

1-1-2012

# Stolen Valor & the First Amendment: Does Trademark Infringement Law Leave Congress an Opening?

Susan Richey

*University of New Hampshire School of Law*

John M. Greabe

*University of New Hampshire School of Law*

Follow this and additional works at: [https://scholars.unh.edu/law\\_facpub](https://scholars.unh.edu/law_facpub)



Part of the [First Amendment Commons](#), and the [Intellectual Property Law Commons](#)

---

## Recommended Citation

Susan Richey & John M. Greabe, "Stolen Valor & the First Amendment: Does Trademark Infringement Law Leave Congress an Opening?," 47 NEW ENG. L. REV. 293 (2012).

This Article is brought to you for free and open access by the University of New Hampshire – School of Law at University of New Hampshire Scholars' Repository. It has been accepted for inclusion in Law Faculty Scholarship by an authorized administrator of University of New Hampshire Scholars' Repository. For more information, please contact [ellen.phillips@law.unh.edu](mailto:ellen.phillips@law.unh.edu).

# Stolen Valor and the First Amendment: Does Trademark Infringement Law Leave Congress an Opening?

SUSAN M. RICHEY\* & JOHN M. GREABE\*\*

## INTRODUCTION

“Lying was his habit.”<sup>1</sup> So begins Justice Kennedy’s plurality opinion in *United States v. Alvarez*, a decision whose release was upstaged by the Supreme Court’s simultaneous issuance of its opinion upholding the Affordable Care Act,<sup>2</sup> but which seems destined nonetheless to enjoy a prominent spot in the First Amendment firmament. The case arose from a federal prosecution initiated against Xavier Alvarez, a pathological liar who served on the Three Valley Water District Board in Claremont, California.<sup>3</sup> Among other things, Alvarez publicly and falsely claimed to have played hockey for the Detroit Red Wings and to have married a Mexican starlet.<sup>4</sup> But when Alvarez falsely announced at a 2007 Board meeting that he had been awarded the Congressional Medal of Honor, he “ventured onto new ground.”<sup>5</sup> For this particular lie was proscribed by a federal criminal statute, the so-called “Stolen Valor Act” of 2005, which outlawed false verbal or written representations about one’s receipt of the

---

\* Professor of Law, University of New Hampshire School of Law; B.S., College of William and Mary; B.A., University of Baltimore; J.D., University of Maryland School of Law.

\*\* Professor of Law, University of New Hampshire School of Law; B.A., Dartmouth College; J.D., Harvard Law School.

<sup>1</sup> *United States v. Alvarez*, 132 S. Ct. 2537, 2542 (2012).

<sup>2</sup> *Nat’l Fed’n of Indep. Bus. v. Sebelius*, 132 S. Ct. 2566 (2012). Both decisions were released on June 28, 2012. Chuck Yarling, *Obamacare Ruling Overshadows Supreme Court Decision on the Stolen Valor Act*, EXAMINER.COM (June 30, 2012), <http://www.examiner.com/article/obamacare-ruling-overshadows-supreme-court-decision-on-the-stolen-valor-act>.

<sup>3</sup> See *Alvarez*, 132 S. Ct. at 2542 (Kennedy, J., plurality).

<sup>4</sup> *Id.*

<sup>5</sup> *Id.*

Medal.<sup>6</sup>

Alvarez was indicted for his statement but challenged the Stolen Valor Act as invalid under the First Amendment.<sup>7</sup> The United States District Court for the Central District of California rejected his challenge and Alvarez entered a conditional guilty plea.<sup>8</sup> On appeal, a divided panel of the United States Court of Appeals for the Ninth Circuit reversed and struck down the Act under the First Amendment.<sup>9</sup> Over a dissent by seven judges, the Ninth Circuit denied the government's request for a rehearing *en banc*.<sup>10</sup> The Supreme Court granted certiorari and, in a fractured decision with none of the three opinions garnering a majority, affirmed.<sup>11</sup>

The *Alvarez* case was litigated on the assumption that the Stolen Valor Act's constitutionality under the First Amendment turned on whether false statements of fact, such as those uttered by Alvarez, fall within a category of speech fully outside the protection of the First Amendment.<sup>12</sup> Justice Kennedy, writing for a plurality of four Justices, concluded that they do not and therefore applied "exacting scrutiny" to facially invalidate the statute.<sup>13</sup> Justice Breyer, writing on behalf of himself and Justice Kagan, eschewed such a categorical approach but concurred in the plurality's judgment after applying "intermediate scrutiny" to conclude that the statute was

<sup>6</sup> See 18 U.S.C. § 704(b) (2006) ("Whoever falsely represents himself or herself, verbally or in writing, to have been awarded any decoration or medal authorized by Congress for the Armed Forces of the United States . . . shall be fined under this title, imprisoned not more than six months, or both."); *id.* § 704(c) ("If a decoration or medal involved in an offense under subsection . . . (b) is a Congressional Medal of Honor, in lieu of the punishment provided in that subsection, the offender shall be fined under this title, imprisoned not more than 1 year, or both."). The Supreme Court held these provisions invalid under the First Amendment in *Alvarez*. See 132 S. Ct. at 2543 (Kennedy, J., plurality).

<sup>7</sup> *Alvarez*, 132 S. Ct. at 2542 (Kennedy, J., plurality).

<sup>8</sup> *Id.*

<sup>9</sup> *Id.*

<sup>10</sup> See *id.*

<sup>11</sup> See *id.* at 2542-43.

<sup>12</sup> See *id.* at 2543 (explaining that Xavier Alvarez challenged the statute "as a content-based suppression of pure speech, speech not falling within any of the few categories of expression where content-based regulation is permissible"); see also *id.* (explaining that the Government defended the statute as "necessary to preserve the integrity and purpose of the Medal," and that "false statements have no First Amendment value in themselves, and thus are protected only to the extent needed to avoid chilling fully protected speech") (internal citation and quotation marks omitted). See generally *United States v. Stevens*, 130 S. Ct. 1577, 1584 (2010) (stating that the categories of speech that may be restricted on the basis of content without regard to First Amendment protections "include[] obscenity, defamation, fraud, incitement, and speech integral to criminal conduct") (internal citations omitted).

<sup>13</sup> See *Alvarez*, 132 S. Ct. at 2548 (Kennedy, J., plurality).

overbroad.<sup>14</sup> Justice Alito, writing on behalf of himself, Justices Scalia, and Thomas, dissented on the ground that false statements of fact should be regarded as categorically unprotected.<sup>15</sup>

In the Supreme Court, the authors of this paper, along with Professors Keith Harrison and J. Jeffrey Hawley, filed a brief on behalf of the Intellectual Property Amicus Brief Clinic of the University of New Hampshire School of Law as *amicus curiae* in support of neither party.<sup>16</sup> Our brief drew to the Supreme Court's attention the potential relevance of trademark law—a body of law that the parties did not raise or discuss in their briefs. More specifically, we explained to the Court that the Stolen Valor Act could be conceptualized as a trademark infringement statute protecting the Congressional Medal of Honor as a collective membership mark, and that the statute ought to survive First Amendment scrutiny under current law if it were so conceived.<sup>17</sup> Unsurprisingly, since this argument was not raised or discussed by the parties, the Court did not discuss it directly. But all three opinions made references to trademark law generally in the course of their analyses.<sup>18</sup>

This paper reiterates and elaborates on the argument that Congress could, if it so chooses, protect the Congressional Medal of Honor as a collective membership mark by means of trademark infringement legislation. In pressing our argument, we do not contend that the Stolen Valor Act is good public policy. In fact, we both tend to regard the Act as heavy-handed and unnecessary legislation. Our argument is instead narrowly directed to whether Congress *may* respect First Amendment boundaries and still proscribe false claims of having been awarded the Congressional Medal of Honor. As explained below, we believe that Congress can do so.

