

## What Trademark Law Is Learning from the Right of Publicity

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In 2006, Stacey Dogan and Mark Lemley published the now classic article “What the Right of Publicity Can Learn from Trademark Law.”<sup>1</sup> There they urged us to “[r]econceiv[e] the right of publicity as a trademark-like right,”<sup>2</sup> particularly because “looking at the right of publicity through the lens of trademark law offers logical ways to limit the right.”<sup>3</sup> Right of publicity law’s failure to incorporate trademark law’s limitations had resulted, they argue, in the right of publicity functioning as “a mutant version of trademark policy . . . .”<sup>4</sup>

I argue here in response that regrettably, notwithstanding Dogan and Lemley’s good advice, the reality is that it is trademark law that has become more like right of publicity law. Indeed, trademark law is in danger of becoming a “mutant version” of right of publicity policy. To defend this claim, I will first briefly survey the conventionally-recognized similarities and differences between trademark law and right of publicity law. I will then propose a more complicated—and, I think, more accurate—comparison between the two areas of law and argue that they are converging in many important ways, giving us the worst of both worlds. In what follows, I will focus more on trademark law, not only because many other contributions to this Symposium thoroughly discuss right of publicity law, but also because I think we should be especially concerned with trademark law’s mutation in the age of *Burwell v. Hobby Lobby Stores*<sup>5</sup> and *Citizens United v. Federal Election Commission*<sup>6</sup> into a kind of right of publicity law for corporate personhoods.

Before I proceed, I should emphasize one point from the start. I very much doubt that Dogan or Lemley would disagree with the general thrust of my argument, not least because much of it draws upon other work by them.

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1. Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161 (2006).

2. *Id.* at 1165.

3. *Id.*

4. *Id.* at 1166.

5. *Burwell v. Hobby Lobby Stores, Inc.*, 573 U.S. 682 (2014).

6. *Citizens United v. Federal Election Comm’n*, 558 U.S. 310 (2010).

## I. THE CONVENTIONALLY-RECOGNIZED SIMILARITIES AND DIFFERENCES BETWEEN TRADEMARK LAW AND RIGHT OF PUBLICITY LAW

I first compare the policy goals understood to be guiding the two areas of law and then turn to a comparison of their subject matter, scope of rights, defenses, and limitations.

In terms of the customary policy justifications for the two areas of law, there are apparent differences. We conventionally say that trademark law protects trademarks from infringement and thereby maintains the integrity of the trademark system in order (1) to minimize consumer search costs and (2) to encourage firms to maintain consistent levels of product quality.<sup>7</sup> This is the orthodox law and economics justification for trademark protection.<sup>8</sup> It makes obvious good sense with respect to trademarks on products like pharmaceuticals or food. If we acknowledge only this justification for the protection of trademarks, then we will be in a position to conclude that trademark law, with its emphasis on search costs, is very different from right of publicity law.

But the orthodox law and economics justification makes less sense when applied to goods whose primary purpose is to convey social distinction, such as certain kinds of apparel.<sup>9</sup> This social distinction may be conventionally hierarchical in nature, and this is how lawyers almost invariably think about social distinction—such that society consists essentially of one giant U.S. News & World Report ranking.<sup>10</sup> But social distinction may more generally take the form simply of non-hierarchical, horizontal difference from mass society.<sup>11</sup> In light of the role that trademarks play in facilitating the consumer's sense of identity, we sometimes admit that we protect trademarks from infringement to preserve firms' incentives to produce signs of social difference and to preserve the distinguishing function of those signs of social difference.<sup>12</sup>

It is conventionally thought that different justifications motivate right of publicity law, and Jennifer Rothman reviews them quite effectively in her book *The Right of Publicity: Privacy Reimagined for a Public World*.<sup>13</sup> As she points out, the notion

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7. See, e.g., *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995); *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 657 (7th Cir. 1995).

8. See generally William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265 (1987) (setting out a law and economics analysis of trademark doctrine).

9. See Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 624 (2004).

10. Admittedly, Jeremy Sheff's work presents good reasons for reading much of the trademark case law in these terms. See Jeremy N. Sheff, *Veblen Brands*, 96 MINN. L. REV. 769, 771–72 (2012).

