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A Counterintuitive Approach to the Interaction Between Trademarks and Freedom of Expression in the US and Europe: A Two-Way Relationship

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As trademarks have evolved to perform an expressive function, courts and scholars on both sides of the Atlantic have devoted increased attention to elucidating when, and how, marks and speech interact. Three forms of interaction can be identified in US and European case law. First, in infringement litigation, a defendant can invoke speech with a view toward insulating from liability his unauthorized use of plaintiff's mark for expressive purposes, usually for parody or commentary. Second, in trademark registration, unsuccessful applicants can invoke speech to challenge the validity of a refusal of registration. And third, in constitutional challenges, a trademark owner can invoke speech in seeking to strike down public measures encroaching on trademark use. Regrettably, to date, commentators have had a tendency to focus on one form of interaction at a time, placing special emphasis on infringement cases. Their analyses and proposals for reform have privileged this form of interaction in an effort to avoid the severe repercussions that unbridled enforcement of trademark rights could have on defendants' speech. This has led to an impoverished understanding of the interaction between marks and speech, broadly considered. In the absence of comprehensive studies covering the diversity of instances where both sets of rights interact, conventional wisdom posits that their interaction is unidirectional, in the sense that trademark rights chill expression. This Article seeks to redress this misconception by engaging in a taxonomic analysis of the diverse scenarios in which marks and speech interact. Their joint study reveals that this interaction is best understood as a two-way street, where freedom of expression can simultaneously limit and validate trademark rights. This Article posits that the proposed reconceptualization of the interaction between marks and speech can contribute significantly to the advancement of the field.

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INTRODUCTION

Trademarks no longer only serve a source-identifying function, but rather have evolved to perform a plethora of functions. These range from signaling information about quality or reputation to conveying complex messages that different individuals can rely upon for expressive purposes.[2] The expressive

2. Trademarks' ability to perform functions beyond source-signaling has been widely acknowledged by courts and commentators on both sides of the Atlantic. *See*, in the United States: Mattel, Inc. v. MCA Recs., Inc., 296 F.3d 894, 900 (9th Cir. 2002) ("[T]rademarks [can] transcend their identifying purpose. Some trademarks enter our public discourse and become an integral part of our vocabulary."); Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 977-78 (1993) ("It is enough for today to recognize that in our culture, trademarks are doing all kinds of work they weren't originally meant to do. As their new functions become more important, so will the need for law to keep up."); Jerre B. Swann Sr., David A. Aaker & Matt Reback, *Trademarks and Marketing*, 91 TRADEMARK REP. 787, 799 (2001) ("[m]odern brands . . . communicate more information at deeper levels than did their progenitors"); Rochelle C. Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, NOTRE DAME L. REV. 397, 397-98 (1990) ("Trademarks have come a long way. … [I]deograms that once functioned solely as signals denoting the source, origin,

capabilities of marks have given rise to unprecedented opportunities and challenges in trademark doctrine, triggering a growing body of case law and literature in both the United States and Europe.[3]

In infringement litigation involving the use of "recoded" (i.e., modified) marks for expressive purposes (usually for parody or commentary),[4] the defendant's invocation of freedom of expression often translates into courts balancing an owner's proprietary interests against the defendant's speech.[5] In such cases, freedom of speech is understood to operate as a defense to the exclusive rights granted to owners,[6] shielding most unauthorized expressive uses

