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SEX EXCEPTIONALISM IN INTELLECTUAL PROPERTY

Jennifer E. Rothman*

INTRODUCTION

The state has long attempted to regulate sexual activity through a combination of criminal and civil sanctions and the award of benefits, such as marriage and First Amendment protections, for acts and speech that conform with the state's vision of acceptable sex.¹ These regulatory efforts contribute to our society's construction of sex. The law's construction of sex has largely been a negative one, in which sex—unless it is in service to other state-approved goals (such as procreation or marital intimacy)—is devalued and feared. In particular, the law has contributed to a vision of sex that discounts sexual pleasure, female sexuality, homosexuality, and a variety of “non-conforming” sex interests, such as bondage/sadomasochism.² Failure to challenge such constructions reinforces the “notion that sexual practices are innate or biological, rather than the product of social and cultural forces.”³ The law is therefore an important site of intervention to expose and critique the construction of sex. Intellectual property (IP) laws, though not commonly considered in writing about the law's construction of sex, play a role in perpetuating this often negative and limiting vision of sex.

Sex has long played a role in determining the scope of IP protection, especially in the context of copyright and trademark law. At common law, works,

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1. For a developed analysis of these regulatory efforts and a survey of the relevant literature, see Laura A. Rosenbury & Jennifer E. Rothman, *Sex in and out of Intimacy*, 59 EMORY L.J. 809 *passim* (2010).

2. *Id.* at 812-13.

3. *Id.* at 814.

inventions, and marks deemed sexually explicit or simply suggestive were denied the protection of the law.⁴ Even today they remain disfavored in some contexts. Although the penalties for non-compliance with the state's vision of appropriate sex are less severe in IP law than those, for example, in criminal or family law, IP law signals the state's normative and exceptional views of sex. By sex exceptionalism I mean the way in which IP (and other laws) treat sex differently than other activities. This sex exceptionalism often exhibits a negative view of sex that either dismisses the value of sex or, worse yet, treats it as something harmful. This sex negativity can also manifest as sex normativity in which the state channels sex into preferred forms while excluding or penalizing other forms of sex. IP laws demonstrate all of these modes of engaging with sex—at times treating all sex as exceptional, as uniquely harmful, or simply valueless, and at other times valuing sex but favoring certain types of sex over others.

IP law not only contributes to the legal construction of sex, but also has a particularly significant multiplying effect on the social construction of sex because IP law influences cultural artifacts, such as movies, books, plays, and products and services, that themselves shape our culture's construction of sex. The parameters of IP law encourage creators, companies, and users into safe zones where they are more likely to get copyright protection, register a mark or benefit from fair use or other defenses to infringement and dilution. Thus, the law can stigmatize works and marks with sexual content or certain forms of sexual content, thereby contributing to the channeling of sex into limited acceptable forms.

Instead of "recognizing the diversity of sexual and intimate relations worthy of respect and protection,"⁵ courts often have imposed their views of what constitutes "good sex." IP laws therefore harm individuals living both within and outside the legal construct of acceptable sex.⁶ For those who cannot conform, the legal and social disapproval can cause psychological and physical harm and negatively affect their relationship to themselves, their sexuality, and

4. See HORACE C. BALL, *THE LAW OF COPYRIGHT AND LITERARY PROPERTY* 67-68, 112-13, 720 (1944); RICHARD ROGERS BOWKER, *COPYRIGHT, ITS HISTORY AND ITS LAW* 86-87 (1912); WILLIAM HENRY BROWNE, *A TREATISE ON THE LAW OF TRADE-MARKS* 341-44, 481-86, 607-08 (2d ed. 1898); EATON S. DRONE, *A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES* 181-98 (1879); HENRY ALBERT HINKSON, *COPYRIGHT LAW* 1-2, 8, 71 (1903); STEPHEN D. LAW, *COPYRIGHT AND PATENT LAWS OF THE UNITED STATES, 1790-1870*, at 123 (1870); LEWIS BOYD SEBASTIAN, *THE LAW OF TRADE MARKS AND THEIR REGISTRATION* 397 (3d ed. 1890); ARTHUR W. WEIL, *AMERICAN COPYRIGHT LAW* 22, 195-96 (1917); Jeremy Phillips, *Copyright in Obscene Works: Some British and American Problems*, 6 *ANGLO-AM. L. REV.* 138, 138 (1977).

5. MICHAEL WARNER, *THE TROUBLE WITH NORMAL: SEX, POLITICS AND THE ETHICS OF THE QUEER LIFE* 36-37 (1999).

6. Rosenbury & Rothman, *supra* note 1, at 839.

their place in society.⁷ The laws also discourage some, who otherwise might wish to or would benefit from doing so, from departing from the dominant construction of sex. IP laws therefore interfere with our ability to develop and embrace a more positive relationship to sex.

In the context of this symposium on the adult entertainment industry,⁸ this sex exceptionalism and normativity reveal that the industry may fare worse in some IP disputes than other industries. But the scope of this project sweeps more broadly than the adult entertainment business and pornography. A consideration of the treatment of sex in IP highlights some of the dangers of the differential treatment of sex in general and also some of the pitfalls of using the IP system to further goals unrelated to its core missions. Few, if any, scholars have made these connections.

This Article will proceed in three Parts. First, I will consider trademark law's explicit and implicit disfavoring of sexual content. Second, I will consider copyright law's putative move toward treating sexual content like all other content. Despite this narrative, I will point out some of the ways in which copyright law continues to treat works with sexual content differently than other works. Finally, I will situate this discussion in a broader critique of the law's treatment of sex. I call for a greater awareness of sex exceptionalism and normativity, particularly in IP law, and its elimination. Works, marks, and uses of them should not be disfavored solely because they have sexual content, nor should courts be in the business of assessing what constitutes good or bad sex.⁹

I. TRADEMARK'S CONTINUED SEX NEGATIVITY

Trademarks are symbols, words, designs, or other indicators of source that identify and distinguish the source of goods or services from those of others.¹⁰ Trademark law prevents others (traditionally competitors) from using the same or similar marks to confuse consumers and from diluting the strength of another's mark. Trademark law both at common law and under the governing stat-

7. *Id.* at 818, 839-43.

8. Although the "adult entertainment" industry is the label for the symposium and the one currently in vogue with people who work in what is sometimes called the pornography business, the term is unsatisfying. The bulk of entertainment for adults has very little to do with sexually explicit works. At the same time, the common alternative term, "pornography," is also problematic largely because the term has most often been used with pejorative connotations. To the extent that I use the term "pornography," I intend it to mean—without a positive or negative connotation—a work that is sexually explicit and intended to stimulate a sexual response among readers, viewers, listeners and other consumers.

9. Although I critique normative judgments distinguishing between types of sex, this conclusion does not challenge distinctions courts make elsewhere about whether particular sex acts are consensual.

10. Technically, the term "trademark" only applies to marks used on goods, and the term "service mark" applies to marks used for services, but "trademark" is often used as an all-encompassing term, and I use it as such here.

utes has long scrutinized the “morality” of marks.¹¹ Today, both federal and state laws deny registration to marks deemed “immoral” or “scandalous.”¹² Marks with sexual content often fall within these bars to registration. Trademark law also disfavors sexual content when evaluating liability for trademark infringement and dilution. Findings of trademark dilution in particular often explicitly turn on whether a defendant’s use associates a mark with sex. In this Part, I will discuss each of these aspects of trademark law.

A. Bars to Registration

At common law there were prohibitions on the protection of marks deemed immoral or against public policy. Trademarks were also not protected if the underlying products or businesses were themselves deemed immoral, obscene, or otherwise against public policy, even if the marks themselves were inoffensive. Many of these prohibitions have dissipated, but the longstanding refusal to register marks deemed immoral or scandalous continues today.¹³ The governing Lanham Act explicitly denies federal registration to marks if they “consist[] of or comprise[] immoral . . . or scandalous matter.”¹⁴ Most states also deny registration to marks deemed immoral or scandalous.¹⁵ Even though trademark infringement under state and federal laws can be established if a mark is not registered, registration (federal registration, in particular) provides many benefits for mark holders, including nationwide priority if a mark is federally registered.¹⁶

The Lanham Act does not define what constitutes an “immoral” or “scandalous” mark. Because what is “immoral” is difficult to assess, examining attorneys at the U.S. Patent and Trademark Office (USPTO) and courts have of-

11. See BROWNE, *supra* note 4, at 341-44, 481-86, 607-08 (noting that “lawful trademarks” cannot “transgress[] the rules of morality or public policy” and that marks must meet certain standards of “propriety” and cannot “shock[]” the “sensibilities” of the public); SEBASTIAN, *supra* note 4, at 397 (describing the longstanding principle that the government could deny registration to marks that were “contrary to law or morality”).

12. 15 U.S.C. § 1052(a) (2006); *see infra* note 15.

13. I note that because a mark is viewed in the context of the market some evaluation of the underlying product or service undoubtedly continues to occur. *See In re Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003).

14. 15 U.S.C. § 1052(a) (2006). The statute also prohibits the registration of deceptive and disparaging marks, among other prohibitions. *Id.* The U.S. Patent and Trademark Office (USPTO) reviews applications and determines whether the marks meet the criteria for registration.

15. *See, e.g.*, MISS. CODE ANN. § 75-25-3(a) (West 2011); WASH. REV. CODE ANN. § 19.77.020(1)(a) (West 2011); W. VA. CODE ANN. § 47-2-2(1) (West 2011).

16. *See, e.g.*, 15 U.S.C. §§ 1057(c), 1115 (2006). Both the federal and state registries allow businesses to stake out geographic territory and to facilitate their marks being easily located and thereby avoided by other businesses developing new trade names, logos, and other marks. Federal registry provides numerous other benefits as well. *See, e.g.*, 15 U.S.C. §§ 1057(c), 1065, 1072, 1111, 1115 (2006).

ten treated the exclusions for immoral and scandalous marks as the same.¹⁷ Courts and the USPTO have defined something as scandalous if it is “shocking to the sense of propriety, offensive to the conscience or moral feelings, or calling out for condemnation.”¹⁸ Marks are also deemed scandalous if they are simply “vulgar.” A mark is vulgar if it is “lacking in taste, indelicate, [or] morally crude.”¹⁹ The meaning of the mark is determined by the contemporary understanding of the word and contemporary attitudes.²⁰ Even though what is scandalous or immoral is to be judged from the perspective of a substantial composite of the public,²¹ the analysis leaves much room for the personal biases of examining attorneys and judges to form the basis of a denial of registration. Moreover, the decision is most often made by a sole attorney at the USPTO. The examining attorneys are the ones who make the initial determinations of eligibility for registration, and their decisions (unless appealed) are final. Many rejections are not appealed to the Trademark Trial and Appeal Board (TTAB) (the administrative body that reviews decisions of the examining attorneys), and even fewer are appealed from the TTAB to the Federal Circuit or federal district courts. Thus, many more marks are denied registration than it appears from the number of published appeals of these rejections.

The list of absurd and contradictory decisions of what constitutes a scandalous or immoral mark by the TTAB, the Federal Circuit, and other courts is long and not entirely reconcilable.²² Nevertheless, one can glean some insights from reading these decisions together. The three dominant categories of marks deemed scandalous or immoral are those that refer to a specific religion in the context of selling a forbidden item under that religion’s precepts (such as *Koran* as a mark for wine),²³ marks referring to defecation or urination, and marks

17. See TMEP § 1203.01 (7th ed. Oct. 2010) (citing *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981)). The USPTO publishes the U.S. Trademark Manual of Examining Procedure (TMEP). This publication provides guidance to examining attorneys based on the USPTO’s interpretation of the relevant statutes and case law.

18. *Id.*; see also *In re Boulevard*, 334 F.3d at 1339 (using an “offensiveness” standard for determining scandalousness).

19. TMEP § 1203.01 (citing *In re Runsdorf*, 171 U.S.P.Q. 443, 444 (T.T.A.B. 1971)).

20. Such attitudes will change over time but are to be judged from the time of registration. See *In re Boulevard*, 334 F.3d at 1340. This could mean that a first-comer could be denied registration, while a subsequent registrant would be able to register the mark if perceptions of the mark changed in the intervening time period and the senior user has a geographically limited reach or is no longer in business.

21. I note that some courts have suggested that only potential purchasers should count, but most courts and the USPTO have considered consumers more generally.

22. The Federal Circuit hears most challenges to denials of registration, although such challenges can also be brought in district courts.

23. See *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215 (T.T.A.B. 2010); see also *In re Riverbank Canning*, 95 F.2d 327 (C.C.P.A. 1938) (affirming the denial of registration of *Madonna* as a mark for wine).

referring to sex.²⁴ Given the topic of this symposium, I will focus only on the last category.

Familiarity with the rulings denying registration on the basis of references to sex or sexual organs leads to several conclusions. First, marks showing actual nudity or drawings that depict genitalia are likely to be denied registration. For example, the USPTO rejected the use of a photograph of a naked man and woman to identify a swingers group (referring to sexual partner switching, not to hipsters or the dancing style) and the Court of Customs and Patent Appeals (the predecessor to the Federal Circuit) affirmed the rejection.²⁵ In contrast, a logo was registered for a product that purportedly lengthened penises that included a drawing of a naked man staring at his penis. In reversing the examining attorney's initial rejection of the logo, the TTAB emphasized that the penis itself was not shown (what the man was looking at was left to the imagination). The TTAB also noted that drawings of naked people are more favorably viewed than photographic depictions.²⁶

Gender and sex discrimination also seep into USPTO adjudications. As discussed, references and depictions of genitalia are disfavored; however, references to male genitalia seem to fare better than those to female anatomy. For example, *Big Pecker* for t-shirts was registered,²⁷ but *Bearded Clam* for a restaurant was not because of its purported reference to female genitalia.²⁸ *Pussy* for a drink was denied registration,²⁹ while *Cocktales* for entertainment services was registered after an initial denial.³⁰ Despite this apparent preference for penises, references to male genitalia also can lead to denials of registration. For example, when an applicant sought to register *Sex Rod* for clothing in an athletic font similar to that used by the Boston *Red Sox* baseball team, the application was denied. The TTAB concluded that the term was a "vulgar" reference to the penis with "lurid" and "offensive" connotations.³¹ The TTAB also supported barring registration because the mark was deemed to disparage the baseball team by associating it with an "overtly sexual mark."³²

24. I note that swear words could form a fourth category but largely are composed of words that refer either to the same disfavored bodily functions or sex or sexual organs. I therefore treat these as encompassed within my enumerated categories.

25. *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981).

26. *In re Thomas Labs., Inc.*, 189 U.S.P.Q. 50, 50-52 (T.T.A.B. 1975) ("It must be emphasized that applicant's mark is not a photograph of a nude male figure, but is rather a cartoon[. . .]").

27. *In re Hershey*, 6 U.S.P.Q.2d 1470 (T.T.A.B. 1988) (reversing the denial of registration).

28. *In re Douglas*, 2004 WL 2202264 (T.T.A.B. Sept. 7, 2004).

29. *In re Shearer*, 2009 WL 4073515 (T.T.A.B. May 14, 2009).

30. *In re Mackman*, 2011 WL 810206 (T.T.A.B. Feb. 9, 2011).

31. *Bos. Red Sox Baseball Club, Ltd. v. Sherman*, 88 U.S.P.Q.2d 1581, 1588 (T.T.A.B. 2008).

32. *Id.* at 1589-90.

Solo sex has also been disfavored in the registration process. The Federal Circuit, in *In re Boulevard Entertainment, Inc.*, recently upheld the denial of registration for the marks *1-800-JACK-OFF* and *JACK-OFF* in connection with a phone sex line.³³ The Federal Circuit relied on the examining attorney's review of dictionary definitions of the term "jack-off" that indicated that it was "vulgar."³⁴ Surveys were not used to demonstrate whether a substantial composite of the public, let alone potential customers, would find the term immoral or scandalous. As sexual slang goes the verb to "jack off" is pretty tame. In fact, at least one dictionary has expressly noted that the term is no longer vulgar and has "now become acceptable in speech, although some older or more conservative people may object to its use."³⁵

Although the denial of the registration was based on the term to "jack off," the Federal Circuit may also have been influenced by disapproval of the underlying business—a sex chat line that facilitated and encouraged solo sex.³⁶ It is uncertain whether the USPTO would register 1-800-MASTRB8 for a similar service. If it would, then that would demonstrate the absurdity of the inquiry and the types of distinctions being made. Why should it matter if we refer to masturbation by a clinical term or by a more colloquial term such as "to jack off"? If the USPTO would not register 1-800-MASTRB8 on the grounds that it was immoral or scandalous,³⁷ then that would demonstrate that the opposition is not based on mere vulgarity, but on a broader opposition to masturbation.

The odds of registering a sexually suggestive (or even explicit) mark increase if a registrant can come up with an alternative definition of the mark—

33. *In re Boulevard Entm't, Inc.*, 334 F.3d 1336 (Fed. Cir. 2003).

34. *Id.* at 1339-43.