11. See Barton Beebe, *Intellectual Property Law and the Sumptuary Code*, 123 HARV. L. REV. 809, 827–28 (2010).

12. See, e.g., *adidas Am., Inc. v. Skechers USA, Inc.*, 890 F.3d 747, 761 (9th Cir. 2018) (affirming injunction of the defendant's sale of certain athletic shoes to protect "the value adidas derives from the scarcity and exclusivity of the Stan Smith brand").

13. JENNIFER E. ROTHMAN, *THE RIGHT OF PUBLICITY: PRIVACY REIMAGINED FOR A PUBLIC WORLD* (Harvard Univ. Press 2018); see also DAVID TAN, *THE COMMERCIAL APPROPRIATION OF FAME:*

that right of publicity law strives to protect consumers from deception is unpersuasive, not least because right of publicity law typically does not require a showing of likelihood of consumer confusion.<sup>14</sup> Instead, a variety of other justifications have been adduced over the years for right of publicity protection: It incentivizes the creation of celebrity personas;<sup>15</sup> it prevents the overgrazing or tarnishment of those personas and protects the public's interest in stable celebrity identities;<sup>16</sup> it provides an appropriate reward for the labor that goes in to the development of a valuable personal identity;<sup>17</sup> and it prevents misappropriation or unjust enrichment of that value.<sup>18</sup> And finally, a rationale that emerges in part from the earliest origins of right of publicity law is that the law protects the individual liberty and dignitary interests of identity holders. It enables identity holders to engage in what Mark McKenna calls "autonomous self-definition"<sup>19</sup> and protects them from certain forms of emotional harm, a rationale which Rothman also endorses.<sup>20</sup>

We care about rationales because they guide—or at least tend to have some influence on—the specific rules that make up trademark law and right of publicity law. An example of their influence is found in the differing subject matters of trademark law and right of publicity law. Individual identities, and especially individual celebrity identities, routinely qualify for trademark protection.<sup>21</sup> Corporations, by contrast, cannot qualify for right of publicity protection (at least not yet), apparently because corporations do not have privacy, dignitary, or autonomous self-definition interests, and do not suffer emotional harms.<sup>22</sup>

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A CULTURAL ANALYSIS OF THE RIGHT OF PUBLICITY AND PASSING OFF 45–62 (Cambridge Univ. Press 2017) (reviewing theoretical justifications for right of publicity).

14. See ROTHMAN, *supra* note 13, at 102.

15. See *id.* at 99–102; see also *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) (“[Right of publicity] protection provides an economic incentive for [the beneficiary of such protection] to make the investment required to produce a performance of interest to the public.”); *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 840 (1979) (Bird, C.J., dissenting) (“[P]roviding legal protection for the economic value in one’s identity against unauthorized commercial exploitation creates a powerful incentive for expending time and resources to develop the skills or achievements prerequisite to public recognition . . .”).

16. See WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY RIGHTS* 222–27 (Harvard Univ. Press 2003) (discussing congestion externalities caused by overuse of celebrity identities); Justin Hughes, “*Recoding Intellectual Property and Overlooked Audience Interests*,” 77 TEX. L. REV. 923 (1999) (considering audience reliance interests in preserving stable meanings of cultural objects).

17. See ROTHMAN, *supra* note 13, at 105–10.

18. See *id.*; TAN, *supra* note 13, at 54–55.

19. Mark P. McKenna, *The Right of Publicity and Autonomous Self-Definition*, 67 U. PITT. L. REV. 225, 232 (2005).

20. See ROTHMAN, *supra* note 13, at 110–12.

21. See, e.g., *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992), *abrogated by* *Lexmark Intern., Inc. v. Static Control Components, Inc.*, 572 U.S. 118 (2014) (“[U]nauthorized use of a celebrity’s identity is a type of false association claim, for it alleges the misuse of a trademark . . .”); *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407, 410 (9th Cir. 1996) (“[F]alse endorsement claims are properly cognizable under section 43(a)” of the Lanham Act).

