

The Constitutional Future of Trademark Tarnishment

or

What the *Elster*?

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Constitutional Scrutiny

- ❖ Strict scrutiny
 - ❖ Speech restriction must be **narrowly tailored** to serve **compelling** state interests
- ❖ Viewpoint-based restrictions
 - ❖ E.g., bar on registering scandalous or immoral trademarks (*Iancu v. Brunetti*, Tam concurrence (Kennedy, J.))
- ❖ Some content-based restrictions
 - ❖ E.g., *Reed v. Town of Gilbert* – content-based restrictions on signage.

Constitutional Scrutiny

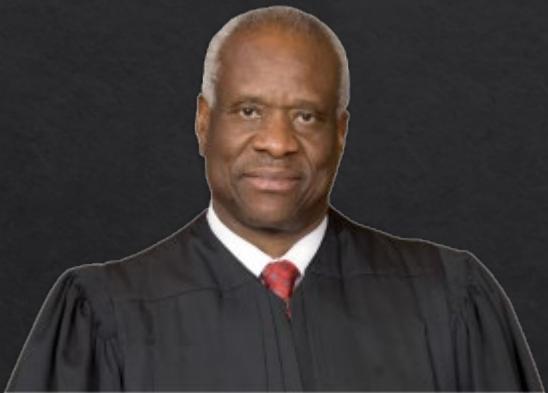
- ❖ *Central Hudson* / intermediate
 - ❖ Speech restriction must serve “a **substantial** interest” and be “**narrowly drawn**” (*Tam* plurality)
- ❖ Some content-based restrictions
 - ❖ See Stern (2022); Lakier (2016)
- ❖ Rational basis
 - ❖ *Eldred v. Ashcroft*: “we are not at liberty to second-guess congressional determinations and policy judgments of this order”
 - ❖ Speech restrictions embedded in copyright provisions
 - ❖ *Eldred*; *Golan v. Holder*

Content-based (viewpoint neutral) registration bars



- ❖ Lanham Act section 2(c) bars registration of a trademark that
- ❖ “[c]onsists of or comprises a name . . . identifying a particular living individual except by his written consent,”
- ❖ Elster lacked Trump’s consent
- ❖ Trademark office rejected the application
- ❖ Federal Circuit reversed, holding government lacked a substantial interest in protecting names on privacy or property grounds

2(c) – content-based, but doesn't violate 1A



2(c) – content-based, but doesn't violate 1A

- ❖ Justice Thomas, writing for the majority:
 - ❖ “despite its content-based nature, trademark law has existed alongside the First Amendment from the beginning. That longstanding, harmonious relationship suggests that heightened scrutiny need not always apply in this unique context.”

Concurrences – not fans of history + tradition

Justice Barrett

- ❖ Even if the Court's evidence of existence of a “common-law tradition” and a “historical analogue” were rock solid, I still would not adopt this approach.

Justice Sotomayor

- ❖ The majority approach, looking to history and tradition of the clause and no further, is like looking over a crowd to find your friends.

2(c) – content-based, but doesn't violate 1A

- ❖ Justice Barrett, concurring in part
 - ❖ Content based trademark restrictions are “permissible so long as they are reasonable in light of the trademark system’s purpose of facilitating source identification,” and “do not trigger the presumption of unconstitutionality.”
 - ❖ ...reasonably related to the preservation of the markowner's goodwill and the prevention of consumer confusion.

2(c) – content-based, but doesn't violate 1A

- ❖ Justice Sotomayor, concurring in the judgment
 - ❖ When assessing the constitutionality of a content-based trademark restriction, the Court should consider whether the restriction is reasonable in light of the purpose of the trademark system:
 - ❖ identifying and distinguishing goods for the public
 - ❖ A reasonable regulation “must reasonably serve the purpose of the content-based scheme

First Amendment Challenges to Tarnishment

- ◊ Section 43(c)(2)(C) of the Lanham Act, the tarnishment provision, imposes liability on use of a mark or trade name which creates “an association arising from the similarity” to “a famous mark that harms the reputation of the famous mark.”



First Amendment Challenges to Tarnishment

- ❖ Is protection against tarnishment consistent with “history and tradition”?
- ❖ Is protection against tarnishment regulation reasonably related to trademark law’s purpose of preservation of the mark owner’s goodwill and/or the prevention of consumer confusion?
- ❖ Is there enough evidence of tarnishment to provide Congress with a basis for granting anti-tarnishment protection?
- ❖ Is the tarnishment provision viewpoint-based?
- ❖ How liberally should courts use constitutional scrutiny to second guess commercial regulation?

Anti-tarnishment consistent with “history and tradition”?

- ❖ Thomas, J., in *Elster*, quoting Yale Elec. Corp. v. Robertson, 26 F. 2d 972, 974 (CA2 1928) (Hand, J.).
 - ❖ Appropriating the reputation of the mark owner “is an injury, even though the borrower does not tarnish it, or divert any sales by its use; for a reputation, like a face, is the symbol of its possessor and creator, and another can use it only as a mask.”
 - ❖ Suggests an early 20th century understanding that tarnishing use of a mark, use that harms the reputation of the mark, might be actionable even in the absence of confusion
- ❖ Cf Rosen, Gibbons, Mazzurco – turn of the 20th century trademark law embraced the idea that a lawful trademark “must avoid transgressing the rules of morality or public policy”

Is tarnishment law reasonably related to preserving goodwill or preventing confusion?