35. COLLINS ENGLISH DICTIONARY (10th ed. 2009), available at <http://dictionary.reference.com/browse/jack+off>. The federal judiciary may well be composed of many of these "older and more conservative people." As Judge Richard Posner has noted "judges know next to nothing about sex beyond their own personal experience, which is limited, perhaps more so than average, because people with irregular sex lives are pretty much . . . screened out of the judiciary." RICHARD A. POSNER, *SEX AND REASON* 1 (1992). This reality may make the judiciary particularly conservative on matters of sex.

36. In other areas of the law, we have seen a disfavoring of solo sex. See, e.g., *Williams v. Pryor*, 240 F.3d 944, 949 (11th Cir. 2001), *aff'd after remand and appeal sub nom. Williams v. Att'y Gen.*, 378 F.3d 1232, 1234-38 (11th Cir. 2004) (upholding the constitutionality of an Alabama statute that banned the distribution and possession of sex toys because they promote "prurient interests in autonomous sex" and "the pursuit of orgasms by artificial means for their own sake"). Although the Fifth Circuit disagreed with *Williams*, concluding that a similar ban on sex toys was unconstitutional, it rooted its analysis in a vision of sex toy use that promoted relationships rather than solo sex. See *Reliable Consultants, Inc. v. Earle*, 517 F.3d 738, 742-47 (5th Cir. 2008); see also *Rosenbury & Rothman*, *supra* note 1, at 832-33.

37. I note that the USPTO potentially could deny registration of such a mark on the grounds that the mark is generic or descriptive without having achieved secondary meaning. I assume for purposes of this discussion, however, that the mark would be deemed suggestive.

no matter how unbelievable or tangential.³⁸ *Black Tail*, as a mark for a pornographic magazine focused on sexual depictions of African-American women, was initially denied registration both by the examining attorney and TTAB because it referred to a colloquial term for a sexual partner (as in a piece of “tail”).³⁹ The Federal Circuit reversed because there was an alternative non-vulgar meaning referring to a woman’s buttocks.⁴⁰ How referring to a woman’s buttocks in the context of a porn magazine is less sexual or scandalous than referring to her as a sexual partner is confounding. The willingness to consider such alternatives, however, is unpredictable. In the rejection of the *Bearded Clam* registration for a seafood restaurant, the USPTO rejected registration on the basis that the name was a vulgar reference to female genitalia,⁴¹ even though there was a compelling and highly relevant alternative meaning in the seafood world—the term indicates a clam with algae on it. It seems that the disfavoring of female genitalia trumped the availability of an alternative meaning of the word.

I do not intend to suggest that all marks with sexual content are denied registration. The above examples demonstrate as much. Despite what could be viewed as an anti-solo-sex position by the Federal Circuit in *In re Boulevard*, there are many examples of registered marks for sex toys that have sexually suggestive names; for example, *Mega Masturbator*, *X-Spot*, *Vibrating Vagina*, and *In Like Flynt* (granted with permission of Hustler owner, Larry Flynt). The contradictory and confusing determinations about the registrability of marks with sexual content are possible because of the explicit bar to registering marks deemed immoral or scandalous. These prohibitions frequently bar the registration of marks with sexual content and, in such instances, signal that sex is something to be viewed negatively, hidden from public view, and that some types of sex and ways of talking about sex are preferred by the state, while others are disfavored. This signaling participates in the construction of sex and channels sex into certain preferred forms that are limiting and discriminatory.

B. *Infringement*

Outside of the registration system, courts have been influenced by sex negativity and normativity in ways that strongly disfavor defendants who use marks (or anything that evokes a mental association with another’s mark) in the context of sex. To establish trademark infringement under federal and state laws, a plaintiff must establish that consumers are likely to be confused as to

38. See, e.g., *In re Ava Watkins*, WL 548042 (T.T.A.B. Feb. 8, 2005) (reversing the USPTO’s rejection of a registration for *Twatty Girl* as a mark for a comic strip, but only because the Board believed that the mark could be interpreted as referring to something other than female anatomy).

39. *In re Mavety Media Grp.*, 33 F.3d 1367, 1368-70 (Fed. Cir. 1994).

40. *Id.* at 1373-75.

41. *In re Douglas*, WL 2202264 (T.T.A.B. Sept. 7, 2004).

the source, sponsorship or affiliation of the product or service because a defendant has used the same or a similar mark on its own goods or in connection with those goods or its services.⁴² Courts use a number of factors to evaluate whether consumers are likely to be confused. These “likelihood of confusion” factors differ in number in different federal circuits.⁴³ Not only does the number of factors vary from circuit to circuit, but so does the content of those factors. One could engage in a much broader critique of these likelihood of confusion factors, which are not provided by the statute and often seem wholly unrelated to the critical question of whether confusion is actually likely, but putting that aside, sexual content is particularly vulnerable to the vagaries of courts applying these factors. The use of disaggregated likelihood of confusion factors itself makes discrimination against uses in a sexual context more likely. Rather than evaluating broadly whether consumers are likely to think a markholder is involved—something that is less likely in a sexual context—courts look at each factor in isolation.

Many of the likelihood of confusion factors are shared between different circuits and several of these factors have disfavored uses of marks in a sexual context. In particular, four of the common likelihood of confusion factors have been wielded against defendants in the context of sex. I consider each of these factors in more detail. The first likelihood of confusion factor that I will consider is the competitive proximity of the goods or services. The more proximate the two products are, the more likely it is that consumers will be confused because the products/services will be sold in the same markets to the same consumers. When evaluating this factor, courts consider the likelihood of expansion of the trademark holder into other markets. In the context of sex, courts have sometimes interpreted competitive proximity quite broadly. One district court, for example, concluded that even though the defendant and plaintiff were selling different services and targeting different markets, the plaintiff and defendant were competitors because of the possibility that the defendant (who had made a sexually suggestive use) would divert the consumers from the mark holder’s product.⁴⁴ Courts also improperly bring in tarnishment concerns, which are tangential to the relevant inquiry of market proximity. Courts point to the possibility that consumers will develop a negative association with the product as a result of the defendant’s use of a mark (or something similar) in a sexual context and then assume that this tarnishment could affect sales. Using

42. *See, e.g.*, 15 U.S.C. § 1125(a) (2006).

43. *Compare, e.g.*, *Sally Beauty Co. v. Beautyco, Inc.*, 304 F.3d 964, 972 (10th Cir. 2002) (describing the Tenth Circuit’s six-factor test), *with Recot, Inc. v. Becton*, 214 F.3d 1322, 1326-27 (Fed. Cir. 2000) (enumerating the thirteen factors used by the Federal Circuit and USPTO to determine likelihood of confusion).

44. *Pfizer, Inc. v. Sachs*, 652 F. Supp. 2d 512, 522 (S.D.N.Y. 2009). The use in *Pfizer* might well have been confusing (as to sponsorship); however, my point is not to challenge the legitimacy of the holding in this particular case, but instead to point out the counterintuitive and exceptional analysis of the proximate-market analysis.

convoluted logic, some courts then conclude that such an effect could only occur if the products were in competitive proximity.⁴⁵

Another likelihood of confusion factor that allows courts to wield their anti-pornography, anti-sex predilections is the consideration of the quality of the defendant's product. If a defendant's goods or services are of low quality, some courts will weigh the factor in favor of a likelihood of confusion.⁴⁶ When courts focus on the quality of the products or services, those with sexual content have sometimes been deemed of "low" or "poor" quality on the basis that they are sexual.⁴⁷ Such conclusions weigh in favor of likely confusion and also reflect negative views of sex and of those who consume works, products, and services of a sexual nature.

Some courts also consider a factor that evaluates the sophistication of purchasers and the price of the product. Higher priced goods likely have more discerning customers who are less likely to be confused. In the context of pornography, a number of courts have suggested that porn consumers are less discerning than others and therefore more easily confused (and "diverted").⁴⁸

Another relevant likelihood of confusion factor that courts consider is the intent of the defendant in adopting or using the relevant mark or something similar to it. Consideration of the defendant's intent often works against defendants in the context of sexually suggestive or explicit uses. Although the traditional analysis focuses on whether a defendant sought to confuse consumers (or sometimes simply to adopt a similar mark),⁴⁹ some courts (even outside of the context of sex) conclude that knowledge of the plaintiff's mark itself demonstrates bad faith and malicious intent.⁵⁰ In the context of sex, courts have concluded that simply trying to profit from an association with another's mark is enough to show likelihood of confusion even if there is no other evidence or

45. See, e.g., *Pfizer*, 652 F. Supp. 2d at 522.

46. See *Imagineering, Inc. v. Van Klassens, Inc.*, 53 F.3d 1260, 1265 (Fed. Cir. 1995). But see *Savin Corp. v. Savin Grp.*, 391 F.3d 439, 460-61 (2d Cir. 2004) (suggesting that low quality goods produced by defendants will signal that the goods are not those of the plaintiff's thereby reducing the likelihood of confusion, but potentially increasing the likelihood of dilution). Putting aside issues of sex, this factor deserves critique because it revolves around questions of harm, rather than likely confusion—thereby putting the cart before the horse.

47. See, e.g., *Pfizer*, 652 F. Supp. 2d at 523-24 (citing with approval *Dall. Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205 (2d Cir. 1979)).

48. See, e.g., *Playboy Enters., Inc. v. Netscape Commcn's Corp.*, 354 F.3d 1020, 1028 (9th Cir. 2004).

49. 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:113 (4th ed. 2011).

50. See, e.g., *PACCAR, Inc. v. TeleScan Techs., L.L.C.*, 319 F.3d 243, 254 (6th Cir. 2003); *Pfizer*, 652 F. Supp. 2d at 523 (suggesting that knowledge of the plaintiff's mark is sufficient in the context of a sexually suggestive use to demonstrate bad faith); *Dall. Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 467 F. Supp. 366, 374-77 (S.D.N.Y. 1979) (concluding that the deliberate adoption of plaintiff's mark without regard to the intent to confuse is evidence of a likelihood of confusion in the context of a pornographic film).

indication of likely confusion.⁵¹ I have criticized elsewhere this more general movement to consider infringing any effort to profit from non-confusing associations with others' marks,⁵² but some judges have been particularly critical of defendants making such associations in the context of the pornography business.

The overall ad hoc balancing of these likelihood of confusion factors gives courts great latitude to bootstrap in other considerations unrelated to likelihood of confusion, such as possible tarnishment of the trademark. Such considerations arose more frequently in infringement discussions before an amendment to the Lanham Act provided for an express cause of action for dilution. Now that there is such a provision, courts most often consider tarnishment under dilution analysis.

Also working against defendants is the fact that courts often make determinations about the likelihood of confusion in the context of motions for preliminary injunctions in which courts focus heavily on the severity of the harm to the plaintiff even when the likelihood of confusion is admittedly minimal.⁵³ In these cases the harm of being associated with sex is deemed significant and can weigh heavily in the plaintiff's favor.⁵⁴ Often, after preliminary injunction rulings, cases are either dropped or settled, so these initial decisions are very influential.

Not only have courts been more likely to find a likelihood of confusion in the context of sex, but they also have disfavored the panoply of defenses to infringement when defendants have used marks (or colorable imitations) in a sexual context. Descriptive fair use is both a statutory and common law defense to trademark infringement that protects defendants from liability when they are not using the plaintiff's mark (or something similar) as a mark but instead to describe the features of a defendant's own product or service.⁵⁵ A referential or nominative fair use is a court-created doctrine that protects uses of another's mark that identify the plaintiff's goods or services, rather than those of the defendant.⁵⁶ Both descriptive and nominative fair use serve to protect First

51. See, e.g., *Dall. Cowboys*, 467 F. Supp. at 377.

52. Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 CARDOZO L. REV. 105 *passim* (2005).

53. See, e.g., *Dall. Cowboys Cheerleaders, Inc. v. Pussycat Cinemas*, 604 F.2d 200, 206-07 (2d Cir. 1979); *Dall. Cowboys*, 467 F. Supp. at 377-78.

54. See, e.g., *Dall. Cowboys*, 604 F.2d at 204-07; *Barbecue Marx, Inc. v. 551 Ogden, Inc.*, 110 F. Supp. 2d 689 (N.D. Ill. 2000) (holding that playing adult films in a restaurant called *Bone Daddy* was sufficient to establish likely confusion in context of balancing harm to plaintiff's *Smoke Daddy* mark), *rev'd*, 235 F.3d 1041 (7th Cir. 2000) (reversing on grounds that there was no likelihood of confusion but not commenting on the dilution conclusion or balancing of harms).

55. See 15 U.S.C. § 1115(4) (2006); 4 MCCARTHY, *supra* note 49, at § 11:45.

56. *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992). Although most courts now accept some form of a nominative fair use defense, some circuits still have not done so. See, e.g., *PACCAR Inc. v. TeleScan Techs., L.L.C.*, 319 F.3d

Amendment values, but courts also consider separate First Amendment arguments in trademark cases. If a work is a parody, for example, courts usually conclude that the First Amendment protects a defendant from liability for trademark infringement (or dilution).

The most prominent example of an alleged use of a plaintiff's mark being found infringing as a result of its use in a sexual context is the Second Circuit's decision in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*⁵⁷ The court upheld a preliminary injunction against the defendants to prevent them from distributing and exhibiting a sexually-explicit film in which the main character, Debbie, briefly wears a uniform similar to that of the Dallas team's cheerleaders' uniforms. The same uniform was used in the posters for the film and the advertising misleadingly suggested that the lead, Bambi Woods, was a former Texas Cowgirl, a term sometimes used to refer to the Dallas Cowboys Cheerleaders. (See Figure 1 below.)

Figure 1—Poster for *Debbie Does Dallas*⁵⁸



Putting aside complaints about the advertising, the court considered the use of the uniform in the film infringing. The court suggested that the use of a cheerleader outfit similar to those of the Dallas Cowboys Cheerleaders and alleged references to the cheerleaders were likely infringing.⁵⁹ The court's animosity toward the film was explicit—it described the film as “gross,” “revolt-

243, 256 (6th Cir. 2003) (“This circuit has never followed the nominative fair use analysis We are not inclined to adopt the [nominative fair use analysis] here.”).

57. 604 F.2d 200 (2d Cir. 1979).

58. Photograph of original one-sheet movie poster displayed for sale by CineMasterpieces. Virtual Gallery, CINEMASTERPIECES, http://www.cinemasterpieces.com/cine_D.htm#debbie.

59. *Dall. Cowboys*, 604 F.2d at 202-07.

ing,” and “sexually depraved.”⁶⁰ The court held that there was infringement because of the negative “association” with the Dallas Cowboys and the likelihood that people would think the Cowboys “sponsored the movie, provided some of the actors, licensed defendants to use the uniform, or was in some other way connected with the production.”⁶¹ There was little to no evidence supporting such an association by consumers; given the quality and nature of the film, it is hard to imagine how anyone could think that the Dallas Cowboys were involved with the project. The court did not review the likelihood of confusion factors in detail but instead suggested that “trademark laws are designed not only to prevent consumer confusion but also to protect ‘the synonymous right of a trademark owner to control his product’s reputation.’”⁶² Thus, the concern was harm to reputation, not harm to consumers who may have been misled. The confusion holding was based on this alleged tarnishment rather than the statutorily required demonstration of likely confusion.

The court in *Dallas Cowboys* rejected arguments that the use of the uniform was a descriptive or referential/nominative fair use or that it was a use protected by the First Amendment. The court dismissed the possibility that *Debbie Does Dallas* was a parody and that it was commenting on the Dallas Cowboys or the team’s cheerleaders. The plot of the film centers on Debbie’s efforts to raise money to get to Texas where she will cheer with the “Texas Cowgirls.” When the movie was made, the Dallas Cowboys were one of, if not *the* most dominant teams in football, and its cheerleaders were so well-known that they were definitional of cheerleading itself.⁶³ It therefore made sense to have Debbie going to perform with them (although, I note that the film never actually mentions the Cowboys or Dallas or shows her going anywhere). At that time there could have been no prize more sought after for an aspiring cheerleader than to become a Dallas Cowboys Cheerleader. Similarly, during that era, if someone was going to have a sexual fantasy about cheerleaders, it likely would have centered around the Dallas Cowboys’ cheerleaders.

It thus seems a referential/nominative use, rather than an exploitative one, to have a male character, who wished he had been a quarterback, request that Debbie wear a Dallas Cowboys Cheerleaders’ costume. The court did not think such a reference was necessary, however, and deemed the message of *Debbie*

60. *Id.* at 202, 205. Experts in the field describe the film as rather tame compared to today’s pornography and as being a full-fledged narrative film that happened to also have sex. The main character only has sex once, in the final sequence of the film. At the time, however, *Debbie Does Dallas* was one of the first major full-length pornographic films to be distributed and therefore may well have been shocking to the judges. *See* DEBBIE DOES DALLAS: UNCOVERED (New Video Grp. 2005).

61. *Dall. Cowboys*, 604 F.2d at 205.

62. *Id.* (citing *James Burrough Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 274 (7th Cir. 1976)).

63. *See* Christopher Kelly, *Porn Yesterday: Debbie Does Dallas Turns Thirty*, TEX. MONTHLY, July 2008, at 48 (contextualizing *Debbie Does Dallas* and discussing its commentary on the Dallas Cowboys).

