

RETRENCHING SPEECH PROTECTIVE THRESHOLDS IN TRADEMARK LAW

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In their article, Raising the Threshold for Trademark Infringement to Protect Free Expression, Christine Haight Farley and Lisa Ramsey argue in favor of a speech-protective fair use test that would replace multiple tests applied by the U.S. Courts of Appeals when a defendant’s alleged infringement has either informational or expressive elements. This Response explains why this raised threshold test is unlikely to be adopted following the U.S. Supreme Court’s retrenchment of speech-protective thresholds in Jack Daniel’s Properties, Inc. v. VIP Productions, LLC. That prediction is bolstered by the Court’s likely holding in Vidal v. Elster. Readers persuaded that current defensive doctrines fail to sufficiently protect expressive and informational trademark uses will find the raised threshold test appealing. However, this Response concludes the proposed test is not constitutionally required. Moreover, applying the raised threshold test will lead courts in a surprisingly broad swath of cases to abandon or severely narrow important elements of current trademark doctrine, some of which are mandated by statute. Those threatened elements help courts correctly calibrate the commercial and expressive interests of trademark owners, alleged infringers, and the trademark-using public.

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INTRODUCTION

In *Raising the Threshold for Trademark Infringement to Protect Free Expression*, Christine Haight Farley and Lisa Ramsey propose a broad fair use test that would insulate informational or expressive use of a claimed trademark from liability for trademark infringement in many cases.¹ Farley and Ramsey first assayed this “raised threshold” test while the Supreme Court was considering a trademark dispute between dog toy manufacturer VIP Products and whiskey distributor Jack Daniel’s Properties over the former’s squeaky toy that resembled a Jack Daniel’s

1. Christine Haight Farley & Lisa Ramsey, *Raising the Threshold for Trademark Infringement to Protect Free Expression*, 72 AM. U. L. REV. 1225, 1274–75 (2023) (describing the proposed framework as both “a categorical speech-protective trademark rule similar to the Ninth Circuit’s . . . *Rogers* test and [a] nominative fair use [rule]” aimed at protecting free speech interests through a “higher standard for infringement”); see *Rogers v. Grimaldi*, 875 F.2d 994, 1005 (2d Cir. 1989) (holding that there is no infringement under the Lanham Act when a film title that includes a celebrity’s name is artistically relevant to the work and does not explicitly mislead the consumer regarding the content of the artistic work or denote celebrity endorsement).

bottle and its distinctive label.² The authors propose that courts utilize their “speech-protective trademark doctrine[, which] can be invoked on a motion to dismiss to stop broadly-worded infringement statutes from chilling” expressive or informational uses that are not “false or misleading.”³

Farley and Ramsey argue that this raised threshold test “balances the trademark and free speech interests of the parties and the public.”⁴ The goal of this raised threshold test is to unify the disparate tests that reach expressive or informational content in trademark contexts.⁵ If applied in the authors’ preferred form, the test would reorder multiple trademark doctrines and reread provisions of the Lanham Act,⁶ the statute enacting federal trademark law.⁷ For those who share the authors’ conviction that current approaches uniformly under-protect speech, the ambitious scope of the proposal will be its most welcome feature. However, while Farley and Ramsey’s article is well-defended and thorough, its raised threshold test extends a judicial approach that the Supreme Court has largely rebuffed. Crucially, the raised threshold test would replace what the Supreme Court in *Jack Daniel’s* referred to

2. Lisa P. Ramsey, *The First Amendment Limits Trademark Rights, But How?*—Jack Daniel’s v. Bad Spaniels (*Guest Blog Post*), TECH. & MKTG. L. BLOG (Apr. 3, 2023), <https://blog.ericgoldman.org/archives/2023/04/the-first-amendment-limits-trademark-rights-but-how-jack-daniels-v-bad-spaniels-guest-blog-post.htm> [<https://perma.cc/49YZ-FFPH>]. The U.S. Supreme Court vacated and remanded a decision by the Ninth Circuit Court of Appeals that found that VIP’s humorous use of the Jack Daniel’s trademark in its product was protected under the *Rogers* test, “which offers an escape from the likelihood-of-confusion inquiry [under the Lanham Act] and a shortcut to dismissal.” *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 155–57 (2023) (holding that the threshold *Rogers* test is inapplicable to infringement claims where a defendant uses a trademark as a source identifier for its own product).

3. Ramsey, *supra* note 2.

4. Farley & Ramsey, *supra* note 1, at 1289.

5. *See id.* at 1257 (explaining that “the main speech-protective doctrines” invoked during trademark infringement actions fail to provide “comprehensive protection of First Amendment values”).

6. Lanham Act, Pub. L. No. 79–489, 60 Stat. 427 (1946) (codified as amended in scattered sections of 15 U.S.C.).

7. Farley & Ramsey, *supra* note 1, at 1291. The authors offer options to lessen the scope of the disruption. *Id.* at 1260 (noting that in light of the public’s interest not to be materially misled about speaker identity “or the source of artistic works or political or religious services, it may be best to only exempt noncommercial uses of another’s mark from infringement liability if the mark is used otherwise than as a designation of source”); *id.* at 1275 (conceding that a court could apply the raised threshold test more narrowly by requiring a defendant to establish that its use is “otherwise than as a designation of source for its own products”).

as “the standard Lanham Act test,”⁸ “ordinary trademark scrutiny,”⁹ or “the standard trademark analysis”¹⁰ with broader and more categorical rules in speech-adjacent disputes.¹¹ This change is a potentially radical point of departure, as many trademark uses are expressive and speech-adjacent, even when they occur within the heartland of trademark law, and even when the junior user adopts an allegedly infringing mark as a designation of source.¹²

I. RESIZING *ROGERS V. GRIMALDI*

For the first two centuries of our national experiment, the First Amendment’s free speech protections and the scope of trademark law operated in distinct and distant spheres.¹³ Over the course of the twentieth century, the U.S. Courts of Appeals developed similar but not identical multifactor tests to assess whether the defendant’s allegedly infringing use of a symbol similar to the plaintiff’s mark was likely to confuse consumers.¹⁴ By the time each circuit had distilled its own test, they all shared four common factors: the similarity of the parties’ marks, the proximity of the goods, evidence of actual

8. *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 155 (2023).

9. *Id.* at 156.

10. *Id.* at 161.

11. See Farley & Ramsey, *supra* note 1, at 1291 (characterizing the raised threshold test as a “bright-line categorical fair use test”).

12. See *Jack Daniel’s*, 599 U.S. at 158 (“[T]rademarks are often expressive, in any number of ways.”).

13. Whether this disconnect stems from trademark law so narrow that it could not possibly implicate speech interests or a First Amendment viewed as incapable of reaching commercial regulation, there was little intersection until the 1970s. Compare *Valentine v. Chrestensen*, 316 U.S. 52, 54 (1942) (“[T]he Constitution imposes no . . . restraint on government as respects purely commercial advertising.”), with William McGeveran & Mark P. McKenna, *Confusion Isn’t Everything*, 89 NOTRE DAME L. REV. 253, 261 (2013) (explaining that early trademark law only addressed “particularly egregious conduct” on the part of direct competitors).

14. Those various tests originated from the 1938 RESTATEMENT (FIRST) OF TORTS, distilling the Restatement’s two multifactor tests—applied respectively when the parties’ goods were competing and non-competing—into a single test in each circuit. Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CAL. L. REV. 1581, 1588–89 (2006); 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 23:19, 24:31–43 (5th ed. 2024) [hereinafter MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION]; see, e.g., *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 n.11 (9th Cir. 1979) (citing to the RESTATEMENT (FIRST) OF TORTS § 729, Comment a); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (citing to the RESTATEMENT (FIRST) OF TORTS §§ 729–31).

consumer confusion, and the strength of the plaintiff's mark. In addition, all but one circuit considers the defendant's intent.¹⁵

Toward the end of the twentieth century, courts and commentators began to perceive greater overlap between First Amendment protections of free expression and government regulation of commercial speech, including via trademark enforcement. However, even during this era of increasing constitutional scrutiny of commercial regulation, cases indicated that, as with other types of personal property, a trademark's owner could enforce its mark against trespasses by infringers who claimed that their infringement was expressive or otherwise shielded by the First Amendment.¹⁶ For instance, claimed parody uses of trademarks were held to be infringing when courts and juries were persuaded that consumers would be confused by the parody and non-infringing when the parody was successful and confusion was unlikely.¹⁷

15. Beebe, *supra* note 14, at 1589–90.

16. See, e.g., *U.S. Jaycees v. Phila. Jaycees*, 639 F.2d 134, 145 (3d Cir. 1981) (holding that enforcement of the Lanham Act against a disaffiliated Philadelphia Jaycees subchapter for its trademark violation did not run afoul of the Equal Protection Clause where the national chapter's discriminatory bar on women's membership, which led to the disaffiliation with the Philadelphia subchapter, was not substantially related to the trademark infringement dispute); *Reddy Commc'ns, Inc. v. Env't Action Found., Inc.*, 199 U.S.P.Q. 630, 633–34 (D.D.C. 1977) (finding that the defendant's First Amendment rights must yield to the plaintiff's Fifth Amendment right to not be deprived of the property interests inherent within its trademark since nearly "infinite" alternative avenues of communication were available to the defendant), *supplemented by Reddy Commc'ns, Inc. v. Env't Action Found.*, 477 F. Supp. 936 (D.D.C. 1979); *Interbank Card Ass'n v. Simms*, 431 F. Supp. 131, 133–34 (M.D.N.C. 1977) (granting the plaintiff's summary judgement motion because of the defendant's failure to show the "requisite governmental involvement" to allege a constitutional violation of its First Amendment rights).

17. Compare *Girl Scouts of the U.S. v. Personality Posters Mfg. Co.*, 304 F. Supp. 1228, 1231, 1235 (S.D.N.Y. 1969) (denying motion for preliminary injunction against publication of a poster with a pregnant woman dressed as a Girl Scout, but finding it unnecessary to invoke the First Amendment), with *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1187, 1189–90, 1193 (E.D.N.Y. 1972) (granting Coca-Cola's motion for a preliminary injunction on the basis that the defendant's "Enjoy Cocaine" bill poster posed a high risk of "mistaken attribution," given the deliberate imitation of Coca-Cola's trademark, including the stylized script, colors, and design). See also Robert J. Shaughnessy, Note, *Trademark Parody: A Fair Use and First Amendment Analysis*, 72 VA. L. REV. 1079, 1106–07 (1986) (distinguishing outcomes in trademark parody cases on the basis of whether the parody was directed at the trademark owner or the trademark itself).

Moreover, the Supreme Court's trademark jurisprudence generally avoided categorical prescriptions that limited congressional discretion to set the scope of trademark protection.¹⁸ Indeed, there has been no Supreme Court holding directly subjecting disputes between trademark owners and alleged infringers to heightened First Amendment scrutiny.¹⁹ Instead, the Court has referred to the modern trademark regime, grounded in preventing consumer confusion and unfair competition, as constitutional.

For example, in *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee*,²⁰ the Court held that Congress acted constitutionally in securing exclusive rights in the word "Olympic" for the U.S. Olympic Committee (USOC) through Section 110 of the Amateur Sports Act.²¹ The Court favorably compared Section 110 to federal trademark protection, which it presumed was constitutional.²² The Court noted that regulating confusing uses was within normal trademark bounds

18. See, e.g., *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29–30 (2001) (holding that the existence of an expired patent claim involving claimed trade dress had vital but not dispositive significance in resolving whether that feature was functional and, thus, invalid for protection as trade dress); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995) (holding that "there is no rule absolutely barring the use of color alone" as a trademark). But see *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003) (holding that "the phrase 'origin of goods' in the Lanham Act" refers only to the manufacturer or producer of the physical "goods" that are made available to the public and cannot be extended to the creative source of an expressive good no longer receiving copyright protection).

19. Cf. *Matal v. Tam*, 582 U.S. 218, 252 (2017) (Kennedy, J., concurring in part) ("It is well settled, for instance, that to the extent a trademark is confusing or misleading[,], the law can protect consumers and trademark owners."); see, e.g., *FTC v. Winsted Hosiery Co.*, 258 U.S. 483, 493 (1922) ("The labels in question are literally false, and . . . palpably so. All are, as the Commission found, calculated to deceive and do in fact deceive a substantial portion of the purchasing public."); see also *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 579 (2011) ("[T]he government's legitimate interest in protecting consumers from commercial harms explains why commercial speech can be subject to greater governmental regulation than noncommercial speech.") (internal quotation marks omitted).

20. *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522 (1987).

21. *Id.* at 534–35; Amateur Sports Act of 1978, Public L. No. 95–606, § 110, 92 Stat. 3045, 3048–49.