22. See 1 J. THOMAS MCCARTHY, *RIGHTS OF PUBLICITY AND PRIVACY* § 4:41 (2d ed. 2018).

The influence of underlying rationales is also apparent in the two areas' different tests for infringement and defenses to liability. Commentators conventionally emphasize, as I did above, that under right of publicity law the plaintiff need not show that the defendant's conduct is likely to confuse consumers as to source or sponsorship. Instead, a defendant may be liable by merely invoking the identity holder's identity, even if consumers do not believe that the identity holder is endorsing a product.<sup>23</sup> The result is that right of publicity law is generally thought to offer a broader scope of protection to identity holders than trademark law has offered to trademark owners.<sup>24</sup>

As for defenses, the various defenses available in right of publicity law, which are also thoroughly reviewed in Rothman's book,<sup>25</sup> tend to be relatively plaintiff-friendly. By comparison, trademark law's *Rogers v. Grimaldi* test<sup>26</sup> (which strictly speaking functions as a limitation on the plaintiff's rights rather than a defense) is more than just defendant-friendly. In operation, it has seemed until recently to be defendant-dispositive. As the Ninth Circuit observed in *Gordon v. Drape*, "on every prior occasion in which we have applied the [*Rogers*] test, we have found that it barred an infringement claim as a matter of law."<sup>27</sup> Though, as I will discuss shortly, in *Gordon*, the Ninth Circuit has finally hinted at some possible limits on the *Rogers* test.

There are other dimensions along which we can compare right of publicity law and trademark law—for example, their terms of protection or their approaches to assignability—that I will skip over here. Instead, I will conclude this very brief survey of the conventional similarities and differences between the two laws by suggesting overall that trademark law has greater built-in limits, especially in its likelihood of confusion requirement and the very powerful *Rogers* test. As Dogan and Lemley explained in 2006, "the structure and content of trademark law provide a theoretical justification for a bounded right of publicity."<sup>28</sup>

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23. *Id.* § 5:11.

24. See, e.g., *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 158 (3d Cir. 2013) (stating "the right of publicity is broader and, by extension, protects a greater swath of property interests").

25. See ROTHMAN, *supra* note 13, at 145–53.

26. See *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (stating that "[i]n the context of allegedly misleading titles using a celebrity's name," infringement will not be found "unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work."). The *Rogers* test has since expanded to include a defendant's use of a mark within the body of the defendant's work. See *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) ("Although this test traditionally applies to uses of a trademark in the title of an artistic work, there is no principled reason why it ought not also apply to the use of a trademark in the body of the work.").

27. *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 261 (9th Cir. 2018).

28. Dogan & Lemley, *supra* note 1, at 1190.

## II. THE MUTATION OF TRADEMARK LAW INTO CORPORATE RIGHT OF PUBLICITY LAW

Despite all of the conventionally-recognized differences between trademark law and right of publicity, and Professors Dogan and Lemley's hopes in 2006, I want to propose that it is trademark law that has increasingly taken on the characteristics of right of publicity law rather than the other way around.

Consider the requirement—if it may still be called a requirement—in trademark law that a plaintiff must show that the defendant's mark creates a likelihood of consumer confusion. As many commentators have suggested, the likelihood of confusion test has arguably mutated into a mere likelihood of association test, which finds liability if consumers merely associate the defendant's mark with the plaintiff, even if consumers are not ultimately confused as to the true source of the defendant's goods and even if consumers' association has no impact on their purchasing behavior.<sup>29</sup> In its recent opinion in *Int'l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ.*, the Second Circuit emphatically embraced this view: "The modern test of infringement is whether the defendant's use [is] likely to cause confusion *not just as to source*, but also as to sponsorship, affiliation or connection."<sup>30</sup> As the *Int'l Info.* court observed, the shift toward a mere association standard began at least with the 1962 amendment to Lanham Act § 32 that deleted from the section the limiting phrase "purchasers as to the source or origin of such goods or services."<sup>31</sup> Formerly, conduct was actionable only when it confused "purchasers" and only when it confused them as to the source of the goods they were purchasing. With this language removed, explained the *Int'l Info.* court, "the Act's protection against infringement is not limited to any particular type of consumer confusion, much less exclusively to confusion as to source."<sup>32</sup>