Does Dallas “barely discernible.”⁶⁴ The court concluded that the filmmakers could comment on sexuality in athletics without actually referring to the plaintiff’s trademarks.⁶⁵ But could they comment on the Dallas Cowboys Cheerleaders without making such an explicit reference? I do not think so. IP law and trademark law should not stand as an obstacle to people, including pornographers, documenting and describing the world around them—a world that includes football teams and cheerleaders who have names that are trademarked.⁶⁶

Moreover, a colorable argument could be made that the movie did provide a revealing (even if unintentional) commentary on the Dallas Cowboys Cheerleaders. In real life, the cheerleaders were sexualized by the team and players both on and off the field. They were obligated to wear short shorts, tall white go-go boots, and vests and shirts that revealed ample cleavage—and (at least for some) likely evoked go-go dancers and strip club culture. There also were undoubtedly physical requirements for the cheerleaders.⁶⁷ By making this sexualization explicit, *Debbie Does Dallas* was simply calling a spade a spade.⁶⁸

In a more mainstream film, the filmmakers would have been given more latitude to use others’ trademarks and to refer to and comment on the real world.⁶⁹ Consider for sake of comparison the 1979 dramatic film *North Dallas Forty*. *North Dallas Forty* was based on a novel of the same name that was a semi-fictionalized account of the author Peter Gent’s time playing in the NFL for the Dallas Cowboys. It was abundantly clear that the team depicted in the film was the Dallas Cowboys, even though the film changed the name of the team, and the uniforms were not identical to those of the Cowboys.⁷⁰

Although no lawsuit, as far as I am aware, was filed against *North Dallas Forty*, if the Cowboys had sued the makers of *North Dallas Forty*, a court would likely have dismissed infringement and dilution claims or have credited a First Amendment defense. This would have been so even if the film had used identical uniforms and been much more explicit about its reference to the Cowboys.⁷¹ The comparison between the films is therefore instructive because it

64. *Dall. Cowboys*, 604 F.2d at 206.

65. *Id.*

66. For a discussion of this issue in the context of copyright law, see Jennifer E. Rothman, *Liberating Copyright: Thinking Beyond Free Speech*, 95 CORNELL L. REV. 463 *passim* (2010).

67. *DEBBIE DOES DALLAS: UNCOVERED*, *supra* note 60.

68. *Id.*

69. *See, e.g.*, *Caterpillar, Inc. v. Walt Disney Co.*, 287 F. Supp. 2d 913 (C.D. Ill. 2003); *Univ. of Notre Dame du Lac v. Twentieth Century-Fox Film Corp.*, 256 N.Y.S.2d 301 (N.Y. Sup. Ct. 1965), *aff’d*, 15 N.Y.2d 940 (N.Y. App. Div. 1965).

70. I note that the filmmakers and Gent likely “fictionalized” the team to avoid defamation suits, rather than trademark claims.

71. *See Dall. Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 467 F. Supp. 366, 375-76 (S.D.N.Y. 1979) (distinguishing *Univ. of Notre Dame du Lac v. Twentieth Century-Fox Film Corp.*, 256 N.Y.S.2d 301 (N.Y. Sup. Ct. 1965), *aff’d*, 15 N.Y.2d 940 (N.Y. App.

demonstrates a locus of sex exceptionalism and negativity. *North Dallas Forty* likely did much more damage to the Dallas Cowboys' image and reputation than *Debbie Does Dallas* did. In *North Dallas Forty*, the team owners and coaches are ruthless, and the players abuse drugs and women. The movie includes sexual references, contains coarse language, and shows male and female nudity but does not show genitalia or actual intercourse. *Debbie Does Dallas*, by contrast, is not about the team or its cheerleaders at all and made no claim to depict anything about the team or its cheerleaders. The movie does not even take place in Dallas, and Debbie has no interaction with anyone from the team. The likely discrepancy in predicted outcomes suggests that harm to reputation is not the real issue but instead the disfavoring of sex when there is little purpose other than the sex to the underlying work. Sex for sex's sake holds no value in the law.

This comparison also demonstrates another locus in which courts are distinguishing between types of sex—sexual suggestiveness is favored over actual sex, and heterosexual sex is preferred over solo sex and sex with more than one other person. *Debbie Does Dallas* contains scenes of masturbation, sex scenes with more than two people, and some same-sex sexual activity. Thus, more than simply the graphic nature of the sex likely led the court to view it as “gross” and “revolting.”⁷²

Although subsequent courts have explained the *Dallas Cowboys* decision by suggesting that there was an express attempt to free ride rather than simply to use a trademark or trade dress in a movie, this explanation is unconvincing.⁷³ Free riding itself is not a basis for trademark infringement or else a much broader swath of uses would be infringing. Instead, the likelihood of confusion standard is the primary determinant of infringement.

To remedy this disconnect subsequent courts have mostly treated *Dallas Cowboys* as a dilution case that took place before the enactment of federal dilution law. Several courts, however, continue to cite the case as good law, supporting the proposition that using a mark (or something similar to it) in a sexually explicit context weighs in favor of a likelihood of confusion finding and against a First Amendment defense.⁷⁴ Regardless of the doctrinal hook, the real

Div. 1965), a case that recognized the First Amendment interests of a “fictional movie about Notre Dame University and its football team”).

72. *Dall. Cowboys Cheerleaders, Inc. v. Pussycat Cinemas*, 604 F.2d 200, 202 (2d Cir. 1979).

73. *See, e.g., Caterpillar, Inc.*, 287 F. Supp. 2d at 913 (describing why the appearance of Caterpillar vehicles in a Disney film was not infringing, but the appearance of costumes similar to the Dallas Cowboys Cheerleader uniforms in a pornographic film was).

74. *See, e.g., Pfizer, Inc. v. Sachs*, 652 F. Supp. 2d 512, 523-24 (S.D.N.Y. 2009) (citing *Dallas Cowboys* in context of sex to support likelihood of confusion finding); *Kraft Foods Holdings, Inc. v. Helm*, 205 F. Supp. 2d 942, 953-54 (N.D. Ill. 2002) (citing *Dallas Cowboys* with approval in context of rejecting a First Amendment defense to a use of a similar mark in a sexual context); *see also Famous Horse, Inc. v. 5th Ave. Photo, Inc.*, 624 F.3d 106, 109 (2d Cir. 2010) (citing *Dallas Cowboys* for its likelihood of confusion analysis); To-

complaint in *Dallas Cowboys* was that the public might develop a negative association with the Dallas Cowboys because of the defendant's use of its mark. This is the harm of dilution. As I will next consider, dilution often has been an outlet for courts to express their antipathy to sex and, to the extent that they permit sexual depictions, to prefer certain types of sex over others that do not conform to the law's vision of "good sex."

C. *Dilution as a Proxy for Sex Negativity*

The dilution of a mark is the whittling away of its strength by others' use of the mark or something similar to it that causes an association with the mark. Dilution can occur and be actionable without regard to whether a use is likely to confuse consumers as to source, sponsorship, or affiliation. Two forms of dilution are usually recognized: The first is dilution by *blurring*—in which multiple associations with a single mark are likely to reduce the selling power of the senior mark. The other form of dilution and the one of the most relevance here is dilution by *tarnishment*. The Lanham Act defines dilution by tarnishment as an "association arising from the similarity between a mark or trade name and a famous mark that *harms the reputation* of the famous mark."⁷⁵ Reputational harm is often presumed when a mark is used in a sexual context.⁷⁶

Dilution law has long been controversial, especially on the national stage.⁷⁷ There was no federal dilution law until the passage of the Federal Trademark Dilution Act in 1995. Because dilution law does not turn on whether consumers are likely to be confused, it primarily serves to control what a mark signifies. This raises free speech and substantive due process concerns. It also furthers the interests of markholders instead of consumers, who were viewed as the primary (though not the sole) focus of federal trademark law prior to passage of the Federal Trademark Dilution Act. The evaluation of uses of marks in a sexual context not only highlights the disparate treatment that sex receives in IP circles, but also provides additional ammunition for questioning dilution's legitimacy.

ny Farmony, *Dallas Cowboys Cheerleaders v. Pussycat Cinema*, 12 J. CONTEMP. L. ISSUES 275, 277-79 (2001) (discussing that *Dallas Cowboys* is still good law and appropriately analyzes the intersection of First Amendment and trademark and reputational interests).

75. 15 U.S.C. § 1125(c)(2) (2006).

76. See, e.g., *V Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382, 385-89 (6th Cir. 2010); *Kraft Foods*, 205 F. Supp. 2d at 948-56; *Ford Motor Co. v. Lapertosa*, 126 F. Supp. 2d 463, 466-67 (E.D. Mich. 2001); *Toys "R" Us, Inc. v. Akkaoui*, 40 U.S.P.Q.2d 1836, 1838 (N.D. Cal. 1996); *Pillsbury Co. v. Milky Way Prods., Inc.*, 215 U.S.P.Q. 124, 135 (N.D. Ga. 1981).

77. See, e.g., Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After Eldred*, 44 LIQUORMART, and Bartnicki, 40 HOUS. L. REV. 697, 732-39 (2003); see also Robert N. Klieger, *Trademark Dilution: The Whittling Away of the Rational Basis for Trademark Protection*, 58 U. PITT. L. REV. 789 *passim* (1997).

The depiction of marks in a sexual context has often been held to dilute those marks by tarnishment. In fact, many courts have suggested that references to marks made in the context of obscenity, sex, or crime constitute *per se* dilution.⁷⁸ Despite the statute's silence on the issue, the Sixth Circuit concluded in *V Secret Catalogue, Inc. v. Moseley* that the Trademark Dilution Revision Act of 2006 created a "rebuttable presumption, or at least a very strong inference that a new mark [created by the defendant] used to sell sex related products is likely to tarnish a famous mark if there is a clear semantic association."⁷⁹ The court suggested that even if a use that was sexual in nature was simply "offensive-to-some," the defendant would have the burden to prove a virtually impossible negative—that the use was *not* likely to dilute.⁸⁰ The Sixth Circuit conceded that there was no evidence other than an association with sex to establish a likelihood of tarnishment. Nevertheless, the defendant was saddled with the burden to contradict the "res-ipsa-loquitor-like" effect of associating any mark with sex.⁸¹ Needless to say, the defendant could not make such a showing.⁸²

The Sixth Circuit's seemingly unjustifiable burden shifting and *per se* treatment of uses in a sexual context was based in part on its reading of the *Restatement (Third) of Unfair Competition* and in particular the *Restatement's* third illustration in its section on dilution. The illustration provided that:

A, a bank, uses the designation "Cookie Jar" to identify its automatic teller machines. B opens a topless bar across the street from A under the trade name "Cookie Jar." Although prospective customers of A are unlikely to believe that A operates or sponsors the bar, B is subject to liability to A for tarnishment under an applicable antidilution statute if the customers are likely to associate A's mark or A's business with the images evoked by B's use.⁸³

The *Restatement* used the illustration not to demonstrate that sex was *per se* tarnishing, but instead to demonstrate that dilution could be shown without re-

78. See *Moseley*, 605 F.3d at 385-89; *Pfizer*, 652 F. Supp. 2d at 525; *Kraft Foods*, 205 F. Supp. 2d at 948-49; *Mattel v. Internet Dimensions, Inc.*, 55 U.S.P.Q.2d 1620, 1627 (S.D.N.Y. 2000); *Polo Ralph Lauren L.P. v. Schuman*, 46 U.S.P.Q.2d 1046, 1048 (S.D. Tex. 1998); see also *Ford Motor Co.*, 126 F. Supp. 2d at 466 ("Courts uniformly have held . . . that the use of a famous trademark in a domain name used to purvey pornography constitutes dilution.").

79. 605 F.3d at 385. The Trademark Dilution Revision Act was passed with the express purpose of overruling an earlier decision by the Supreme Court in which the court held that plaintiffs needed to establish *actual* dilution rather than a mere *likelihood* of dilution. The 2006 revision changed the standard to one of likely dilution and made a number of other changes to federal dilution law, including expressly adding tarnishment to the definition of dilution. See Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730.

80. *Moseley*, 605 F.3d at 389.

81. *Id.*; see also *id.* at 391-95 (Moore, J., dissenting).

82. *Id.* at 388-89.

83. RESTATEMENT (THIRD) UNFAIR COMPETITION § 25 cmt. g (citing Cmty. Fed. Sav. & Loan Ass'n v. Orondorff, 678 F.2d 1034 (11th Cir. 1982)).

gard to likely confusion. There is no statutory or other support for the proposition that no additional evidence need be shown by plaintiffs to establish likelihood of dilution other than a reference to sex. The Sixth Circuit's conclusion, however, is not entirely unfounded. The court picked up on the common trend of using topless bars and strip clubs as exemplars of tarnishing uses.⁸⁴ No court, however, has provided any evidence or even explanation of why such uses are in fact likely to tarnish a plaintiff's mark.

Other examples from the case law demonstrate dilution law's sex negativity. In *Pillsbury Co. v. Milky Way Productions, Inc.*, a district court found, after a bench trial, that an artist's rendering of the Pillsbury Dough Boy and Dough Girl—*Poppin' Fresh* and *Poppie Fresh*—engaged in sexual intercourse and fellatio in a pornographic magazine called *Screw* diluted Pillsbury's trademark rights in those characters.⁸⁵ (See Figure 2.) The court held that consumers were not likely to be confused by the use of these characters.⁸⁶ Nevertheless, the court concluded that the use of the marks in a sexualized manner was likely to "dilute the distinctive quality" of the plaintiff's marks and "injure [the company's] commercial reputation."⁸⁷

Figure 2—The Challenged Fake Ad from *Screw* Magazine⁸⁸



84. See, e.g., *Ty, Inc. v. Perryman*, 306 F.3d 509, 511 (7th Cir. 2002) (referring to a "striptease joint" called *Tiffany* as an exemplar of what it means to dilute a mark by tarnishment).

85. 215 U.S.P.Q. 124, 125-26 (N.D. Ga. 1981).

86. *Id.* at 129-34 (rejecting infringement claims).

87. See *id.* at 135 (finding a violation of Georgia's anti-dilution statute).

88. Photocopy from *Screw* Magazine, at 2 (Dec. 19, 1977), available to scholars and students in Intellectual Property Teaching Resources, Georgetown Law (image on file with author).

Similarly, a court issued a preliminary injunction concluding that a defendant's use of a mark similar to Kraft's *Velveeta* for processed cheese was likely to dilute Kraft's *Velveeta* because of the sexual content on the defendant's website.⁸⁹ The defendant, Stu Helm, alleged that he had used the nickname King VelVeeda for seventeen years and signed his artwork with that name. Helm is a graphic artist and ran two websites, one at the web address www.cheesygraphics.com, where he continues to advertise his services as a graphic artist,⁹⁰ and another at www.courtofporn.com, which contained more sexually explicit materials. These websites made a number of references to cheese and cheesiness—in the sense of his artwork being tacky or low-brow, rather than it being an edible milk-based product. Some of the illustrations on Helm's websites included naked women or women in suggestive poses and some depicted sexual activity. The court concluded that irreparable harm would befall Kraft if consumers associated its *Velveeta* cheese with sex. Because the court dismissed the possibility that Helm's use of the moniker King VelVeeda was valuable, the balance of harms easily weighed in favor of injunctive relief.⁹¹

The entrenched notion in dilution law that an association with something sexual is automatically tarnishing supports and perpetuates sex negativity. It is also patently absurd when the mark or product/service is already associated with sex. For example, a small sex toy shop called *Victor's Little Secret* was found likely to dilute (by tarnishment) Victoria's Secret's mark in its store name, despite the larger company's sale of lingerie and use of sexually suggestive advertising campaigns.⁹² The Sixth Circuit concluded that the defendant's mark—which was not confusing—might tarnish the larger company's mark because it was “sex related.”⁹³ It is a classic example of the law sitting in judgment of what constitutes “good” sex. Victoria's Secret, which unquestionably treats women as sexual objects, scantily clad in underwear, represents “good” sex, while a store that sells vibrators that those same women might enjoy “tarnishes” the “wholesome” image of sex that Victoria's Secret tries to construct.⁹⁴ Playboy also has made successful dilution arguments that associations with “hardcore” porn sites tarnish its high-brow, soft-core porn reputation.⁹⁵ Similarly, a federal district court thought the association of Viagra with an at-

89. Kraft Foods Holdings, Inc. v. Helm, 205 F. Supp. 2d 942, 948-49 (N.D. Ill. 2002).

90. For the current version of the website and information on the defendant Stu Helm, see www.cheesygraphics.com.

91. Kraft Foods, 205 F. Supp. 2d at 948-57.

92. See V Secret Catalogue, Inc. v. Moseley, 605 F.3d 382, 394 n.4 (6th Cir. 2010) (Moore, J., dissenting) (describing *Victoria's Secret's* sexually suggestive marketing campaigns).

93. *Id.* at 385.

94. See *id.* at 391-95 (Moore, J., dissenting); see also *Victoria's Cyber Secret Ltd. P'ship v. V Secret Catalogue, Inc.*, 161 F. Supp. 2d 1339 (S.D. Fla. 2001) (finding dilution of *Victoria's Secret* mark because of an association with adult entertainment websites).