This paper proceeds as follows. Part II addresses how the three *Alvarez* opinions deployed trademark law as a referent, but cautions against the dissent's suggestion that the Stolen Valor Act should have been conceptualized and upheld against a First Amendment challenge as a type of trademark *anti-dilution* statute. Part III explains why the Act could have been conceptualized as a trademark *anti-infringement* statute protecting the phrase "Congressional Medal of Honor" as a collective membership mark.

---

<sup>14</sup> See *id.* at 2551-52 (Breyer, J., concurring in the judgment).

<sup>15</sup> See *id.* at 2556-57 (Alito, J., dissenting).

<sup>16</sup> See Brief of the Intellectual Property Amicus Brief Clinic of the University of New Hampshire School of Law as *Amicus Curiae* in Support of Neither Party, *United States v. Alvarez*, 132 S. Ct. 2537 (2012) (No. 11-210).

<sup>17</sup> *Id.* at 4.

<sup>18</sup> See *Alvarez*, 132 S. Ct. at 2547 (Kennedy, J., plurality); *id.* at 2554-55 (Breyer, J., concurring in the judgment); *id.* at 2559 (Alito, J., dissenting).

Finally, Part IV argues that Congress may prohibit infringement of the “Congressional Medal of Honor” collective membership mark without running afoul of the First Amendment.

### I. Trademark Law as a Referent in *United States v. Alvarez*

Although never explicitly characterizing the Congressional Medal of Honor as a trademark, the Supreme Court invokes federal trademark law in the three *Alvarez* opinions as an example of one way in which federal law regulates unauthorized use of words and symbols without violating the First Amendment.<sup>19</sup> Implicit in those opinions is the notion that federal trademark enforcement measures, authorized by the U.S. Constitution’s Commerce Clause<sup>20</sup> and available when a defendant’s conduct either does or is likely to result in some sort of commercial harm,<sup>21</sup> act as useful touchstones for the Court’s interpretation of the provisions of the Stolen Valor Act. The 1946 Lanham Act is the federal statute that provides enforcement mechanisms for unauthorized use of another’s trademark.<sup>22</sup> In order to prove infringement under the Lanham Act, the trademark holder

---

<sup>19</sup> See *id.* at 2547 (Kennedy, J., plurality); *id.* at 2554-55 (Breyer, J., concurring in the judgment); *id.* at 2559 (Alito, J., dissenting).

<sup>20</sup> Federal trademark law is codified in the 1949 Lanham Act, 15 U.S.C. §§ 1051-1141 (2006), a statute enacted pursuant to Congress’s powers under the Commerce Clause of the U.S. Constitution. Compare *Trade-Mark Cases*, 100 U.S. 82, 94, 97-98 (1879) (declaring the first federal trademark registration and enforcement schemes to be unconstitutional exercises of Congress’s power because trademarks are not included in the intellectual property clause of the U.S. Constitution and because the legislation in question exceeded Congress’s authority under the Commerce Clause by encompassing purely intrastate use of marks, a matter reserved to the states for regulation), with *Steele v. Bulova Watch Co.*, 344 U.S. 280, 283-84 (1952) (interpreting the broad jurisdictional grant of the Lanham Act to extend to all commerce that Congress may lawfully regulate consonant with the Commerce Clause).

<sup>21</sup> The statute’s expressed intent is:

to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.

Lanham (Trademark) Act § 45, 15 U.S.C. § 1127 (2006).

<sup>22</sup> See 15 U.S.C. § 1127; Dawn Phleger, *The Lanham Act’s Contribution to Trademark Rights*, 12 J. CONTEMP. LEGAL ISSUES 141, 141-45 (2001) (discussing the Lanham Act’s creation of procedural rights and remedies for owners of copyrights that did not exist at common law).

must prove that the defendant's acts are likely to create confusion among the consuming public as to the commercial origin of specific goods or services or as to the mark holder's affiliation with or endorsement of the defendant.<sup>23</sup> The statute's anti-dilution provisions, on the other hand, focus not on the likelihood of harm to the consumer but upon the likelihood of harm to the intangible asset itself—either to its commercial value or to its reputation in the marketplace.<sup>24</sup> Fundamentally, the fact that the Stolen Valor Act's prohibitions are not cabined in a manner similar to federal trademark law contributes to the Court's conclusion that the provisions are overbroad;<sup>25</sup> that is, that they will intrude upon purely expressive behavior and chill the legitimate exercise of First Amendment rights.

A. *The Court's Reference to First Amendment Protections Inherent in Trademark Enforcement Law*

Citing *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*,<sup>26</sup> in which the Court upheld civil remedies designed to protect the U.S. Olympic Committee's (USOC's) trademarks from unauthorized commercial exploitation, the plurality implicitly contrasts federal trademark law with the Stolen Valor Act.<sup>27</sup> The plurality notes that the latter attempts to prohibit false statements regarding receipt of the Congressional Medal of Honor "in almost limitless times and settings" and "without regard to whether the lie was made for the purpose of material gain."<sup>28</sup> The concept of "material gain" is drawn from *San Francisco Arts & Athletics*, where it was used by the Court to uphold trademark protection for Olympic trademarks. This trademark protection is conferred by section 110 of the Amateur Sports Act of 1978,<sup>29</sup> which allows access to Lanham Act remedies without a showing of likelihood of confusion when

<sup>23</sup> See 15 U.S.C. § 1116 (providing a federal cause of action for infringement of a registered mark); *id.* § 1125(a) (providing a federal cause of action for false designation of origin, including infringement of an unregistered mark).

<sup>24</sup> See 15 U.S.C. § 1125(c) (providing a federal cause of action for dilution without regard to the presence or absence of likely confusion to the consumer). Dilution occurs when a defendant uses a mark or a trade name in commerce that is similar to the plaintiff's famous mark, resulting in either: (1) blurring, defined as impairing "the distinctiveness" of the famous mark; or (2) tarnishment, defined as harm to "the reputation" of the famous mark. *Id.* § 1125(c)(2)(B)-(C).

<sup>25</sup> See *United States v. Alvarez*, 132 S. Ct. 2537, 2547-48 (2012) (Kennedy, J., plurality). Compare 18 U.S.C. § 704 (containing broader requirements and criminal penalties), with 15 U.S.C. § 1125 (containing stricter requirements to bring suit and only civil penalties).

<sup>26</sup> 483 U.S. 522 (1987).

