced a Parody*, 45 J. COPYRIGHT SOC'Y U.S.A. 546, 548–52 (1998) (quoting Margaret A. Rose, *PARODY: ANCIENT, MODERN AND POST-MODERN* 54 (1993)).

149. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905 (9th Cir. 2002).

150. *Id.* Though *Mattel* was decided before the TDRA's enactment in 2006, the language of the noncommercial use exception has not changed.

151. 15 U.S.C. § 1125 (c)(3)(C).

152. See John Zevitas, Comment, *If it Doesn't Fit, Keep on Trying?: The Court's Attempt to Find A Place For Pure Political Speech in the Lanham Act*, 60 CATH. U.L. REV. 243, 271 (2010).

III. PROPOSAL

To protect the underlying goals of the TDRA, Congress should remove the noncommercial use exception from the TDRA. Furthermore, to protect First Amendment rights and the ability to effectively communicate messages using trademarks, Congress should take the “artistic relevance” of the *Rogers* test,¹⁵³ and apply it to the TDRA’s exceptions. The proposed statute would read as follows:

The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person’s own goods or services, including use in connection with—

(i) advertising or promotion that permits consumers to compare goods or services; or

(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.¹⁵⁴

(C) *Any use artistically relevant to a noncommercial message.*¹⁵⁵

Eliminating the noncommercial use exception will promote the Lanham Acts’ twin objectives: preventing consumer confusion, and protecting mark owners’ distinctive marks from misappropriation and dilution. As it stands, the noncommercial use exception allows the frivolous, unauthorized use of famous trademarks, along with their damaging repercussions, to persist so long as the use is not solely “to propose a commercial transaction.”¹⁵⁶ The proposed statute will protect innocent trademark owners from value-decreasing unauthorized uses and will justly curtail obvious attempts to “free ride” on a mark’s fame. Moreover, the

153. *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

154. 15 U.S.C. § 1125(c).

155. The italicized section (C) would replace the noncommercial use exception in 15 U.S.C. § 1125(c)(3)(C).

156. *Bolgers v. Young Drug Prods Corp.*, 463 U.S. 60, 66 (1983) (quoting *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976)).

general public will continue to have broad First Amendment protections through the TDRA's numerous existing exceptions and the proposed artistic relevance exception. With this proposal, the general public may continue to criticize, make fun of, comment on, compare, describe, advertise, promote, or make any tarnishing noncommercial message using a mark, so long as the mark is relevant to the message.¹⁵⁷

A. Application of the Proposed Amendment

Under the proposed TDRA amendment, a court's analysis would begin by determining whether the unauthorized use would likely tarnish the mark. Tarnishment occurs when an unauthorized user "associates a mark with something unwholesome or somehow damages the positive image the trademark holder has built up in the [mark]."¹⁵⁸

Once a court determines that an unauthorized use dilutes a famous mark, it may look to the newly enacted statutory defense, the "artistic relevance" test, if the other defenses—nominative or descriptive fair use, comparative advertising, parody, criticism, commentary, and news reporting—fail to apply to the unauthorized use.¹⁵⁹ In applying the artistic relevance exception, the court would determine whether the mark had some "artistic relevance to the underlying work."¹⁶⁰ To do so, the court would examine the speech's underlying message. The *Louboutin* case, if hypothetically brought to a U.S. court, illustrates this point below.

B. Louboutin Under the Proposed Statute

Under the proposed TDRA amendment, *Louboutin* could bring a cause of action for dilution by tarnishment. Displaying *Louboutin*'s trademark on a poster expressing disdain for the Islamic religion is likely to associate its expensive, high fashion shoes with images of stoning and anti-Islamic sentiment. Political associations or philosophies are naturally discriminatory against certain citizens, and the unauthorized uses of marks in such speech certainly damage

157. 15 U.S.C. § 1125(c)(3).

158. See Shakow, *supra* note 140, at 208.

159. 15 U.S.C. § 1125(c)(3)(A)–(C).

160. *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d. Cir. 1989).

the owner and the mark's image.¹⁶¹ For this reason, Louboutin may lose a good portion of its client base in the Middle East.¹⁶² Dilution by tarnishment is an appropriate cause of action.

A court would next decide whether the use falls under any of the articulated exceptions to dilution. Nominative or descriptive fair use, comparative advertising, parody, criticism, commentary, news reporting, and any noncommercial use of a mark, as discussed in Part II.B.2, would not merit a successful defense for the Islamic group.¹⁶³ This leaves the proposed artistic relevance exception.