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and quality of goods, have become products in their own right, valued as indicators of the status, preferences, and aspirations of those who use them. Some trademarks have worked their way into the English language; others provide bases for vibrant, evocative metaphors. In a sense, trademarks are the emerging lingua franca: with a sufficient command of these terms, one can make oneself understood the world over"). In Europe, the recognition that marks can perform additional functions to that of origin is often framed within the broader debate on the "functions theory" as developed by the Court of Justice of the European Union in, *inter alia*, Case C-487/07, L'Oréal v. Bellure, ECLI:EU:C:2009:378 (June 18, 2009). As acknowledged by the Court, marks can also perform quality, advertising, investment, and communication functions. *See*, discussing this topic: Luis H. Porangaba, *A Contextual Account of the Trade Mark Functions Theory*, 3 INTELL. PROP. Q. 230 (2018); Martin Senftleben, *Function Theory and International Exhaustion: Why it is Wise to Confine the Double Identity Rule in EU Trade Mark Law to Cases Affecting the Origin Function*, 36 EUR. INTELL. PROP. REV. 518 (2014); Annette Kur, *Trade Marks Function, Don't They? CJEU Jurisprudence and Unfair Competition Practices*, 45 INT'L REV. OF INTELL. PROP. & COMPETITION L. 434 (2014); Annette Kur, *Harmonization of Intellectual Property Law in Europe: The ECJ Trade Mark Case Law 2008-2012*, 50 COMMON MKT. L. REV. 773 (2013); Lisa P. Ramsey & Jens Schovsbo, *Mechanisms for Limiting Trade Mark Rights to Further Competition and Free Speech*, 44 INT'L REV. OF INTELL. PROP. & COMPETITION L. 671 (2013); Dev S. Gangjee, *Property in Brands*, *in* CONCEPTS OF PROP. IN INTELL. PROP. LAW 29 (Helena Howe & Jonathan Griffiths eds., 2013); Tobias Cohen Jehoram, *The Function Theory in European Trade Mark Law and the Holistic Approach of the CJEU*, 102 TRADEMARK REP. 1243 (2012).

3. As we shall see upon closer study of the different scenarios in which trademarks and speech interact, the volume of case law and literature addressing this topic is overwhelming, especially in the United States. These sources are cited in a systematic way throughout this Article to ensure adequate support to the taxonomic methodology employed, in notes 8, 12, 16 (case law), 10, 13 and 17 (literature) *infra. See* Dev S. Gangjee & Robert Burrell, *Trade Marks and Freedom of Expression: A Call for Caution*, 41 INT'L REV. OF INTELL. PROP. & COMPETITION L. 544 (2010) (acknowledging the growing interest in the interaction between marks and freedom of expression).

4. The term 'recoded' is borrowed from Justin Hughes, *"Recoding" Intellectual Property and Overlooked Audience Interests*, 77 TEX. L. REV. 923 (1998).

5. Jonathan Moskin, *Frankenlaw: The Supreme Court's Fair and Balanced Look at Fair Use*, 95 TRADEMARK REP. 848, 871 (2005) ("courts have employed a balancing approach, weighing fair use concerns and First Amendment rights of expression, on the one hand, against the trademark owner's claimed proprietary interests–at least for some parodic fair use cases.").

6. The ability of speech to insulate defendants' unauthorized use of marks for expressive purposes has been explicitly recognized by courts on numerous occasions. *See, e.g.*, Yankee Publ'g Inc. v. News Am. Publ'g Inc., 809 F. Supp. 267, 275-76 (S.D.N.Y. 1992) ("where the unauthorized use of a trademark is for expressive purposes …, the law requires a balancing of the rights of the trademark owner against the interests of free speech"; and "the First Amendment confers a measure of protection for the unauthorized use of trademarks when that use is a part of the expression of a communicative message."); Mut. of Omaha Ins. Co. v. Novak, 648 F. Supp. 905, 911 (D. Neb 1986) ("In defense of [the likelihood of confusion] claim, [defendant] relies on the First Amendment. …

from liability.[7] Regrettably, the litigious—and contentious—nature of third party recoding has had the unintended consequence of overshadowing other scenarios where marks and speech rights interact. Because the vast majority of cases addressing the interaction between marks and speech involve expressive uses of marks by recoders,[8] conventional wisdom posits that the relationship between