<sup>27</sup> *Alvarez*, 132 S. Ct. at 2547.

<sup>28</sup> *Id.*

<sup>29</sup> 36 U.S.C. § 220506 (2000).

unauthorized use of the USOC's marks is charged.<sup>30</sup> The Court found the Act's provisions to be a reasonable response on the part of Congress to protect the USOC's "legitimate property right," which could be both diluted and infringed by the defendant's commercial and promotional activities, conduct from which it stood "to profit . . . without paying the customary price."<sup>31</sup> Specifically, the Court opined that Congress could reasonably have determined that an explicit likelihood of confusion requirement is unnecessary because most commercial uses of the Olympic words and symbols are likely to be confusing and, for those that are not, the risk of diminishing the distinctiveness of the marks remains, giving rise to anti-dilution measures not reliant on a showing of likely confusion.<sup>32</sup>

Although Justice Breyer's opinion concurring in the judgment explicitly analogizes federal trademark law to the Stolen Valor Act, it distinguishes the statutory schemes by also expressing concerns regarding the breadth of the challenged provision:

But trademark statutes are focused upon commercial and promotional activities that are likely to dilute the value of a mark. Indeed, they typically require a showing of likely confusion, a showing that tends to assure that the feared harm will in fact take place.

. . . .

The statute before us lacks any such limiting features.<sup>33</sup>

Like the plurality, the opinion concurring in the judgment references both infringement and dilution as legitimate concerns motivating regulation of unauthorized use of another's symbols, and finds the Stolen Valor Act overbroad because it lacks the limiting principles upon which the two enforcement doctrines depend.<sup>34</sup> The cited excerpt from the concurring opinion appears to conflate both enforcement doctrines, but the point remains that the Court sees neither doctrinal limitation as informing the Stolen Valor Act.

The dissenting opinion takes the strongest stand on the applicability of trademark law and draws a direct analogy between protecting the phrase "Congressional Medal of Honor" and protecting famous trademarks associated with status goods through the dilution doctrine. Citing *San Francisco Arts & Athletics*, the dissent notes:

---

<sup>30</sup> See *S.F. Arts & Athletics*, 483 U.S. at 541.

<sup>31</sup> *Id.* & n.19 (quoting *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562 (1985) (internal quotation marks omitted)).

<sup>32</sup> *Id.* at 539.

<sup>33</sup> *Alvarez*, 132 S. Ct. at 2554 (Breyer, J., concurring in the judgment).

<sup>34</sup> *Id.* at 2555-56.

It is well recognized in trademark law that the proliferation of cheap imitations of luxury goods blurs the signal given out by the purchasers of the originals. . . . In much the same way, the proliferation of false claims about military awards blurs the signal given out by the actual awards by making them seem more common than they really are, and this diluting effect harms the military by hampering its efforts to foster morale and esprit de corps. Surely it was reasonable for Congress to conclude that the goal of preserving the integrity of our country's top military honors is at least as worthy as that of protecting the prestige associated with fancy watches and designer handbags.<sup>35</sup>

Interestingly, the dissenting opinion makes no reference to the trademark doctrine of infringement—the only traditional trademark enforcement doctrine for which criminal penalties are available<sup>36</sup>—and then, only when the infringement amounts to counterfeiting, and the government has proven the defendant's knowing and intentional use of a counterfeit mark.<sup>37</sup>

#### B. *Observations on the Court's Invocation of the Dilution Doctrine*

Since enactment of the Lanham Act's original anti-dilution provisions in 1996,<sup>38</sup> the dilution doctrine has come under criticism for extending the reach of federal trademark law too far. Although the Lanham Act confines dilution protection to famous marks—those marks that are “widely recognized by the general consuming public of the United States as a

---

<sup>35</sup> *Id.* at 2559 (Alito, J., dissenting) (internal citations and quotation marks omitted).

<sup>36</sup> The authors categorize statutes directed to the fraudulent use of specific words and symbols, such as those enumerated in *San Francisco Arts & Athletics*, as fraud statutes and not traditional trademark enforcement schemes. See *S.F. Arts & Athletics*, 483 U.S. at 532 n.8 (citing criminal sanctions for fraudulent use of “Red Cross,” “Smokey Bear,” etc.).

<sup>37</sup> Section 2320 of Title 18 establishes criminal penalties for unauthorized use of a mark that is identical to or substantially indistinguishable from a mark registered on the Principal Register of the United States Patent and Trademark Office when: (1) the use is in conjunction with the goods or services listed in the registration or on patches or other items intended for attachment to such goods; (2) the use amounts to the defendant's intentional trafficking in counterfeit goods or services knowing the mark to be counterfeit; and (3) the use of which is likely to cause confusion. Proof of likelihood of confusion was included as an element of the offense “to ensure that no conduct will be criminalized by this act that does not constitute trademark infringement under the Lanham Act.” See 130 CONG. REC. 31,675 (1984) (Joint Legislative Explanatory Statement to the Trademark Counterfeiting Act of 1984, Pub. L. No. 98-473, 98 Stat. 2178). Counterfeiting is a subset of infringing conduct that Congress deems to be the most egregious type of infringement and, therefore, appropriate for criminal penalties. *Id.*

<sup>38</sup> Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985, 985 (codified at 15 U.S.C. §§ 1125(c)(1), 1127 (2006)).



designation of source of the goods or services of the mark's owner"<sup>39</sup>—it requires only that such use is likely to result in blurring or tarnishment of the mark, irrespective of any consumer confusion the use may cause as to commercial origin of particular goods or services or with regard to sponsorship or endorsement.<sup>40</sup> Critics argue that the dilution doctrine's disregard for likelihood of confusion threatens freedom of expression because it may render a particular word or phrase proprietary, beyond the specific goods or services with which it is in use,<sup>41</sup> a concept known as a "trademark in gross."<sup>42</sup> Additionally, scholars urge that the difficulty in articulating the harm in dilution cases evidences the ill-defined nature of the wrong and could lead to over-enforcement and consequent chilling of speech.<sup>43</sup> These concerns are bounded by the Lanham Act's requirement that the defendant's unauthorized use of the famous mark must be a trademark use made in commerce, as well as the Act's explicit fair use and noncommercial use exclusions, although arguably these boundaries provide ineffective protection for freedom of expression against the still amorphous concept of dilution.<sup>44</sup>

---

<sup>39</sup> Lanham Act § 43(c)(1)-(2)(A), 15 U.S.C. § 1125 (c)(1)-(2)(A) (2006).

<sup>40</sup> See *supra* note 20 and accompanying text.

<sup>41</sup> See, e.g., Paul Alan Levy, *The Trademark Dilution Revision Act—A Consumer Perspective*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1189, 1192-93 (2006) (criticizing trademark enforcement through dilution law "because it extends protection to trademarks as an asset apart from their sole function of protecting consumers against confusion, and which, indeed, is used to suppress completely truthful and non-confusing commercial speech by other merchants").

<sup>42</sup> *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918) ("There is no such thing as property in a trade-mark except as a right appurtenant to an established business or trade in connection with which the mark is employed.").