95. See, e.g., *Playboy Enters., Inc. v. Webbworld, Inc.*, 991 F. Supp. 543 (N.D. Tex. 1997).

tractive woman sitting astride a missile tarnished the image of the erectile dysfunction drug.⁹⁶ It is confounding how encouraging people to have sex tarnishes the image of a drug intended to facilitate sex. It is also telling that in other non-sexual contexts, courts have suggested that making something seem low-brow and contrary to a plaintiff's upscale reputation is not dilutive, yet in the context of sex such associations have been considered relevant.⁹⁷ Thus, dilution law perpetuates a sex-negative message and imposes troubling distinctions between "good" and "bad" sex.

Dilution law also runs contrary to everything advertising agencies know. Rather than discouraging purchases, sex often sells.⁹⁸ So an association with sex might often be a plus for businesses. Far from harming sales of products, causing consumers to (consciously or subconsciously) associate a product or service with sex might actually enhance sales and the image of the underlying products. Nevertheless, courts make unsubstantiated conclusions to the contrary. The Sixth Circuit, for example, concluded that an association between a famous mark and "lewd or bawdy sexual activity disparages and defiles the famous mark and reduces the commercial value of its selling power. This consensus stems from an economic prediction about consumer taste and how the predicted reaction of conventional consumers in our culture will affect the economic value of the famous mark."⁹⁹ Yet, neither this court nor any other that I have found has cited any evidence that this effect in fact occurs. It is possible that associations with certain types of sex (perhaps "hardcore" or uncommon sexual practices) would discourage purchases, but no such evidence has ever been discussed in dilution cases. Even the TTAB has admitted that the scandalousness of a mark may actually generate more interest in a product or service.¹⁰⁰ This confounding state of affairs suggests that the tarnishment conclusion may revolve more around efforts to channel sex into accepted, sanitized, and controllable forms instead of around efforts to protect trademark holders from negative repercussions of sexual associations with their marks.

Not only is a finding of dilution much more likely in the context of sexually explicit references to trademarks, but the usual array of defenses that make enforcement of dilution a rarity have sometimes been disfavored in the context

96. *Pfizer, Inc. v. Sachs*, 652 F. Supp. 2d 512, 525 (S.D.N.Y. 2009).

97. *See, e.g., Paco Sport, Ltd. v. Paco Rabanne Parfums*, 86 F. Supp. 2d 305, 329 (S.D.N.Y. 2000) (asserting that perfume company cannot complain that defendant's sale of clothing interferes with its "carefully crafted upscale image," but suggesting that if there had been a sexual reference that conclusion might be different).

98. Although there are no definitive studies, a number of studies suggest that sex is both a frequent and useful advertising technique. Association with sex increases interest in advertisements and some studies have shown that it increases the likelihood that consumers will purchase the advertised goods. *See, e.g., Tom Reichert, Sex in Advertising Research: A Review of Content, Effects, and Functions of Sexual Information in Consumer Advertising*, ANN. REV. SEX RESEARCH 241 *passim* (2002) (surveying relevant studies).

99. *Moseley*, 605 F.3d at 388.

100. *See, e.g., In re Douglas*, 2004 WL 2202264 at *5 (T.T.A.B. Sept. 7, 2004).

of sexually explicit uses. Dilution law raises free speech concerns and judges often credit defenses to dilution on the basis of these concerns. Although First Amendment and other defenses to dilution are frequently successful, when the uses at issue relate to sex, such defenses have sometimes been rejected because of the sexual content.¹⁰¹ Parody has long been a defense to trademark dilution and current federal law has an explicit exemption for parodies.¹⁰² Some courts, however, have rejected the possibility that uses of marks in a sexual context can form a parody or any other form of commentary or critique that would be exempted from liability for dilution either via the explicit statutory exemptions or the First Amendment.¹⁰³ There is no justification for the conclusion that parodies cannot have sexual content, and such a holding cuts off a host of important potential commentaries.

Some of the decisions finding dilution in sexual contexts are now suspect on doctrinal grounds because of a new (or more explicit—depending on your point of view) statutory requirement that dilutive uses be uses of a plaintiff's mark as a "mark or trade name" for the defendant's product or services. Some state laws, however, continue to permit dilution findings absent use as a mark and do not set forth an express non-commercial use defense.¹⁰⁴ The longstanding pattern of disfavoring uses in a sexual context is, therefore, likely to persist.

101. *See, e.g., infra* note 103; *see also* 4 MCCARTHY, *supra* note 49, at § 24:89. *But see* *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806-12 (9th Cir. 2003) (rejecting trademark infringement and dilution claims based on photographic art works that used Barbie dolls in sexual, as well as other, contexts); *Lucasfilm Ltd. v. Media Mkt. Grp., Ltd.*, 182 F. Supp. 2d 897, (N.D. Cal. 2002) (rejecting dilution claim by makers of movie *Star Wars* against animated adult film *Starballz* because the use was a noncommercial one). I note that recent doctrinal changes have also shored up defenses to dilution. *See infra* note 104 and accompanying text. Nevertheless, many of these successful defenses have involved courts deciding that the defendant's use had some artistic value. Such decisions, as I will discuss, leave open the door for courts to impose their views about what sorts of depictions of sex are appropriate. *See* discussion *infra* Parts III.A.6 & III.C.

102. *See* 15 U.S.C. § 1125(c)(3)(A)(ii) (2006); 4 MCCARTHY, *supra* note 49, at § 24:90.

103. *See, e.g.,* *Dall. Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205-07 (2d Cir. 1979) (dismissing the possibility of parody, fair use, or First Amendment defenses in the context of a use of a mark in a pornographic film); *Kraft Foods Holdings, Inc. v. Helm*, 205 F. Supp. 2d 942, 953-54 (N.D. Ill. 2002) (rejecting a parody defense in the context of sexually explicit content); *Archdiocese of St. Louis v. Internet Entm't Grp., Inc.*, 34 F. Supp. 2d 1145 (E.D. Mo. 1999) (rejecting the possibility that a pornographic website set up in association with the Pope's visit to St. Louis could be a parody).

104. *See, e.g.,* CAL. BUS. & PROF. CODE § 14247 (West Ann. 2008) (not explicitly requiring defendant to use another's mark as a trade name or mark); ILL. COMP. STAT. § 1036/65 (West 2011) (same); *see also* 4 MCCARTHY, *supra* note 49, at §§ 24:67-24:122 (discussing state and federal law prior to the 2006 amendment to federal dilution law and then the requirement of use as a trademark under federal law after that amendment).

II. COPYRIGHT'S PURPORTED MOVE TOWARD INDIFFERENCE ABOUT SEX AND MORALITY

While trademark law has continued to explicitly discriminate against marks and uses with sexual content, copyright law has largely moved away from explicit discrimination. Copyright law is a constitutionally authorized mechanism to protect original works of authorship from being copied, distributed, displayed, performed, and more recently from having derivative works made without the permission of the copyright owner.¹⁰⁵ The conventional wisdom today is that copyright law no longer concerns itself with the underlying morality or legality of works when determining their eligibility for copyright.¹⁰⁶ The actual law is somewhat more opaque, however, with many jurisdictions leaving open the possibility that copyright law could continue to exclude works judged immoral or illegal, especially works with sexually explicit material. Even absent such exclusions, several copyright doctrines unintentionally lead to “thin” protection for pornography—similar to that for phonebooks or other factual compilations. Most significantly, fair use analysis leaves ample room for courts to impose sex exceptionalism, negativity, and normativity. In this Part, I will begin with a historical analysis of copyright's treatment of sex and then consider the current state of the law.

A. *Historical Limits on the Copyrightability of “Immoral” Works*

It is useful to consider the historical treatment of works with sexual content because some courts continue to follow these rules, others leave open the possibility of their continued viability, and even if defunct, the analysis in individual cases is telling about how judges use their own moral views about sex to mete out the benefits and burdens of copyright. These cases, though antiquated, demonstrate the biases of the time—some of which persist. I will discuss these cases below. Taken together, they demonstrate discomfort with nudity and female sexuality—a discomfort that continues in fair use analyses and in trademark law today.

At common law, copyright law denied copyright protection to works deemed, *inter alia*, immoral, illegal, fraudulent, or blasphemous.¹⁰⁷ Works with

105. Copyright is governed by federal law pursuant to the Copyright Act of 1976 and subsequent amendments to that act. See 17 U.S.C. §§ 101 *et seq.* (2006).

106. BRUCE KELLER ET AL., COPYRIGHT LAW § 2:7:3 (2010); MELVILLE NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §§ 1.03, 2.17 (2011).

107. See BALL, *supra* note 4, at 67-68, 112-13, 720; BOWKER, *supra* note 4, at 86-87; DRONE, *supra* note 4, at 181-98; HINKSON, *supra* note 4, at 1-2, 8, 71 (citing *Southey v. Sherwood*, 35 Eng. Rep. 1006 (1817)) (“There can be no property in works of an immoral nature, or which are likely to have an injurious influence”); WEIL, *supra* note 4, at 22, 195-96 (“The rule that there can be no copyright in any blasphemous, seditious or immoral or libelous work rests in sound principles of public policy”); PHILLIPS, *supra* note 4, at 138.

sexual content were often deemed immoral.¹⁰⁸ In his classic nineteenth-century treatise, Eaton Drone described three requirements for copyrightability: first, that the work is “innocent” and not “injurious to public peace or morals”; second, the familiar requirement that it is original; and finally, that it contributes to “useful knowledge.”¹⁰⁹ Only the second requirement consistently remains today, but both the first and third requirements were traditionally used to bar copyright protection for works with sexual content. Such works were deemed contrary to public peace and morals, as well as devoid of any useful knowledge. Early statutory copyright regimes also denied copyright to sexually suggestive works on the basis that they were immoral.¹¹⁰

One of the most well-known early cases from England denying copyright protection on the basis of immorality refused to extend copyright protection to a memoir by a courtesan. The denial of copyright was based in part on the alleged sexual content of the work.¹¹¹ The “immorality” of the work stemmed in large part from the fact that the memoir was about a courtesan—the memoir itself is far from sexually explicit and from a contemporary perspective, does not even seem sexually suggestive.¹¹²

A number of American cases also denied copyright protection to works deemed sexual in nature. In 1898, a U.S. District Court denied copyright protection to a song, “Dora Dean,” because the lyrics referred to a woman as the “hottest thing you ever seen.”¹¹³ The narrator of the song expressly wanted to marry Dora Dean, so the disapproval of the song was focused solely on the “obscene and vulgar” connotations of the word “hottest.”¹¹⁴ The court defined “hottest” (using a dictionary) as a term to describe a “lustful, lewd, [and] lecherous” woman.¹¹⁵ The court could have viewed the word as suggesting that she was attractive but instead put a negative spin on the sexy nature of the woman and concluded that this “immoral signification” justified the denial of copyright.¹¹⁶

Findings of immorality were also common when there was nudity or simply the suggestion of it. A play that showed women in various states of undress was deemed likely to “corrupt the morals of people.”¹¹⁷ Accordingly, copyright

108. Phillips, *supra* note 4 *passim*.

109. DRONE, *supra* note 4, at 181-82.

110. *See, e.g.*, Hoffman v. Le Traunik, 209 F. 375, 379 (N.D.N.Y. 1913).

111. Stockdale v. Onwhyn, [1826] 108 Eng. Rep. 65 (K.B.); *see also* DRONE, *supra* note 4, at 185-86. The court also suggested that the memoirs might be libelous (she named names) which formed a separate basis to deny copyright protection at that time. *See Stockdale*, 108 Eng. Rep. at 66-67.

112. *See* HARRIETTE WILSON, MEMOIRS OF HARRIETTE WILSON (1825).

113. Broder v. Zeno Mauvais Music Co., 88 F. 74, 74, 78 (N.D. Cal. 1898).

114. *Id.* at 78-79; BERT WILLIAMS, *Dora Dean* (Broder & Schlam 1895), *available at* <http://www.traditionalmusic.co.uk/songster/50-dora-dean.htm>.

115. *Broder*, 88 F. at 79.

116. *Id.*

117. Martinetti v. Maguire, 16 F. Cas. 920, 922 (C.C. Cal. 1867) (No. 9,173).

protection was denied.¹¹⁸ Another play which included an on-stage costume change by the lead actress (behind a screen) was judged lascivious in nature and thereby outside the protections of the Copyright Act.¹¹⁹ In 1958, the Attorney General wrote an opinion letter acknowledging the continued denial of copyright protection to immoral and obscene works and concluding that the Register of Copyright could also deny registration to such works.¹²⁰ Although much has changed in our tolerance of depictions and descriptions of sex, this historical treatment of sex in copyright continues to inform our current law.

B. *Copyright Law Today—See No Evil?*

The dominant view of today's copyright law is that obscene and pornographic works are capable of receiving copyright protection and equitable theories such as unclean hands do not prevent the enforcement of copyright in such instances. This view has been expressly adopted by both the Fifth and the Ninth Circuit Courts of Appeals.¹²¹ The D.C. Circuit and a number of district courts in other circuits have cited these decisions with approval, but have not made any specific holdings on the matter.¹²² Commentators therefore often claim that copyright today no longer concerns itself with whether works are obscene, pornographic, or otherwise sexually explicit for purposes of protectability and also does not care about such judgments when considering whether a use is fair.¹²³

This conventional wisdom and the reality, however, are somewhat different from one another. Despite the consensus that the morality and sexual content of

118. *Id.* at 923.

119. *Barnes v. Miner*, 122 F. 480, 489-93 (S.D.N.Y. 1903). I note that the court in *Barnes* suggested that the defendant might not have infringed the work even if copyrighted, but the bulk of the opinion analyzes why the plaintiff's work was not deserving of copyright protection.

120. Copyrights—Denial of Registration of Claims Because of Content, 41 Op. Att'y Gen. 395 (1958). Despite suggesting the legitimacy of such denials, the Attorney General noted that the review process and probable appeals of such denials were likely to be so administratively burdensome as to weigh against the adoption of such a review process.

121. See *Jartech, Inc. v. Clancy*, 666 F.2d 403 (9th Cir. 1982); *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979); see also *Dream Games of Ariz., Inc. v. PC Onsite*, 561 F.3d 983, 990-92 (9th Cir. 2009) (stating that the illegal or immoral status of the underlying work is irrelevant for determinations of copyrightability or its enforcement); *Belcher v. Tarbox*, 486 F.2d 1087 (9th Cir. 1973) (rejecting argument that plaintiff's work did not deserve copyright protection because it was fraudulent).

122. See *Schnapper v. Foley*, 667 F.2d 102, 112 (D.C. Cir. 1981) (citing *Mitchell Brothers* with approval for the proposition that the preamble to the Progress Clause does not limit congressional power); *Nova Prods., Inc. v. Kisma Video, Inc.*, 2004 WL 2754685, at *2-3 (S.D.N.Y. Dec. 1, 2004) (agreeing with the analysis from *Mitchell Brothers* that obscene works could receive copyright protection).

123. See, e.g., *Pillsbury Co. v. Milky Way Prods., Inc.*, 1981 WL 1402, *9, *11 n.10 (N.D. Ga. Dec. 24, 1981); see also *supra* note 106. But see Rebecca Tushnet, *My Fair Ladies: Sex, Gender, and Fair Use in Copyright*, 15 AM. U. J. GENDER SOC. POL'Y & L. 273 (2007) (contending that courts now favor sexual content in fair use determinations).

a work no longer matters, remnants of the earlier exclusions and aesthetics seep through in fair use and other copyright considerations. Additionally, some judges continue to suggest that there may be an exception to copyright for obscene works.¹²⁴ The issue remains an open one in all circuits except the Fifth and Ninth, and the Supreme Court has not addressed the question. Even when courts accept the copyrightability of sexually explicit works, they have sometimes disfavored works with sexual content when determining the scope of copyright protection and also when evaluating claims of fair use by defendants. It is to these pockets of sex negativity, normativity, and exceptionalism that I now turn.

C. *Lingering Sex Exceptionalism and Sex Normativity in Copyright*

The stability of the existing law is unclear since most federal circuit courts have not made holdings on the question of whether pornographic (or other “immoral”) works merit copyright protection and a number of courts have expressly suggested that such an exception to copyright may persist. Moreover, legislators and scholars have made repeated calls over the years to use copyright law to discourage pornography and obscenity. A number of copyright doctrines, such as originality and fair use, also can disfavor works with sexually explicit content. I will look in more detail at each of these pockets of lingering differential treatment of sex or at least of disfavored forms of sex.

1. Continued limits on protectability

Although two federal circuits have concluded that there is no longer a bar to copyright protection for obscene, pornographic or immoral works, some courts continue to suggest that immoral and obscene works sit outside copyright’s purview,¹²⁵ and most federal circuits have not considered the question. This leaves open the door to restrict copyright for works with sexual content. Such an event is not too far-fetched given both recent and longstanding advocacy urging the elimination of copyright protection for pornographic works,¹²⁶

124. *See, e.g., Devil Films, Inc. v. Nectar Video*, 29 F. Supp. 2d 174, 175-77 (S.D.N.Y. 1998) (questioning availability of copyright protection for obscene works and denying order of seizure and preliminary injunction to adult film company on the basis that courts should not exercise their equitable powers and resources to assist those who produce obscene works); *see also Liberty Media Holdings, LLC v. Swam Sharing Hash File*, No. 11-10802-WGY, at 4, n.2 (D. Mass. Oct. 31, 2011) (noting that whether pornography is protected by copyright law is an open question in the First Circuit); *United States v. Stagliano*, 693 F. Supp. 2d 25, 33 n.11 (D.D.C. 2010) (suggesting post-*Lawrence v. Texas*, 539 U.S. 558 (2003), that copyright law could exclude obscene works from its purview).