22. *S.F. Arts & Athletics, Inc.*, 483 U.S. at 540.

and within the government’s constitutional power to “regulate ‘deceptive or misleading’ commercial speech.”²³

Trademark law and the First Amendment converged more fully when the Court of Appeals for the Second Circuit decided *Rogers v. Grimaldi*.²⁴ In that case, actress and dancer Ginger Rogers sued the producer of a film titled “*Ginger and Fred*.”²⁵ Rogers claimed the title created the false impression that she endorsed the movie, violating the Lanham Act.²⁶ The court held in favor of the film producers, crafting a threshold test to avoid “overextension of Lanham Act restrictions in the area of titles” of artistic works to prevent the act from “intrud[ing] on First Amendment values.”²⁷ The *Rogers* test requires a trademark owner to satisfy one of two threshold showings if the alleged infringing use is part of an expressive work, like the film at issue in *Rogers*.²⁸ The court concluded that balancing the need to avoid consumer confusion against free expression “will normally not support application of the [Lanham] Act unless” (1) “the title has no artistic relevance to the underlying work” or (2) “the title explicitly misleads as to the source or the content of the work.”²⁹

In the past four decades, several federal courts of appeals have adopted the *Rogers* test,³⁰ none more enthusiastically than the Ninth Circuit.³¹ The Ninth Circuit applied the *Rogers* test far beyond cases

23. *Id.* at 535 n.12 (quoting *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Couns., Inc.*, 425 U.S. 748, 771 (1976)); *see also* *Friedman v. Rogers*, 440 U.S. 1, 9 (1979) (noting that governmental restrictions are permissible to address “false, deceptive, and misleading commercial speech”); *S.F. Arts & Athletics, Inc.*, 483 U.S. at 535 (stating that “[c]ommercial speech ‘receives a limited form of First Amendment protection’”) (quoting *Posadas de P.R. Assocs. v. Tourism Co. of Puerto Rico*, 478 U.S. 328, 340 (1986)) (citing *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 562–63 (1980)).

24. 875 F.2d 994 (2d Cir. 1989).

25. *Id.* at 996–97.

26. *Id.* at 997.

27. *Id.* at 998.

28. *Id.* at 999.

29. *Id.*

30. *See, e.g.*, *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664–65 (5th Cir. 2000); *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 928 (6th Cir. 2003); *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012).

31. *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 901–02 (9th Cir. 2002), *abrogated by* *Punchbowl, Inc. v. AJ Press, LLC*, 90 F.4th 1022, 1032 (9th Cir. 2024).

involving trademark uses in the titles of expressive works;³² it also applied the test in cases where the defendant's source indicating use (i.e., trademark use) of a claimed trademark also "convey[ed] a humorous message" or was otherwise expressive.³³ Some courts and scholars expressed concern that, under the Ninth Circuit's approach, *Rogers* "potentially encompasses just about everything."³⁴ Indeed, one court opined that, if the First Amendment puts "[a] thumb on the scale" in favor of expression in trademark cases, expansive interpretations of *Rogers* put "a fist on the scale."³⁵

Presumptions about the Lanham Act's constitutionality shifted dramatically in 2017 and again in 2019. The Supreme Court invalidated two neighboring Lanham Act provisions that barred the registration of disparaging marks and immoral and scandalous marks, respectively. In *Matal v. Tam*,³⁶ the Court held that the ban on registering trademarks that disparaged a person, living or dead, was a viewpoint-based restriction on the trademark registrant's speech that violated the First Amendment; however, conclusions regarding how this understanding should drive constitutional scrutiny were deeply

32. The Ninth Circuit frequently applied *Rogers* in cases where the defendant sold an expressive work. *See, e.g.*, *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) (analyzing the use of trademarks in the defendant's videogame under *Rogers*), *abrogated by* 90 F.4th at 1032; *see also* *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1241 (9th Cir. 2013) ("The *Rogers* test is reserved for expressive works."), *abrogated by* 90 F.4th at 1032.

33. *VIP Prods. LLC v. Jack Daniel's Prods., Inc.*, 953 F.3d 1170, 1175 (9th Cir. 2020) (alteration in original), *vacated and remanded by* *Jack Daniel's Prods., Inc. v. VIP Prods. LLC*, 599 U.S. 140 (2023).

34. MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, *supra* note 14, § 31:144.20 n.22.

35. *Stouffer v. Nat'l Geographic Partners, LLC*, 460 F. Supp. 3d 1133, 1143 (D. Colo. 2020).

36. 582 U.S. 218 (2017).

split.³⁷ Subsequently, in *Iancu v. Brunetti*,³⁸ the majority held that the bar on registering trademarks that consist of or comprise immoral or scandalous matter also violated the Constitution because it was a viewpoint-based restriction.³⁹ Dissenting justices in *Brunetti* would have read the statute narrowly and, thus, held it to be constitutional as applied to scandalous marks but not immoral marks.⁴⁰

In both *Tam* and *Brunetti*, the government denied federal trademark registration to the hopeful registrant based on the viewpoint conveyed in the registration.⁴¹ The holdings in *Tam* and *Brunetti* raised the possibility that the Court might also apply heightened constitutional scrutiny to judicial enforcement of trademark rights when it granted certiorari in *Jack Daniel's Properties, Inc. v. VIP Products LLC*.⁴² VIP, the seller of the Bad Spaniels toy, argued that its toy was an expressive work and, thus, was not infringing under *Rogers*.⁴³ After remand from the Ninth Circuit, a district court applied the Ninth Circuit's *Rogers* analysis and found that the Lanham Act did not reach the sale of the Bad

37. Compare *id.* at 245 (Alito, J., plurality opinion) (concluding that the disparagement bar would fail *Central Hudson* scrutiny), with *id.* at 247 (Kennedy, J., concurring in part and concurring in the judgment) (concluding that the disparagement bar “constitutes viewpoint-based discrimination . . . that . . . must be subject to rigorous constitutional scrutiny” which it “cannot survive”). See also *id.* at 254 (Thomas, J., concurring in part and concurring in the judgment) (quoting *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 572 (2001) (Thomas, J., concurring in part and concurring in judgment) (“I continue to believe that when the government seeks to restrict truthful speech in order to suppress the ideas it conveys, strict scrutiny is appropriate, whether or not the speech in question may be characterized as ‘commercial.’”)).

38. 588 U.S. 388 (2019).

39. *Id.* at 394.

40. See *id.* at 400–01 (Roberts, C.J., concurring and dissenting in part) (“[R]efusing registration to obscene, vulgar, or profane marks does not offend the First Amendment.”); *id.* at 405, 408 (Breyer, J., concurring and dissenting in part) (“[I]t is hard to see how a statute prohibiting the registration of only highly vulgar or obscene words discriminates based on ‘viewpoint.’”); *id.* at 424, 426 (Sotomayor, J., concurring and dissenting in part) (“Prohibiting the registration of obscene, profane, or vulgar marks qualifies as reasonable, viewpoint-neutral, content-based regulation.”).

41. *Id.* at 393 (majority opinion) (“The Justices [in *Tam*] thus found common ground in a core postulate of free speech law: The government may not discriminate against speech based on the ideas or opinions it conveys.”).

42. 599 U.S. 140 (2023); see *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) (excepting expressive works from enforcement under the Lanham Act unless certain other considerations justify remedial action).

43. *Jack Daniel's*, 599 U.S. at 151.

Spaniels toy despite evidence of likely confusion because Jack Daniel's could not meet either prong of *Rogers*.⁴⁴

The Supreme Court held instead that where the defendant uses the contested trademark as a source indicator to brand or identify the source of the defendant's goods or services,⁴⁵ the *Rogers* test does not apply, and courts should apply "ordinary trademark scrutiny."⁴⁶ Prior to *Jack Daniel's*, in cases where it concluded that the defendant's use was expressive, the Ninth Circuit replaced its multifactor *Sleekcraft* test for likely confusion with the *Rogers* threshold inquiry.⁴⁷ The Second Circuit instead continued to use its multifactor *Polaroid* test in *Rogers* cases to determine whether the defendant's use is explicitly misleading, with the added burden that the factors "must be particularly compelling to outweigh the First Amendment interest recognized in *Rogers*."⁴⁸ One could reasonably read the Supreme Court's invocation of "standard" or "ordinary" scrutiny in *Jack Daniel's* as a signal it intends lower federal courts to apply their traditional multifactor likelihood of confusion tests when the defendant's use is both arguably expressive and source signifying without a "threshold inquiry like the *Rogers* test."⁴⁹

The Supreme Court in *Jack Daniel's* parted ways with the Ninth Circuit, concerned that if any alleged infringement that "communicates a humorous message" is automatically entitled to the *Rogers* shortcut, the test "might take over much of the world. For trademarks are often expressive, in any number of ways."⁵⁰ The Court correctly recognized that even in cases that are traditionally placed at the core of First Amendment concerns, namely those regarding political competition, the First Amendment will not always remove infringement from the scope of the Lanham Act. For example, in *United We Stand America, Inc. v. United We Stand, America New York, Inc.*,⁵¹

44. *Id.* at 152.

45. *Id.* at 156.

46. *Id.* at 155–56.

47. *Compare* *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003), *with* *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979). *See also* *Farley & Ramsey*, *supra* note 1, at 1245.

48. *See, e.g.*, *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993); *Hermès Int'l v. Rothschild*, 654 F. Supp. 3d 268, 281 (S.D.N.Y. 2023) (citing *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961)).

49. *Jack Daniel's*, 599 U.S. at 159.

50. *Id.* at 157–58.

51. 128 F.3d 86 (2d Cir. 1997).

the Second Circuit affirmed a grant of summary judgment against the appropriation of plaintiff’s political party service mark, “United We Stand America,” noting that if trademark protection were removed in political contexts,

The resulting confusion would be catastrophic; voters would have no way of understanding the significance of an endorsement or position taken by parties of recognized major names. The suggestion that the performance of such functions is not within the scope of ‘services in commerce’ seem to us to be not only wrong but extraordinarily impractical for the functioning of our political system.⁵²

The Court in *Jack Daniel’s* did not reach a conclusion about where and how *Rogers* should apply but hinted at proper applications of the test.⁵³ The Court cited to cases where the defendant’s alleged infringement is embedded in an expressive work.⁵⁴ Applications of *Rogers* were cited with approbation in cases where the defendant used the plaintiff’s mark in an expressive work that sits at the core of copyright protection: a pop song from the perspective of the Barbie doll,⁵⁵ paintings of scenes from University of Alabama football lore,⁵⁶ and a motion picture.⁵⁷ Counter-examples include uses of words, images, or trade dress substantially similar to the plaintiff’s mark in source-designating trademarks on commercial products including logos and labels on bottles of alcohol,⁵⁸ children’s exercise equipment,⁵⁹ a motorcycle repair shop,⁶⁰ and a canine perfume.⁶¹ The Supreme Court’s categorization of lower court precedents signals that the inclusion of expressive content or a “humorous message” does not

52. *Id.* at 90 (footnote omitted); *see also* Jake Linford & Aaron Perzanowski, *Calculating the Harms of Political Use of Popular Music*, 75 U. CALIF. L.J. 293, 346 (2024).

53. *Jack Daniel’s*, 599 U.S. at 153.

54. *Id.* at 154–55.

55. *Mattel, Inc. v. MCA Recs., Inc.*, 296 F.3d 894, 901 (2002), *abrogated by* *Punchbowl, Inc. v. AJ Press, LLC*, 90 F.4th 1022, 1032 (9th Cir. 2024).

56. *Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266, 1279 (2012).

57. *Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc.*, 868 F. Supp. 2d 172, 174–75 (S.D.N.Y. 2012).

58. *JL Beverage Co. v. Jim Beam Brands Co.*, 828 F.3d 1098, 1102–04 (9th Cir. 2016).

59. *PlayNation Play Sys., Inc. v. Vex Corp.*, 924 F.3d 1159, 1164–65 (11th Cir. 2019).

60. *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 812–13 (2d Cir. 1999).

61. *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*, 221 F. Supp. 2d 410, 412 (S.D.N.Y. 2002).

insulate the defendant's source indicating trademark use from standard likelihood of confusion analysis.⁶²

To address concerns about expressive content not embedded in expressive works, the Court cited favorably to the district court decision in *Tommy Hilfiger Licensing, Inc. v. Nature Labs, LLC*,⁶³ a case where the defendant's line of parody pet perfumes, including "Timmy Holedigger," was accused of infringing the plaintiff's Tommy Hilfiger marks.⁶⁴ The defendant argued that its use was a parody and, thus, it was entitled to a narrow application of the Lanham Act to vindicate its First Amendment interests.⁶⁵ However, the district court rejected this argument and held that First Amendment interests do not determine the likelihood of confusion inquiry when the defendant's use "in part [] promote[s] a somewhat non-expressive, commercial product."⁶⁶ Instead, as the Supreme Court summarized the case, the defendant was required to "meet [the] infringement claim on the usual battleground of 'likelihood of confusion.'"⁶⁷

While the Court was unified in holding *Rogers* did not apply in this case, Justice Gorsuch, joined by Justices Thomas and Barrett, signaled skepticism about whether the *Rogers* test is "commanded by the First Amendment, . . . merely gloss on the Lanham Act, [or] perhaps

62. *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 158 (2023). In distinguishing between clearly expressive uses and predominantly source indicating uses on commercial goods—see *supra* notes 55–61 and accompanying text—the Court selectively read Ninth Circuit precedent, citing cases where alleged infringement occurred in expressive works and where the use was not source indicating, but omitting cases where the expression was embedded in source indication. See, e.g., *Punchbowl, Inc. v. AJ Press, LLC (Punchbowl I)*, 52 F.4th 1091, 1097–1100 (9th Cir. 2022) (holding that AJ Press's use of the Punchbowl Mark in its brand and publications was inextricably linked to the "First Amendment-protected information" it sold, and therefore, qualified as expressive), *abrogated by* *Punchbowl, Inc. v. AJ Press, LLC*, 90 F.4th 1022, 1032 (9th Cir. 2024); *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1196–97 (9th Cir. 2017) (finding that despite Fox's use of the Empire trademark as an "umbrella brand . . . [that] promote[s] and sell[s] music and other commercial products" auxiliary to the same-titled show, defendant's use still fell within the ambit of *Rogers*, because otherwise, "[t]he balance of First Amendment interests . . . could be destabilized if the titles of expressive works were protected but could not be used to promote those works"), *abrogated by* *Punchbowl*, 90 F.4th at 1032.