Subsequent developments have only quickened the shift toward a mere association standard for confusion. As Professors Dogan and Lemley recognize in their article on the merchandising right in trademark law, the merchandising cases of the 1970s and '80s consolidated the principle that a defendant may be liable for merely invoking the plaintiff's identity and suggesting to consumers that the plaintiff has endorsed or merely acceded to the defendant's conduct.<sup>33</sup> Making matters worse,

29. See, e.g., Stacey Dogan, *Bullying and Opportunism in Trademark and Right-of-Publicity Law*, 96 B.U. L. REV. 1293, 1305 (2016) ("Doctrines such as post-sale confusion, initial interest confusion, the merchandising right, and certain versions of affiliation confusion seem designed, at least in part, to prevent parties from evoking others' trademarks, without regard to confusion among customers about the source or provenance of products." (internal citations omitted)). See also Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 414 (2010) (observing that "sponsorship and affiliation confusion has taken on a life of its own, leading courts to declare as infringing a variety of practices that might be confusing in some sense, but that do not affect consumers' decision-making process.").

30. *Int'l Info. Sys. Sec. Certification Consortium v. Sec. Univ., LLC*, 823 F.3d 153, 161 (2d Cir. 2016) (quoting 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:76 (4th ed.)).

31. Trademark Registration Act, Pub. L. No. 87-772, 76 Stat. 769 (1962).

32. *Int'l Info.*, 823 F.3d at 161.

33. See Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L.J. 461 (2005).

the Trademark Law Revision Act of 1988 amended section 43(a) of the Lanham Act to include extraordinarily capacious language covering the kind of conduct that violates the act.<sup>34</sup> The case law under section 43(a) now seems to suggest that anyone who does anything referential shall be liable to any entity that believes that it is “likely to be damaged”<sup>35</sup> by that reference. The Fourth Circuit Court of Appeal’s recent opinion in *Belmora LLC v. Bayer Consumer Care AG* further suggests that the language of section 43(a) refers to any entity in the world, regardless of whether it is actually using a trademark within the territorial borders of the United States.<sup>36</sup> In sum, what is conventionally recognized as one of the fundamental distinctions between trademark law and right of publicity law—that the former requires a showing of consumer confusion while the latter does not—has arguably become a distinction without a difference.

One objection to this characterization of the evolution of the likelihood of confusion test in trademark law may stem from the claim that only the strongest marks benefit from the shift toward a mere association test for confusion. But even if this claim is true, and it likely is not, it simply shows how trademark law has further followed—or at least paralleled—the example of right of publicity law. Both areas of law increasingly express the legal logic of the economics of superstars, in which superstars—be they the strongest marks or the most famous celebrities—dominate their markets and further enable themselves to do so by promoting legal rules designed to protect and enhance their superstar status.<sup>37</sup> In both areas of law, the stronger benefit from broader protection.<sup>38</sup>

But probably the best expression of the mutation of trademark law into a right of publicity law for persons both natural and corporate is antidilution protection.<sup>39</sup> Here, the majority of courts interpret the anti-blurring provisions of the Lanham Act to require that the plaintiff show only that consumers associate the defendant’s mark with the plaintiff’s in order to trigger a finding of blurring.<sup>40</sup> The leading survey method for dilution by blurring simply asks respondents what comes to their minds when they are exposed to the defendant’s mark; if respondents identify the plaintiff,

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34. Trademark Law Revision Act of 1988, Pub. L. No. 100–667, 102 Stat. 3935.

35. Lanham Act, 15 U.S.C. § 1125(a)(1).

36. *Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697, 705–09 (4th Cir. 2016).

37. On superstar economics, see generally Sherwin Rosen, *The Economics of Superstars*, 71 AM. ECON. REV. 845 (1981).

38. See Barton Beebe & C. Scott Hemphill, *The Scope of Strong Marks: Should Trademark Law Protect the Strong More than the Weak?*, 92 N.Y.U. L. REV. 1339 (2017) (criticizing trademark doctrine that stronger marks enjoy a greater scope of protection).