<sup>43</sup> See Christine Haight Farley, *Why We Are Confused About the Trademark Dilution Law*, 16 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1175, 1184 (2006) (opining that the reason trademark holders have difficulty defining actual dilution is because it does not exist); see also Mary LaFrance, *No Reason to Live: Dilution Laws as Unconstitutional Restrictions on Commercial Speech*, 58 S.C. L. REV. 709, 718 (2007) ("[D]ilution is the 'vaporware' of trademark law. The harms which dilution laws are designed to prevent, or remedy, or both, cannot be clearly defined and have not been proven to exist."); Levy, *supra* note 41, at 1194 (characterizing dilution as "a fuzzy concept" with the potential to needlessly limit expression).

<sup>44</sup> See generally LaFrance, *supra* note 43 (taking the position that federal dilution provisions do not satisfy the *Central Hudson* test for constitutional regulation of commercial speech and urging a moratorium on injunctive relief until harm from dilution may be better assessed); Farley, *supra* note 43, at 1183 (characterizing the trademark bar's enthusiastic support of federal anti-dilution measures as a desire for "statutorily enforced mind control"); Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After Eldred*, 44 LIQUORMART, and Bartnicki, 40 HOUS. L. REV. 697, 732-39 (2003) (arguing that trademark dilution law should not be used to justify restrictions on the use of specific words in non-misleading commercial speech because such speech may contribute to the fabric of human experience on a variety of

The concurring and dissenting opinions in *United States v. Alvarez* make no mention of such concerns, but suggest that protection from dilution might account for the prohibitions in the Stolen Valor Act in a manner similar to the role such protection played in the passage of civil penalties for unauthorized use of the USOC's trademarks.<sup>45</sup> The legislative history of the respective statutes, however, does not support the analogy.<sup>46</sup> The principal motivation behind passage of section 110 of the Amateur Sports Act of 1978 was to enable the USOC to be self-funding through a strong licensing program that could be effectively enforced, thereby making such licenses an attractive proposition to potential corporate sponsors.<sup>47</sup> Omitting a likelihood of confusion requirement and establishing a violation of the statute for unauthorized use of the word "Olympic" or any related mark for commercial or promotional purposes, regardless of the goods or services involved, evidences Congress's intent to create dilution-like protection in addition to infringement protection.<sup>48</sup> This approach lessens the USOC's burden of proof substantially when enforcing its marks, freeing it from heavy litigation expenses and allowing it to channel precious resources in support of its mission.<sup>49</sup> In fact, section 110 repealed criminal penalties for the same conduct undertaken with fraudulent intent because Congress determined proof of criminal intent to be "unworkable," thereby hampering enforcement of the marks and their value as merchandising properties.<sup>50</sup>

---

noncommercial levels, and because the legal system should not be in the business of suppressing speech in order to preserve customer attitudes).

<sup>45</sup> *United States v. Alvarez*, 132 S. Ct. 2537, 2554-55 (2012) (Breyer, J., concurring in the judgment); *id.* at 2559 (Alito, J., dissenting).

<sup>46</sup> See *infra* notes 47-54 and accompanying text.

<sup>47</sup> See *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 538-39 (1987) ("Section 110 directly advances [the USOC's mission] by supplying the USOC with the means to raise money to support the Olympics and encourages the USOC's activities by ensuring that it will receive the benefits of its efforts."); see also Steven B. Hay, *Guarding the Olympic Gold: Protecting the Marketability of Olympic Trademarks Through Section 110 of the Amateur Sports Act of 1978*, 16 Sw. U. L. REV. 461, 469-72 (1986) (discussing Congress's intent in passing section 110 to strengthen the Olympic designations and provide for their effective enforcement as a means of supporting the USOC's corporate sponsorship program).

<sup>48</sup> See Hay, *supra* note 47, at 471 n.55.

<sup>49</sup> *Id.* at 494-95 (contrasting the more extensive proof requirements in a traditional infringement action with those arising under section 110 and noting the lack of expensive survey evidence necessary to prevail in the latter action).

<sup>50</sup> H.R. REP. NO. 95-1627, at 10 (1978), *reprinted in* 1978 U.S.C.C.A.N. 7478, 7483. Congress re-enacted criminal penalties for such conduct in the Trademark Counterfeiting Act of 1984. Although 18 U.S.C. § 2320 now authorizes criminal penalties for such conduct, assuming it rises to the level of counterfeiting of the Olympic marks, the intent requirement is confined to a showing that the defendant intentionally trafficked in goods that it knew bore a counterfeit

Nowhere in the legislative history of the Stolen Valor Act does a similar concern for the ability to self-fund through trademark enforcement appear. On the other hand, a concern that unauthorized use of the phrase “Congressional Medal of Honor” to self-identify will confuse those to whom the representation is made permeates the legislative history of the Stolen Valor Act.<sup>51</sup> Just as the Court observed in *San Francisco Arts*, Congress may well have concluded that an express likelihood of confusion element was unnecessary in the Stolen Valor Act because most unauthorized uses are likely to be confusing.<sup>52</sup> Nor is the failure to confine the prohibitions in the Act to defendants’ unauthorized commercial use surprising, given that the phrase in question, “Congressional Medal of Honor,” functions as a collective membership mark in the context of the Act<sup>53</sup>, and the sole purpose of extending federal protection to such marks is to protect them from commercial exploitation.<sup>54</sup> In light of the persistent concerns attendant to the dilution doctrine, protection of “Congressional Medal of Honor” as a collective membership mark is better achieved through the trademark enforcement mechanism of infringement, and if criminal penalties are at issue, through the targeted subset of counterfeiting measures.

## II. Viewing the Phrase “Congressional Medal of Honor” Through a Trademark Lens

The phrase “Congressional Medal of Honor” performs a trademark function by distinguishing recipients of the nation’s highest military honor from non-recipients.<sup>55</sup> In this fashion, the phrase behaves like a collective membership mark, particularly so because Congress chartered a collective organization, the Congressional Medal of Honor Society, over fifty years ago and directed that its membership be comprised solely of recipients of the Medal.<sup>56</sup> As with any other type of trademark, a collective membership mark may be protected through available trademark enforcement mechanisms.<sup>57</sup> Because no reason exists to confine those mechanisms to the civil arena, congressional imposition of criminal penalties for falsely claiming to be a member of this elite group is a reasonable response to concerns that its collective membership mark is being infringed, assuming

---

mark. 18 U.S.C. § 2320 (2006).

<sup>51</sup> See *infra* notes 66-67 and accompanying text.

<sup>52</sup> *S.F. Arts & Athletics, Inc.*, 483 U.S. at 539.

<sup>53</sup> See *infra* notes 74-76 and accompanying text.

<sup>54</sup> See *infra* notes 71-73 and accompanying text.

<sup>55</sup> See *United States v. Alvarez*, 132 S. Ct. 2537, 2559 (2012) (Alito, J., dissenting).

<sup>56</sup> See *infra* notes 87-92 and accompanying text.

<sup>57</sup> See *infra* notes 77-78 and accompanying text.

Congress's scheme has appropriate limitations in place.