63. 221 F. Supp. 2d 410 (S.D.N.Y. 2002).

64. *Jack Daniel's*, 599 U.S. at 156 (citing *Tommy Hilfiger*, 221 F. Supp. 2d at 412).

65. *Tommy Hilfiger*, 221 F. Supp. 2d at 414.

66. *Id.* at 415–16.

67. *Jack Daniel's*, 599 U.S. at 156 (citing *Tommy Hilfiger*, 221 F. Supp. 2d at 416).

inspired by constitutional-avoidance doctrine.”⁶⁸ The Court in *Jack Daniel’s* resized—or perhaps right-sized *Rogers*—and the authors’ proposal must be considered in light of this decision.

II. RAISING ALL THE THRESHOLDS

Professors Farley and Ramsey view the *Rogers* test and other defensive doctrines as falling short of the optimal speech protective regime in trademark cases.⁶⁹ To that end, the authors argue that any expressive or informative use of a plaintiff’s mark should be insulated from liability under the Lanham Act, unless the use is false or likely to mislead regarding the source of the products or message.⁷⁰ To guide courts in reaching that outcome, they propose a two stage raised threshold test. At the first stage, the defendant must show that its use is expressive or informational. If the defendant crosses that threshold, the plaintiff must meet a raised burden at the second stage to establish trademark infringement.

A. *The Defendant’s Threshold*

To qualify for the shelter of the authors’ two stage fair use test, the defendant must first establish that its use is expressive or informational. Like the Ninth Circuit’s application of *Rogers*, the defendant’s access to the safe harbor is not limited to ostensibly infringing use in an expressive work like a movie or television show.⁷¹ Expressive use would also include “uses of another’s mark to convey ideas, jokes, viewpoints, and similar communications,” so long as those uses “do something more than identify the trademark owner as the source of the products.”⁷² In other words, if the defendant uses the plaintiff’s claimed mark as a source indicator for defendant’s goods or services, but the defendant’s use also carries a humorous or expressive

68. *Id.* at 165 (Gorsuch, J., concurring).

69. Farley & Ramsey, *supra* note 1, at 1248 (“*Rogers* is not applicable in all of the conflicts between trademark and free speech rights.”); *id.* at 1257 (describing each of the trademark law’s “main speech-protective rules” as subject to “constraints or other problems that prevent them from providing comprehensive protection of First Amendment values in trademark law”).

70. *Id.* at 1234–35.

71. *Id.* at 1279.

72. *Id.* (“Such expression can range from storytelling, parody, satire, mashups, memes, and puns, to artistic, political, social, and religious messages”); *see also id.* at 1274 n.211 (“The term ‘expressive’ arguably incorporates all decorative, ornamental, and aesthetically functional uses of another’s mark”).

element, then a plaintiff would have to meet a raised burden to establish infringement.⁷³

The authors' test would also apply to any informational uses, including "uses of marks for their inherent or primary meaning to provide information about products, as well as certain nominative uses."⁷⁴ Informational uses would include uses of generic or descriptive names of products or informational symbols, or uses that refer to the trademark owner.⁷⁵ Applying this threshold would lead courts to the second stage raised burden, replacing the current statutory descriptive fair use defense,⁷⁶ as well as the nominative fair use tests applied in several circuits.⁷⁷ The raised threshold test would also subsume inquiries into noncommercial use, non-trademark use, parody, and aesthetically functional or ornamental use.⁷⁸ Indeed, the stated aim of the authors' raised threshold test is to unify the disparate tests that reach expressive and informational content in trademark contexts.⁷⁹

Even if the defendant's use was source indicating or "trademark use," they could still cross the first stage threshold so long as the use also provided expression or information. That expressive or informational use would also carry the defendant across the first threshold irrespective of the goods sold or whether the defendant's use is commercial or non-commercial.⁸⁰

73. For a discussion of the plaintiff's raised burden, see *infra* Section II.B.

74. Farley & Ramsey, *supra* note 1, at 1278.

75. *Id.*

76. See 15 U.S.C. § 1115(b)(4); see also *EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmopolos Inc.*, 228 F.3d 56, 64 (2d Cir. 2000) (explaining that, to avail itself of the descriptive or classic statutory fair use defense, the defendant must use the charged infringing symbol "(1) other than as a mark, (2) in a descriptive sense, and (3) in good faith").

77. See, e.g., *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1177 (9th Cir. 2010); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992); *Century 21 Real Estate Corp. v. Lendingtree Inc.*, 425 F.3d 211, 218, 220–21 (3d Cir. 2005); *Int'l Info. Sys. Sec. Certification Consortium, Inc. v. Sec. Univ., LLC*, 823 F.3d 153, 166–68 (2d Cir. 2016).

78. See Farley & Ramsey, *supra* note 1, at 1257, 1291 (explaining that their broader test would encompass many of the rules and doctrines that courts apply in trademark fair use cases).

79. *Id.* at 1256–57.

80. *Id.* at 1279–80; see also *id.* at 1280 ("[I]f the use of another's mark only conveys the information that the trademark owner or the accused infringer is the source of the product (such as 'Nike' displayed by itself on the label or hangtag of a shoe or T-shirt), it is *not* an informational or expressive use . . . and the traditional likelihood of confusion analysis should [apply].").

Farley and Ramsey’s discussion of the first stage does not indicate whether the defendant’s obligation to establish expressive or informational use is particularly demanding, although they assure that the “defensive doctrine does not apply if—from an objective point of view—the threshold requirement is not satisfied.”⁸¹ In making this objective assessment, courts are invited to consider evidence typically consulted to evaluate the descriptiveness and distinctiveness of trademarks, including dictionaries and third party media references about the contested term.⁸² But the authors advise that nearly anything might count as informational or expressive, up to and including any “non-source-indicating meaning or value of the mark at the time of the trademark dispute.”⁸³ That sets a low bar. For instance, even some coined words—fanciful trademarks typically extended broad protection in infringement cases—possess non-source-indicating meaning or value.⁸⁴

As the authors describe the first stage threshold, the sole use of expressive or informational matter that clearly fails to cross this threshold is “use of another’s mark [that] *only* conveys the information

81. *Id.* at 1288–89.

82. *Id.* at 1277–78.

83. *Id.* (stating that courts are tasked to determine “if the allegedly-infringing phrase, name, or symbol had a pre-existing informational or expressive meaning or decorative value before it was adopted or used as a mark by the plaintiff (such as the word “empire”, a political message, or the fleur de lis symbol) . . .”). The “empire” reference invokes *Twentieth Century Fox Television v. Empire Distrib., Inc.*, 875 F.3d 1192, 1198–99 (9th Cir. 2017), where the court applied *Rogers* and eschewed confusion analysis between plaintiff and defendant’s releases of recorded music because the defendant’s use of “empire” was artistically relevant for a television show set in New York, the Empire State, about a business empire, and defendant made “no overt claims or explicit reference to Empire Distribution.” *Id.* The Empire framework, which arguably expanded application of the *Rogers* test, effectively precluded “any application of trademark law in allegations involving ‘expressive’ content except in the most limited circumstances.” Zachary Shufro, *Based on a True Story: The Ever-Expanding Progeny of Rogers v. Grimaldi*, 32 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 391, 411 (2022). One might reasonably distinguish the junior user’s use of “empire” in the name of a television show from its use to sell records under the same name as the senior user’s record label, but the Ninth Circuit lumped them together.

84. See Jake Linford, *Are Trademarks Ever Fanciful?*, 105 *GEO. L.J.* 731, 734 (2017) [hereinafter Linford, *Fanciful*] (describing the “sound symbolism” that a coined word with no other meaning might convey); Barton Beebe & Jeanne C. Fromer, *Are We Running out of Trademarks? An Empirical Study of Trademark Depletion and Congestion*, 131 *HARV. L. REV.* 945, 967 (2018) (explaining that “certain phonemes are more effective than others depending on the circumstances.”).

that the trademark owner or the accused infringer is the source of the product.”⁸⁵ In other words, if the use fulfills an expressive or informational purpose in addition to a source indicating purpose, the plaintiff must face a raised burden at the second stage. Thus, only those expressive or informational uses that do nothing more than signify source will be subject to the “standard” or “ordinary” likelihood of confusion test.⁸⁶ The sole proffered example of a case where defendant’s use would not meet the expressive or informational threshold assures that the use of “‘Nike’ for a brand of athletic shoes or ‘Starbucks’ for the name of a coffee shop, without any criticism or other commentary” does not qualify as an “informational use.”⁸⁷ That example should come as no surprise, but it also provides little added clarity. Unauthorized use of ‘Nike’ for a brand of shoes would present a classic case of passing off; ordinary or standard trademark scrutiny should apply. It does not present a compelling case for a speech-protective threshold.

In the absence of other signals about the burden the defendant must meet to establish expressive or informational use, the reader is left to imagine where a court might set that threshold. If a court sets the threshold at the same level as the *Rogers* inquiry into artistic relevance applied in the Ninth Circuit, the defendant could meet the threshold by establishing any level of expression or information “above zero.”⁸⁸ An approach that permissive would, depending on the plaintiff’s burden at the second stage, replace *Rogers* and other speech-sensitive inquiries with a test that, in the words of the Court in *Jack Daniel’s*, would “take over much of the world.”⁸⁹ Under *Rogers*, plaintiffs almost never establish the defendant’s use is explicitly misleading, so a court’s

85. Farley & Ramsey, *supra* note 1, at 1280 (emphasis added).

86. *Id.* at 1279 (stating that expressive uses include a range of “messages that do something more than identify the trademark owner as the source of the products”); *see also supra* notes 8–10 and accompanying text.

87. *Id.* at 1278 (“using another’s mark to provide information *solely* about the origin or source of the defendant’s products”) (emphasis in the original).

88. *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008).

89. *See Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 158 (2023); *see also supra* notes 24–29 and accompanying text for a discussion of *Rogers*. Courts might instead require defendants to meet a higher threshold showing by limiting the type of expression or information that qualifies. For instance, expressive and informative uses might be limited to parodies that target the mark owner or its commercial activities. *But see* Farley & Ramsey, *supra* note 1, at 1268 (discussing limits of using parody to reweight the standard likelihood of confusion factors).

decision about how broadly to construe artistic relevance determined whether the defendant was subject to liability.

B. *The Plaintiff's Raised Burden*

If the defendant establishes expressive or informational use, the burden falls on the plaintiff at the second stage to prove that the defendant's use either (1) makes "a false statement about [the defendant's] products," or (2) is "likely to mislead a reasonable person about the source of the goods, services, or message."⁹⁰ As discussed below, it seems unlikely that a plaintiff will surmount either hurdle. If that is correct, then the raised threshold test may put its own *Rogers*-sized hand on the scale in favor of the defendant, but in a much broader swath of cases than even the Ninth Circuit reached with *Rogers*. But if the plaintiff's burden at the second stage is lower than anticipated, the risk of overreach is mitigated.

A court applying the raised threshold test would necessarily narrow statutory protections against uses likely to confuse consumers as to sponsorship or affiliation.⁹¹ If the informational or expressive use would likely confuse consumers about the plaintiff's sponsorship of or affiliation with the junior user, then the senior user may only prevail at the second stage if the junior user makes an expressly false claim. Thus, the statutory right to enforce the trademark against sponsorship or affiliation confusion would be barred even if the junior use is likely to mislead consumers—a standard the authors intend to be higher than the typically applied likely to confuse standard.⁹²

1. *Defendant makes false claims*

The plaintiff might attempt to meet its second stage burden by establishing that the defendant made "false claims about the product's

90. Farley & Ramsey, *supra* note 1, at 1274.

91. 15 U.S.C. § 1125(a)(1)(A) imposes liability for uses in commerce "likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person." Similarly, 15 U.S.C. § 1114(1) imposes liability for use of, *inter alia*, a "colorable imitation" of a registered mark. A "colorable imitation . . . includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive." 15 U.S.C. § 1127. The definition of "colorable imitation" does not specify whether the confusion is limited to source confusion, and section 1114(1) doesn't provide any further clarification.

92. Farley & Ramsey, *supra* note 1, at 1282.

origin or the parties' connection (such as untrue statements about the trademark owner's sponsorship or endorsement of the products).⁹³ The authors posit that a false claim might include the false representation on sports jersey labels that the jerseys are "licensed" products from a sports league.⁹⁴ Cases where a defendant makes a false claim may be rare. For instance, under the Ninth Circuit's *Rogers* precedent, only two uses that were found to be artistically relevant were also held to be explicitly misleading, and in neither case did the defendant make an overtly false statement about the plaintiff's sponsorship or endorsement.⁹⁵

2. *Defendant's use is likely to mislead*

The plaintiff might instead meet their second stage burden by establishing that the defendant's use is "likely to mislead a reasonable person regarding the *source* of [the defendant's] goods, services, or message."⁹⁶ The authors advance their likely to mislead benchmark to signal "a more rigorous standard than the traditional multi-factor likelihood of confusion analysis."⁹⁷ To that end, only use likely to mislead as to origin or source is relevant if the defendant passes the first stage threshold. Thus, a use with expressive or informational matter would not trigger liability even if it is likely to mislead about the sponsorship, affiliation, or approval of the defendant's goods or

93. *Id.* at 1275.