39. See Clarisa Long, *Dilution*, 106 COLUM. L. REV. 1029, 1061 (2006) (“If one goal of dilution is to prevent free riding, then dilution law starts to look somewhat like a right of publicity law for corporations . . . .”); see also Mary LaFrance & Gail H. Cline, *Identical Cousins?: On the Road with Dilution and the Right of Publicity*, 24 SANTA CLARA COMPUT. & HIGH TECH. L.J. 641 (2008) (comparing right of publicity protection and antidilution protection in various nations).

40. See Barton Beebe, Roy Germano, Christopher Jon Sprigman & Joel Steckel, *Testing for Trademark Dilution in Court and the Lab*, 86 U. CHI. L. REV. (forthcoming 2019) (manuscript at 6) (on file with author) (discussing the “mere association” standard for trademark blurring).

then this is taken as evidence of blurring.<sup>41</sup> The parallels with right of publicity protection are even clearer in anti-tarnishment protection, where corporations appear to possess something akin to dignitary interests. This has been apparent in cases where the defendant has had the temerity to associate the New York Stock Exchange with gambling<sup>42</sup> or to associate the Victoria's Secret corporation with "sex-related products."<sup>43</sup> In these and other anti-tarnishment cases, courts rule according to rationales very similar to those in right of publicity law.<sup>44</sup>

Still, I do not want to overstate my case. Doing so would risk what I think is a common problem in academic intellectual property law writing, including in my own. This is what might be called the problem of the self-fulfilling description, in which a scholar exaggerates how bad the law is on a particular issue (in order to sell the importance of the scholar's topic). In doing so, the scholar risks persuasively restating the law in such a way that judges and lawyers come to believe that the law is in fact as bad as the scholar says it is, and they decide cases and counsel clients accordingly. I mean to refer to the practice of citing horrible edge cases as representative of the center of the law—which thereby helps to bring these peripheral cases into the center.

Trademark law is certainly still its own thing, especially in the area of limitations and defenses. The best example of this is the *Rogers* test. But even here, we are beginning to see a breakdown. The Ninth Circuit's *Gordon v. Drape* probably still counts as an edge case, but it should give us cause for concern. The author of the *Gordon* opinion was Judge Jay Bybee, who just happened also to author the Ninth Circuit's opinion in the trademark case *Brown v. Electronic Arts, Inc.*, which applied the *Rogers* test to find no infringement.<sup>45</sup> Judge Bybee likewise authored the majority opinion in the right of publicity case *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, which held that *Rogers* cannot be applied to a right of publicity claim.<sup>46</sup> In *Gordon*, Judge Bybee needed to find some limit on the *Rogers* test. (And who can blame him? The test is probably too defendant-friendly.) He found that limit in something like a transformativeness test, which analyzes "the degree to which the junior user uses the mark in the same way as the senior user" and the "extent to which the junior user has added his or her own expressive content to the work beyond the mark itself."<sup>47</sup> No doubt the copyright fair use concept of

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41. See *Nike, Inc. v. Nikepal Int'l, Inc.*, No. 05 Civ. 1468, 2007 WL 2782030, at \*2–4 (E.D. Cal. Sept. 18, 2007).

42. See *N.Y. Stock Exchange, Inc. v. N.Y., N.Y. Hotel, LLC*, 293 F.3d 550, 555–58 (2d Cir. 2002).

43. See *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 384–89 (6th Cir. 2010), *cert. denied*, 562 U.S. 1179 (2011).

44. See, e.g., *Deere & Co. v. MTD Prod., Inc.*, 41 F.3d 39, 45 (2d Cir. 1994) (stating that alterations to a trademark, "accomplished for the sole purpose of promoting a competing product, are properly found to be within New York's concept of dilution because they risk the possibility that consumers will come to attribute unfavorable characteristics to a mark and ultimately associate the mark with inferior goods and services.").

45. 724 F.3d 1235, 1248 (9th Cir. 2013).

46. 724 F.3d 1268, 1281–82 (9th Cir. 2013).