125. *See, e.g., supra* note 124.

126. *See, e.g., Ann Bartow, Pornography, Coercion, and Copyright Law 2.0*, 10 VAND. J. ENT. & TECH. L. 799, 831-34 (2008) [hereinafter Bartow, *Coercion and Copyright*]; Phillips, *supra* note 4 *passim* (describing the longstanding prohibition on copyrighting obscene

and an increasing interest in looking back to the common law for contemporary guidance.¹²⁷

Even absent an explicit exclusion for immoral, obscene, or pornographic works, existing doctrines limit the copyrightability of sexually explicit works and provide a narrow scope of copyright protection to such works. These doctrines do not single out sexual content, but in combination lead to thin copyright protection for works that are primarily composed of sexual activities. Originality, for example, is a requirement for copyrightability; however, it is challenging to establish the originality of sex acts and courts can be dismissive of the inventiveness of particular depictions of sex.

Other copyright doctrines such as the merger doctrine and *scènes à faire* further limit the scope of protection afforded to sexually explicit works.¹²⁸ The merger doctrine precludes copyright protection when there is only one (or a very few ways) to express a particular idea—in such instances the expression merges with the relevant idea; because ideas are not copyrightable, neither is the merged expression.¹²⁹ One well-known case involving merger held that the idea of a jewel-encrusted bee pin could only be expressed in one way and therefore the defendant's "copy" did not use any protectable elements.¹³⁰ In the context of pornography, the expression of fellatio or a "cum shot" might similarly be considered to merge with those "ideas," such that no one could enforce copyright over a particular sexual act.

Scènes à faire are common elements that necessarily flow from the choice of a particular setting or genre. If plot devices or types of characters, for instance, are considered stock, generic features in a genre, then they will be non-protectable *scènes à faire*. For example, in a work about a superhero, scenes that depict the superhero performing "feats of miraculous strength," wearing a

and/or immoral works); Kurt L. Schmalz, Note, *Problems in Giving Obscenity Copyright Protection: Did Jartech and Mitchell Brothers Go Too Far?*, 36 VAND. L. REV. 403 (1983); Ann Bartow, Copyright Law and the Commoditization of Sex (May 11, 2011) (unpublished manuscript) (on file with author), available at <http://ssrn.com/abstract=1825946> [hereinafter Bartow, *Copyright Law and Commoditization*].

127. Recent calls from scholars to incorporate more of the common law of copyright might unwittingly lead us down a path toward such prohibitions. See, e.g., INTELLECTUAL PROPERTY AND THE COMMON LAW (Shyamkrishna Balganeshe ed., forthcoming 2012); Shyamkrishna Balganeshe, *The Pragmatic Incrementalism of Common Law Intellectual Property*, 63 VAND. L. REV. 1543 (2010).

128. I note that there is a split of opinion over whether these doctrines are more properly defenses to infringement or if instead they limit the scope of copyright protection in the first instance. See *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1082 (9th Cir. 2000) (holding that these doctrines are defenses to infringement); NIMMER & NIMMER, *supra* note 106, § 13.05 (noting the conflicting views and advocating for the doctrines being defenses). For my purposes, the difference is not important because in practice even when asserted as a defense these doctrines ultimately limit the scope of the copyright that can be enforced.

129. *Dunlap v. G & L Holding Grp.*, 381 F.3d 1285, 1295 (11th Cir. 2004); see also 17 U.S.C. § 102(b) (2006).

130. *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971).

“tight-fitting acrobatic costume[,]” “fight[ing] wealthy megalomaniacal villains,” or propelling himself into flight are all unprotectable *scènes à faire*.¹³¹ In the context of pornography, a possible example of a *scène à faire* is the common trope of a delivery person arriving with a pizza box and staying on for a sexual encounter.

Putting together the requirement of originality, and the doctrines of *scènes à faire* and merger, we rarely see courts finding copyright infringement in the context of pornographic works outside of exact copying. Such limits may well be appropriate but unquestionably mean that works that are primarily composed of sexually explicit content are likely to have very narrow copyright protection. Thus, calls to deny such works protection seem both unnecessary and primarily focused on conveying an anti-sex message.

2. Fair use and the hidden doctrine of copyright dilution

Sex exceptionalism most often percolates up in today’s copyright law when courts analyze the fair use defense to copyright infringement.¹³² The fair use provision of the Copyright Act specifically provides an exception to copyright infringement when works are used for certain “purposes such as criticism, comment, news reporting, teaching . . . scholarship, or research.”¹³³ These enumerated examples in the preamble to the fair use section are not exhaustive but provide preferred zones of uses. When evaluating pornographic works, courts often dismiss the possibility that pornography could fall into any of these categories. Works that incorporate others’ copyrighted works into something with sexual content therefore have often been held unfair.

Until recently, courts have dismissed the possibility that sexually explicit works could have any communicative impact other than a sexual one and have dismissed the possibility that sexual content itself can carry important social commentary.¹³⁴ Yet, even pornography that ostensibly is targeted only at sexual arousal (a value that itself should merit greater credit) can carry meaningful messages. For example, gay porn has been described by some in the community as liberating, affirming, educational, and in service to the disruption of dominant narratives of sexuality that presume heterosexuality.¹³⁵

131. Warner Bros. v. Am. Broad. Cos., 654 F.2d 204, 209-10 (2d Cir. 1981).

132. According to the terms of the Copyright Act, a fair use does not constitute an infringement of a copyright. See 17 U.S.C. § 107 (2006). Courts and litigants, however, often treat fair use as a defense to infringement. For the sake of simplicity, I will sometimes also refer to it as a defense.

133. *Id.*

134. See, e.g., Dall. Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 205-06 (2d Cir. 1979).

135. See, e.g., Michael Lucas, *On Gay Porn*, 18 YALE J.L. & FEMINISM 299 *passim* (2006).

Not only have courts dismissed the potential of sex to provide important commentary, but as part of assessing fair use, courts also have made overall assessments of the worthiness of a particular use. The Ninth Circuit, for example, has treated the fair use analysis as one that interrogates the “propriety” of the use.¹³⁶ Such an evaluation could lead to a conclusion that uses judged immoral or obscene would not qualify for fair use because they would be deemed improper.¹³⁷ Even if such uses are acceptable, the law often places no value (or a negative value) on sex. Therefore, when the worth of the use is balanced against the interests of copyright holders, sex (and the defendants) often lose.

Even when courts faithfully apply the fair use factors set forth in the statute, rather than make broader judgments about the worthiness of a given use, the factors themselves provide great judicial latitude to determine what qualifies as fair. The four non-exclusive fair use factors are: (1) the purpose and character of the use (including whether it is a commercial or nonprofit use); (2) the nature of the original copyrighted work; (3) the amount and substantiality of the portion used; and (4) the effect of the use upon the potential market for or value of the copyrighted work.¹³⁸ The first and fourth factors are usually the most influential, and in the context of sexual content often weigh heavily against fair use.

The first factor—the purpose and character of the use—provides great latitude for courts to disapprove of the type of use made of the work. As discussed, when pornographic works are at issue, courts often discount the worthiness of the use. In addition, the first factor calls for an evaluation of whether a use is commercial. Commerciality is not determinative of fair use but it does weigh against it. Pornographic works and other sexually explicit works are often sold for profit. They accordingly are almost uniformly considered commercial in nature.

Courts also consider in the first factor whether a use is a “transformative” one.¹³⁹ In a broad sense, transformative uses are those that recast, alter, or comment on the original. What qualifies as transformative in practice is more confounding.¹⁴⁰ There is universal agreement that parodies are transformative, but less agreement about what else counts.¹⁴¹ Because courts have sometimes

136. *Fisher v. Dees*, 794 F.2d 432, 436-37 (9th Cir. 1986) (using “propriety” as a separate factor in fair use analysis).

137. *Id.* (assuming without deciding that immoral and obscene uses might be improper and ineligible for fair use, but concluding that the parody at issue was neither).

138. 17 U.S.C. § 107 (2006).

139. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578-79 (1994).

140. Additionally, the focus on transformativeness causes many courts to discount the significant values of non-transformative uses. For critiques of this approach, see Rothman, *supra* note 66, at 490-93, and Rebecca Tushnet, *Copy This Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 *YALE L.J.* 535, 537, 566-87 (2004).

141. I note that despite the etymological and historical meaning of parody, courts have extended fair use only to parodies that comment on the original work; they routinely deny fair use to works that use the style of an existing work to make a broader social commentary.

dismissed the ability of sexually explicit content to comment on the original work or constitute a parody, such uses have until recently been less likely to be considered transformative.¹⁴² Some pornographic works, however, may be particularly transformative and important both personally and culturally. In the context of “transgressive” pornography—such as gay porn—this is particularly true because the works comment on and disrupt the standard narratives about sex.

The fourth fair use factor—the effect of the use on the copyrighted work’s market or the copyrighted work’s value—has also been wielded against defendants who have used others’ works in a sexual context. Harm to the plaintiff’s markets weighs heavily against a finding of fair use. Because some courts have concluded that the association of a copyrighted work with a sexually explicit or pornographic use will lead consumers to think less favorably of the original work, such uses sometimes have been treated as having a negative market effect on the underlying work (and its derivatives).¹⁴³ This analysis is akin to trademark dilution, which protects the strength of marks from being whittled down either by blurring (the creation of multiple associations in the minds of consumers) or by tarnishment (the creation of negative associations with the mark).¹⁴⁴

Copyright law does not have an explicit doctrine of dilution, but we see something similar to dilution permeating fair use analysis, particularly in cases involving sex. A couple of scholars have recently noticed (and criticized) several forms of such “copyright dilution.”¹⁴⁵ Copyright dilution views uses that potentially “tarnish” the image of the original less favorably. As in the context of trademark dilution, uses in the context of sex are often treated as presumptively tarnishing.¹⁴⁶

A few specific examples demonstrate how these fair use factors have been interpreted against defendants who use works in sexual contexts. In *MCA, Inc. v. Wilson*, the Second Circuit rejected a fair use defense for a song titled the

142. See *supra* notes 64-68 and *infra* notes 147-170 and accompanying text. But see Tushnet, *supra* note 123, at 275-91 (suggesting that after *Campbell*, 510 U.S. 569, courts have swung the other direction and now often conclude that all sexual uses are transformative with little further analysis). See discussion *infra* notes 164-170 and accompanying text.

143. See, e.g., *Dall. Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205-07 (2d Cir. 1979). I note that there is a dispute about whether the market impact on derivative works is an appropriate consideration in the market effects analysis.

144. See discussion *supra* Part I.C.

145. See, e.g., Barton Beebe, *Intellectual Property Law and the Sumptuary Code*, 123 HARV. L. REV. 809, 859-62 (2010) (discussing aspects of “antidilution law” in copyright that serve to protect the rarity and uniqueness of works); Christina Bohannon, *Copyright Harm, Foreseeability, and Fair Use*, 85 WASH. U. L. REV. 969, 1023-27 (2007) (criticizing “copyright dilution” and courts’ unreasonable consideration of reputational harm in context of fair use analysis).

146. See *supra* Part I.C.

“Cunnilingus Champion of Company C.”¹⁴⁷ The song was viewed by the court as a “take-off” of the copyrighted song “Boogie Woogie Bugle Boy.”¹⁴⁸ When considering the purpose and character of the use and the market effect, the court focused on the value that society would gain from the use versus the harm to the copyright holder of the use.¹⁴⁹ In such analyses, sexually explicit or suggestive uses fare poorly. Despite the majority’s purported consideration of each of the fair use factors, the court’s distaste for the song undoubtedly colored its analysis. The court pointedly suggested that the “dirty lyrics” were used for commercial gain and dismissed the value of the “end result[.]”¹⁵⁰ But as Judge Mansfield appropriately noted in his dissent, “We cannot, under the guise of deciding a copyright issue, act as a board of censors outlawing X-rated performances. Obscenity or pornography [should] play no part in this case.”¹⁵¹

In addition, although the court in *Wilson* concluded that the work was not a parody, reasonable minds could disagree about this conclusion. Mansfield’s dissent contended that the use was a “fair and limited use in a reasonable manner . . . to produce what amounts to a sexual satire or burlesque of contemporary mores by putting a comic or humorous twist on the more conventional Bugle Boy and by parodying the Andrews Sisters’ style.”¹⁵² Mansfield noted that only “one short phrase” from the plaintiff’s lyrics was used in the defendant’s work and that only the boogie-woogie style, rather than the actual musical composition had been used.¹⁵³ He also questioned the majority’s unsubstantiated conclusion that the defendant’s use would harm the market for the original.¹⁵⁴

The Ninth Circuit in *Walt Disney Productions v. Air Pirates* also rejected a fair use defense when the defendants used sacred American icons, the Disney cartoon characters, in scenes involving drugs and sex.¹⁵⁵ The defendants claimed that they were parodying the wholesomeness of the Disney characters.¹⁵⁶ Contrary to other parody analyses, the court dismissed the need to use the characters in order to parody them, claiming that too much of the likenesses of the cartoon characters had been taken for the parody.¹⁵⁷ It has struck many commentators, including me, that this case is wrong as a matter of fair use and

147. 677 F.2d 180, 182-86 (2d Cir. 1981).

148. *Id.* at 184.

149. *Id.* at 182-86.

150. *Id.* at 185.

151. *Id.* at 191 (Mansfield, J., dissenting).

152. *Id.* at 188 (Mansfield, J., dissenting).

153. *Id.* at 190 (Mansfield, J., dissenting).

154. *Id.* at 188-91 (Mansfield, J., dissenting).

155. 581 F.2d 751 (9th Cir. 1978).

156. *Id.* at 756-59.

157. *Id.*

free speech law.¹⁵⁸ The *Air Pirates* case is therefore often viewed as an outlier, a fair use misstep. But I contend that it is not—it is part of a group of cases that involve defendants’ uses of copyrighted works in sexual contexts. They may all be wrongly decided, but they form a historical pattern of disfavoring fair use in the context of sex, even after the purported move away from doing so.

In *Walt Disney Productions v. Mature Pictures Corp.*, a district court in New York again protected Disney characters from the dreaded sexual innuendo.¹⁵⁹ The court rejected a fair use claim for the use of music from the *Mickey Mouse Club* television show in a movie titled *The Life and Times of the Happy Hooker*.¹⁶⁰ The music played in the background of a sex scene containing three male actors and one woman. The men were wearing Mouseketeer hats and apparently celebrating either one or all of their birthdays. The defendant filmmakers claimed that they used the music to “highlight and emphasize the transition of such teenagers from childhood to manhood . . . in a highly comical setting.”¹⁶¹ The music and the hats signaled their childhood in contrast to the sex act that took place. The court discounted any possible parody as the entire original work was used, even though courts have suggested in nonsexual contexts that broad latitude must be given for parodists to conjure up and comment on the original.¹⁶² Moreover, the court’s real issue was revealed in its expressed concern that the use would “immediately compromise” Disney’s original work because of the association with the pornographic film.¹⁶³ The concern was not whether there was a colorable parody, but instead whether the use would tarnish Disney’s image.

Since the mid-1990s and the Supreme Court’s fair use decision in *Campbell v. Acuff-Rose Music, Inc.* that emphasized the role of transformativeness in fair use analysis,¹⁶⁴ courts have increasingly moved away from disfavoring sexual content in fair use determinations. Although it is difficult to make overall assessments of the state of the current law because there have been few published cases over the past fifteen years that have addressed sexual content (par-

158. See, e.g., NEIL NETANEL, COPYRIGHT’S PARADOX 19, 29, 33, 42-43 (2008); Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533, 1602-03 (1993).

159. 389 F. Supp. 1397 (S.D.N.Y. 1975).

160. *The Life and Times of the Happy Hooker* (Mature Pictures 1974) was an “adult” film starring the legendary porn star John Holmes, immortalized in *Boogie Nights* (New Line Cinema 1997).

161. *Mature Pictures*, 389 F. Supp. at 1398.

162. See, e.g., *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579-89 (1994) (suggesting that 2 Live Crew could take a substantial amount of music and lyrics from Roy Orbison’s *Pretty Woman*, including the heart of the song, for use in its parody); cf. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 449-50 (1984) (concluding that reproduction of an entire work does not weigh against fair use in the context of home taping).

163. *Mature Pictures*, 389 F. Supp. at 1398.