A. *The Stolen Valor Act Bans False Statements of Association or Affiliation.*

The Stolen Valor Act arose as an amendment to 18 U.S.C. § 704.<sup>58</sup> Until the effective date of the amendment in 2006, § 704 prohibited an individual from falsely identifying oneself with Medal recipients, but only insofar as such conduct took the form of wearing or displaying an actual Medal or colorable imitation of the Medal.<sup>59</sup> The purpose of the Act was to extend imposition of criminal penalties to encompass knowing false verbal or written representations about one's receipt of the Medal in order to close a perceived gap in the statutory scheme.<sup>60</sup> Prior to passage of the Act, Congress estimated that over 250 imposters existed who were beyond the reach of the law because their false claims of receiving the Medal were purely oral or written in nature.<sup>61</sup> In fact, an additional count against Alvarez charged him with making the same false oral representation in a meeting with the Pomona Police Officer's Association in November 2005, when he was seeking the group's endorsement of his candidacy for mayor of Pomona.<sup>62</sup> The second count was dismissed, however, apparently because Alvarez's November 2005 statement was made before the amendment's 2006 effective date.<sup>63</sup> Passage of the Act put false claimants

<sup>58</sup> Stolen Valor Act of 2005, Pub. L. No. 109-437, 120 Stat. 3266, 3266 (2006).

<sup>59</sup> Military Medals of Decorations, 10 U.S.C. § 704 (2001) (amended 2006), *invalidated by* United States v. Alvarez, 132 S. Ct. 2537 (2012).

<sup>60</sup> See 152 CONG. REC. H8748, H8821 (daily ed. Dec. 6, 2006) (statement of Rep. John Salazar). One of the authors of the legislation, U.S. Representative John Salazar, offered the following observations about the proposed amendment:

Current law basically allows Federal law enforcement to prosecute individuals who physically wear medals on their person. The problem has been occurring where individuals are claiming to have earned these medals and there is no way for authorities to be able to prosecute these individuals. These frauds and these phonies have diminished the meaning and the honor of the recognitions received by our military heroes.

In addition to diminishing the meaning, on several occasions phonies have used their stature as a decorated war hero to gain credibility that allows them to commit more serious frauds.

*Id.*

<sup>61</sup> *Id.* at H8820.

<sup>62</sup> First Superseding Information at 2, United States v. Alvarez, 132 S. Ct. 2537 (2012) (No. 07-0135(A)-ER); Will Bigham, *Alvarez to Face More Charges*, SAN GABRIEL VALLEY TRIB., Jan. 13, 2008.

<sup>63</sup> See Judgment and Commitment at 2, United States v. Alvarez, 132 S. Ct. 2537 (2012) (No.

such as Alvarez within the reach of federal prosecutors.

In the legislative history of the Act, Congress acknowledged that Congressional Medal of Honor impersonators are motivated by a desire to identify themselves with the heroic characteristics of actual recipients.<sup>64</sup> But Congress also explicitly recognized the damaging nature of such conduct.<sup>65</sup> Whether done to perpetrate fraudulent activity or simply to aggrandize oneself in the eyes of others, false identification with this distinguished group “denigrate[s]” and “dishonor[s]” the collective members of the group.<sup>66</sup> Congress sought to return to Medal recipients “the dignity and respect taken by those who have stolen it” by enacting the Stolen Valor Act.<sup>67</sup>

B. *Trademark Infringement Law Regulates False Statements of Association or Affiliation.*

Generally, trademarks function by distinguishing the goods or services of one commercial entity from those of another.<sup>68</sup> Collective membership marks, however, are a non-traditional type of trademark in that they do not indicate the commercial origin of goods or services; such marks serve solely to indicate membership in a group, such as a fraternal society, a cooperative, or a trade union.<sup>69</sup> Prior to enactment of the 1946 Lanham Act, which established the current system of federal registration,<sup>70</sup> collective membership marks were not considered the proper subject of federal registration due to the fact that they are not used in conjunction with the marketing of goods or services.<sup>71</sup> This change in legislative stance was

07-0135(A)-RGK).

<sup>64</sup> See 152 CONG. REC. at H8820-21.

<sup>65</sup> *Id.* at H8820.

<sup>66</sup> *Id.* at H8821.

<sup>67</sup> *Id.*

<sup>68</sup> See Lanham Act § 45, 15 U.S.C. § 1127 (2006) (statutory definition of “mark”); see also *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412 (1916) (pre-Lanham Act decision).

<sup>69</sup> 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:101, at 19-311 to 19-312 (4th ed. 2012) (noting that collective membership marks “are unique in the Lanham Act in that they are the only registrable symbols that are not used by the sellers of anything”); see also U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1304.08(d) (Catherine P. Cain, ed., 8th ed. 2011) (hereinafter TMEP), available at [http://tess2.uspto.gov/tmdb/tmep\\_8ed/](http://tess2.uspto.gov/tmdb/tmep_8ed/) (“An identification of goods or services is not appropriate in connection with a collective membership mark. The purpose of a collective membership mark is to indicate membership in an organization.”).

<sup>70</sup> See 1 ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 1.04[2][a] (2012) (“The Lanham Act, a product of many years of effort to overhaul the antiquated 1905 Trademark Act, is the U.S. federal statute covering trademark registration and trademark infringement actions.”).

<sup>71</sup> See Trademark Act of 1905 § 5(b), 15 U.S.C. § 85(b) (repealed 1946) (prohibiting federal

highlighted in an early post-Lanham Act decision overturning a trademark examiner's refusal to register the phrase, "Order of the White Shrine of Jerusalem," for "organizing subordinate shrines in an international fraternal society; maintaining membership therein and furthering the civic and educational ideals thereof."<sup>72</sup> The decision, issued by the Commissioner of Patents, notes:

Applicant is not engaged in a business or trade. It is what is commonly termed a "fraternal society" which promotes fellowship among its members and performs charitable and civic services as it sees fit. It sells neither goods nor services.

. . . .

It seems obvious that the effect of the change in the legislation was to permit fraternal societies and other organizations to register their names and insignia so that the registration could be used to prevent registration of such names and insignia to others who might use them commercially, rather than to have the Patent Office rely on its own knowledge of all such names and insignia . . . .

Such marks are not trademarks in the ordinary sense of the term, but they are nevertheless identifying and distinguishing marks which are registrable under the specific terms of the statute.<sup>73</sup>

The Act protects marks from infringing uses that arise when one party uses a commercial designation in such a way as to create a likelihood of confusion with regard to its association or affiliation with another or with regard to the origin of their respective goods or services.<sup>74</sup> When a collective membership mark is in issue, courts measure likelihood of confusion, not by reference to "ordinary purchasers" as in the usual infringement action,<sup>75</sup> but by reference to "relevant persons," i.e., "those persons or groups of persons for whose benefit the membership mark is displayed."<sup>76</sup> Although collective membership marks are atypical

---

registration of identifying names and insignia of fraternal organizations or similar clubs or societies); *see also* TMEP, *supra* note 69, at § 1304.01 (briefly describing the history of collective membership marks).

<sup>72</sup> *Ex parte* The Supreme Shrine of the Order of the White Shrine of Jerusalem, 109 U.S.P.Q. (BNA) 248, 249-50 (Dec. Comm'r Pat. 1956).