- ❖ Barrett, J., quoting Jack Daniel's Properties
 - ❖ "The law protects trademarks because they help consumers identify the goods that they intend to purchase and allow producers to 'reap the financial rewards associated with the[ir] product's good reputation.'" *Jack Daniel's Properties, Inc.*
 - ❖ "if the markowner's goods or services are shoddy, she might jeopardize the named individual's reputation."
- ❖ Sotomayor, J., noting the connection between trademarks and identity
 - ❖ Famous baseball players "Jeter and Posada [would not] want a Boston Red Sox fan to manufacture cheaper goods and use their names to promote second-rate products."

Is there evidence of harm from tarnishment?

- ❖ Courts frequently conclude that connection to drugs or sex will have an **“unfairly destructive effect”** on the appropriated trademarks.
- ❖ If so, we have the sort of harm to mark owners that might preserve dilution by tarnishment from a potential constitutional challenge.
- ❖ But if not, that might militate in favor of a **constitutional challenge** to the tarnishment provision of the TDRA or in favor of requiring **stronger evidentiary proof** at trial (see *Alvarez, Tam, Brunetti*)
- ❖ Empirical evidence is mixed – my own coauthored study suggests the harm is weak.

VIP Products LLC v. Jack Daniel's Properties, Inc.

- ❖ VIP argued that the tarnishment provision is a viewpoint-based restriction that cannot survive either strict or intermediate scrutiny.
- ❖ Tarnishing a mark is actionable, burnishing a mark is not
- ❖ No tarnishment claim against a “positive parody”
- ❖ The only explicable interest is to “stop speech that the government does not like, or to stop criticism of speech it does like.”

VIP Products LLC v. Jack Daniel's Properties, Inc.

- ❖ Obviously, Jack Daniel's disagreed
- ❖ More interesting, so did the government –
- ❖ The government's brief argues first that the tarnishment provision is viewpoint neutral.
- ❖ "Graffiti" analogy
 - ❖ Graffiti on a building may lower the commercial value of the building, and the tendency of consumers to patronize businesses in the building, irrespective of the graffiti's message
 - ❖ although the government doesn't characterize it that way.

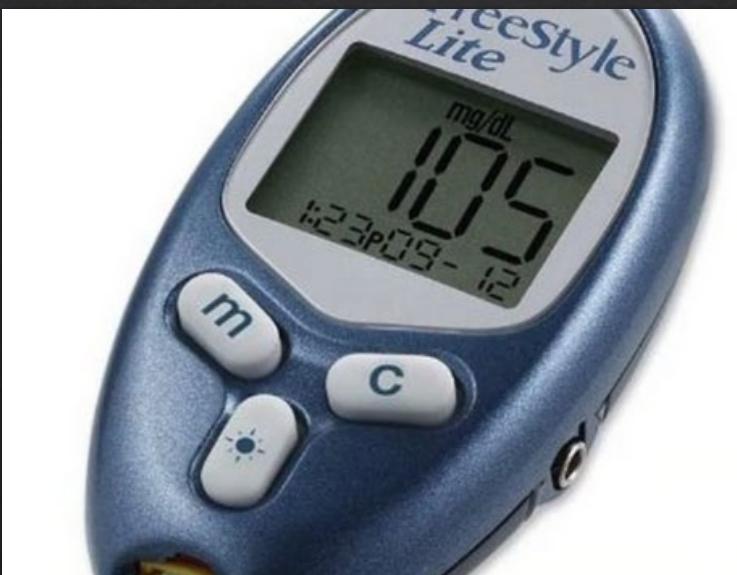
VIP Products LLC v. Jack Daniel's Properties, Inc.

- ❖ “Whether an “association . . . harms the reputation of the famous mark” does not depend on the viewpoint (if any) expressed in connection with the tarnishing use.
- ❖ Instead, liability for tarnishment turns on proof that harm to the famous mark is likely to follow from the use of a similar mark or tradename in connection with a **discordant** use.
- ❖ Citing *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 30 (1st Cir. 1987) (“The threat of tarnishment arises when the goodwill and reputation of a plaintiff’s trademark is linked to products which are of **shoddy quality** or which **conjure associations that clash** with the associations . . . generated by the owner’s lawful use of the mark.”).
- ❖ “Dilution by tarnishment . . . focuses on the **likely effect** of the mark’s use, not the expressive content of the mark itself.”



VIP Products LLC v. Jack Daniel's Properties, Inc.

- ❖ “Dilution by tarnishment … focuses on the likely effect of the mark’s use, not the expressive content of the mark itself.”
- ❖ Imagine a glucose monitor
- ❖ branded with the Cheesecake Factory trademark
- ❖ A “valuable lifesaving device[]” that “the Cheesecake Factory would have very strong reasons to not want” associated with its mark



VIP Products LLC v. Jack Daniel's Properties, Inc.

- ❖ Gov't argued the tarnishment provision satisfies intermediate scrutiny, following *San Francisco Arts & Athletics v. United States Olympic Committee* (1987)
- ❖ Applies only to commercial uses (albeit narrower than the constitutional category of commercial uses post SCOTUS holding in *JDPI*)
- ❖ Any “restrictions on expressive speech [were] . . . incidental to the primary congressional purpose of encouraging and rewarding the [Olympic Committee’s source identifying] activities.” SFAA, 483 U.S. at 536.
- ❖ Statutory limits on dilution are more speech protective than limits identified in SFAA

First Amendment as “Deregulatory Cudgel”



Thank you!

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