While the Court recognizes [defendant's] right to express his views, such a right must in this case be balanced against the rights of [plaintiff] to protection of its trademark."); Reddy Commc'ns., Inc. v. Envt'l Action Found., Inc., 199 U.S.P.Q. (BNA) 630 at 634 (D.D.C. 1977) ("a more proper characterization of the case is that it pits plaintiff's … right … against defendant's First Amendment right of free speech, and requires a delicate balancing of the conflicting interests"); Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc., 886 F.2d 490, 494 (2d Cir. 1989) ("the principal issue before the district court was how to strike the balance between the two competing considerations of allowing artistic expression and preventing consumer confusion."); Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989) ("in general the [Lanham] Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression."); Planned Parenthood Feder'n of Am., Inc. v. Bucci, 42 U.S.P.Q. 2d (BNA) 1430, 1440 (S.D.N.Y. 1997) ("Defendant's use of another entity's mark is entitled to First Amendment protection when his use of that mark is part of a communicative message."); Anheuser-Busch, Inc. v. Balducci Publ'ns, 28 F.3d 769, 776 (8th Cir. 1994) ("There is no simple, mechanical rule by which courts can determine when a potentially confusing parody falls within the First Amendment's protective reach."); *Mattel*, 296 F.3d at 906 ("If speech is not "purely commercial"—that is, if it does more than propose a commercial transaction—then it is entitled to full First Amendment protection."); Bundesgerichtshof [BGH] [Federal Court of Justice] Apr. 7, 2005, Neue Juristische Wochenschrift [NJW] 2856 (2005) (Ger.) (for an English translation of the decision, *see* Violet Postcard 38 INT'L REV. OF INTELL. PROP. & COMPETITION L. 119, 121 (2007)) ("a trade mark infringement by the defendant. . .can be excluded by taking into account the defendant's right to the freedom of art[istic expression] as protected by … the Constitution."); Rb.'s-Gravenhage 4 mai 2011 NJF 2011, 264 (Nadia Plesner/Louis Vuitton) (Neth.), para. 4.6 ("the interest of [defendant] to (continue to) be able to express her (artistic) opinion … should outweigh the interest of [plaintiff] in the peaceful enjoyment of its possessions."); Cour d'Appel [CA] [regional court of appeal] Paris, 4 ch., Nov. 16, 2005, 04/12417 (Fr.) (for an English translation of the decision, *see* Esso Plc v. Greenpeace France [2006] ETMR 53, 671 ("[defendant] has … kept its activities within the limits of freedom of expression, in such a way that the trade mark infringement suit brought against it by [plaintiff] must be rejected.")

7. William McGeveran, *The Imaginary Trademark Parody Crisis (and the Real One)*, 90 WASH. L. REV. 713, 713 (2015) ("plausible claims of parody almost always prevail over trademark rights in judicial rulings."); *id.* at 715 ("In the last decade, defeats for trademark parodies have become blue-moon rarities."); Sonia K. Katyal, *Trademark Cosmopolitanism*, 47 U.C. DAVIS L. REV. 875, 927 (2013) ("All of the major cases discussed thus far have all reached conclusions that are strongly protective of the [recoder].").

8. In the **United States**: VIP Prods. L.L.C. v. Jack Daniel's Props., 953 F.3d 1170 (9th Cir. 2020); Ebony Media Operations L.L.C. v. Univision Commc'ns Inc., No. 18-cv-11434-AKH (S.D.N.Y. Jun. 3, 2019); Louis Vuitton Malletier S.A. v. My Other Bag Inc., 156 F. Supp. 3d 425 (S.D.N.Y. 2016); Louis Vuitton Malletier S.A. v. Hyundai Motor Am., 10 Civ. 1611 (PKC) (S.D.N.Y. 2012); Univ. of Ala. Bd. of Trs. v. New Life Art Inc., 683 F.3d 1266 (11th Cir. 2012); Starbucks Corp. v. Wolfe's Borough Coffee Inc., 588 F.3d 97 (2d Cir. 2009); Smith v. Wal-Mart Stores, Inc., 537 F. Supp. 2d 1302 (N.D. Ga. 2008); E.S.S. Entm't. 2000 Inc. v. Rock Star Videos Inc., 547 F.3d 1095 (9th Cir. 2008); Louis Vuitton Malletier S.A. v. Haute Diggity Dog L.L.C., 507 F.3d 252 (4th Cir. 2007); Nissan Motor Co. v. Nissan Comput. Corp., 378 F.3d 1002 (9th Cir. 2004); Mattel Inc. v. Walking Mountain Prods., 353 F.3d 792 (9th Cir. 2003); World Wrestling Fed'n Ent. Inc. v. Big Dog Holdings Inc., 280 F. Supp. 2d 413 (W.D. Pa. 2003); Parks v. LaFace Recs., 329 F.3d 437 (6th Cir. 2003); *Mattel,* 296 F.3d 894; Tommy Hilfiger Licensing v. Nature Labs L.L.C., 221 F. Supp. 2d 410 (S.D.N.Y. 2002); Harley Davidson Inc. v. Grottanelli, 164 F.3d 806, 813 (2d Cir. 1999); Jews For