164. 510 U.S. at 583 (holding that 2 Live Crew’s rap song was a parody of Roy Orbison’s *Oh, Pretty Woman*).

ticularly that of an explicit nature) there does appear to be increasing tolerance of sex in the context of copyright's fair use analysis. In particular, courts have begun to recognize that some sexual content can be transformative.¹⁶⁵ Courts have also shifted to a view that the markets for sexually suggestive or explicit uses and those for the original works are distinct, as well as to a view that possible market harm caused by negative associations should not be cognizable.¹⁶⁶

Despite what appears to be a less exceptionalist treatment of sex in recent years, Rebecca Tushnet has suggested that these cases taken together suggest another form of sex exceptionalism. She concludes that some courts now treat references to sex as presumptively transformative without engaging in more detailed analysis.¹⁶⁷ Professor Tushnet hypothesizes that this different though more favorable treatment may result from some judges' discomfort with sex.¹⁶⁸ Courts may therefore avoid engaging with sexual content; rather than rejecting such uses outright as they used to do, some courts now are accepting them outright. To the extent that courts continue to treat sex differently—even if better than other categories—an exceptionalist system remains. The legal discourse therefore continues to demonstrate discomfort with sex in ways that either unreasonably elevate or degrade sex.

These recent cases do not demonstrate a complete retreat from the sex negativity and normativity of the past—not only for the reasons that Professor Tushnet identifies, but also because these more “sex-positive” cases have been limited in nature. They have primarily involved unrealistic depictions of sex (*e.g.*, animated pornography), or been situated in contexts that courts consider “artistic” (*e.g.*, photographs by an artist whose works were shown in major art galleries), or both.¹⁶⁹ In addition, these more favorable fair use decisions primarily have been decided in the Ninth Circuit, which has often been more accepting of sexual content than many other circuits.

It is possible that these more “sex-positive” cases do demonstrate a movement toward greater acceptance of sexual content in fair use analysis. In fact, several cases decided in the last couple of years suggest that at least some judges have become comfortable analyzing sexual content and now treat sex with

165. *See, e.g.*, *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 801-03 (9th Cir. 2003) (artist's use of Barbie doll in “sexualized” contexts was transformative); *Burnett v. Twentieth Century Fox Film Grp.*, 491 F. Supp. 2d 962, 967-69 (C.D. Cal. 2007) (holding that the use of the Charwoman character, associated with Carol Burnett, in a scene in a porn shop in the animated television series *Family Guy* was a transformative parody); *Lucasfilm Ltd. v. Media Mkt. Grp., Ltd.*, 182 F. Supp. 2d 897, 901 (N.D. Cal. 2002) (holding that sexually-explicit animated parody of *Star Wars* titled *Starballz* likely was protected by fair use); *see also* Tushnet, *supra* note 123, at 275-91.

166. *See, e.g.*, *Walking Mountain Prods.*, 353 F.3d at 804-06; *Burnett*, 491 F. Supp. 2d at 971-72.

167. *See* Tushnet, *supra* note 123, at 271-91.

168. *Id.* at 274.

169. *See supra* note 165.

greater neutrality—avoiding knee-jerk acceptance or rejection.¹⁷⁰ Nevertheless, sex exceptionalism and normativity are likely to continue to arise in fair use analyses today and in the near future even if less frequently than they have in the past.

In sum, despite copyright's purported blind-eye toward sex, sexual content continues to influence the scope of copyright; the malleability of fair use in particular leaves open the door for individual courts to interpret fair use against defendants who produce sexual content.

III. RETHINKING INTELLECTUAL PROPERTY'S TREATMENT OF SEX

As demonstrated in Parts I and II, IP law contributes to a problematic legal construction of sex. Sex exceptionalism, negativity and normativity lead courts and lawmakers to treat sex (or certain types of sex) differently than other activities. In the context of IP, even though patent, copyright, and trademark laws have all moved away from the days of denying wholesale protection for objects like sex toys and works and marks that address sexual matter, underlying anti-sex or sex-normative judgments continue to percolate up, particularly in copyright and trademark laws. Trademark law disfavors marks of a sexual or sexually suggestive nature, and both trademark and copyright law have disfavored defendants who use marks or copyrighted works in a sexual context.

In this Part, I will present a number of reasons why we should reject calls to return to the more explicit discrimination against works with sexual content and reasons why even the more subtle forms of discrimination that persist today should be recognized, rather than overlooked, and rooted out of the system. I will begin by discussing reasons within the IP framework to discourage such sex exceptionalism, negativity, and normativity. I will then turn to situating this discussion in the larger context of the law's role in constructing sex. In particular, I will focus on how IP laws devalue sex and serve to channel sex into particular limited, state-sanctioned forms.

A. *IP-Specific Justifications for Sex Neutrality*

A number of considerations internal to IP law suggest the impropriety of treating sex differently from other categories of works or marks, or distinguishing between different types of sex. Some reasons not to consider sexual content in evaluating IP matters stem from statutory interpretation. For example, early copyright statutes protected only limited subject matter. Some courts relied on

170. See, e.g., *LaChapelle v. Fenty*, 2011 WL 2947007, at *5-*7, Exhibits A-D (July 20, 2011) (rejecting fair use defense at motion to dismiss stage in context of sexually-charged *S & M* video by pop star Rihanna). The court here, in contrast to some that Professor Tushnet identifies, engages in a detailed analysis of the sexual content of the relevant music video in its substantial similarity analysis.

language in the then-governing copyright acts to exclude works with sexual content because the works were judged as mere “spectacle” or solely of a prurient nature, rather than as “dramatic composition[s]” that merited copyright protection.¹⁷¹ Subsequent copyright acts broadened the copyright privilege to “all writings.”¹⁷² As a result, some courts have concluded that there is no longer an exclusion for immoral, obscene, or illegal works.¹⁷³

In this Subpart, I will focus not on these minutiae, but rather on broader principles of trademark and copyright law that suggest that maintaining and/or increasing sex exceptionalism and normativity runs contrary to many foundational principles of these bodies of law. I will consider how the preference for nationwide uniformity and uniformity over time weigh in favor of leaving questions of morality, particularly in the sexual context, out of IP adjudications. Consideration of other goals undergirding both trademark and copyright law also disfavor making distinctions on the basis of sexual content. Such bans or limits on sexual content also are likely to be ineffective. Finally, sex normativity requires aesthetic judgments that have largely been disfavored in IP law, especially in copyright. I will address each of these considerations in turn.

1. *Uniformity and federal preemption and primacy*

Federal IP law, especially copyright, strives to provide uniform laws across the country that further innovation, knowledge, and business development and growth. Since 1976 copyright laws have been entirely federal in nature and state laws in the area have been preempted. Trademark law, in contrast, permits continued state legislation in the area; nevertheless, the federal registration system fosters and supports federal uniformity and federal trademark law dominates legal disputes that revolve around marks.

To the extent that protectability or registrability turns on whether works or marks are deemed obscene (thus losing First Amendment protection), such determinations are based on the standards of the relevant locale. The *Miller* test for determining whether a work is obscene specifically depends on local “community standards” to determine whether a work “appeals to the prurient interest.”¹⁷⁴ If courts rely on such evaluations when determining

171. *Barnes v. Miner*, 122 F. 480, 491-93 (C.C.D.N.Y. 1903); *Martinetti v. Maguire*, 16 F. Cas. 920, 922 (C.C.D. Cal. 1867) (No. 9,173).

172. *See Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 854 (5th Cir. 1979).

173. *See, e.g., id.* at 854-65.

174. *Miller v. California*, 413 U.S. 15, 24 (1973). The *Miller* test provides three factors for courts to consider: (1) “whether the average person, applying contemporary community standards would find that the work, taken as a whole, appeals to the prurient interest”; (2) “whether the work depicts or describes, in a patently offensive way, sexual conduct specifically defined by the applicable state law”; and (3) “whether the work, taken as a whole, lacks serious literary, artistic, political, or scientific value.” *Id.*

copyrightability, trademarkability, or to determine infringement, dilution, or defenses to those claims, then we could see contradictory decisions depending on the jurisdiction. For example, a work held not obscene in New York City and accordingly protected by federal copyright law in that state could be freely copied in Oklahoma City where it might be judged obscene. This would defeat copyright protection on the basis of the mores of the most conservative communities. Even if obscenity were not the benchmark, what is deemed pornographic or immoral on the basis of sexual content will likely differ from region to region leading to disparate decisions and protections. Such a result would defeat the goals of national uniformity and, as I will discuss, undercut many of the goals behind copyright and trademark law, such as promoting progress and protecting consumers.

2. *Changing social mores*

Not only do social mores, whether related to sex or not, change from region to region, but they change over time. Given the lengthy copyright term, this means that a work once judged scandalous because a woman changed costumes behind a screen on stage could soon become quaint, but by that time the work would have been cast out into the public domain and the author or copyright holder would have lost the protections that copyright provides. There is a long list of great works that were once banned as obscene only later to be celebrated as literary classics or great works of art.¹⁷⁵ In the trademark context, a determination that a mark is scandalous or immoral (and therefore unregistrable) may allow others to use the same mark. Such an occurrence could cause the loss of nationwide priority and make it more difficult, if not impossible, to enforce rights against some junior users even if the senior mark later becomes socially acceptable.¹⁷⁶ To the extent that we subsequently find the marks unproblematic we will be unable to undo the damage to a business's goodwill caused by its inability to register its mark and to establish nationwide priority.

Recalling some of the banned works of the past, the change in what is acceptable is dramatic. The song "Dora Dean," once denied copyright protection for using the word "hottest" to describe a woman, now seems tame and innocent when compared to some of today's hit songs, such as Enrique Iglesias's "Tonight (I'm Fuckin' You)" and Cee Lo Green's "Fuck You."¹⁷⁷ And calling women "hot" is almost *de rigueur* in contemporary pop music. The Pussycat

175. See *Mitchell Bros. Film Grp.*, 604 F.2d at 857 (providing such a list).

176. As discussed, the denial of registration does not prevent a mark from being protectable under federal or state law. It will, however, make it more likely that others can use the same marks in limited geographic areas.

177. BERT WILLIAMS, *Dora Dean* (Broder & Schlam 1895); ENRIQUE IGLESIAS, *Tonight (I'm Fuckin' You)*, on EUPHORIA (Universal Republic 2010); CEE LO GREEN, *Fuck You*, on THE LADY KILLER (Elektra 2010).

Dolls' grammatically troubling, but hardly scandalous song, "Don't Cha," trumpets the sex appeal of the singer by taunting her audience: "Don't cha wish your girlfriend was *hot* like me!"¹⁷⁸ Rihanna's 2006 hit, "Break It Off," makes things more explicitly sexual with her call to "make me *hot* all over my body."¹⁷⁹ No court would deny copyright protection to these songs today, even if the exclusion for "immoral or obscene" works were resurrected. Yet, once cast into the public domain works cannot regain their copyright.¹⁸⁰ The authors and copyright holders of these works will therefore lose all rights to profit from them, to control how they are used, and to authorize derivative works based upon them.

3. *Fiction of state endorsement*

One of the most frequently posited justifications for limiting copyright and trademark protection for sexually explicit works or marks is that the government should not give any state support or sanction to them. This argument is unconvincing. The state no more approves of individual porn films than it does issues of the comic book *Spawn* or issues of the magazine *Martha Stewart Living*. When I read something particularly offensive or simply drecky, I do not think "how could the copyright office have registered this?" I might question the judgment of the publisher or whomever had recommended the book to me, but not the government. In the context of trademark registrations, there is greater review by the USPTO of marks before they are registered than there is by the Copyright Office of works; nevertheless, consumers still are not likely to think that the registration of a mark indicates government approval of that mark or of the underlying product or service.

The much stronger signaling takes place when courts evaluate whether a work has too much sexual content or an inappropriate kind of sex and therefore does not merit copyright protection. Similarly, the rejection of a trademark registration on the basis of immorality or scandalousness takes place after an extended review and scrutiny of the mark. This sends a clear message of the government's views about sex and particular types of sex or ways of talking about or depicting sex. Evaluating the legitimacy of various uses of others' works or marks in a sexual context allows the government (via the courts) to set forth its vision of appropriate sex and the appropriate place(s) for sex. By prohibiting pornographic works and marks, the state's endorsement and disapproval of

178. PUSSYCAT DOLLS, *Don't Cha*, on PCD (A & M 2005) (emphasis added).

179. RIHANNA, *Break It Off*, on A GIRL LIKE ME (Def Jam 2006) (emphasis added).

180. I note that restoration from the public domain may not be impossible. For example, some copyrights have been restored to conform with international treaties. The constitutionality of these restorations was recently upheld by the Supreme Court. *See Golan v. Holder*, 132 S. Ct. 873 (2012). Despite the decision in *Golan*, works are not resurrected from the public domain absent a specific statute. Moreover, restoration should be disfavored because parties rely on a work's public domain status when creating new works.

content is buoyed rather than disrupted. Supporters of prohibitions on copyright and trademark protection for sexual content might approve of such indications of government disapproval; however, as I have discussed and will further develop, significant harms flow from such state-sanctioned channeling of sex.

4. *Promotion of progress, incentives and disincentives*

Another of the primary justifications for excluding immoral or obscene works from copyright protection is the conclusion that such works do not promote progress and therefore either are not appropriate beneficiaries of the copyright privilege or, at the extreme, are constitutionally barred from copyright protection pursuant to the terms of the Progress Clause.¹⁸¹ This interpretation of the Progress Clause is problematic. First, the language in the clause is an explanation of purpose—to promote progress—not a mandate.¹⁸² Second, this underlying goal of copyright and patent law applies to the body of law, not to individual works.¹⁸³ Courts are not supposed to judge the merits of individual works to decide whether a particular work promotes progress. Not only would such a task be a fool's errand, but it would leave decidedly too much discretion to courts to act as taste-makers, and to some degree censors, in every context. Also, such an approach could have a significant chilling effect on authors, forcing them to stay in safe zones to demonstrate that their works are furthering progress. Such an effect would ultimately undercut the fundamental goal of promoting progress.

Moreover, and of particular relevance to this discussion, why should sexual content not be viewed as promoting progress? As I will discuss in Subpart B, providing greater space for discussions and depictions of various forms of sex ultimately does promote progress in significant ways. Sexually explicit works may not be at the top of everyone's list of works that increase our stockpile of knowledge, but discussions and depictions of sex are decidedly important.¹⁸⁴

181. *See Barnes v. Miner*, 122 F. 480, 489-93 (C.C.S.D.N.Y. 1903); *Martinetti v. Maguire*, 16 F. Cas. 920, 922-23 (C.C.D. Cal. 1867) (No. 9,173); *cf. LAW, supra* note 4, at 123 (explaining that “immoral,” “mischievous,” “frivolous,” and “injurious” inventions are not useful and therefore not patentable). I use the term Progress Clause rather than copyright clause or IP clause because the word “progress” actually appears in the clause. *See U.S. CONST. art. I, § 8, cl. 8* (“To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”).

182. *See Eldred v. Ashcroft*, 537 U.S. 186, 209-17 (2003) (rejecting “Copyright Clause” argument that the Copyright Term Extension Act is unconstitutional because it fails to promote progress).

183. Although the incentive rationale for copyright law is front and center in the Constitution, it is important to note that there are many other rationales for copyright protection, including labor-reward and personality-based theories. *See Jennifer E. Rothman, The Questionable Use of Custom in Intellectual Property*, 93 VA. L. REV. 1899, 1948, 1948 n.179 (2007).

184. *See* discussion *infra* Parts III.B., III.C.

Watching people have sex or reading about sex promotes progress significantly more than, for example, a manual on how to kill someone or build a bomb, both of which are afforded copyright protection.

Another frequently posited and related justification for the denial of copyright and trademark protection in the context of sex is to discourage the production of works and marks with sexual content. As I will discuss, the goal of discouraging works and marks that relate to sex perpetuates and creates sex negativity. It also furthers the questionable goal of channeling sex into certain forms deemed preferable by the state. But even putting such normative objections to the side, there is no reason to think that limits on copyright and trademark protection actually will discourage production; in some instances the lack of IP protection may in fact increase the dissemination of the purportedly offending materials.

As an initial matter, receiving copyright protection does not greatly incentivize the production of pornography. As discussed, pornographic works currently receive fairly thin copyright protection; yet, pornography has long been a productive and profitable business. Pornography flourished even when it was expressly denied copyright protection; even today in the context of the Internet, where copyright enforcement is rare, pornography proliferates.¹⁸⁵ The types of pornographic works being made might change without copyright protection—potentially for the worse—but that’s a different issue.¹⁸⁶ Additionally, some have questioned whether copyright provides much of an incentivizing effect in any context.¹⁸⁷ Accordingly, for those concerned that providing copyright protection might incentivize the “wrong type” of works, the incentivizing effect is likely to be quite small.

On the other hand, denying copyright protection and trademark protection to works and marks deemed pornographic or immoral may actually increase their dissemination. Such denials not only provide free advertising and promotion, which will generate increased consumer interest, but such denials also make the works and marks more freely available to copy and disseminate.¹⁸⁸

185. Bartow, *Coercion & Copyright*, *supra* note 126, at 136; Christopher Cotropia & James Gibson, *The Upside of Intellectual Property’s Downside*, 57 UCLA L. REV. 921, 961-66 (2010).