<sup>73</sup> *Id.*

<sup>74</sup> With regard to traditional trademarks, courts analyze likelihood of confusion by examining and balancing a variety of factors including, among other things, the strength of the plaintiff's mark, the similarity of the parties' marks and their respective goods or services, evidence of actual confusion in the marketplace, and the defendant's intent. *See generally* MCCARTHY, *supra* note 69, § 23:19.

<sup>75</sup> *E.g.*, McLean v. Fleming, 96 U.S. 245, 251 (1877).

<sup>76</sup> *See, e.g.*, Carefirst of Md., Inc. v. FirstHealth of the Carolinas, Inc., 77 U.S.P.Q.2d (BNA)

trademarks, they are subject to the same protection as other types of marks under the Lanham Act.<sup>77</sup> And, in fact, the need to protect these marks from unauthorized commercial exploitation is the reason Congress explicitly included such marks in the provisions of the Lanham Act.<sup>78</sup>

C. *The Phrase “Congressional Medal of Honor” Functions as a Collective Membership Mark.*

Under the Lanham Act, governmental entities may own, register, and enforce trademarks, including collective membership marks,<sup>79</sup> and, although the marks may be federally registered, there is no registration requirement for purposes of enforcement at the federal level.<sup>80</sup> The federal government reserves the phrase “Congressional Medal of Honor” to designate members of the U.S. armed services who have distinguished themselves through conspicuous gallantry and disregard for personal safety while engaged in conflict on behalf of the nation’s military.<sup>81</sup> These

1492, 1513 (T.T.A.B. 2005).

<sup>77</sup> *Carefirst of Md., Inc. v. First Care, P.C.*, 350 F. Supp. 2d 714, 715, 723 & n.9 (E.D. Va. 2004).

<sup>78</sup> *See id.* at 725-26.

<sup>79</sup> Lanham Act § 4, 15 U.S.C. § 1054 (2006) (authorizing “nations, States, municipalities, and the like” to register collective marks). As used in the Lanham Act, the term “collective mark” not only includes trademarks or service marks used by the members of a cooperative, an association, or other collective group or organization but also encompasses marks used by a collective entity’s members to indicate membership in that entity, generally referred to as “collective membership marks.” Lanham Act § 45.

Examples of federally-registered collective membership marks belonging to a department or agency of the U.S. government include: “SEAL,” U.S. Reg. No. 3,285,473, “indicating membership in an organization of applicant that develops and executes military missions involving special operations strategy, doctrine, and tactics,” registered by the Department of the Navy; “MEDICAL RESERVE CORPS” and Design, U.S. Reg. No. 3,007,633, indicating “membership in a group of service-providers who have an established group of practicing and retired physicians, nurses, and other health professionals to act in a coordinated manner in times of local emergencies,” registered by the Office of the Surgeon General; “AIRBORNE A A” and Design, U.S. Reg. No. 2,487,176, “indicating membership in the United States Army 82nd Airborne Division,” registered by the Department of the Army.

Brief of the Intellectual Property Amicus Brief Clinic of the University of New Hampshire Law School as Amicus Curiae in Support of Neither Party at 12 n.21, *United States v. Alvarez*, 132 S. Ct. 2537 (2012) (No. 11-210).

<sup>80</sup> *See, e.g., Nat’l Bd. of Young Women’s Christian Assoc. of U.S.A. v. Young Women’s Christian Assoc. of Charleston, S.C.*, 335 F. Supp. 615, 619, 621 (D.S.C. 1971).

<sup>81</sup> 1 *Manual of Military Decorations and Awards*, in DEP’T OF DEF. MANUAL § 1348.33, at 31-32 (Nov. 23, 2010) (incorporating change Oct. 12, 2011).

individuals receive the nation's highest military award.<sup>82</sup> The actual title of the honor, awarded by the President in the name of Congress, is "Medal of Honor"; the award is made under separate statutory authorization to members of each branch of the armed services.<sup>83</sup> Section 704(c)(2) of Title 18 uses the composite phrase "Congressional Medal of Honor" to refer to the Medal as awarded to members of all branches of the armed services, or to duplicates or replacements of the Medal.<sup>84</sup>

The owner of a collective membership mark need not be a collective organization itself but may form a collective for the benefit of specific individuals,<sup>85</sup> so long as the owner exercises legitimate control over the collective and that entity's members' use of the mark.<sup>86</sup> In 1958, Congress extended a federal charter to the Congressional Medal of Honor Society,<sup>87</sup>

<sup>82</sup> See *id.* (listing criteria for award of the Medal of Honor).

<sup>83</sup> See, e.g., 10 U.S.C. §§ 3741, 6241 (2006) (Army, Naval Services); 10 U.S.C. § 8741 (2006) (Air Force); 14 U.S.C. § 491 (2006) (Coast Guard).

<sup>84</sup> 18 U.S.C. § 704(c)(2) (2006).

<sup>85</sup> See *In re Stencil Aero Eng'g Corp.*, 170 U.S.P.Q. (BNA) 292, 292-93 (T.T.A.B. 1971) (explaining how an applicant for federal registration of "GRASSHOPPER CLUB" is a manufacturer of aircraft escape equipment and may register the phrase as a collective membership mark for a club that it formed for persons who have escaped disabled aircraft utilizing the company's equipment).

<sup>86</sup> *Id.*; see also Lanham Act § 4, 15 U.S.C. § 1054 (2006) (explaining how collective marks are registrable by those persons and entities exercising "legitimate control" over use of the marks); TMEP, *supra* note 69, at § 1304.08(f)(i) (explaining that an application for federal registration of a collective membership "must assert that the applicant has a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members"). Note that the minimal "legitimate control" requirement does not rise to the level of an obligation to exercise any level of quality control as would be required of a trademark licensor. See, e.g., *The Collective Trademark: Invitation to Abuse*, 68 YALE L.J. 528, 536 n.52 (1958-1959) (explaining how the Lanham Act § 4 requires only that a collective-mark association exercise "legitimate control over use of the mark" to obtain registration).

<sup>87</sup> The Congressional Medal of Honor Society was organized in 1948 by a group of recipients of the Medal

for the purpose of providing a common ground on which all recipients of the Congressional Medal of Honor may meet to preserve the dignity of the Nation's highest award; to protect the medal and the holders thereof from exploitation or other improper action; to provide assistance as may be needed by holders of the medal and their dependents; to bring the medal to the attention of the public wherever possible to inspire the youth of the Nation; and to serve our country in all proper ways in peace as its holders did in time of war.