47. *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 270 (9th Cir. 2018).

transformativeness was the ultimate origin of Judge Bybee's transformativeness test.<sup>48</sup> But one imagines the more immediate source was right of publicity law and specifically Judge Bybee's emphasis on transformativeness in *In re NCAA Student-Athlete Name & Likeness Licensing Litigation*.<sup>49</sup> The risk is that *Gordon* has now opened the door to the inevitable reactionary swing away from the *Rogers* test and back toward speech-restrictive tests like those found in the 1979 case of *Dallas Cowboys Cheerleaders v. Pussycat Cinema, Ltd.*—or, more recently, in the Sixth Circuit's 2010 majority opinion in *V Secret Catalogue, Inc. v. Moseley*.<sup>50</sup>

There would be much more to say along these lines if I were adequately to persuade you of my point, but I want to take what time I have left instead to speculate on *why* we are seeing trademark law mutate into something like right of publicity law.

### III. EXPLAINING THE MUTATION

I think there are several different explanations for the mutation of trademark law into a right of publicity law for corporate personas, many of which may be obvious to you. I will briefly focus on two primarily to set out what might be an agenda for further research.

The first relates to the legal concept of misappropriation and to the concept, now increasingly fashionable in the humanities, of "affect,"<sup>51</sup> a term perhaps best defined broadly as intensities of feeling. I very much doubt that courts are consciously patterning trademark law after right of publicity, and I suspect you doubt this too. Instead, courts applying trademark law and courts applying right of publicity law have both long been converging toward the general prevention of conduct they perceive to constitute misappropriation.<sup>52</sup>

What is it that is being misappropriated? Right of publicity law teaches us that it is something more essential than source or goodwill, or even what I mentioned above—commodified social difference. The thing of value that is being misappropriated is raw positive affect in commodified form, which is especially

48. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578–81 (1994) (discussing the copyright fair use concept of transformativeness).

49. See 724 F.3d at 1273–79.

50. See *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 384–85 (6th Cir. 2010), *cert. denied*, 562 U.S. 1179 (2011); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205–06 (2d Cir. 1979).

51. See generally Gregory J. Seigworth & Melissa Gregg, *An Inventory of Shimmers*, in *THE AFFECT THEORY READER 1* (Melissa Gregg & Gregory J. Seigworth eds., 2010) (discussing various definitions of affect and histories of the concept); Sunil Erevelles, *The Role of Affect in Marketing*, 42 J. BUS. RES. 199 (1998) (surveying academic studies of the role of affect in marketing).

52. See Dogan, *supra* note 29, at 1294 ("Normatively, both [trademark law and right of publicity law] have gravitated toward an unjust enrichment model, which gives trademark holders and celebrities support for a broad sense of entitlement to the economic value of their marks and identities."). See also *id.* at 1300 ("[C]ourts shaping [several modern trademark law] doctrines routinely deride parties for riding on the coattails of someone else's success. These courts seem to presume that one goal of trademark law is not to avoid harm, but to reserve to the trademark holder the fruits of its reputational investments.").



valuable in a world filled with affectless mass-produced commodities but whose media is otherwise “characterized by a surfeit of [affect].”<sup>53</sup> Just as a celebrity persona can endow a product with positive feeling, so too can a corporate persona as embodied in its trademark. One need think only of Apple or of Nike. More generally, so often when trademark law uses the term “aesthetic,” as in the Ninth Circuit cases struggling with the trademark law concept of “aesthetic functionality,”<sup>54</sup> what we mean to refer to is affect and affective value.<sup>55</sup> The anti-misappropriation impulse in trademark law, as in right of publicity law, seeks to protect this affective value from free riders.

The second explanation for the shift in trademark law toward a right of publicity framework for corporate personas is perhaps more interesting but also more difficult to prove. Trademark law is both reflecting and contributing to the continued rise of corporate rights and attention to corporate personhood.<sup>56</sup> If the merchandising cases of the ‘70s and ‘80s were one chapter in the recent evolution of trademark law,<sup>57</sup> another chapter—the one we find ourselves in the midst of right now—is the corporate personhood chapter. Courts today are solicitous of corporations’ entitlement to “autonomous self-definition,”<sup>58</sup> to borrow Mark McKenna’s term, and