To determine whether the unauthorized use falls under the artistic relevance exception, the court would look to the poster's underlying message. In this case, the message pertains to Islam, and more specifically Islam's treatment of women as either prostitutes to be stoned or housewives with floor-length skirts. However, Louboutin's mark—the red-soled stilettos—is not artistically relevant to that message because with or without the red-soled stilettos the poster adequately communicates the criticism of Islam's treatment of women. This point is further illustrated by the group's post-injunction tweet, depicting a similar image with yellow soles.¹⁶⁴ This tweet demonstrates the mark's irrelevance to the poster because the Flemish group's message was not lost or even slightly lessened by the change. Instead, the group still communicated an Anti-Islamic message using a woman's leg to portray different skirt lengths and its alleged "sharia" compatibility. The Flemish group's use of Louboutin's mark had no significance or relevance to their message.

Upon finding no artistic relevance, a court may enjoin the unauthorized use as unlawfully tarnishing the mark. Therefore, under the proposed amendment, Louboutin's mark would be protected from the Flemish group's free-riding use. The Antwerp Court and Court of Appeal in Belgium correctly decided Louboutin's case, and should Congress implement the changes proposed, the result in the United States would

161. See Shakow, *supra* note 140, at 208.

162. See Sambridge, *supra* note 10.

163. See analysis *supra* Part II.B.2.

164. See *infra* Figure 3.

similarly protect Louboutin's mark.¹⁶⁵

C. First Amendment Challenges

Inevitably the proposed amendment will be challenged on the grounds of the First Amendment's freedom of expression.¹⁶⁶ Protecting trademark use in noncommercial speech is a laudable goal that allows the public to comment on a recognizable brand. The proposed artistic relevance exception will maintain this protection. Courts will retain the discretion to factually determine "artistic relevance" in unauthorized uses, rather than sweepingly deny trademark owners dilution remedies in noncommercial uses. The TDRA's existing exclusions—such as parody, criticism, and news commentary¹⁶⁷—will continue to protect the public's interest in free speech in most noncommercial uses. By extending the artistic relevance test to dilution actions involving artistic, expressive, or political speech, the proposed statute will bridge any gap remaining in protecting free speech interests.

In addition, unauthorized uses wholly unrelated to a trademark, but which nevertheless use that mark in an unsavory and reputation-damaging manner, are less informative and *should* allow for more regulation.¹⁶⁸ The Supreme Court has promoted this view as well, albeit more controversially. In *San Francisco Arts & Athletics v. United States Olympic Committee*¹⁶⁹ the Court upheld the Amateur Sports Act and prohibited San Francisco Arts & Athletics

165. Assuming courts will analyze the Anti-Islamic group's poster as political speech. See *Henley v. Devore*, 733 F. Supp. 2d 1144, 1159 (C.D. Cal. 2010) ("District Courts that have actually considered whether campaign advertisements are commercial in the fair use context come down on the side of noncommercial." (citing *MasterCard Int'l Inc. v. Nader* 2000 Primary Comm., Inc., No. 00 Civ.6068(GBD), 2004 WL 434404, at *12 (S.D.N.Y. Mar. 8, 2004)); see also Cong. Rec. H. 1216 (daily ed. April 13, 1989) (statement of Wisconsin Rep. Kastenmeier) ("Political advertising and promotion is political speech, and therefore not encompassed by the term 'commercial.'").

166. Some scholars express worries that free speech rights are diminishing, especially if First Amendment defenses are further limited, because users will refrain from speaking in fear of being subject to lengthy and costly litigation. See Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 SMU L. REV. 381, 405–06 (2008).

167. 15 U.S.C. § 1125(c).

168. See Shakow, *supra* note 140, at 108.

169. 483 U.S. 522 (1987).

Inc.'s ("SFAA") use of the word "Olympic" in promoting its "Gay Olympic Games."¹⁷⁰ Although the dissent chastised this prohibition as chilling SFAA's First Amendment right to communicate its message of promoting social and political ideas,¹⁷¹ the majority brushed aside these concerns by focusing on mark owners' rights.¹⁷² The majority reasoned that the SFAA's use would "undercut the USOC's efforts to use, and sell the right to use, the word in the future, since much of the word's value comes from its limited use."¹⁷³