H.R. REP. NO. 85-2322, at 11 (1958) (H. Comm. on the Judiciary). Accepting that the Society was possessed of "a meritorious purpose," the 85th Congress extended a federal charter to the Society that was signed into law by President Dwight D. Eisenhower. *Id.*; see also *Society History*, CONG. MEDAL OF HONOR SOC'Y, <http://www.cmohs.org/society-history.php> (last



the Society's purposes are in the statutory charter, including, among other things, "to protect the name of the medal . . . from exploitation"<sup>88</sup> and "to protect, uphold, and preserve the dignity and honor of the medal at all times and on all occasions."<sup>89</sup> Membership in the Society is restricted to recipients of the Medal and honorary memberships are prohibited.<sup>90</sup> The Society possesses the usual corporate powers, but the Society, its directors, and its officers are restricted by statute from participating in any political activity.<sup>91</sup> Today, the Society provides a platform for its members to engage in educational outreach, fundraising for scholarships, and a variety of other initiatives.<sup>92</sup> The restrictions in the Society's congressional charter concerning membership and the legislative direction regarding protection of the phrase "Congressional Medal of Honor" from exploitation and suffering public indignities indicates that Congress exercises the requisite control over the collective and use of the mark by the collective's members.

### III. Congress May Prohibit Infringement of the "Congressional Medal of Honor" Collective Membership Mark Without Violating the First Amendment.

As explained in the Introduction, at no point during the course of the trial and appellate proceedings in *Alvarez* did the Government seek to defend the constitutionality of the Stolen Valor Act under a trademark theory. Rather, the case was litigated on the assumption that the statute's constitutionality under the First Amendment turned on whether false statements of fact fall within a category of speech fully outside the protection of the First Amendment.<sup>93</sup> It is therefore unsurprising that the Supreme Court invalidated the Act on its face once a plurality of four Justices concluded that false statements generally do not constitute a category of speech with a long (if heretofore unrecognized) tradition of being proscribed on the basis of their content,<sup>94</sup> and two Justices concurred in the plurality's judgment that the statute violated the First Amendment.<sup>95</sup>

---

visited Feb. 19, 2012).

<sup>88</sup> 36 U.S.C. § 40502(3) (2006).

<sup>89</sup> *Id.* § 40502(2).

<sup>90</sup> *Id.* § 40503(a).

<sup>91</sup> *Id.* §§ 40505, 40506(b).

<sup>92</sup> See generally CONG. MEDAL OF HONOR SOC'Y, <http://www.cmohs.org> (last visited Feb. 19, 2013). The Society's activities in this regard are aided and supported by the Congressional Medal of Honor Foundation, a charitable corporation founded by the Society. See generally CONG. MEDAL OF HONOR FOUND., <http://www.cmohfoundation.org> (last visited Feb. 19, 2013).

<sup>93</sup> See *United States v. Alvarez*, 132 S. Ct. 2537, 2542-51 (2012).

<sup>94</sup> See *id.* at 2547.

<sup>95</sup> See *id.* at 2551 (Breyer, J., concurring in the judgment) (explaining that he and Justice Kagan agree with the plurality that the Act violates the First Amendment but resting his

True, as summarized above, all three of the *Alvarez* opinions made references of varying degrees of explicitness to federal trademark law.<sup>96</sup> Again, the plurality implicitly contrasted the Stolen Valor Act with trademark law by citing a prior Supreme Court decision upholding a trademark statute against a First Amendment challenge.<sup>97</sup> The Court also observed that, in contrast to the upheld measure, the Act prohibits false statements regarding receipt of the Medal “in almost limitless times and settings”<sup>98</sup> and “without regard to whether the lie was made for the purpose of material gain.”<sup>99</sup> The concurrence explicitly analogized federal trademark law to the Act, but, conflating trademark infringement and dilution theories, contrasted the statute’s breadth with trademark law,<sup>100</sup> which focuses on commercial and promotional activities that are likely to dilute the value of a mark and typically requires a showing of likely consumer confusion.<sup>101</sup> The dissent, in contrast, favorably analogized the Act to a trademark *dilution* statute; it did not refer to trademark *infringement* statutes, which are the only provisions of federal law that authorize *criminal* actions.<sup>102</sup> But none of the *Alvarez* opinions went so far as to consider the Act as an anti-infringement statute protecting “Congressional Medal of Honor” as a collective membership mark.

Yet, as explained, it is entirely plausible to view the Stolen Valor Act in just such a way. Moreover, if the Government had defended the statute on this ground, we believe that the Court could have upheld it against a First Amendment challenge<sup>103</sup>—at the very least facially<sup>104</sup>—under the

---

conclusion not on a “strict categorical analysis” but rather on the view that “the Government can achieve its legitimate objectives in less restrictive ways”).

<sup>96</sup> See *supra* Part II.A.

<sup>97</sup> See *Alvarez*, 132 S. Ct. at 2547 (citing *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 539-40 (1987)).

<sup>98</sup> *Id.*

<sup>99</sup> See *id.* (noting that *San Francisco Arts & Athletics* recognized the authority of Congress to enact a trademark law “prohibiting a nonprofit corporation from exploiting the ‘commercial magnetism’ of the word ‘Olympic’ when organizing an athletic competition”).

<sup>100</sup> See *id.* at 2554 (Breyer, J., concurring in the judgment) (“Trademarks identify the source of a good; and infringement causes harm by causing confusion . . . thereby diluting the value of the mark to its owner, to consumers, and to the economy. Similarly, a false claim of possession of a medal or other honor creates confusion . . . thus diluting its value to those who have earned it, to their families, and to their country.”).

<sup>101</sup> *Id.*

<sup>102</sup> See *id.* at 2559 (Alito, J., dissenting).

<sup>103</sup> In the *Alvarez* litigation, questions arose as to whether the Stolen Valor Act violated due process by failing to contain minimal scienter requirements necessary to ground a criminal conviction. See *Alvarez*, 132 S. Ct. at 2552-53 (Breyer, J., concurring in the judgment) (reading a scienter requirement into the statute that was necessitated by due process concerns). This paper offers no position on whether the Stolen Valor Act was unconstitutional on grounds

infringement analysis the Court endorsed in *San Francisco Arts & Athletics*. But in any event, the Stolen Valor Act has been invalidated.<sup>105</sup> Thus, the important point for present purposes is that, if Congress should wish to enact legislation that constitutionally proscribes false statements of the sort uttered by Xavier Alvarez, it would do well to heed *San Francisco Arts & Athletics* and enact a statute making clear that it is proscribing *infringements* of the Congressional Medal of Honor Society's collective membership mark.<sup>106</sup>

*San Francisco Arts & Athletics* involved a First Amendment challenge to the constitutionality of a federal statute that granted the USOC the right to prohibit certain commercial and promotional uses of the word "Olympic."<sup>107</sup> Exercising that right, the USOC obtained an injunction prohibiting the petitioner from promoting an athletic event under the name "Gay Olympic Games."<sup>108</sup> Petitioner challenged the injunction before the Supreme Court, arguing, in relevant part, that the statute violated the First Amendment by authorizing the USOC to prohibit use of the word "Olympic" without showing that such use was likely to confuse the public.<sup>109</sup>

---

other than the First Amendment.

<sup>104</sup> Of course, the Supreme Court ordinarily exempts First Amendment challenges from the rule that a successful facial attack on a statute requires the challenger to establish "that no set of circumstances exists under which [the statute] would be valid." *United States v. Stevens*, 130 S. Ct. 1577, 1587 (2010) (explaining that, in the First Amendment context, a statute will be invalidated as overbroad under the First Amendment "if a substantial number of its applications are unconstitutional, judged in relation to [its] plainly legitimate sweep" (citation and internal quotation marks omitted)). But a statute regulating commercial speech—which the Stolen Valor Act would be if it were characterized as a trademark infringement statute—is likely not subject to this exception. See *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 536 n.15 (1987) (noting that the application of the overbreadth doctrine to a commercial speech regulation "is highly questionable" (citing *Ohralik v. Ohio State Bar Assn.*, 436 U.S. 447, 462 n.20 (1978))).