94. *Id.* at 1281.

95. Lynn M. Jordan & David M. Kelly, *Another Decade of Rogers v. Grimaldi: Continuing to Balance the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 109 TRADEMARK REP. 833, 860–61 (2019) (citing *Titan Sports, Inc. v. 3-G Prods.*, No. CV 90-3022, 1991 WL 228716, at *4 (C.D. Cal. July 31, 1991) (holding the defendant's use of recent images of well-known wrestlers on older video content with misleading titles "explicitly misleads the consumer as to the contents of the tape"); *Warner Bros. Ent. v. Global Asylum, Inc.*, No. CV 12-9547, 2012 WL 6951315, at *17, *23 (C.D. Cal. Dec. 10, 2012) (granting the plaintiff's request for a TRO against defendant's use of "Age of the Hobbits" on a direct to DVD movie scheduled for release the same month as the plaintiff's "The Hobbit: An Unexpected Journey" and finding the plaintiff would likely prevail on a motion for preliminary injunction under *Rogers* because the "particularly compelling" likelihood of confusion case made the defendant's use explicitly misleading).

96. Farley & Ramsey, *supra* note 1, at 1281 (emphasis in original).

97. *Id.* at 1282. *But see* *Jack Daniel's Prods., Inc. v. VIP Prods. LLC*, 599 U.S. at 140, 154–56 (2023) (explaining that the *Rogers* test does not apply when the defendant's use is source indicating and that courts should instead apply "ordinary trademark scrutiny").

services.⁹⁸ Although the Lanham Act expressly establishes liability for the use in commerce of any symbol “likely to cause confusion or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person,”⁹⁹ the authors’ test would insulate expressive or informational uses from liability unless plaintiff could establish the defendant made a false claim.¹⁰⁰

Courts and readers might wonder whether this second stage inquiry, part of the authors’ claimed “bright line categorical fair use test,”¹⁰¹ should be interpreted to insulate all expressive and informational uses from liability, or whether the plaintiff is expected to occasionally prevail in establishing that the defendant’s use is likely to mislead an objectively reasonable consumer. The authors provide two examples where the plaintiff might prevail. The first example stretches plausible definitions of expressive or informational use: “prominent use of ‘Harry Potter’ (rather than ‘Boy Wizard’) on the packaging of a Halloween costume that closely resembles that character’s clothing.”¹⁰² Perhaps the authors intend to indicate that uses of ‘Harry Potter’ are generally expressive,¹⁰³ but not when used to sell an unlicensed Hogwarts uniform.¹⁰⁴ The second example posits that the defendant’s use might mislead “if a company displayed the phrase ‘Super Hero’”—an arguably descriptive phrase for which DC Comics and Marvel Characters, Inc. jointly own several incontestable trademark registrations—¹⁰⁵ “on packaging for a Halloween costume along with

98. Farley & Ramsey, *supra* note 1 at 1282–83, 1289.

99. 15 U.S.C. § 1125(a)(1)(A).

100. *See supra* Section II.B.1.

101. *Id.* at 1291.

102. *Id.* at 1282.

103. *Id.* at 1279 (“[E]xpressive use[s]” . . . include use of the name ‘Harry Potter’ within the title or content of fan fiction . . .”).

104. HARRY POTTER, Registration No. 2,683,060 (including inter alia masquerade and Halloween costumes).

105. SUPER HEROES, Registration No. 1,140,452 (toy figures); SUPER HEROES, Registration No. 1,179,067 (publications); SUPER HEROES, Registration No. 3,674,448 (T-shirts); SUPER HEROES, Registration No. 5,613,972 (including production and distribution of a series of animated motion pictures, and entertainment services in the nature of cartoon exhibitions); SUPER HERO, Registration No. 0,825,835 (including masquerade costumes).

other known references” to the mark owners’ characters,¹⁰⁶ like Batman or Spider-Man.

Consider what the “Super Hero” example teaches about how to apply the second stage misleading use inquiry. Courts applying the test would consider only three types of evidence to determine whether defendant’s use would likely mislead a reasonable person about the source of the product or message: (1) the expressive or informational *content* of the defendant’s use; (2) the (non) source-indicating *context* of the use; and (3) the *products sold or provided* by the defendant.¹⁰⁷ The authors define the use of “Super Hero” on products related to superheroes as informational *content*.¹⁰⁸ But the use of other symbols related to the trademark owners on the packaging mitigates the informational content and signals that the defendant is not using “Super Hero” for its “inherent informational or expressive meaning.”¹⁰⁹ The example does not indicate where the phrase is displayed on the package, but assuming “Super Hero” appears in a trademark space, centrally located on the package,¹¹⁰ that *context* would be “relevant—but not determinative—to whether the use is infringing.”¹¹¹ If one assumes the costume inside the package is in the likeness of Batman or Spider-Man, (the authors do not so specify), then the costume sales are more likely to mislead a reasonable consumer as to source. But in this case, the *products sold* factor—the least of the three holistic factors¹¹²—would necessarily turn the court back to the question of informational *content*. If the costume resembles

106. Farley & Ramsey, *supra* note 1, at 1284.

107. *Id.* at 1283; *see also id.* at 1286 (explaining that context is “relevant—but not determinative”); *id.* at 1287 (asserting that the type of infringed goods “should not be the determinative factor”).

108. *Id.* at 1283–84.

109. *Id.* at 1283.

110. *Id.* at 1285–86 (citing Mark A. Lemley & Mark P. McKenna, *Trademark Spaces and Trademark Law’s Secret Step Zero*, 75 STAN. L. REV. 1 (2023); Alexandra J. Roberts, *Trademark Failure to Function*, 104 IOWA L. REV. 1977 (2019); Thomas R. Lee, Eric D. DeRosia & Glenn L. Christensen, *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 ARIZ ST. L.J. 1033 (2009)).

111. Farley & Ramsey, *supra* note 1, at 1286.

112. *Id.* at 1288 (“The fact that an accused infringer is selling T-shirts instead of news, movies, or books is not as important when evaluating liability under our trademark fair use test as evidence about the content of the words or designs used, and whether they are used (or not used) as a product-source-identifying trademark.”).

a known DC or Marvel hero, it is thus more likely to mislead consumers as to source.¹¹³

The authors categorize the likely to mislead inquiry as holistic, but the effort to reverse engineer its application from this example suggests that the *content* element will dominate the proposed inquiry. Imagine that the package does not use DC- or Marvel-related elements other than the trademark. The placement of “Super Hero” on the package in the place a trademark typically appears is *contextual* evidence of source-indicating trademark use—use that the Supreme Court in *Jack Daniel’s* instructs should not trigger a “threshold inquiry like the *Rogers* test.”¹¹⁴ Unless the costume looks like a superhero connected to one of the owners, the authors’ *product sold* element would be unlikely to do any work. And if the costume is connected to a DC or Marvel hero, that additional *content* suggests that the defendant’s use of “Super Hero” to sell their costume should not have crossed the first threshold.

The *content* analysis is thus somewhat recursive. Expressive or informational use brings the defendant’s use across the first stage threshold, and then is examined for whether the use might be objectively misleading to a reasonable consumer. The authors posit that informational and expressive uses are less likely to confuse consumers, and if a court agrees with that general assessment, then the second stage likely to mislead inquiry may heavily favor defendants just as the *Rogers* explicitly misleading prong has historically favored them.¹¹⁵

C. *Rereading the Lanham Act and Shortcutting Standard Inquiries*

More critically, this tripartite likely to mislead test would replace the standard multi-factor likelihood of confusion test. When assessing whether the defendant’s use is likely misleading under the raised threshold test at the second stage, the authors advise that courts “should not [] consider the numerous likelihood of confusion factors typically used to determine infringement in regular trademark disputes because such an analysis does not adequately protect First Amendment interests when the mark is used in an informational or

113. *Id.* at 1287.

114. *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 159 (2023).

115. *Farley & Ramsey*, *supra* note 1, at 1283–85; *see also* *Jordan & Kelly*, *supra* note 95, at 845–71 (discussing the inconsistency in circuits’ determinations of whether a use is explicitly misleading).

expressive manner.”¹¹⁶ In particular, the tripartite second stage misleading use inquiry would replace “subjective intent of the defendant or consumer survey evidence.”¹¹⁷ Additionally, the second stage inquiry would replace or downweight analysis of the similarity of the parties’ marks or the strength of the plaintiff’s mark when the context of the use is informational, decorative, descriptive, or expressive.¹¹⁸ The authors’ likely to mislead inquiry would thus expressly narrow or replace “standard” or “ordinary” likelihood of confusion factors considered by every federal appellate court: similarity of the marks, the strength of the plaintiff’s mark, and evidence of actual confusion.¹¹⁹ It would also replace the intent inquiry considered in all but one circuit. And it would similarly read the “good faith” element out of the Lanham Act’s statutory descriptive fair use defense.¹²⁰

What might we lose if the likely to mislead test makes the defendant’s intent or bad faith irrelevant? *Vis-a-vis* the subset of informational uses that currently fall within the statutory descriptive or classic fair use test, the second stage likely to mislead inquiry conflicts with the text of the Lanham Act. Descriptive fair use is the use of a plaintiff’s mark to describe the defendant’s goods or services. That use must not be trademark or source signifying use, and it must be in good faith. Lack of good faith includes “intent to trade on the good will of the trademark holder by creating confusion as to source or sponsorship.”¹²¹

In addition to its statutory mandate in the descriptive fair use context, an inquiry into defendant’s intent long predates the modern Lanham Act.¹²² That history may matter to the Court in assessing

116. Farley & Ramsey, *supra* note 1, at 1283.

117. *Id.*

118. *Id.* at 1288.

119. See *supra* notes 14–15 and accompanying text.

120. *Id.*; see also 15 U.S.C. § 1115(b)(4).

121. EMI Catalogue P’ship v. Hill, Holliday, Connors, Cosmopolos Inc., 228 F.3d 56, 56 (2d Cir. 2000); see also Int’l Stamp Art, Inc. v. U.S. Postal Serv., 456 F.3d 1270, 1274 (11th Cir. 2006) (“[T]he standard for good faith for fair use is the same as the legal standard for good faith in any other trademark infringement context . . . whether the alleged infringer intended to trade on the good will of the trademark owner by creating confusion as to the source of the goods or services.”); Inst. for Sci. Info., Inc. v. Gordon & Breach, Sci. Publishers, Inc., 931 F.2d 1002, 1010 (3d Cir. 1991).

122. See, e.g., Jake Linford, *The Path of the Trademark Injunction*, 403, 425, § 3.2.2, in RESEARCH HANDBOOK ON THE LAW AND ECONOMICS OF TRADEMARK LAW (Lunney, ed. 2023) [hereinafter Linford, *Injunction*].

whether the defendant's good faith is constitutionally infirm or otherwise irrelevant.¹²³ Moreover, if trademark law's constitutional scope should be construed in light of the Lanham Act's stated goals,¹²⁴ as the authors suggest,¹²⁵ courts might reasonably query how one makes actionable "deceptive" uses of trademarks, "protects . . . against unfair competition," or "prevents fraud and deception" without considering the intent behind the defendant's adoption of a symbol.¹²⁶

Similarly, section 43(a) of the Lanham Act expressly protects against uses that are "likely to cause confusion" as to "sponsorship, or approval."¹²⁷ While some historical accounts suggest that the initial judicial expansion of trademark law to reach beyond point-of-sale source confusion misread a clerical amendment,¹²⁸ Congress acquiesced to protection against sponsorship and affiliation confusion more than three decades ago when it adopted the modern text of section 43(a).¹²⁹

Moreover, if the trademark signals responsibility for quality,¹³⁰ then sponsorship confusion is consistent with the source confusion account of trademark law. One expects a fungible experience at every McDonald's restaurant, even though individual restaurants are franchisees.¹³¹ To suggest that sponsorship or affiliation confusion is constitutionally suspect is to risk upending a century of licensing-

123. See *infra* Section III.A.2.

124. 15 U.S.C. § 1127.

125. See Farley & Ramsey, *supra* note 1, at 1271–74.

126. *Id.*

127. 15 U.S.C. § 1125(a)(1)(A).

128. Sara Stadler Nelson, *The Wages of Ubiquity in Trademark Law*, 88 IOWA L. REV. 731, 800–02 (2003) (discussing passage of the Trademark Registration Act, Pub. L. No. 87–772, 76 Stat. 769 (1962)).

129. Trademark Law Revision Act of 1988, Pub. L. 100-667, Title I, § 132, Nov. 16, 1988, 102 Stat. 3946; see also *Int'l Info. Sys. Sec. Certification Consortium v. Sec. Univ., LLC*, 823 F.3d 153, 161 (2d Cir. 2016) (quoting 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:76 (4th ed.)) ("The modern test of infringement is whether the defendant's use [is] likely to cause confusion not just as to source, but also as to sponsorship, affiliation or connection."); Barton Beebe, *What Trademark Law is Learning from the Right of Publicity*, 42 COLUM. J.L. & ARTS 389, 393 (2019).

130. Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 415 (2010) (sponsorship confusion would be material in cases where consumers believe the senior user is responsible for the junior user's quality).

131. Matthew B. Kugler, *The Materiality of Sponsorship Confusion*, 50 U.C. DAVIS L. REV. 1911, 1918–19 (2017).

related trademark law.¹³² Additionally, Matthew Kugler's research indicates sponsorship is more important to significant swaths of the population than some critics believe.¹³³

The second stage likely to mislead inquiry also expressly eschews survey evidence. Farley and Ramsey argue that courts can determine whether the defendant's use "is fraudulent, deceptive, or misleading" without "evidence about the impact of that use."¹³⁴ Thus, consumer survey evidence is discounted as at best an indication "that some people are confused from a subjective perspective" but not that a reasonable person is likely to be confused.¹³⁵ The authors' disinclination towards surveys is not without precedent. Courts often discuss the importance of surveys, but they are not necessarily of

132. Indeed, licensing a mark without quality control provides a basis for the forfeiture of trademark rights. *See* *Eva's Bridal Ltd. v. Halanick Enters.*, 639 F.3d 788, 790–91 (7th Cir. 2011) (holding that a licensor must retain a level of control over the licensee's use of the trademark to ensure that the licensee's goods and/or services meet the consumers' expectations that are created by the trademark); *FreecycleSunnyvale v. Freecycle Network*, 626 F.3d 509, 515–16 (9th Cir. 2010) (determining that when licensors engage in "naked licensing" by not controlling their trademark, it will lead the court to determine that the licensor has abandoned their trademark); Jake Linford, *Valuing Residual Goodwill After Trademark Forfeiture*, 93 NOTRE DAME L. REV. 811, 830–33 (2017) [hereinafter Linford, *Residual Goodwill*] (explaining that if trademark law protects the ability of the mark to signal to consumers the quality of mark-bearing goods or services, naked licensing is antithetical to that purpose as it weakens mark-related signals of quality).

133. Kugler, *supra* note 131, at 1957 (synthesizing data and finding that sponsorship confusion in merchandising cases is material to roughly half of surveyed consumers).

134. Farley & Ramsey, *supra* note 1, at 1275.

135. *Id.*

dispositive weight,¹³⁶ and not every trial includes them.¹³⁷ When they are used, courts and scholars sometimes criticize them.¹³⁸

The authors invite courts to focus on objective evidence of how consumers should construe defendant's use, not "evidence about the impact of that use."¹³⁹ Left unstated is whether eschewing evidence about impact should lead courts to ignore testimonial evidence from consumers about their confusion. The plural of anecdote is not data, so evidence of impact on one consumer does not necessarily mean that many consumers would be confused.¹⁴⁰ Moreover, a survey is but a proxy of consumer confusion, albeit one with a long history of use in

136. *E.g.*, *Zippo Mfg. Co. v. Rogers Imps., Inc.*, 216 F. Supp. 670, 685–86 (S.D.N.Y. 1963) (reasoning that surveys are admissible to establish elements of a trademark case, but the weight of the survey results should be balanced with the survey methods and other possible explanatory variables).

137. Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1586, 1622 (2006); *see also* Kevin Blum, Ariel Fox, Christina J. Hayes, & James Xu, *Consistency of Confusion? A Fifteen-Year Revisiting of Barton Beebe's Empirical Analysis of Multifactor Tests for Trademark Infringement*, 2010 STAN. TECH. L. REV. 3, 30 (2010) ("[S]urvey data is less frequently employed than one might expect given the conventional wisdom that survey evidence is routinely employed to prove a likelihood of confusion.").

138. *Indianapolis Colts, Inc. v. Metro. Balt. Football Club Ltd.*, 34 F.3d 410, 415 (7th Cir. 1994) (Posner, CJ.) (positing that "[m]any experts are willing for a generous . . . fee to bend their science in the direction from which their fee is coming."); *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 163 (2023) (Sotomayor, J., concurring) (writing "separately to emphasize that in the context of parodies and potentially other uses implicating First Amendment concerns, courts should treat the results of surveys with particular caution"). *But see* Jerre B. Swann, *A History of the Evolution of Likelihood of Confusion Methodologies*, 113 TRADEMARK REP. 723, 733, 744 (2023) (arguing that a focus on open responses meant to solicit why consumers are confused may introduce, rather than control for, error in surveys because the respondent "will search for a plausible explanation that may or may not be the reason for their earlier response") (quoting Shari Seidman Diamond, *Control Foundations: Rationales and Approaches*, in TRADEMARK AND DECEPTIVE ADVERTISING SURVEYS 201, 211 (Shari Seidman Diamond & Jerre B. Swann eds., 1st ed. 2012)).

139. *Farley & Ramsey*, *supra* note 1, at 1276.

140. *Compare* *McDonald's Corp. v. McBagel's, Inc.*, 649 F. Supp. 1268, 1277 (S.D.N.Y. 1986) ("[A]ny evidence of actual confusion is, of course, highly persuasive in proving the existence of its likelihood.") *with* *McDonald's Corp. v. Shop at Home, Inc.*, 82 F. Supp. 2d 801, 810 (M.D. Tenn. 2000) (given McDonald's tremendous market reach and millions of customers served each day, sixteen phone calls from confused consumers "borders on insignificant").

trademark disputes.¹⁴¹ Without testimonial or proxy evidence of actual confusion, courts are left to construct a virtual reasonable consumer and decide whether or not that imaginary consumer might be misled by the defendant's use.

Some of the authors' distrust of survey evidence appears to stem from a suspicion that surveys are inappropriately deemed probative of confusion when only a limited subset of the surveyed population were misled.¹⁴² On the surface, numbers probative of confusion may seem too modest in some cases. For instance, courts in false advertising cases have held that surveys are probative of materially misleading advertising when approximately 15% of consumers were misled or deceived by an advertiser's statements.¹⁴³ But at least between competitors, this may not be surprising after some reflection. Misleading statements that persuade a subset of consumers that one seller's products have desirable characteristics will plausibly shift consumer behavior, causing the other seller to lose a portion of the relevant market and "suffer irreparable injury."¹⁴⁴ If the concern is that the percentages considered probative are too low, the answer may be to require a higher percentage of consumers to be confused or misled before granting probative weight to the survey, rather than eliminating

141. See generally Jake Linford, *Democratizing Access to Survey Evidence of Distinctiveness*, in RESEARCH HANDBOOK ON TRADEMARK LAW REFORM 225 (Graeme B. Dinwoodie & Mark D. Janis eds., 2021).

142. Farley & Ramsey, *supra* note 1, at 1275.

143. *Coca-Cola Co. v. Tropicana Prod., Inc.*, 690 F.2d 312, 317 (2d Cir. 1982) (holding that surveys finding that 15% of consumers experienced confusion with regard to the defendant's offered product "demonstrated that a significant number of consumers would be likely to be misled"); *Novartis Consumer Health, Inc. v. Johnson & Johnson-Merck Consumer Pharms. Co.*, 129 F. Supp. 2d 351, 367 (D.N.J. 2000), *aff'd but criticized*, 290 F.3d 578, 599–600 (3d Cir. 2002). False advertising's materiality requirement is identified as more demanding than trademark infringement's likely confusion standard. Lemley & McKenna, *supra* note 130, at 414–16; Glynn S. Lunney, Jr., *Trademark Monopolies*, 48 EMORY L.J. 367, 483 (1999) ("[W]hen confusion concerns something other than source, courts should expressly require the plaintiff to establish that the confusion concerns material information," i.e., information material to a purchasing decision); Rebecca Tushnet, *Running the Gamut from A to B: Federal Trademark and False Advertising Law*, 159 U. PA. L. REV. 1305, 1363–65 (2011) (describing how a materiality requirement serves as a barrier to plaintiffs' claims).

144. *Coca-Cola Co.*, 690 F.2d at 317.

reference to what Graeme Austin called “the insights of cognitive science.”¹⁴⁵

III. THE CONSTITUTIONALITY OF TRADEMARK LAWS

The proposed raised threshold test promises to increase space for and predictability of decisions by junior users of informational and expressive trademarks.¹⁴⁶ If Congress cannot be persuaded to enact the raised threshold test, courts could apply such a test if they find it constitutionally required. Whether courts are required to adopt the test turns on whether existing tests fail to adequately protect commercial speech of junior users,¹⁴⁷ and whether that failure is of constitutional magnitude.¹⁴⁸

One operating presumption of the authors’ proposal is that trademark owners’ own speech interests are inferior to the information and expressive uses of junior users.¹⁴⁹ Similarly, the interests of consumers in avoiding sponsorship confusion are subordinated to the interests of consumers disinterested in the question.¹⁵⁰ While the authors characterize a senior user’s interests as weak when the junior use has expressive or informational elements, there are nonetheless competing speech interests on both sides.¹⁵¹ Constitutionalizing the inquiry smooths the path of the junior user. The creation of a heightened threshold to insulate otherwise infringing behavior from liability requires justification for the junior

145. Graeme W. Austin, *Trademarks and the Burdened Imagination*, 69 BROOK. L. REV. 827, 837, 917 (2004) (arguing that trademark law’s “constructed character of trademark’s consumer” might be corrected by “greater use of survey evidence” and “the insights of cognitive science”).

146. Farley & Ramsey, *supra* note 1, at 1280.

147. *Id.* at 1272–74; *see also id.* at 1258–59 (discussing the Supreme Court’s test in *Bolger v. Youngs Drug Prods. Corp.* 463 U.S. 60, 66–67 (1983) in the context of noncommercial use safe harbors).

148. *Cf. id.* at 1282–83 (“This type of breathing space is critical for expression protected by the First Amendment.”).

149. *Id.* at 1273–74 (“It is understandable that trademark owners like Jack Daniel’s do not want dog toy companies, T-shirt manufacturers, and other businesses to free ride off their investment of time and money in their brand. Yet the public has a compelling government interest in free expression—and in fair and undistorted competition—which prevents trademark owners from enlisting courts to enjoin nonmisleading speech simply to protect the goodwill invested in these marks.”).

150. *Id.* at 1289.

151. *See infra* Section III.A.2.

user's speech interest to dominate over that of the senior user,¹⁵² or for concluding that the scope of the Lanham Act is unconstitutionally broad.

If the application of the standard likelihood of confusion test is constitutionally suspect when an allegedly infringing use has any informational or expressive content, the authors' proposal might be justified on constitutional avoidance grounds.¹⁵³ It would then be permissible to read the Lanham Act narrowly in cases where the defendant's source indicating use includes expressive or informational matter, and to deny plaintiff relief even if the defendant's use misleads as to "affiliation, connection, . . . association . . . sponsorship, or approval."¹⁵⁴ If one is persuaded that the standard likely confusion analysis fails to sufficiently protect speech, narrow tailoring might be necessary, and it would best be ensured by crafting speech-protective and categorical affirmative defenses like the raised threshold test.¹⁵⁵

That is an inquiry that should not be undertaken lightly. As Judge Leval explains, when a court concludes that a statute violates the Constitution, a large portion of the legislature's role in the dialogue is precluded.¹⁵⁶ If courts heed Judge Leval's caution, they are unlikely to conclude that the First Amendment requires imposing categorical gateways that privilege expressive or informative content and insulate defendants from ordinary trademark scrutiny, at least when that content appears in source-indicating trademark uses.

152. David McGowan, *Some Realism About the Free Speech Critique of Copyright*, 74 *FORDHAM L. REV.* 435, 438 (2005) ("[W]hen one speaker wants to use another's work, the relevant legal rules embody a choice between two speech interests.").

153. Farley & Ramsey, *supra* note 1, at 1290. *But see* Eric S. Fish, *Constitutional Avoidance as Interpretation and as a Remedy*, 114 *MICH. L. REV.* 1275, 1275 (2016) (critiquing the Court's constitutional avoidance canon as "rewriting [statutes] in the service of constitutional norm enforcement.").

154. 15 U.S.C. § 1125(a)(1)(A).

155. Farley & Ramsey, *supra* note 1, at 1271–72. The authors invoke two variations of the Supreme Court's First Amendment jurisprudence: the intermediate scrutiny and strict scrutiny tests. Those tests vary in their details, but at their core, both ask whether the government action or statute furthers substantial or compelling government interests in a manner sufficiently narrow to avoid restricting constitutionally protected speech more than necessary.

156. Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 *COLUM. J.L. & ARTS* 187, 209 (2004).

A. *Reordering Rogers' Rules After Jack Daniel's*

The courts of appeals for the Ninth and Second Circuits have reconsidered their application of *Rogers* after *Jack Daniel's*,¹⁵⁷ and the Supreme Court has again granted certiorari in a First Amendment challenge to a Lanham Act provision.¹⁵⁸ These datapoints illuminate the post-*Jack Daniel's* landscape and the Court's trajectory vis-à-vis First Amendment scrutiny of trademark law. They also allow further consideration of how the raised threshold test might shift the analysis in trademark infringement disputes, and at what cost.