More notably, the United States Supreme Court has never held that First Amendment rights are absolute.¹⁷⁴ In *United States v. O'Brien*,¹⁷⁵ the Court upheld a law that criminalized destruction of draft cards and upheld the defendant's criminal conviction for burning his draft card.¹⁷⁶ The law did not unconstitutionally limit the defendant's First Amendment freedom of speech rights because the government's interest was "limited to the noncommunicative aspect [the burning of the card] of O'Brien's conduct."¹⁷⁷ To determine the level of protection afforded to this speech, the Court articulated that the regulation must be within the constitutional power of government; it must further a substantial or important governmental activity; the government interest must be unrelated to the suppression of free expression, and the incidental restriction must go no farther than is essential to furtherance of that interest.¹⁷⁸ Here, Congress has the power to regulate trademark protection, it has a substantial interest in protecting mark owners from harm to its livelihood, which is an interest unrelated to the suppression of free expression, and lastly the restriction only restricts speech that harms famous trademarks through uses irrelevant to the underlying speech. By removing the noncommercial use exception and applying the proposed statute, Congress could regulate the

170. *Id.* at 525–28.

171. *Id.* at 567–70.

172. *Id.* at 534–35.

173. *Id.* at 539.

174. *Elrod v. Burns*, 427 U.S. 347, 348 (1976) (citing *Buckley v. Valeo*, 424 U.S. 1, 94, 96 (1976)).

175. *United States v. O'Brien*, 391 U.S. 367, 382 (1968).

176. *O'Brien*, 391 U.S. at 382.

177. *Id.* at 381.

178. *Id.* at 377.

noncommunicative aspects of unauthorized users' message and protect mark owners from reputation-damaging unauthorized uses. Unauthorized uses of trademarks, unrelated to a message, such as in the Louboutin scenario, frustrates the TDRA's purpose in providing protection to famous marks.

The proposed statute would also protect trademark owner's First Amendment right to refrain from speaking. Corporations have First Amendment rights similar to individuals;¹⁷⁹ therefore, a trademark owner (whether as an individual or corporation) has its own First Amendment rights, including the "right to refrain from speaking."¹⁸⁰ This First Amendment guarantee cannot be protected if trademark law is not amended. This First Amendment guarantee cannot be protected if trademark law is not amended. For example, in Louboutin's case, the unauthorized use of a mark in political propaganda associates the mark owner with the Flemish groups particular message—one with which the owner wholly disagrees—Anti-Islam. As in *Wooley v. Maynard*,¹⁸¹ where the Court held that a state could not force residents to display "Live Free or Die" on a government-issued license plate,¹⁸² courts should strive to protect an entities right not to speak particularly in regards to speech to which it may be ideologically opposed.

CONCLUSION

Reputation and goodwill are fundamental to trademark owners. Unauthorized use of a mark in unrelated political speech diminishes the protections that dilution law aims to provide. Congress should amend the TDRA to protect trademark owners from exploitation by unauthorized users. By substituting the noncommercial use exception with the artistic relevance exception, Congress will allow trademark owners to enjoin unauthorized users from tarnishing a trademark when the unauthorized use is unrelated to the message. By ensuring this protection to trademark owners, Congress will also alleviate First Amendment concerns in

179. *Buckley v. Valeo*, 424 U.S. 1, 236 (1976).

180. *Wooley v. Maynard*, 430 U.S. 705, 714 (1977).

181. *Id.*

182. *Id.*

noncommercial use dilution claims.

APPENDIX A



Figure 1¹⁸⁴



Figure 2¹⁸³



Figure 3¹⁸⁵

183. Photograph of Christian Louboutin Stilettos, in *Louboutin Wins Battle to Stop Anti-Islam Ad*, SPECIAL BROADCASTING SERVICE (Oct. 15, 2013, 8:43 AM), <http://www.sbs.com.au/news/article/2013/10/15/louboutin-wins-battle-stop-anti-islam-ad>.

184. Photograph of “Women Against Islamisation” Campaign Poster, in Philip Blenkinsop, *Christian Louboutin Wins Case Against Shoe Use by Flemish Far-Right*, TELEGRAPH.CO.UK (Oct. 15, 2013), <http://fashion.telegraph.co.uk/article/TMG10379534/Christian-Louboutin-wins-case-against-shoe-use-by-Flemish-far-right.html>.

185. Photograph of “Women Against Islamisation” Campaign Poster, in Philip Blenkinsop, *Christian Louboutin Wins Case Against Shoe Use by Flemish*

Far-Right, TELEGRAPH.CO.UK (Oct. 15, 2013),
<http://fashion.telegraph.co.uk/article/TMG10379534/Christian-Louboutin-wins-case-against-shoe-use-by-Flemish-far-right.html>.