<sup>105</sup> See *Alvarez*, 132 S. Ct. at 2551.

<sup>106</sup> The U.S. House of Representatives recently passed a bill outlawing false claims of having been awarded the Congressional Medal of Honor made with fraudulent intent to obtain "money, property, or other tangible benefit." See *Stolen Valor Act of 2012*, H.R. 1775, 112th Cong. § 2(b) (2012). The pending legislation tracks the approach taken by the precursor statute to section 110 of the Amateur Sports Act of 1978, imposing criminal sanctions for fraudulent claims of affiliation, etc. Pub. L. No. 95-606, 92 Stat. 3048, § 110 (1978). Such an approach suffers from the same enforcement drawbacks as the precursor to section 110. Crafting the statute to function as an anti-infringement measure will protect the phrase "Congressional Medal of Honor" from false claims that one is a recipient of the Medal far more effectively and it would do so within constitutional bounds. See *supra* Part II.B.

<sup>107</sup> See generally *S.F. Arts & Athletics*, 483 U.S. at 532-41.

<sup>108</sup> See *id.* at 525-27.

<sup>109</sup> *Id.* at 532.

In assessing petitioner's argument, the Court concluded that the constitutionality of the infringement on petitioner's commercial and promotional speech rights effected by the statute should be assessed under variants of intermediate First Amendment scrutiny.<sup>110</sup> Insofar as petitioner was precluded from engaging in commercial speech, the Court applied the test authorized in *Central Hudson Gas & Electric Corp. v. Public Service Commission of New York*,<sup>111</sup> which holds that a restriction on non-misleading commercial speech is valid if the government's interest in the restriction is substantial, directly advances the government's asserted interest, and is no more extensive than necessary to serve that interest.<sup>112</sup> Insofar as petitioner was precluded from engaging in non-commercial speech, the Court applied the balancing test prescribed in *United States v. O'Brien*,<sup>113</sup> which applies to measures that incidentally restrict speech while seeking to further substantial non-speech purposes.<sup>114</sup> Explaining that the application of these two balancing tests to the facts of the case was "substantially similar,"<sup>115</sup> the Court concluded that the challenged statute passed constitutional muster even without a "likelihood of confusion" requirement.<sup>116</sup>

According to the Court, the statute directly advanced the government's substantial interest in incentivizing the USOC to produce a quality product that would benefit the public and promote amateur competition in the Olympic Games by American athletes.<sup>117</sup> And it did so by functioning as trademark statutes do: by seeking to ensure that the USOC receives the benefits, including monetary compensation, for its own commercial and promotional efforts.<sup>118</sup> The absence of a "likelihood of confusion" requirement did not render the statute unconstitutional,<sup>119</sup> for Congress reasonably could have concluded that *most* commercial uses of the Olympic words and symbols were likely to be confusing and thus likely to infringe the USOC's mark.<sup>120</sup> The possibility that *some* statutory violations would not confuse the public, or that *some* statutory violations would involve non-commercial speech, was not sufficient to warrant *facial*

---

<sup>110</sup> See *id.* at 535-41.

<sup>111</sup> 447 U.S. 557, 566 (1980).

<sup>112</sup> See *S.F. Arts & Athletics*, 483 U.S. at 537 n.16.

<sup>113</sup> 391 U.S. 367, 377 (1968).

<sup>114</sup> See *S.F. Arts & Athletics*, 483 U.S. at 537 n.16.

<sup>115</sup> *Id.*

<sup>116</sup> See *id.* at 537-41.

<sup>117</sup> See *id.* at 537.

<sup>118</sup> See *id.* at 537-39.

<sup>119</sup> See *id.* at 539, 565 n.25.

<sup>120</sup> See *S.F. Arts & Athletics*, 483 U.S. at 539.

invalidation of the statute and frustration of the non-speech-related purposes that it sought to advance.<sup>121</sup>

If the Supreme Court had read the Stolen Valor Act as a trademark infringement statute protecting the Congressional Medal of Honor Society's collective membership mark, and if the Court had followed the reasoning adopted and applied in *San Francisco Arts & Athletics*, it could have upheld the statute's prohibition on falsely claiming to have been awarded the Congressional Medal of Honor against Xavier Alvarez's facial challenge.<sup>122</sup> Insofar as the statute prohibited one from falsely making such a claim in the course of commercial self-promotion, it should have been seen to function as an entirely lawful restriction on false or misleading commercial speech.<sup>123</sup> Moreover, as the statute prohibited one from making such a claim in a non-commercial context, its restriction on speech rights should have been seen as significantly outweighed by Congress's strong, non-speech-related interest in preserving the value of the Nation's highest military honor.<sup>124</sup> Indeed, even though Xavier Alvarez was not engaged in commercial speech, this latter justification, standing alone, was probably sufficient to have permitted the Stolen Valor Act to be constitutionally applied against him once the scienter requirements compelled by due process concerns were read into the statute.<sup>125</sup> But even if not, these justifications should have sufficed to insulate the Stolen Valor Act against a successful facial attack. And more to the present point, they certainly should suffice to permit Congress to re-enact the Stolen Valor Act as a constitutional trademark infringement protection for the Congressional Medal of Honor Society's collective membership mark.

---

<sup>121</sup> See *id.* at 536 n.15. The Court also invoked an anti-dilution argument to buttress its conclusion, noting that Congress reasonably could have determined that unauthorized uses, even if not confusing, nevertheless may harm the USOC by lessening the distinctiveness and thus the commercial value of the marks. See *id.* at 539 (citing Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 825 (1927)) (arguing that trademark owners may be harmed by "the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by non-confusing uses"). As explained in Part II.B, using this same buttressing rationale to apply to false claims that one has been awarded the Congressional Medal of Honor falls prey to concerns of constitutional dimensions.

<sup>122</sup> See *supra* notes 26-32 and accompanying text.

<sup>123</sup> See *Central Hudson Gas & Elec. Co. v. Pub. Serv. Comm'n*, 447 U.S. 557, 566 (1980).

<sup>124</sup> See *United States v. O'Brien*, 391 U.S. 367, 377 (1968).

<sup>125</sup> See *United States v. Alvarez*, 132 S. Ct. 2537, 2551-53 (2012) (Breyer, J., concurring in the judgment).

## CONCLUSION

To date, Congress has bypassed the most obvious and effective way to achieve the goals it sought to advance in the Stolen Valor Act. The phrase "Congressional Medal of Honor," insofar as it describes the recipients of the highest military honor our country can bestow and the only individuals invited into the Congressional Medal of Honor Society, is a legitimate trademark capable of protection under federal trademark enforcement law. This approach would preserve the government's rights in its intangible property without threatening freedom of expression.

\* \* \* \*