53. Brian Massumi, *The Autonomy of Affect*, 31 CULTURAL CRITIQUE 83, 88 (1995).

54. See, e.g., *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 636 F.3d 1115 (9th Cir. 2011), *withdrawn and superseded by* 654 F.3d 958 (9th Cir. 2011); *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062 (9th Cir. 2006); *Vuitton Et Fils S.A. v. J. Young Enters., Inc.*, 644 F.2d 769 (9th Cir. 1981); *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 925 F. Supp. 2d 1067 (C.D. Cal. 2012). For a discussion of the efforts of the Ninth Circuit to make sense of the concept of aesthetic functionality in these cases, see BARTON BEEBE, TRADEMARK LAW: AN OPEN-SOURCE CASEBOOK pt. I, 228–30 (Version 2.0, 2015), <https://perma.cc/LHM6-D543>.

55. See generally Nigel Thrift, *Understanding the Material Practices of Glamour*, in THE AFFECT THEORY READER, *supra* note 5151, at 289 (discussing the relation between aesthetics and affect).

56. See *Burwell v. Hobby Lobby Stores, Inc.*, 573 U.S. 682 (2014); *Citizens United v. Federal Election Comm’n*, 130 S. Ct. 876 (2010). As Adam Winkler and others have argued, recent leading corporate rights cases, such as *Citizens United* and *Hobby Lobby*, do not rely on a corporate personhood framework, but rather look through the corporate form to identify the source of corporate rights in the corporation’s shareholders. Winkler explains:

[C]orporate personhood has played only a secondary role in the corporate rights movement. While the Supreme Court has on occasion said that corporations are people, the justices have more often relied upon a very different conception of the corporation, one that views it as an *association* capable of asserting the rights of its members. This alternative way of thinking about the corporation has paved the way for the steady expansion of corporate rights. Indeed . . . corporate personhood has traditionally—and surprisingly—been used to justify limits on the rights of corporations.

ADAM WINKLER, WE THE CORPORATIONS 7 (2018). See also Elizabeth Pollman, *Reconceiving Corporate Personhood*, 2011 UTAH L. REV. 1629, 1630 (2011) (“[C]orporate personhood should be understood as merely recognizing the corporation’s ability to hold rights in order to protect the people involved. This concept is the only common thread in the case law.”). One question this raises in the trademark law context is the extent to which courts may begin similarly to justify trademark rights as based on shareholder interests. The trademark case law does not yet appear to have incorporated this basis for trademark rights.

57. See generally Dogan & Lemley, *supra* note 33.

58. McKenna, *supra* note 19, at 231.

perhaps even corporations' right of privacy.<sup>59</sup> Instead of corporate persona, we say "brand," and this may explain why a good deal of scholarship would prefer to describe trademark law as "brand law" rather than trademark law.<sup>60</sup>

#### IV. TRADEMARK LAW AS COMPETITION POLICY

I will briefly conclude by asking how we might try to counteract trademark law's shift toward a right of publicity sensibility. This issue brings us to one important remaining difference between right of publicity law and trademark law. Trademark law seeks, in essence, to promote competition. By contrast, right of publicity law does not try to promote competition in the production of celebrity personas; much of right of publicity doctrine has been developed without any attention to optimizing competition for the benefit of consumers.<sup>61</sup> This distinction may go far toward explaining why right of publicity rights are generally so much more expansive than trademark rights. But just as competition concerns represent an important check on the expansion of corporate rights, so in trademark law, an emphasis on competition may help to limit the expansion of trademark rights stemming from—or at least coincident with—the rise of corporate rights. As the federal courts shift ideologically more to the right and toward finding greater protections for corporate interests, it may be that economic arguments will find a more receptive audience than arguments driven by the First Amendment or a disaffection for consumer culture.

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59. *Cf.* *Federal Commc'ns Comm'n v. AT&T, Inc.*, 562 U.S. 397, 398 (2011) (stating the case "[did] not call upon [the Court] to pass on the scope of a corporation's 'privacy' interests as a matter of constitutional or common law").

60. *See, e.g.*, Deven R. Desai, *From Trademarks to Brands*, 64 FLA. L. REV. 981 (2012).

61. On the possibility of using competition policy to limit the scope of the right of publicity, see Steven Semeraro, *Property's End: Why Competition Policy Should Limit the Right of Publicity*, 43 CONN. L. REV. 753 (2011).