186. Cf. Kal Raustiala & Christopher Sprigman, *Copyrighting Porn: A Guest Post*, FREAKONOMICS (May 5, 2010, 12:00 PM), <http://freakonomics.blogs.nytimes.com/2010/05/05/copyrighting-porn-a-guest-post> (describing how the proliferation of pornography online and the difficulties of enforcing copyright online will likely alter the type of pornography that gets made).

187. See, e.g., Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 HARV. L. REV. 281 (1970); Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687 (2006).

188. Cf. *Belcher v. Tarbox*, 486 F.2d 1087, 1088 n.3 (9th Cir. 1973) (noting in the context of an allegedly fraudulent work, the illogic of the argument that when we do not want to promote a certain type of work, we will permit it to be freely copied).

Less copyright protection for sexual content may actually increase exposure to such works because they are free to be copied. Similarly, in the context of trademarks, we see the same likely effect of limiting the protection of marks with sexual content. The lack of registrability or even protectability (if the law were so changed) would make it easier for more businesses (rather than fewer) to adopt the “offending” mark because more competing businesses would be free to use the mark, particularly in geographically remote areas.

At the same time, denial of registration does not prevent the use of marks. Trademark laws (both federal and state) still enforce the rights of unregistered marks. If an explicit or suggestive term like “The Bearded Clam” is attractive to seafood restaurants, they may continue to adopt it without regard to registration. To the extent that a mark indicates source in a given area, the mark holder will still be able to enforce trademark rights via federal unfair competition law and state law.

Moreover, denial of trademark registration will likely not affect the public interest in particular marks or the underlying businesses. In fact, salacious marks often generate more interest and the publicity emanating from denials of registration may only build such interest. People want to drink a beer with a logo showing a frog flipping people off or go to a restaurant with a name that refers to women’s breasts. Such activities may be even more sought after if the government tells people that the names or logos of such businesses are scandalous.

Furthermore, at least in the context of copyright, the denial of copyright protection may actually harm the very performers that some anti-pornography scholars, such as Ann Bartow, are concerned about.¹⁸⁹ Margaret Radin has raised the problem of such a “double bind” in the context of her consideration of a ban on prostitution. By prohibiting prostitution, we may force some individuals to engage either in less profitable and less appealing work or to engage in prostitution in circumstances in which they make less and are more likely to be mistreated.¹⁹⁰ The same might be true for performers in a porn world without copyright law. Without the protections of copyright, the industry will likely make works with more sex and less plot because there will be no need to have any copyrightable content. The works—because they can be freely copied—may also make less money leading to performers being paid less. The work itself and the working conditions therefore may be less satisfying for many performers if copyright protection is denied to such works.

189. See Bartow, *Coercion & Copyright*, *supra* note 126, at 101-06, 113, 118-26, 137-40; Bartow, *Copyright Law & Commoditization*, *supra* note 126, at 2, 34-38, 43-45.

190. Margaret Jane Radin, *Market-Inalienability*, 100 HARV. L. REV. 1849, 1915-17 (1987).

5. *Consumer protection and other trademark goals*

Trademark law protects consumers from deceptive business practices, in particular the passing off of one's goods as those of another or another's goods as one's own. Trademark law therefore facilitates the identification of the source and/or sponsorship of goods and services. By so protecting a business's goodwill, trademark law makes it more likely that consumers will have more products and services to choose from and that these products/services will be of a consistent and high quality. The secondary goal of trademark law is to protect a business's goodwill; this aspect of trademark law has greatly expanded in recent years, often overshadowing the consumer protection rationale.¹⁹¹ Denying registration to marks deemed scandalous or immoral, however, furthers none of these goals. In fact, if anything the goals are defeated by such denials because without registration it is more likely that consumers will be confused by competing marks and competitors will have greater difficulty knowing what marks are available.

For example, the denial of the registration for the mark *Bearded Clam* led to many *Bearded Clam* restaurants around the country. Consumers might think they are related to one another, when in fact they are not. Moreover, the public is not protected from encountering the purportedly scandalous mark in the marketplace—if anything they are likely to see it more often because the priority trademark holder will have a more limited ability to prevent others from using the mark outside of its bounded geographic area and others will be more likely to adopt the mark thinking it is available for use.

6. *Discouragement of aesthetic evaluations*

Copyright law has long discouraged judges from making aesthetic evaluations.¹⁹² The Fifth Circuit in *Mitchell Bros. Film Group v. Cinema Adult Theater* concluded that copyright protection should be extended to pornographic works in part because to do otherwise would force judges to make disfavored

191. This is most notably evident with the expansion and adoption of dilution law and the initial interest confusion doctrine. See Rothman, *supra* note 52 *passim*.

192. BALL, *supra* note 4, at 107-10 (suggesting that a work does not need artistic or literary value to merit copyright protection, but noting that the work must be of some societal value); HINKSON, *supra* note 4, at 2, 9 (“[To be property it] need not be of any ascertainable value, but it must be original.”). Another well-known critique of judges making aesthetic evaluations in the context of copyright law comes from Lord Campbell. Campbell criticized his fellow judge Lord Eldon's decision to deny copyright protection to a poem by Lord Byron because Lord Eldon concluded that the work was blasphemous. Campbell considered it a “strange occupation for a judge who for many years had meddled with nothing more imaginative than an act of Parliament, to determine in what sense the speculations of Adam, Eve, Cain, and Lucifer are to be understood, and whether the tendency of the whole poem be favorable or injurious to religion.” LORD CAMPBELL, 10 LIVES OF THE LORD CHANCELLORS AND KEEPERS OF THE GREAT SEAL OF ENGLAND FROM THE EARLIEST TIMES TILL THE REIGN OF KING GEORGE IV 257 (5th ed. 1868), *quoted in* DRONE, *supra* note 4, at 187-88 n.2.

evaluations of the “aesthetic and educational” value of works.¹⁹³ The *Mitchell Bros.* court quoted Justice Holmes and his famous language from *Bleistein v. Donaldson Lithograph, Co.* In the context of concluding that lithographs used as advertisements were deserving of copyright protection, Holmes observed that “[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”¹⁹⁴

Despite such longstanding views, aesthetic evaluations are sometimes unavoidable in copyright law. Aesthetics have played a role in determining originality and substantial similarity.¹⁹⁵ Defenses to copyright and trademark infringement, and trademark dilution also often turn on aesthetic judgments. For example, copyright’s fair use defense considers the purpose and character of a use; a work judged artistic in nature will be considered both worthwhile and transformative—qualities that both weigh in favor of fair use. When considering First Amendment defenses to trademark infringement and dilution, courts also often favor uses deemed artistic in nature.¹⁹⁶ One such example is the *Rogers* test that explicitly favors uses of another’s trademark when the use has “artistic relevance.”¹⁹⁷

In the context of sex, aesthetic evaluations have played a particularly significant role in determining both the protectability of marks and works, as well as the legitimacy of uses of those marks or works. Works or uses that are sexually explicit will frequently be viewed as having little to no artistic value, making infringement findings and other unfavorable conclusions more likely. Moreover, consideration of what is artistically valuable often devolves into a question of whether the sex itself is appropriate.

193. 604 F.2d 852, 856 (5th Cir. 1979) (quoting *Bleistein v. Donaldson Lithograph Co.*, 188 U.S. 239, 251-52 (1903)). See also *Belcher v. Tarbox*, 486 F.2d 1087, 1088 (9th Cir. 1973) (“There is nothing in the Copyright Act to suggest that the courts are to pass upon the truth or falsity, the soundness or unsoundness, of the views embodied in a copyrighted work. The gravity and immensity of the problems, theological, philosophical, economic and scientific, that would confront a court if this view were adopted are staggering to contemplate.”).

194. *Bleistein*, 188 U.S. at 251. Recent work by Rebecca Tushnet has focused attention on the “*pictorial*” aspect of the decision, but courts have long relied on Holmes’ opinion for the broader proposition that judges should refrain from making aesthetic judgments in the copyright arena. Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright Law*, 125 HARV. L. REV. (forthcoming 2012), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1911352.

195. See Christine Farley, *Judging Art*, 79 TUL. L. REV. 805, 806-09, 819, 827-30, 833-36 (2005); Alfred C. Yen, *Copyright Opinions and Aesthetic Theory*, 71 S. CAL. L. REV. 247, 247-52, 266-302 (1998).

196. See, e.g., *ETW, Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 924-28 (6th Cir. 2003).

197. *Rogers v. Grimaldi*, 875 F.2d 994, 999, 1001 (2d Cir. 1989) (holding that Federico Fellini’s movie title *Fred and Ginger* was protected by the First Amendment because the title was artistically relevant to the underlying work and not explicitly misleading as to source). Although the *Rogers* test initially only applied to titles, it now applies to all uses in “works of artistic expression.” *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp.*, 886 F.2d 490, 495 (2d Cir. 1989).

To the extent that protectability or a defense turns on classifying a work or use as obscene, courts are explicitly required to evaluate the artistic value of the underlying works or marks. The *Miller* test used to determine whether works are obscene and fall outside of First Amendment protection expressly considers whether the relevant work has “serious literary, artistic, political or scientific value.”¹⁹⁸ If it does, then the First Amendment protects the work from government censorship.

Even when courts do not look to obscenity law, evaluations of what works/marks (or uses of those) are deserving of protection or are immoral or scandalous will frequently turn on aesthetic judgments. Determinations of whether works with sexual content are “immoral,” for example, have often relied on such artistic evaluations. In *Martinetti v. Maguire*, a California district court denied copyright to a play because of its evaluation of the quality of the work: “The principal part and attraction of the spectacle seems to be the exhibition of women in novel dress or no dress, and in attractive attitudes or action To call such a spectacle a ‘dramatic composition’ is an abuse of language, and an insult to the genius of the English drama.”¹⁹⁹ Although the basis for the denial of protection was that the work did not promote progress because it did not “encourage virtue and discourage immorality,”²⁰⁰ the above analysis demonstrates that the judge’s literary tastes were at the heart of the determination. Similarly, in *Barnes v. Miner*, the court assessed the primary “idea and purpose” of the play as to display the human being in “nude or seminude conditions making quick changes of dress or costume.”²⁰¹ The court analyzed the dialogue and found it wanting.²⁰² Another of the classic early cases afforded copyright to a work with an interracial sex scene despite the bar against providing copyright to immoral works, but the court emphasized in so concluding that the work at issue had some basis in “actual conditions”—suggesting that at least one consideration in evaluating the morality of works is whether they are “true” or based on reality, as opposed to purely creations of an author’s imagination.²⁰³ Similarly, uses of trademarks in the context of works deemed artistic are more likely to be protected by the First Amendment or a fair use defense.²⁰⁴

Because evaluations of works, marks, and uses of those with sexual content often involve aesthetic considerations, much room is left not only for problem-

198. *Miller v. California*, 413 U.S. 15, 24 (1973).

199. 16 F. Cas. 920, 922 (C.C.D. Cal. 1867) (No. 9,173).

200. *Id.*

201. 122 F. 480, 489 (S.D.N.Y. 1903).

202. *Id.* at 490.

203. *Simonton v. Gordon*, 12 F.2d 116, 124 (S.D.N.Y. 1925).

204. Compare *Dall. Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205-07 (2d Cir. 1979) (rejecting defenses to a use of a mark in a pornographic film) with *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806-12 (9th Cir. 2003) (protecting uses of a mark even in a sexual context when the uses were in photographs made by a known artist).

atic judgment calls about what constitutes “art,” but also about what constitutes acceptable portrayals of sex. Such evaluations permit judges to hide their biases about sex behind the cloak of artistic evaluations, which are disfavored in and of themselves.

B. *Valuing Sex*

The law often treats sex differently (and worse) than other activities or aspects of human identity because courts treat sex as if it lacks any value unless it serves other goals, such as procreation, or marital or emotional intimacy.²⁰⁵ As discussed, legal scholars and jurists routinely dismiss the value of sex in the context of IP adjudications and elsewhere.²⁰⁶ Both trademark and copyright law have disfavored works, marks and uses that depict sex or simply nudity. Trademark law continues to deny registration to marks with sexual content, especially marks that refer to sexual intercourse, genitalia, or masturbation, or that show nudity, and trademark dilution law treats references to sex as *per se* tarnishing.²⁰⁷

Such devaluations of sex make it more likely that uses of works or marks in a sexual context will be found infringing or dilutive and that no defense will protect them. For example, if not for the sexual content, the “Cunnilingus Champion of Company C,” the use of Disney cartoon characters in *Air Pirates*, and the use of Mouseketeer hats in a film would all be good candidates for fair use. The rejection of the fair use claims in each instance was based on an antipathy toward sex and a view that associations with sex would be harmful to the underlying copyrighted works.²⁰⁸ Evaluations of whether an injunction (preliminary or otherwise) should issue or the legitimacy of First Amendment and fair use defenses all turn on the balancing of the plaintiff’s interests with the public interest in permitting the defendant’s use. When trademark and copyright holders’ rights are on one side of the scale and on the other are purportedly valueless or harmful activities, users do not stand a chance.

Despite the frequent sex-negative discourse, there are many reasons to value sex more affirmatively in the legal system. Sex can be something pleasurable, self-defining, and empowering whether cabined into an intimate relationship or not and regardless of whether any particular end is served.²⁰⁹ A positive relationship to sex promotes self-love, love of others, identity-development, care, pleasure, self-esteem, commitment, community, and intimacy.²¹⁰ Greater

205. Rosenbury & Rothman, *supra* note 1, at 809-18, 824-36.

206. *Id.* at 818.

207. *See* discussion *supra* Part I.

208. *See* discussion *supra* notes 147-163 and accompanying text.

209. Rosenbury & Rothman, *supra* note 1, at 811, 836-38, 848.

210. *Id.* at 858.

comfort with sex and the ability to act as sexual subjects also can lead to improved mental and physical health.²¹¹

Not only do courts and advocates of limiting IP protection for pornographic works devalue and stigmatize sex directly, but they also do so indirectly by treating sex as more harmful than violence and bigotry. Ann Bartow, for example, wants to carve out an exception to copyright law for sexually explicit works, but does not address the fact that protection remains for works that are violent, racist, homophobic, or that depict animal cruelty.²¹² Such confounding sex exceptionalism was recently showcased in the Supreme Court's decision in *Brown v. Entertainment Merchants Ass'n*.²¹³ In *Brown*, the Court held unconstitutional, on First Amendment grounds, a ban on selling violent video games to children. Bans on sales of sexually explicit materials, however, remain. Justice Stephen Breyer dissented from the decision noting the "serious anomaly" that it created: "[W]hat sense does it make to forbid selling to a 13-year-old boy a magazine with an image of a nude woman, while protecting a sale to that 13-year-old of an interactive video game in which he actively, but virtually, binds and gags the woman, then tortures and kills her. What kind of First Amendment would permit the government to protect children by restricting sales of that extremely violent video game *only* when the woman—bound, gagged, tortured, and killed—is also topless?"²¹⁴ Putting aside whether such bans should be permitted, we should be concerned about our society's and legal system's disapproval of sexual content and nudity, especially when compared to its acceptance of violence and animal cruelty.²¹⁵

C. Sex Normativity and Judging the "Appropriateness" of Sex

Even when IP law permits discourse about sex to be protected under its umbrella, it often picks and chooses preferred forms of sex. Instead of

211. *Id.* at 844 (citing Lucia F. O'Sullivan et al., *To Your Sexual Health! Incorporating Sexuality into the Health Perspective*, in HANDBOOK OF GIRLS' AND WOMEN'S PSYCHOLOGICAL HEALTH 192, 194 (Judith Worell & Carol Goodhearts eds., 2006)).

212. I note that Professor Bartow has suggested at times that instead of banning all copyright protection, the copyright office could require proof of consent of all performers in pornographic works before registering them and granting copyright protection. If consent is demonstrated, copyright registration and protection would then be extended. Bartow allows, however, for performers to withdraw their consent at any time—something that would not be extended outside the realm of pornography. See Bartow, *Coercion & Copyright*, *supra* note 126. Her more recent work on the subject, however, calls for a broader ban on copyright protection for pornographic works judged "non-progressive" and "non-useful." See Bartow, *Copyright Law & Commoditization*, *supra* note 126. My focus here is not on the specifics of Bartow's or other scholars' suggestions, but instead on broader-based claims that IP law should discriminate against sexual content.

213. 131 S. Ct. 2729 (2011).

214. *Id.* at 2771 (Breyer, J., dissenting).