1. *Rogers relinquished*

A recent opinion from the Ninth Circuit in *Punchbowl, Inc. v. AJ Press, LLC*,¹⁵⁹ retrenches from its earlier expansive reading of *Rogers*.¹⁶⁰ Prior to *Jack Daniel's*, the Ninth Circuit held that a defendant's trademark use was outside the scope of the Lanham Act so long as the use was somehow expressive in nature, even if the defendant used the mark "to identify its commercial brand."¹⁶¹ Under the Ninth Circuit's original reading of *Rogers*, because Punchbowl News was expressive in nature and not explicitly misleading as to source, it qualified for the *Rogers* off-ramp, and, thus, Punchbowl, Inc. could not proceed on a claim that Punchbowl News infringed its trademark rights.¹⁶² However, following *Jack Daniel's*, the Ninth Circuit held that because AJ Press was using Punchbowl News to identify its products, *Rogers* does not apply and the dispute was subject to traditional likelihood of confusion analysis.¹⁶³

On remand, the district court will determine whether Punchbowl, Inc. will prevail on its likelihood of confusion claim, and the court expressed some skepticism on that point.¹⁶⁴ But the reference to the

157. *Punchbowl, Inc. v. AJ Press, LLC (Punchbowl II)*, 90 F.4th 1022, 1024 (9th Cir. 2024); *Vans, Inc. v. MSCHF Prod. Studio, Inc.*, 88 F.4th 125 (2d Cir. 2023) (per curiam).

158. *In re Elster*, 26 F.4th 1328, 1330 (Fed. Cir. 2022), *cert. granted sub nom. Vidal v. Elster*, 143 S. Ct. 2579 (2023).

159. *Punchbowl II*, 90 F.4th at 1024.

160. *Id.*

161. *Id.* at 1026 (citing *Punchbowl, Inc. v. AJ Press, LLC (Punchbowl I)*, 52 F.4th 1091, 1099–1100 (9th Cir. 2022), *withdrawn by* *Punchbowl, Inc. v. AJ Press, LLC*, 78 F.4th 1158 (9th Cir. 2023)).

162. *Punchbowl I*, 52 F.4th at 1095, 1098.

163. *Punchbowl II*, 90 F.4th at 1030.

164. *Id.* at 1032.

secret service nickname should not insulate the news service from liability if greeting card consumers will likely be confused as to source.

Under the raised threshold test, however, AJ Press would easily cross the first stage threshold. The reference to the punchbowl nickname has some expressive and/or informational elements, selected to “elicit the theme and geographic location” of defendant’s publication.¹⁶⁵ At the second stage, Punchbowl, Inc. would be unable to establish a false claim by AJ Press about source or sponsorship; AJ Press makes no statement about Punchbowl, Inc. at all.¹⁶⁶ But the Punchbowl case raises an interesting question about the relative weights of the defendant’s expressive *content*, trademark-relevant *context*, and *products sold* elements under the authors’ second stage misleading use inquiry.

AJ Press makes source signifying use of the term Punchbowl as part of its Punchbowl News mark. That type of *contextual* use would weigh in favor of source confusion in the abstract, although Farley and Ramsey warn that use as a mark “is relevant—but not determinative—to whether the use is infringing.”¹⁶⁷ Under the *content* element, the nature of the expression returns to the analysis. The identified expressive nature of the use would necessarily outweigh context.¹⁶⁸ Additionally, the use of Punchbowl to sell news services would likely tip the *product sold* factor against misleading use.¹⁶⁹ Thus content does double duty—both to qualify for the special analysis and to prevail at the misleading threshold.¹⁷⁰ This application highlights the potential overreach of the raised threshold test and echoes the flaw in the Ninth Circuit’s previous application of *Rogers*. The use of “punchbowl” as the Secret Service’s nickname for the Capitol is a thin reed on which to hang categorical immunity to “ordinary” trademark scrutiny.¹⁷¹

While the likelihood of confusion test might favor AJ Press, it did not favor another defendant that would have enjoyed categorical immunity under the raised threshold test. In *Vans, Inc. v. MSCHF Product Studio, Inc.*,¹⁷² the Second Circuit held that MSCHF was not entitled to heightened First Amendment protections for its use of

165. *Punchbowl I*, 52 F.4th at 1095.

166. *Id.* at 1101.

167. Farley & Ramsey, *supra* note 1, at 1286.

168. *Id.* at 1284.

169. *Id.* at 1287.

170. *Id.* at 1279–82.

171. *Punchbowl I*, 52 F.4th at 1095; *see also supra* Section II.C and notes 8–10, 46–49 and accompanying text.

172. 88 F.4th 125 (2d Cir. 2023) (per curiam).

Vans’ trademarks and Old Skool trade dress in a distorted “wavy” shoe.¹⁷³ MSCHF styled its Wavy Baby shoe as “a parodic work of artistic expression.”¹⁷⁴ The Wavy Baby looks like a microwaved or melted Old Skool shoe.¹⁷⁵

Consistent with the holding in *Jack Daniel’s*, the court concluded that MSCHF’s Wavy Baby shoes and packaging “evoked myriad elements of the Old Skool trademarks and trade dress,” and thus the *Rogers* safe harbor did not apply.¹⁷⁶ Instead, the court applied a likelihood of confusion analysis, weighing MSCHF’s parody claims as part of the analysis as instructed by the Supreme Court.¹⁷⁷ The court affirmed the finding of the district court, holding that MSCHF’s use of the marks and trade dress was likely to confuse consumers.¹⁷⁸ Key elements of the analysis included Vans’ previously created special editions of its Old Skool sneakers in collaboration with celebrities and high-profile brands;¹⁷⁹ the proximity of the goods—the district court viewed the MSCHF shoes as wearable shoes in addition to museum pieces;¹⁸⁰ and evidence of consumer confusion.¹⁸¹ The Second Circuit’s analysis of the parody argument was somewhat cursory but consistent with its precedent in cases where *Rogers* does not apply. The court noted that successful parodies generally make the humor clear; when they do not, the parody has not succeeded, and if confusion results, the use is infringing.¹⁸²

Commentary on the *Vans* case critiques the application of the multifactor test as insufficiently solicitous of “the value of expression or of parody.”¹⁸³ MSCHF’s claimed parody of shoe culture and the Vans

173. *Id.* at 138.

174. *Id.* at 134.

175. *Id.* at 140.

176. *Id.* at 138–39. MSCHF used the Vans trademarks which constitutes “quintessential ‘trademark use’” subject to the Lanham Act. *Id.* (quoting *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 155 (2023)).

177. *Id.* at 137–38 (quoting *Jack Daniel’s*, 599 U.S. at 161 (“[A] trademark’s expressive message—particularly a parodic one . . .—may properly figure in assessing the likelihood of confusion.”)).

178. *Id.* at 142.

179. *Id.* at 140.

180. *Id.*

181. *Id.* at 140–41.

182. *Id.* at 142.

183. See Mark A. Lemley & Rebecca Tushnet, *First Amendment Neglect in Supreme Court Intellectual Property Cases*, S. CT. REV. (forthcoming 2024) (draft at 25),

Old Skool as the pinnacle of that culture merits some reflection. MSCHF's commentary about the Old Skool shoe is both artistic and highly lucrative. Its use clearly leverages Vans' trademarks and trade dress. Applying the raised threshold in this case, or treating MSCHF's use as an expressive work because of its claimed artistic statement, would leave no place for the valid question of consumer confusion about sponsorship or affiliation, i.e., whether MSCHF and Vans collaborated on the drop. Brands and consumers reasonably care about the partnerships they embrace or eschew. Consider the decision of Adidas to cut ties with Ye in October 2022 after he made antisemitic remarks online.¹⁸⁴

Compare how the case would resolve under the authors' raised threshold test. Once the court perceived the claimed parody, MSCHF would cross the first stage threshold and could access the second stage fair use test.¹⁸⁵ The raised threshold test would simplify the inquiry in MSCHF's favor, replacing the *Polaroid* factors. Under the second stage express falsity analysis, MSCHF's use of the Vans trademarks and trade dress would not amount to an overt false claim of sponsorship or affiliation. Without the overt false claim, evidence of consumer confusion about a likely sponsorship between Vans and MSCHF would be irrelevant.¹⁸⁶

This follows because under the authors' second stage likely to mislead analysis, a court may not consider sponsorship or affiliation confusion at all; liability for use likely to mislead consumers about sponsorship or affiliation confusion is deemed insufficiently speech protective if the defendant's use includes enough expressive or

https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4691950 [<https://perma.cc/3QCZ-NHSE>]; see also Christine Haight Farley, *Hot Take on the Wavy Baby Decision* (Guest Blog Post), TECH. & MKTG. L. BLOG, Dec. 11, 2023, <https://blog.ericgoldman.org/archives/2023/12/hot-take-on-the-wavy-baby-decision-guest-blog-post.htm> [<https://perma.cc/3U55-59BM>] (suggesting that, under *Vans*, "within the structure of the multifactor likelihood of confusion test, it will be the burden of the parodist to prove that their joke clearly landed").

184. David McHugh, *Adidas Says It May Write Off Remaining Unsold Yeezy Shoes After Breakup with Ye*, AP NEWS (Nov. 8, 2023, 10:42 AM), <https://apnews.com/article/adidas-ye-kanye-west-antisemitism-df2df5a6489beba1a23ffefa6acc98c3> [<https://perma.cc/7UHF-AH3V>].

185. Farley & Ramsey, *supra* note 1, at 1267, 1280.

186. Cf. Lemley & Tushnet, *supra* note 183, at 25 (works with expressive, informational, or noncommercial elements should fall outside the scope of the Lanham Act absent "some *explicit* falsehood about source or sponsorship by the artist.").

informational matter to cross the first stage threshold. Testimony from “sneakerheads” and other independent sources persuaded the district court that Vans demonstrated sponsorship confusion,¹⁸⁷ but that evidence is irrelevant under the misleading use analysis. Instead, the court must consider objective evidence of the *content* and *context* of MSCHF’s use on the shoes sold. Although defendant is selling shoes that are wearable, if uncomfortable, the *product inquiry* may not dominate the analysis.¹⁸⁸ *Contextually*, MSCHF used Vans’ brand elements in the spaces consumers would expect source signifying use to appear.¹⁸⁹ But MSCHF’s distortion of Vans’ brand elements add new expression as the authors delineate their *content* element.¹⁹⁰ For the raised threshold test to have its desired outcome, a court would find it difficult to conclude the Wavy Baby is likely to mislead as to source, unless trademark *context* and the nature of the *products sold* outweighed the *content*.¹⁹¹

Comparing the Second Circuit’s application of the *Polaroid* factors to the raised threshold test highlights how the raised threshold test would smooth the path for parties able to plausibly claim expressive or informational uses. As David McGowan reminds us, that result would be reasonable if the speech interests of the junior user systemically dominate over the speech interests of the senior user.¹⁹² But the Supreme Court’s activity in another recent case suggests a more traditional test will better reflect the interests on both sides of a trademark dispute.

2. *First Amendment scrutiny after Elster—too big, too small, or just right?*

The Supreme Court returned to the question of the scope of congressional authority to regulate trademarks in *Vidal v. Elster*.¹⁹³ Elster sought a registration for TRUMP TOO SMALL as a mark for

187. *Vans, Inc. v. MSCHF Prod. Studio, Inc.*, 602 F. Supp. 3d 358, 368 (E.D.N.Y. 2022), *aff’d*, 88 F.4th 125 (2d Cir. 2023).

188. *Id.* at 1287.

189. *Vans, Inc.*, 602 F. Supp. 3d at 368 (describing an observation from the host of a “sneakerhead” podcast that “the average person” would mistake the shoes for Vans unless they could examine the label “with . . . a magnifying glass.”).

190. *Id.* at 1285–86.

191. Farley & Ramsey, *supra* note 1, at 1283.

192. McGowan, *supra* note 152, at 442–43 (refuting the formulaic argument that all copyright enforcement infringes speech because “it ignores the speaker whose words are copied. That speaker has as much normative claim as any other”).

193. 143 S. Ct. 2579 (June 5, 2023) (granting cert).

shirts.¹⁹⁴ The mark is a negative reference to former President Donald J. Trump that invokes both critiques of his preferred policy outcomes and his personal attributes.¹⁹⁵ A trademark examiner refused to register the trademark because Elster used Trump's name without his consent.¹⁹⁶ Such a registration is barred by section 2(c) of the Lanham Act.¹⁹⁷ Elster challenged the examiner's refusal as unconstitutional as applied to his critique of Trump.¹⁹⁸ The Trademark Trial and Appeal Board affirmed the examiner's decision, holding that even if heightened scrutiny applied, section 2(c) "is narrowly tailored to advance two compelling government interests: protecting the named individual's rights of privacy and publicity and protecting consumers against source deception."¹⁹⁹

On subsequent appeal, the Court of Appeals for the Federal Circuit noted that while Elster could make his protest and put his slogan on a shirt without a trademark registration, the correct question is "whether section 2(c) can legally disadvantage" Elster's speech by refusing to register his trademark.²⁰⁰ So framed, the appellate court rejected the government's arguments grounded in either Trump's privacy or his publicity interest, holding "the government does not have a privacy or publicity interest in restricting speech critical of government officials or public figures in the trademark context."²⁰¹

The Supreme Court granted the government's petition for certiorari.²⁰² The case has been argued but not yet decided.²⁰³ The oral argument suggests the Court will reverse the Federal Circuit and find section 2(c) constitutional as applied to the TRUMP TOO SMALL

194. *In re Elster*, 26 F.4th 1328, 1330 (Fed. Cir. 2022), *cert. granted sub nom. Vidal v. Elster*, 143 S. Ct. 2579 (2023).