marks and speech is unidirectional, in the sense that trademark rights chill expression.[9] Scholars have contributed to this phenomenon through analyses and proposals for reform that have focused on recoding cases in an effort to avoid the severe repercussions that unbridled enforcement of trademark rights could have on recoders' freedom of expression.[10] The unduly narrow emphasis placed on one

Jesus v. Brodsky, 993 F. Supp. 282 (D. N.J. 1998); Am. Dairy Queen Corp. v. New Line Prods. Inc, 35 F. Supp. 2d 727 (D. Minn. 1998); *Planned Parenthood,* 42 U.S.P.Q. 2d (BNA) 1430; Dr. Seuss Enters., L.P. v. Penguin Books USA Inc., 109 F.3d 1394 (9th Cir. 1997); Hormel Foods Corp. v. Jim Henson Prods., Inc., 73 F.3d 497 (2d Cir. 1996); Panavision Int'l, L.P. v. Toeppen, 945 F. Supp. 1296 (C.D. Cal. 1996); *Balducci Publ'ns*, 28 F.3d 769; Deere & Co. v. MTD Prods. Inc., 41 F.3d 39 (2d Cir. 1994); *Yankee Publ'g*, 809 F. Supp. 267; Anheuser–Busch Inc. v. L. & L. Wings, Inc., 962 F.2d 316 (4th Cir. 1992); Hard Rock Cafe Licensing Corp. v. Pac. Graphics, Inc., 776 F. Supp. 1454 (W.D. Wash. 1991); *Cliffs Notes, Inc.*, 886 F.2d 490; Schieffelin & Co v. Jack Co of Boca Inc., 725 F. Supp. 1314 (S.D.N.Y. 1989); *Rogers*, 875 F.2d 994; *Mut. of Omaha Ins. Co.*, 836 F.2d 397; Jordache Enters. Inc. v. Hogg Wyld Ltd, 828 F.2d 1482 (10th Cir. 1987); L.L. Bean Inc. v. Drake Publishers Inc., 811 F.2d 26 (1st Cir. 1987); Universal City Studios, Inc. v. Nintendo Co., Ltd., 746 F.2d 112 (2d Cir. 1984); Wendy's Int'l, Inc. v. Big Bite, Inc., 576 F. Supp. 816 (S.D. Ohio 1983); Gen. Foods Corp. v. Mellis, 203 U.S.P.Q. 261 (S.D.N.Y. 1979); Dallas Cowboy Cheerleaders Inc. v. Pussycat Cinema Ltd., 604 F.2d 200 (2d Cir. 1979); Gucci Shops, Inc. v. RH Macy & Co., 446 F. Supp. 838 (S.D.N.Y. 1977); *Reddy Commc'ns., Inc.*, 199 U.S.P.Q. (BNA) 630; Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183 (E.D.N.Y. 1972). In **Europe**: Cour d'Appel [CA] [regional court of appeal] Paris, 5 ch., Dec. 11, 2015, 14/32109 (Fr.); Cour d'Appel [CA] [regional court of appeal] Rennes, 2 ch., Apr. 27, 2010, 09/00413 (Fr.); Cour de cassation [Cass.] [supreme court for judicial matters] 1e civ., Apr. 8, 2008, Bull. civ. I, No. 104 (Fr.); Cour de cassation [Cass.] [supreme court for judicial matters] 2e civ., Oct. 19, 2006, Bull. civ. II, No. 282 (Fr.) (for an English translation of the decision, *see* Comité National contre les Maladies Respiratoires et la Tuberculose v. Société JT International GmbH 38 INT'L REV. OF INTELL. PROP. & COMPETITION L. 357 (2007)); Cour d'Appel [CA] [regional court of appeal] Paris,4 ch., Nov. 16, 2005, 04/12417 (Fr.) (for an English translation of the decision, see Esso Plc v. Greenpeace France [2006] ETMR 53); Cour d'Appel [CA] [regional court of appeal] Paris, 14 ch., Feb. 26, 2003, 02/16307 (Fr.) (for an English translation of the decision, *see* Association Greenpeace France v. SA Société ESSO [2003] ETMR 66); Tribunal de grande instance [TGI] [ordinary court of original jurisdiction] Paris, May 14, 2001, 01/55088 (Fr.) (for an English translation of the decision, *see* Société Gervais Danone v. Société Le Réseau Voltaire [2003] ETMR 26); Ate My Heart, Inc. v. Mind Candy Ltd. [2011] EWHC 2741; Miss World Ltd. v. Channel 4 Television Corp. [2007] EWHC 982; Gof's-Amsterdam 13 september 2011, IES 2012, 15 m.nt. Herman MH Speyart (Mercis BV/Punt.nl BV) (Neth.); Rb.'s-Gravenhage 4 mai, 2011 NJF 2011, 264 (Nadia Plesner/Louis Vuitton) (Neth.); Rb.'s-Amsterdam 3 april 2003 KG 2003, 108 (Joanne Kathleen Rowling/Uitgeverij Byblos BV) (Neth.); Oberlandesgericht Hamburg [OLG] [Hamburg Higher Regional Court] Aug. 9, 2010, Gewerblicher Rechtsschutz und Urheberrecht, Rechtsprechungs-Report [GRUR-RR] 382 (2010) (Ger.); Oberlandesgericht Hamburg [OLG] [Hamburg Higher Regional Court] Jan. 5, 2006, Gewerblicher Rechtsschutz und Urheberrecht, Rechtsprechungs-Report [GRUR-RR] 231 (2006) (Ger.); Bundesgerichtshof [BGH] [Federal Court of Justice] Apr. 7, 2005, Neue Juristische Wochenschrift [NJW] 2856 (2005) (Ger.) (for an English translation of the decision, *see* Violet Postcard 38 INT'L REV. OF INTELL. PROP. & COMPETITION L. 119 (2007)).

9. Given the relevance of this assertion for purposes of my argument, I provide extensive proof of this misconception below. *See* text to notes 134 to 136 *infra*, as well as the quoted excerpts in note 137 *infra*.

10. Michal Bohaczewski, *Conflicts Between Trade Mark Rights and Freedom of Expression Under EU Trade Mark Law: Reality or Illusion?*, 51 INT'L REV. OF INTELL. PROP. & COMPETITION L. 856 (2020); Kathleen E. McCarthy, *Free Ride or Free Speech: Predicting Results and Providing Advice for Trademark Disputes Involving Parody*, 109 TRADEMARK REP. 691 (2019); Sara Gold, *Does Dilution Dilute the First Amendment: Trademark Dilution and the Right to Free Speech after Tam and Brunetti*, 59 IDEA 483 (2018); Sabine Jacques, *A Parody Exception: Why Trade Mark Owners*

subset of expressive users has come at a cost: it has led to an impoverished understanding of other interactions between marks and speech.