215. See, e.g., *United States v. Stevens*, 130 S. Ct. 1577 (2010) (striking down ban on depictions of animal cruelty).

“recogniz[ing] the diversity of sexual and intimate relations as worthy of respect and protection,”²¹⁶ courts have imposed their views of what constitutes “good sex.” IP law is therefore part of a larger network of laws that promote a narrow vision of acceptable sexual expression and conduct.²¹⁷ These laws harm individuals living both within and outside their framework.²¹⁸ For those who cannot conform to the legally and socially constructed vision of sex, the legal and social disapproval can cause psychological and physical harm and fundamentally alter their relationship to themselves, their sexuality, and their place in society.²¹⁹ The law also discourages some, who otherwise might wish to or who would benefit from doing so, from departing from this dominant construction of sex. IP law and the works and marks that seek to comply with it “construct the range of choices through norms of acceptable gender and sexual performance.”²²⁰

Although everyone is affected by this narrow construction of sex, certain groups may be particularly affected and harmed, in particular, women, gay, lesbian, and bisexual individuals, and those who engage in purportedly dangerous or commercial sex. For example, IP law can perpetuate the idea that women do not enjoy sex or only enjoy certain types of domesticated or procreative sex. Such disfavoring of female sexuality is common in IP law and more broadly.²²¹ As the decisions discussed in Parts I and II reveal, IP laws have sometimes expressed a vision of sex that excludes women from sexual activity. When copyright law excluded immoral and sexual works from its purview, the vast majority of the works deemed immoral portrayed female sexuality. James Cain’s book *Serenade* was granted copyright protection in part because the female character that had premarital sex in a church was later punished for her misdeed by being killed.²²² In *Barnes v. Miner*, the court deemed a work “lascivious and immoral” because the on-stage costume changes (conducted behind a screen) “would naturally excite passions” of the males in the audience while producing “disgust” among the “chaste females.”²²³ The non-chaste females in the audience, according to the judge, would have “no particular emotions whatever other than expectancy or curiosity” of how the play would affect the men.²²⁴ The judge assumed heterosexuality in his analysis and favored chaste women while assuming that men are sexually experienced and easily excitable. Courts today would analyze things differently—after all many contemporary

216. WARNER, *supra* note 5, at 88.

217. Rosenbury & Rothman, *supra* note 1, at 818.

218. *Id.* at 839.

219. *Id.* at 818, 839-43.

220. *Cf. id.* at 839 (speaking about the intimacy model for regulating sex).

221. *Id.* at 839-44.

222. Cain v. Universal Pictures Co., 47 F. Supp. 1013, 1017-19 (S.D. Cal. 1942).

223. Barnes v. Miner, 122 F. 480, 489 (S.D.N.Y. 1903).

224. *Id.*

plays have naked actors parading across the stage.²²⁵ Nonetheless, the latitude for imposing biases and perpetuating stereotypes remains and should discourage us from returning to such prohibitions on the protectability of works.

Trademark law also has disfavored references to female sexuality. A significant number of rejected applications for marks refer to female genitalia and decisions about which marks to register sometimes objectify, rather than liberate women. The USPTO, for example, rejected the registration of the cheekily-named mark *Bubby Trap* for a bra, but did not hesitate to register the name and logo for the restaurant *Hooters* with its owl/breast logo.²²⁶ For the few who have not seen the logo, I have reproduced it below in Figure 3 as well as a photograph of the logo as it appears in context on servers' uniforms. (See Figure 4.) Even without entering the restaurant and seeing the all female wait-staff wearing short-shorts and very tight t-shirts, it would be difficult to miss the literary and visual allusion to women's breasts.²²⁷

225. See RICHARD GREENBERG, TAKE ME OUT (2004) (earlier versions were performed in 2002); TERRENCE MCNALLY, LOVE, VALOR, COMPASSION (1995) (originally produced in 1994).

226. Compare *In re Runsdorf*, 171 U.S.P.Q. 443 (T.T.A.B. 1971), with HOOTERS, Registration No. 73464115.

227. *Hooters*, WIKIPEDIA, http://en.wikipedia.org/wiki/Hooters#Employee_handbook_requirements; Barbara Kasper & Barbara Moore, *WAVE's Review of Hooters*, ROCHESTER NOW (originally published Apr. 12, 1995), <http://www.rochesternow.org/hooters.html>; *Maximum Weight/Size Requirements?*, HOOTERS GIRL (July 21, 2009), <http://thehootersgirl.blogspot.com/2009/07/maximum-weightsize-requirements.html>; *So You Want to Be a "Hooters" Girl?*, THE SMOKING GUN (Sept. 15, 2005), <http://www.thesmokinggun.com/file/so-you-wanna-be-hooters-girl?page=7> (scanned excerpts from the Hooters Employee Handbook). The employee handbook observes that the concept of Hooters is based on female sex appeal and that to work there one must accept a certain degree of sexual innuendo and joking that might otherwise form a hostile work environment. *Id.*

Figure 3—Hooters Logo²²⁸



Figure 4—Servers at Hooters Wearing the Required Uniform²²⁹



It is possible that the reference to owls gave cover to Hooters, but a more troubling interpretation of this discrepancy is also possible. Using a cute reference to breasts in a product marketed to women and for use with actual breasts is vulgar, but objectifying women's breasts and using them to sell hamburgers to men is okay. It is also possible that the decade between the two registration decisions led to a liberalization of attitudes toward references to breasts or that different examining attorneys had different views about the propriety of such

228. Image filed with USPTO as part of Intent-To-Use Application, No. 85151738 (notice of allowance issued, May 17, 2011), for use on goods composed of beef, chicken, pork and shrimp. This most recent filing is similar to other drawings registered with the USPTO, but best reflects the Hooters logo as used in commerce. *See also* HOOTERS, Registration Nos. 1602377, 1652377, 73712461, 7364115.

229. Photograph posted by Richard Metzger, *'Holy Preachers' and the Hooters Waitresses*, DANGEROUS MINDS, (Jan. 20, 2011, 4:24 p.m.), http://www.dangerousminds.net/site/comments/holy_preachers_and_the_hooters_waitresses.

references. Regardless of the explanation, the message conveyed is that it is okay to sexualize women's breasts for men, but not for products targeted at women to make fun of these revered features of the female anatomy. Such messages reinforce the treatment of women as sex objects, while denying their efforts to become sexual subjects.

These biases perpetuate the sexual double standard, in which sexual desire and pleasure are reserved for straight men whereas women are assumed not to enjoy sex.²³⁰ Both societal and legal discourses provide more space for men to express interest in sex and sexual pleasure than for women.²³¹ This socio-legal construction then both constructs and reinforces existing constructions of sex and appropriate sexual gender roles, restricting the liberty and/or agency of both men and women.²³²

Not only does the constellation of IP decisions demonstrate disparagement of female sexuality, but it also raises the specter of disapproval of homosexuality and other less common sexual practices. Same-sex conduct is likely to be treated less favorably, as we have seen in criminal law and elsewhere, even after *Lawrence v. Texas*.²³³ Obscenity trials tell us that historically gay content has been deemed obscene and Hollywood ratings boards' and television studios' standards and practices continue to limit references and depictions of homosexuality. Giving IP law latitude to determine acceptable sex leaves wide open the door to discriminate against sexual minorities, such as gay, lesbian, bisexual, and transgender individuals.

For example, the Supreme Court held that a gay organization could not use the moniker the "Gay Olympics" for an athletic competition. This decision (under a special law for the U.S. Olympic Committee similar to trademark law) suggests disapproval of uses of trademarks in the context of homosexuality and, at the very least, demonstrates a lack of awareness by the Court of the importance of the word "Olympics" to communicate the legitimacy of gay athletes.²³⁴ The USPTO's bars to registration can also obstruct the ability of groups that have been targets of discrimination to comment on and/or subvert derogatory terms.²³⁵ The USPTO recently struggled to decide whether a lesbian motorcycle group that leads off gay pride parades could register the mark

230. Sylvia A. Law, *Homosexuality and the Social Meaning of Gender*, 1988 Wis. L. REV. 187, 210; Rosenbury & Rothman, *supra* note 1, at 840.

231. Rosenbury & Rothman, *supra* note 1, at 840-41.

232. *Id.* at 842.

233. *See id.* at 823-35, 828 n.107.

234. *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 438 U.S. 522 (1987). *SFAA* was not strictly speaking a trademark case. Instead, the suit by the USOC was brought under a separate statute that protects the *Olympic* mark without regard to confusion. Many other organizations have been given permission to refer to themselves as "Olympics." The USOC opposition to the SFAA's use therefore likely revolved around the fact that it was a gay organization.

235. *Cf.* Amy Adler, *What's Left?: Hate Speech, Pornography, and the Problem for Artistic Expression*, 84 CAL. L. REV. 1499 *passim* (1996).

Dykes on Bikes for its organization and related merchandise. The USPTO initially rejected the registration of the mark on the basis that it disparaged a particular group and was immoral and scandalous. After scholars and the San Francisco City Council filed letters in support of the registration, the USPTO reconsidered its decision and registered the mark. The USPTO's initial rejection of *Dykes on Bikes* suggests a possible disfavoring of references to gays and lesbians even when adopted by the in-group.

Scholars who have advocated for limits on pornography and limits on copyright protection for such works also seek to impose their views about what sex is acceptable. For example, anti-pornography feminists have long rejected the possibility that women could enjoy participating in or watching bondage.²³⁶ If "whips and chains excite" Rihanna and Brittany Spears, and Rihanna wants to make a video showing her participation in S&M (which she has done), why should the state step in to tell her that her expression of her sexuality is bad, inappropriate, and does not deserve copyright protection?²³⁷ This debate in IP circles evokes the sex wars between anti-pornography, anti-sex feminists and more sex-positive feminists and queer theorists.²³⁸ I do not have space here to fully recount this debate, but similar critiques can be leveled against using IP law to channel sex as those that have been leveled against sex-negative feminism. It portrays a very narrow view of sex and gender that is ultimately constraining rather than liberating and empowering.²³⁹

IP laws also have disfavored depictions of commercial sex and depictions of sex that are for profit. Some of the earliest cases denying copyright protec-

236. See ANDREA DWORKIN, *WOMAN HATING* 55-90 (1974); CATHERINE A. MACKINNON, *FEMINISM UNMODIFIED* 125-228 (1987); CATHERINE A. MACKINNON, *TOWARD A FEMINIST THEORY OF THE STATE* 195-214 (1989); Andrea Dworkin, *Against the Male Flood: Censorship, Pornography, and Equality*, 8 HARV. WOMEN'S L.J. 1 *passim* (1985); see also Bartow, *Copyright Law & Commoditization*, *supra* note 126, at 13-14, 28 (referring to MacKinnon & Dworkin's draft of the Indianapolis anti-pornography law and at times seeming to embrace limits on providing copyright even to consensual depictions of bondage).

237. RIHANNA, *S&M*, on LOUD (Def Jam 2010). Rihanna, however, is not free to copy others' work in her music videos. See *supra* note 170.

238. LISA DUGGAN & NAN D. HUNTER, *SEX WARS: SEXUAL DISSENT AND POLITICAL CULTURE* *passim* (1995); Kathryn Abrams, *Sex Wars Redux: Agency and Coercion in Feminist Legal Theory*, 95 COLUM. L. REV. 304 *passim* (1995); Lisa Duggan, *The Sex Panic: Women Censorship, and Pornography: An Historical Overview*, 38 N.Y.L. SCH. L. REV. 25 *passim* (1993); Katherine M. Franke, *Theorizing Yes: An Essay on Feminism, Law, and Desire*, 101 COLUM. L. REV. 181, 182, 197-202 (2001); Carol S. Vance, *More Danger, More Pleasure: A Decade After the Barnard Sexuality Conference*, 38 N.Y.L. SCH. L. REV. 289 *passim* (1993).

239. See, e.g., Franke, *supra* note 238 *passim* (advocating for a positive theory of female sexuality); Nadine Strossen, *A Feminist Critique of "The" Feminist Critique of Pornography*, 79 VA. L. REV. 1099 *passim* (1993); see also Sallie Tisdale, *Talk Dirty To Me*, 284 HARPER'S MAG. 37 *passim* (1992) (describing her love affair with pornography).

tion to works were those in which memoirs of prostitutes were at issue.²⁴⁰ As discussed, courts penalize those who seek to profit from depictions of sex. The opposition to mixing sex with commerce is longstanding.²⁴¹ The dividing lines between commercial and non-commercial sex, however, are not as clear as the judiciary and some commentators think. Sex is already commodified (even in private, martial relationships) and commodification does not disrupt many of the privileged aspects of sex—for example, the promotion of emotional intimacy.²⁴²

Another reason pornography may be disfavored is that its poorly developed plot lines tend to portray sex without developing connections or intimacy between the characters. This is akin to sex without intimacy—something that courts and society have disfavored and which they assume women find no pleasure in.²⁴³ Sex, however, should be valued for its own sake and for the pleasure and sometimes care that takes place within it without regard to any instrumental goals, such as procreation or relationship-building, and without differentiating between different visions of sex. Copyright and trademark law should embrace all forms of sexuality—rather than limit them—and not disfavor sex merely because it takes place in a commercial or paid context, nor because it involves same-sex participants or consensual bondage.

CONCLUSION

Despite the purported movement away from exclusions for sexually explicit or suggestive content, trademark and copyright law continue to exhibit sex exceptionalism, negativity, and normativity in a variety of ways. Nevertheless, I do not intend to overstate the existing limits on sexual content. Today, many copyrighted works have sexual content and numerous registered trademarks are sexually suggestive. Pornographers have successfully sued for copyright and trademark infringement and some defendants (including pornographers) have been able to use copyrighted works and/or trademarks in a sexual context without losing fair use or First Amendment defenses.²⁴⁴ Both bodies of law, how-

240. See discussion *supra* notes 110-112 and accompanying text; see also *Pornography*, DICTIONARY.COM (2011), <http://dictionary.reference.com/browse/pornography> (describing the etymology of the term “pornography” as writing about “harlots” (a.k.a. prostitutes)).

241. Noah Zatz, *Sex Work/Sex Act: Law, Labor, and Desire in Constructions of Prostitution*, 22 SIGNS 277, 283-85, 289-91 (1997).

242. Rosenbury & Rothman, *supra* note 1, at 845-46.

243. See *id.*, *passim*.

244. See, e.g., *Playboy Enters., Inc. v. Netscape Commc'ns. Corp.*, 354 F.3d 1020 (9th Cir. 2004) (permitting trademark infringement and dilution claims by adult entertainment website to go forward against a search engine, but in the context of advertisements for competing pornography sites); *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26 (1st Cir. 1987) (finding that a sexual spoof of the *L.L. Bean* catalog was a parody protected by the First Amendment); *Perfect 10, Inc. v. Megaupload Ltd.*, 2011 WL 3203117 (S.D. Cal. 2011) (rejecting a motion to dismiss a copyright infringement claim brought by the adult enter-

ever, leave much latitude for judges to discriminate against works, marks, and uses of both solely on the basis of sexual content. This project has described some of the ways IP law continues to devalue and channel sex. This is most evident in trademark dilution law where courts have read in an explicit prohibition on using marks or colorable imitations in sexual contexts. Without a clear and developed articulation of why disfavoring sexual content is a problem, courts and legislatures could easily heed the calls of those who wish to move back in the direction of limiting protection for works and marks with sexual content.

My critique of such an approach should not be read, however, as an endorsement of all pornography or adult entertainment. Some pornography does degrade women (and men), involves organized crime, and/or includes non-consenting participants. To the extent that pornography degrades, a counter-narrative—perhaps even a pornographic one—is necessary.²⁴⁵ To the extent that organized crime is involved, criminal law enforcement should address this problem. To the extent performers have acted without consent or under duress, criminal charges are appropriate. The adult entertainment industry has also underpaid its workers and failed to protect performers from contracting sexually transmitted diseases. Labor organizing and better safety precautions might all be appropriate, but none of this is properly the purview of IP law.

Using copyright and trademark to achieve these alternative ends is destructive both to the IP system and to our broader culture. It provides yet another avenue for the law (and in this case art and commerce) to shape a vision of sex that is narrow, discriminatory, pejorative, and exclusionary. Works, marks, and uses of them should not be disfavored solely because they have sexual content nor should courts be in the business of assessing what constitutes good or bad sex. Ultimately, sex should be no more exceptional than other activities, and courts should be agnostic about the type of sex that takes place or is depicted. Outside of IP law, courts should continue to evaluate whether sex is consensual and whether sexual activities or depictions of sex are forced on a “captive audience.”²⁴⁶ There may also be reasons to limit the use of marks or advertising that is sexually explicit to protect children from seeing images that they may not be ready for or that their parents may not wish for them to see.

A recalibration of IP law will not fundamentally alter our society’s relationship to sex, but it is one step in a larger project to provide more space for

tainment company Perfect 10, Inc.); *Lucasfilm Ltd. v. Media Mkt. Grp., Ltd.*, 182 F. Supp. 2d 897 (N.D. Cal. 2002) (finding animated pornographic movie entitled *Starballz* a parody of *Star Wars* and concluding that copyright and trademark claims were not likely to succeed); *Pillsbury Co. v. Milky Way Prods., Inc.*, 215 U.S.P.Q. 124, 131 & n.10 (N.D. Ga. 1981) (permitting a fair use defense to a copyright claim in a sexual context and concluding that pornographic uses should not be disfavored in fair use analysis) (citing *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979)).

245. *Cf. Adler, supra* note 235 *passim*.

246. *Miller v. California*, 413 U.S. 15, 44 (1973) (Douglas, J., dissenting).

individuals to develop their own views and experiences of sex.²⁴⁷ The promotion of more positive and pluralistic views and portrayals of sex is important; IP laws should promote frank, honest public discussions of sex, rather than penalize them.

²⁴⁷. See Rosenbury & Rothman, *supra* note 1, at 823-35, 828 n.107 (advocating for a constitutional right to sex).