195. *Elster*, 26 F.4th at 1330.

196. *Id.*

197. 15 U.S.C. § 1052(c).

198. *Elster*, 26 F.4th at 1330.

199. *Id.*

200. *Id.* at 1332.

201. *Id.* at 1339.

202. Greg Stohr, 'Trump "Too Small" Trademark Fight Gets US Supreme Court Review', BL NEWS (June 5, 2023, 9:31 AM), <https://www.bloomberglaw.com/product/blaw/bloomberglawnews/us-law-week> [<https://perma.cc/YAP4-DW9D>].

203. Kyle Jahner, *Justices Have Multiple Paths to Doom "Trump Too Small" Trademark*, BL NEWS (Nov. 3, 2023, 1:30 PM), <https://www.bloomberglaw.com/bloomberglawnews/ip-law/XO2KLS000000?> [<https://perma.cc/ZW7A-ZCFV>].

trademark.²⁰⁴ Some threads from the oral argument hint that the Court is unlikely to further constitutionalize judicial relief in trademark disputes. Moreover, some justices indicated an interest in dialing back the severity of intermediate scrutiny analysis of federal trademark statutes.

First, on the question of the constitutional scrutiny, Justice Kagan advanced the characterization of the 2(c) bar as a case of the government declining to support speech.²⁰⁵ She pressed the government's attorney on whether the correct standard of review was rationality or reasonableness,²⁰⁶ both of which are less demanding than heightened, intermediate, or strict scrutiny.²⁰⁷ Justice Sotomayor queried whether there was a "rational basis for the government's activity" in setting the 2(c) bar, noting that "these kinds of limitations have been historically accepted, [so] there's certainly a rational basis . . . for the . . . government's actions."²⁰⁸ Justice Kavanaugh complained, regarding intermediate scrutiny, "I don't really know what that means other than is it reasonable. What's the difference?"²⁰⁹ An inquiry into whether the 2(c) bar was a rational or reasonable exercise of Congressional power provides more legislative discretion than would an application of heightened or strict scrutiny. If the Court is less interested in applying exacting scrutiny to bars to registration, it may be commensurately less likely to apply it in contests between parties in trademark litigation. Perhaps these questions herald yet another swing in intermediate scrutiny of commercial speech.²¹⁰

204. See, e.g., Transcript of Oral Argument at 73:6–19, 143 S. Ct. 2579 (2023) (No. 22-704) [hereinafter Transcript] (detailing how in a conversation between Elster's attorney and Justice Kavanaugh, Mr. Taylor noted "the burden should be on the government to try to justify the law," to which Justice Kavanaugh replied that he and others had offered the rationale, "a judgment that you shouldn't be able to profit off use of someone else's name").

205. Transcript, *supra* note 204, at 33:13–17.

206. *Id.* Justice Kagan indicated rationality might be distinguished from reasonableness because the latter considers whether the speaker has other expressive opportunities as a means of avoiding hidden but official oppression. Transcript at 33:19–24.

207. Transcript, *supra* note 204, at 33:16–17.

208. Transcript, *supra* note 204, at 21:4–13.

209. Transcript, *supra* note 204, at 72:6–9.

210. The severity of judicial scrutiny over commercial speech has waxed and waned in the half century since *Va. State Board of Pharmacy* was decided. See Nat Stern, *The Stubborn Survival of the Central Hudson Test for Commercial Speech*, 45 SEATTLE U.L. REV. 647, 653–60 (2022); see also *supra* note 23 and accompanying text.

Second, several of the Justices seemed amenable to the idea that every person (including former presidents) might have, as Justice Alito phrased it, “almost a quasi-property interest, in his or her own name[.]”²¹¹ Justice Gorsuch referred to a long history “since the founding . . . common law type stuff” of prohibiting trademarks mentioning a living person’s name without their consent.²¹² That history was also referenced by Justices Sotomayor²¹³ and Kavanaugh.²¹⁴ Justice Jackson referred to a restriction on registering the names of other people as a means of preventing confusion,²¹⁵ although that particular false endorsement angle might be better captured by section 2(a)’s bar on false connections. In summing up the perceived persuasive power of this history, Justice Gorsuch noted the difficulty of arguing such a bar “is inconsistent with the First Amendment.”²¹⁶

Finally, questions from the Court drew admissions from Elster that he could engage in the decorative or ornamental use of the slogan on the front of a T-shirt or other apparel without securing a trademark registration.²¹⁷ Indeed, the trademark office should reject an application to register an ornamental use like Elster’s on the front of a T-shirt because it fails to function as a trademark.²¹⁸ Some Justices also raised the possibility that Elster’s trademark registration would allow him to pursue other critics of Trump whose messages on T-shirts were confusingly similar to his own. For example, Chief Justice Roberts asked whether registering the TRUMP TOO SMALL trademark would “undermin[e] First Amendment values because the whole point of the trademark, of course, is to prevent other people from doing the same

211. Transcript, *supra* note 204, at 68:13–16.

212. Transcript, *supra* note 204, at 57:2–10; *see also* Transcript, *supra* note 204, at 14:14–20, 15:6–8. For one plausible source recounting the historical protection of personal reputation and dignity in infringement and unfair competition actions, see Jennifer E. Rothman, *Navigating the Identity Thicket: Trademark’s Lost Theory of Personality, the Right of Publicity, and Preemption*, 135 HARV. L. REV. 1271, 1307–09 (2022).

213. Transcript, *supra* note 204, at 21:7–13.

214. Transcript, *supra* note 204, at 55:23–56:2, 72:23–25.

215. Transcript, *supra* note 204, at 53:18–54:6.

216. Transcript, *supra* note 204, at 57:2–10.

217. Transcript, *supra* note 204, at 44:16–20 (exchange between Justice Thomas and Mr. Taylor).

218. *See, e.g.*, Roberts, *supra* note 110, at 2006, 2042 (discussing the ornamental basis for refusal to register); TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1202.03 (2023).

thing?”²¹⁹ Thus, granting trademark protection also had speech chilling implications.

B. First Amendment Scrutiny of Judicial Enforcement of Trademarks

The tea leaves from *Elster* suggest members of the Court see rights on both sides of the 2(c) bar. If the Court holds the section 2(c) bar to be constitutional, it remains to be seen what level of formal constitutional scrutiny it will apply, if any. If the Court’s opinion in *Elster* weighs the competing interests of the person whose name, likeness, or signature would otherwise appear in the registration against the hopeful registrant, that would continue a path charted when the Court in *Jack Daniel’s* declined to apply a raised First Amendment hurdle in assessing VIP’s source signifying trademark use. Those decisions might indicate that the Court is unlikely to require heightened scrutiny of judicial enforcement of many trademark disputes.²²⁰ This does not mean that the expressive interests of the alleged infringer are irrelevant, just that they do not hold the dominant position in the analysis. Nor would such a result signal a failure by a court to meet its constitutional duty to protect a speaker from government interference. In trademark cases, there are speakers on both sides of the dispute.

Trademark law’s current contours are otherwise unlikely to trigger heightened scrutiny. The Lanham Act does not reflect attempts by government officials to “approv[e] or disapprov[e] content, . . . feather their nests, hide their misdeeds, or perpetuate their power,”²²¹ which are the types of harms typically invoked when the First Amendment shields critics from the exercise of government power. To persuade courts that an adjustment to trademark infringement standards is constitutionally mandated should reasonably require the proponent to establish that speech-protective gateways will generally operate in those cases where “the speech

219. Transcript, *supra* note 204, at 60:12–17 (Roberts, J.).

220. *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 154–55 (2023). Mark Lemley and Rebecca Tushnet see the expected reversal in *Elster* as of a piece with a view that the government is empowered to act to protect private intangible property (here, something akin to a federal right of publicity) without violating the First Amendment, because the government is not asserting interests of its own. Lemley & Tushnet, *supra* note 183, draft at 44 n.134; *see also id.* at 30–31 n.96.

221. McGowan, *supra* note 152, at 445–48.

interests of defendants were systematically greater than the interests of plaintiffs,”²²² and not in those cases where the converse is true.

1. *Judicial enforcement of trademarks as prior restraint*

One line of First Amendment critiques asks whether the grant of injunction works a prior restraint on the defendant’s expression. Some experts have argued that enforcing trademark rights via judicial order amounts to state action subject to heightened scrutiny.²²³ Recently, Mark Lemley and Rebecca Tushnet have asserted that the Supreme Court has overly simplified the state action doctrine and evinced less concern about “courts actually ordering people not to speak than . . . about the potential chilling and distorting speech implications of ordinary regulations by other branches of government.”²²⁴

222. *Id.* at 448 (discussing the result of treating copyright enforcement as state action and subjecting copyright claims to First Amendment scrutiny where both the copyright owner and the copier have speech claims).

223. Yvette Joy Liebesman, *Offensive Mark Owners Have an Enforcement Problem*, 59 HOUS. L. REV. 57, 87 (2021) (distinguishing trademark enforcement from trademark registration, and arguing that “it is at the enforcement of a mark that it becomes government speech”) (citing *Shelley v. Kraemer*, 344 U.S. 1, 18–19 (1948)); Dan L. Burk, *Patents and the First Amendment*, 96 WASH. U.L. REV. 197, 236 (2018) (“[T]he system that vets and certifies patent claims, allowing them to be enforced via the coercive mechanisms of the state, is undoubtedly state action.”); Lisa P. Ramsey, *Free Speech Challenges to Trademark Law After Matal v. Tam*, 56 HOUS. L. REV. 401, 455 (2018); Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 SMU L. REV. 381, 407–08 (2008); Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 224 (1998); Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 190, 192 n.146. *But see* S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm., 483 U.S. 522, 547 (1987) (“The USOC’s choice of how to enforce its exclusive right to use the word ‘Olympic’ simply is not a governmental decision.”). *See also* McGowan, *supra* note 152, at 442 (refuting the strong form argument that enforcing copyrights is state action, and noting that, unlike “the classic free-speech worry [] that government officials will evaluate speech to see whether it suits them, and suppress or penalize speech that does not,” courts in copyright cases “do not judge the merit or acceptability of speech. They compare the defendant’s speech to the plaintiff’s”). *See generally* Tun-Jen Chiang, *Patents and Free Speech*, 107 GEO. L.J. 309, 333–34 (2019) (comparing state action in copyright and patent at the creation of individual rights and concluding that patent law involves state action “because every patent is individually examined and issued by the PTO.”). Chiang’s analysis would suggest that there is no state action in the recognition of unregistered but valid trademarks, which, like copyrights, are effective “upon the creation of the work, without the need for registration,” but that there is state action in the registration of trademarks because they are individually examined and issued, like patents.

224. Lemley & Tushnet, *supra* note 183, draft at 43.

But if questions from the Justices that emphasize the importance of historical practice in the *Elster* oral argument coalesce into an opinion finding section 2(c) constitutional,²²⁵ that bodes well for the continued use of injunctions as the primary remedy in trademark cases. Such a holding would hint at the Court's disinclination to treat the grant of an injunction as a potentially unconstitutional state action.

The historical record further suggests constitutionalizing judicial remedies in trademark law would be an uphill climb.²²⁶ Nearly two centuries ago, Lord Westbury recognized that the courts of equity rested their jurisdiction "upon property, and the Court interferes by injunction, because that is the only mode by which property of this description can be effectually protected."²²⁷ Courts have historically granted injunctions to remedy trademark infringement, despite defendants' protests of prior restraint.²²⁸ Indeed, preliminary injunctions have been upheld in Lanham Act cases, even against noncommercial speech.²²⁹ Treating a grant of injunctive relief as state

225. See Transcript, *supra* note 204, at 14–17 (Gorsuch, J.); *id.* at 56 (Kavanaugh, J.).

226. See Tun-Jen Chiang, *Rehabilitating the Property Theory of Copyright's First Amendment Exemption*, 89 NOTRE DAME L. REV. 521, 576 (2013) (noting that while courts are comparatively "more willing to directly apply the First Amendment to trademark cases than to copyright cases, they are still overall extremely hesitant to do so," a phenomenon Chiang attributes in significant part to "the fact that trademark is generally regarded as property"); *id.* at 575 n.266 ("Although less extensive than in the copyright context, the literature arguing in favor of applying First Amendment scrutiny to trademark law makes the same basic argument as in the copyright context."); Ramsey, *supra* note 223, at 385 (noting that while "many current trademark doctrines raise First Amendment concerns . . . courts do not generally apply constitutional analysis to trademark laws or injunctions").

227. *Leather Cloth Co. v. Am. Leather Cloth Co.* 4 De G.J. & S. 137, 142, 46 Eng. Rep. 868, 870 (Ch) (1863); see also Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1849–62 (2007) (describing historical use of trade marks, tracing from medieval usage and English common law to the early American trademark jurisprudence); Linford, *Injunction*, *supra* note 122, at 424 [§ 3.2.1] (noting that Chancery courts deciding trademark matters settled on providing equity via injunctions).