Should Get the Joke, 38 EUR. INTELL. PROP. REV. 471 (2016); Stacey L. Dogan & Mark A. Lemley, *Parody as Brand*, *in* THE LUXURY ECONOMY AND INTELLECTUAL PROPERTY 93 (Barton Beebe, Haochen Sun, & Madhavi Sunder eds., 2015); Christine H. Farley & Kavita DeVaney, *Considering Trademark and Speech Rights through the Lens of Regulating Tobacco*, 43 AIPLA Q.J. 289 (2015); McGeveran, *supra* note 7; Rebecca Tushnet, *More than a Feeling: Emotion and the First Amendment*, 127 HARV. L. REV. 2392 (2014); Rt. Hon. Sir Robin Jacob, *Parody and IP claims: A Defence? – A Right to Parody?*, *in* INTELLECTUAL PROPERTY AT THE EDGE – THE CONTESTED CONTOURS OF IP 427 (Rochelle C. Dreyfuss & Jane C. Ginsburg eds., 2014); Ramsey & Schovsbo, *supra* note 2; Katyal, *supra* note 7; David A. Simon, *The Confusion Trap: Rethinking Parody in Trademark Law*, 88 WASH. L. REV. 1021 (2013); Wojciech Sadurski, *Allegro without Vivaldi: Trademark Protection, Freedom of Speech, and Constitutional Balancing*, 8 EUR. CONST. L. REV. 456 (2012); Lucie Guibault, *The Netherlands: Darfurnica, Miffy and the right to parody!*, 3 JIPITEC 236 (2011); Gangjee & Burrell, *supra* note 3; Rochelle C. Dreyfuss, *Reconciling Trademark Rights and Expressive Values: How to Stop Worrying and Learn to Love Ambiguity*, *in* TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH 261 (Graeme B. Dinwoodie & Mark Janis eds., 2008); Rebecca Tushnet, *Truth and Advertising: the Lanham Act and Commercial Speech Doctrine*, *in* TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH 294 (Graeme B. Dinwoodie & Mark Janis eds., 2008); William McGeveran, *Four Free Speech Goals for Trademark Law*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1205 (2008); William McGeveran, *Rethinking Trademark Fair Use*, 94 IOWA L. REV. 49 (2008); Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 S.M.U. L. REV. 381 (2008); Andreas Rahmatian, *Trade Marks and Human Rights*, *in* INTELLECTUAL PROPERTY AND HUMAN RIGHTS 335 (Paul Torremans ed., 2008); Christophe Geiger, *Trade Marks and Freedom of Expression – The Proportionality of Criticism*, 38 INT'L REV. OF INTELL. PROP. & COMPETITION L. 317 (2007); Katja Weckström, 11 LEWIS & CLARK L. REV. 671 (2007); Margreth Barrett, *Domain Names, Trademarks and the First Amendment: Searching for Meaningful Boundaries*, 39 CONN. L. REV. 973 (2007); Stacey L. Dogan & Mark A. Lemley, *The Trademark Use Requirement in Dilution Cases*, 24 SANTA CLARA COMPUT. & HIGH TECH. L.J. 541 (2007); Mary LaFrance, *No Reason to Live: Dilution Laws as Unconstitutional Restrictions on Commercial Speech*, 58 S.C. L. REV. 709 (2007); Moskin, *supra* note 5; Hannibal Travis, *The Battle for Mindshare: The Emerging Consensus That the First Amendment Protects Corporate Criticism and Parody on the Internet*, 10 VA. J.L. & TECH. 74 (2005); Pratheepan Gulasekaram, *Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works*, 8 WASH. L. REV. 887 (2005); Megan Richardson, *Trade Marks and Language*, 26 SYDNEY L. REV. 193 (2004); Kelly L. Baxter, *Trademark Parody: How to Balance the Lanham Act with the First Amendment*, 44 SANTA CLARA L. REV. 1179 (2003); Sarah M. Schlosser, *The High Price of (Criticizing) Coffee: The Chilling Effect of the Federal Trademark Dilution Act on Corporate Parody*, 43 ARIZ. L. REV. 931 (2001); Michael Spence, *Intellectual Property and the Problem of Parody*, 114 L.Q.R. 594 (1998); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687 (1998); Michael K. Cantwell, *Confusion, Dilution, and Speech: First Amendment Limitations on the Trademark Estate*, 87 TRADEMARK REP. 48 (1997); Keith Aoki, *How the World Dreams Itself to Be American: Reflections on the Relationship between the Expanding Scope of Trademark Protection and Free Speech Norms*, 17 LOY. L.A. ENT. L. REV. 523 (1996); Mark V. B. Partridge, *Trademark Parody and the First Amendment: Humor in the Eye of the Beholder*, 29 J. MARSHALL L. REV. 877 (1995); Kozinski, *supra* note 2; Arlen W. Langvardt, *Protected Marks and Protected Speech: Establishing the First Amendment Boundaries in Trademark Parody Cases*, 36 VILL. L. REV. 1 (1991); Dreyfuss, *supra* note 2; Robert N. Kravitz, *Trademarks, Speech, and the Gay Olympics Case*, 69 B.U. L. REV. 131 (1989); Robert J. Shaughnessy, *Trademark Parody: A Fair Use and First Amendment Analysis*, 72 VA. L. REV. 1079 (1986); Harriette K. Dorsen, *Satiric Appropriation and the Law of Libel, Trademark, and Copyright: Remedies Without Wrongs*, 65 B.U. L. REV. 923 (1985); Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 2 WIS. L. REV. 158 (1981).