228. See, e.g., *Vans, Inc. v. MSCHF Prod. Studio, Inc.*, 88 F.4th 125, 142 n.8 (2d Cir. 2023) ("Generally, if a product is found to infringe, preliminary injunctions under the Lanham Act are *not* considered prior restraints." (citing *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979)); MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, *supra* note 14, § 31:142 (5th ed.) (citation omitted).

229. *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1396 (9th Cir. 1997).

action that then mandates formal constitutional scrutiny in the average trademark case would run counter to that history.

2. *A place for the consuming public*

The raised threshold test claims indifference both to the intent of the alleged infringer and to survey evidence. The latter is an oft-utilized means of measuring the impact of the defendant's use on the consuming public.²³⁰ The authors instead invite courts to determine on the pleadings what a reasonable person might conclude about the defendant's use.²³¹ That approach may distort the competitive market more than the authors recognize.

A properly functioning trademark system has three key objectives that are often complementary but sometimes in tension: reducing consumer search costs, encouraging mark owner investment in consistent quality, and maintaining a fair competitive environment.²³² Correctly calibrated, trademark law encourages the mark owner to invest in the source significance of the trademark, which empowers the mark to communicate information to consumers about source and quality. New entrants are encouraged to compete on quality and price, but "discouraged from free riding on the mark's source significance or . . . impeding the information transmission function of the mark."²³³ Indeed, the debate about whether trademark law is properly viewed as preventing consumer confusion, or protecting the property right of the mark owner,²³⁴ resolves in part when we recognize the property the mark owner aspires to hold is driven by and centered in consumer goodwill or consumer perception.²³⁵ The mark owner holds rights to

230. Farley & Ramsey, *supra* note 1, at 1276, 1279.

231. *Id.* at 1283.

232. *Matal v. Tam*, 582 U.S. 218, 223–25; *see also* Linford, *Residual Goodwill*, *supra* note 132, at 817–18; Robert G. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U. L. REV. 547, 549 (2006) (describing that under the "information transmission model," trademarks are "devices for communicating information to the market" and tools to "prevent[] others from using similar marks to deceive or confuse consumers").

233. Jake Linford, *Placebo Marks*, 47 PEPP. L. REV. 45, 53 (2019).

234. *Compare* Bone, *supra* note 232, at 560 (highlighting judicial treatment of trademarks as property), *with* McKenna, *supra* note 227, at 1916 (framing modern trademark law as industrial policy protecting consumer expectations).

235. *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 413 (1916) ("Common-law trade-marks, and the right to their exclusive use, are . . . property rights . . . only in the sense that a man's right to the continued enjoyment of his trade reputation and the

the extent that the mark provides communicative information. The raised threshold encourages courts to ignore the most commonly provided evidence of consumer perception. But if devaluing consumer perception becomes the dominant approach in trademark litigation, it threatens to distort the market for consumer goods.

3. *Good, fast, and cheap?*

Farley and Ramsey prefer their raised threshold test in part because avoiding fact-intensive inquiries into defendants' intent and the impact of defendants' use on consumers provides an opportunity for courts to streamline analysis and resolve cases at an earlier stage of litigation.²³⁶ The raised threshold test proposes to replace multiple nuanced inquiries with a simplified process to resolve cases at an earlier stage.²³⁷ To do that work, the test must push the decision point in trademark disputes earlier, and therefore must simplify the evidentiary burden on courts and defendants. The more effectively it fulfills that role, the more rule-like it must become.

But rules and rule-like proxies are known to over- and under-correct undesirable behavior, compared to more nuanced standards.²³⁸ Rules trade simplicity for accuracy, reducing administrative costs but increasing error costs. While the authors' tripartite inquiry into misleading use provides more guidance than the *Rogers* "explicitly misleading" phrase, its recursiveness will likely lead to the same uniform results—defendants who successfully invoke expressive or informational matter will prevail irrespective of likely confusion, source indication, or commerciality.²³⁹

Rule-like clarity is one clear virtue of the Supreme Court's hinted approach to *Rogers*; granting motions to dismiss in litigation over creative works that contain non-source indicating uses of trademarks minimizes administrative costs in the cases where the error cost is lowest. A court might also economize by focusing on works where the expressive content typically dominates over trademark uses: the

good-will that flows from it, free from unwarranted interference by others, is a property right, for the protection of which a trade-mark is an instrumentality." (citation omitted); Linford, *Residual Goodwill*, *supra* note 132, at 815 n.24.

236. Farley & Ramsey, *supra* note 1, at 1291 (discussing how because their test does not require an evaluation of certain evidence, cases where it applies can be dismissed at an earlier stage); *see also id.* at 1247.

237. *Id.* at 1291.

238. Linford, *Fanciful*, *supra* note 84, at 760.

239. *See supra* Section II.B.2.

Supreme Court speaks approvingly in *Jack Daniel's* of lower courts applying *Rogers* to a pop song, a painting of a sporting event, and a motion picture.²⁴⁰ Such a shortcut might be easier to apply than the authors' preferred inquiry into expressive or informational matter.

Ideally, courts could retain some analytical complexity while reducing the decision time for the easiest cases. Courts can grant motions to dismiss or motions on the pleadings in intellectual property cases before discovery, even when their speech clause analysis is not truncated.²⁴¹ Indeed, the Supreme Court in *Jack Daniel's* noted the importance of avoiding "full-scale litigation" even in source confusion cases when the defendant's use "will not present any plausible likelihood of confusion."²⁴² In those cases, "the district court should dismiss the complaint under Federal Rule of Civil Procedure 12(b)(6)."²⁴³

4. *On dilution and its discontents*

Finally, the authors cabin the question of whether anti-dilution protection against blurring and tarnishing uses violate the Free Speech clause of the First Amendment. The Lanham Act protects famous marks against uses that are nonconfusing but either blur or diminish the distinctiveness of the famous mark or harm the reputation of the famous mark.²⁴⁴

240. *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 154–55.

241. *See, e.g.*, *Brody v. Fox Broad. Co.*, No. 22CV6249, 2023 WL 2768730, at *1, *4 (S.D.N.Y. Apr. 3, 2023) (holding that fair use was "so clearly established on the face of the amended complaint and its incorporated exhibits as to support dismissal" (quoting *TCA Television Corp. v. McCollum*, 839 F.3d 168, 178 (2d Cir. 2016))); *Stouffer v. Nat'l Geographic Partners, LLC*, 460 F. Supp. 3d 1133, 1140, 1146 (D. Colo. 2020) (crafting a six-factor test to elicit whether the junior user had "a genuine artistic motive for using the senior user's mark" but nonetheless granting defendant's motion to dismiss); *Brownmark Films, LLC v. Comedy Partners*, 682 F.3d 687, 691 (7th Cir. 2012) (treating defendant's motion to dismiss on fair use grounds as a motion for summary judgment and granting the motion prior to discovery).

242. *Jack Daniel's*, 599 U.S. 140 at 176 n.2 (2023) (citing 6 MCCARTHY § 32:121.75).

243. *Id.* at 176–77 n.2.

244. 15 U.S.C. § 1125(c). The authors' Article already undertakes Herculean labors, and a full analysis of dilution's constitutionality has been offered by other works. *See* Farley & Ramsey, *supra* note 1, at 1256 n.143. *But see id.* at 1274 n.211 (positing that the raised threshold test could be applied to dilution actions). *See also id.* at 1277 n.216 (citing scholars including Ramsey as having "persuasively argued that trademark dilution laws conflict with the First Amendment," but recognizing that "an evaluation of the constitutionality of these laws regulating nonmisleading commercial speech is beyond the scope of this Article").

Taking a page from the Supreme Court’s analysis of free speech concerns about copyright protection, dilution laws might survive constitutional scrutiny because of the clear statutory insulation of non-actionable nominative and descriptive fair uses, comparative advertising, parody, criticism, commentary, news reporting, and noncommercial uses from liability under the antidilution statute.²⁴⁵ Similarly, in *Eldred v. Ashcroft*,²⁴⁶ the Supreme Court viewed the idea-expression divide and the fair use inquiry as “traditional contours” of copyright that were sufficiently speech protective to preclude the need for exacting or intermediate First Amendment scrutiny, so long as Congress did not alter those contours.²⁴⁷ Thus, the Court may be reluctant to find anti-dilution protection to be unconstitutional.

If, as some argue,²⁴⁸ antidilution protection is subject to heightened scrutiny, then the government must have a basis for asserting that “the harms it recites are real and that its restriction will in fact alleviate them to a material degree.”²⁴⁹ Scholarship testing the empirical evidence of

245. 15 U.S.C. § 1125(c)(3)(A)–(C); *see also* *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 431 (2003) (noting that the addition of fair use and noncommercial use provisions in the Federal Trademark Dilution Act appeared to quell concerns raised against a dilution provision—considered as part of The Trademark Law Revision Act of 1988—that “might have applied to expression protected by the First Amendment”). *But see* Lisa Ramsey, *A Free Speech Right to Trademark Protection?*, 106 TRADEMARK REP. 797, 879–80 (2016) (arguing that copyright law and trademark law differ in crucial ways, including a comparative absence of limitations on trademark subject matter).

246. 537 U.S. 186 (2003).

247. *Id.* at 219–21 (“[W]hen, as in this case, Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary.”).

248. *See* Ramsey, *supra* note 223, at 443 (articulating how dilution laws regulate based on viewpoint); Zahraa Hadi, *If Disparagement Is Dead, Dilution Must Die Too*, 33 BERKELEY TECH. L.J. 1189, 1190, 1216–17 (2018) (suggesting antidilution protection suppresses speech); Rebecca Tushnet, *Stolen Valor and Stolen Luxury: Free Speech and Exclusivity*, in *THE LUXURY ECONOMY AND INTELLECTUAL PROPERTY: CRITICAL REFLECTIONS* 121–22 (Haochen Sun, Barton Beebe & Madhavi Sunder eds., 2015) (exploring why courts in the U.S. support antidemocratic theories that justify the suppression of nonfalse speech); Mary LaFrance, *No Reason to Live: Dilution Laws as Unconstitutional Restrictions on Commercial Speech*, 58 S.C. L. REV. 709, 718–22 (2007) (recommending higher First Amendment protection for advertising and commercial speech to guard against trademark suppression).

249. *Edenfield v. Fane*, 507 U.S. 761, 771 (1993); *see also* *United States v. Alvarez*, 567 U.S. 709, 725 (2012) (holding that in passing the Stolen Valor Act, which criminalized telling lies about receiving military honors, Congress failed to articulate “a direct causal link between the restriction imposed and the injury to be prevented”); Jake Linford, “*Tell the Truth*”: *Truth in Music Advertising Post Tam*, in *OXFORD HANDBOOK*

blurring and tarnishment yields mixed results.²⁵⁰ If blurring or tarnishment as phenomena resist empirical testing—or the net result of tests indicates the harm is more imagined than real—then the antidilution provision might be ripe for reconsideration irrespective of its speech-protective safety valves.²⁵¹

But the holding in *Jack Daniel's* and the oral argument in *Elster* suggest that the Court's constitutional skepticism of trademark regulation on display in *Tam* and *Brunetti* is already ebbing.²⁵² Moreover, the Court could reasonably differentiate between the government's refusal to register trademarks due to their disparaging or scandalous nature and the judicial protection of famous marks against blurring and tarnishment. This distinction aligns with the Court's stated view that trademark rights remain generally enforceable, consistent with the First Amendment.²⁵³

CONCLUSION

After gorging itself on the disparaging, scandalous, and immoral bars to registration, the Supreme Court's appetite for First Amendment scrutiny in trademark contexts may be sated. Courts invited to try the raised threshold test will likely find its streamlined approach to speech analysis inconsistent with the most recent guidance from the Supreme Court. Instead, accounting for expressive uses as part of the likelihood of confusion inquiry will provide sufficient protection for First Amendment concerns in trademark cases without casting aside nuance that helps ground the judicial view of the market in actual consumer experience.²⁵⁴ But should the Court again find its edacity for constitutional reconstruction of the trademark

OF MUSIC LAW AND POLICY (Seán M. O'Connor ed., 2020) (summarizing arguments that *Alvarez* may signal the Court's willingness to apply heightened First Amendment scrutiny to laws that punish reputation-related harms, including antidilution laws).

250. See Jake Linford, Justin Sevier & Allyson Willis, *Trademark Tarnishmyths*, 55 ARIZ. ST. L.J. 609, 616–17 (2023) (summarizing the literature testing tarnishment); see also *id.* at 616 n.21 (summarizing the literature testing blurring).

251. *Id.* at 642. For a summary of the evidence considered by Congress during debates about the Trademark Dilution Revision Act, see Jake Linford & Kyra Nelson, *Trademark Fame and Corpus Linguistics*, 45 COLUM. J.L. & ARTS 171, 179–85 (2022).

252. See *supra* notes 204–19 and accompanying text.

253. *Jack Daniel's Props., Inc. v. VIP Prod. LLC*, 599 U.S. 140, 169.

254. See Laura A. Heymann, *The Reasonable Person in Trademark Law*, 52 ST. LOUIS L.J. 781, 785–86 (2008) (recognizing that trademarks are encountered by consumers who may not resemble the judge deciding the case, and that the “reasonable person” in trademark law is a judicial construct).

statute, Christine Haight Farley and Lisa Ramsey have provided it with a banquet that will allow it to replace a plethora of precise speech-protective doctrines with a broad and categorical test to insulate expressive and informational uses from liability in many—if not most cases.