Thus, the literature lacks in comprehensive studies mapping the multi-faceted nature of the interaction between marks and speech. This is surprising in an area of law that has attracted so much scholarly attention over the past four decades.[11] To redress this gap in the literature, this Article aims to dispel the notion that the interaction between marks and speech is unidirectional. Speech claims need not operate as a limit to owners' exclusive rights in all instances where marks interact with freedom of expression. Precedent exists in both US and European case law where free speech is invoked to validate trademark rights. These cases involve instances where the constraints imposed on expressive use of marks stem not from owners' exclusive rights, but rather from measures of public law encroaching on trademark use or registration. In doing so, they erect legal barriers preventing trademark owners and applicants, respectively, from making use of marks to express their preferred messages.

For instance, in recent years, refusals to register signs pursuant to the statutory ground that they are immoral, disparaging, or scandalous in the United States—or contrary to public policy or morality in Europe—have been challenged on grounds that they contravene applicants' speech rights.[12] Admittedly, these decisions sparked a lively debate among commentators on the role that speech protection ought to play in the registration context, especially in the United States.[13] However, and as was the case with scholarship discussing recoding

11. The first articles on the subject date back to the early and mid-1980s: Shaughnessy, *supra* note 10; Dorsen, *supra* note 10; Denicola, *supra* note 10.

12. Respectively: Iancu v. Brunetti, 139 S. Ct. 2294 (2019); Case C-240/18, Constantin Film Produktion ('FACK JU GÖHTE') v. EUIPO, ECLI:EU:C:2019:553 (Feb. 27, 2019). Other cases include, in the **United States**: Matal v. Tam, 137 S. Ct. 1744 (2017); Pro-Football, Inc. v. Blackhorse, 112 F. Supp. 3d 439 (E.D. Va. 2015); *In re* Fox, 702 F.3d 633 (Fed. Cir. 2012); *In re* Boulevard Ent., Inc., 334 F.3d 1336 (Fed. Cir. 2003); Pro–Football, Inc. v. Harjo, 57 USPQ 2d 1140 (D.D.C. 2000); William B. Ritchie v. Orenthal James Simpson, 170 F.3d 1092 (Fed. Cir. 1999); Harjo v. Pro Football, Inc., 30 USPQ 2d 1828 (TTAB 1994); *In re* Mavety Media Grp. Ltd. Eyeglasses, 33 F.3d 1367 (Fed. Cir. 1994); *In re* McGinley, 660 F.2d 481 (CCPA 1981). In **Europe**: Case T-69/17, Constantin Film Produktion v. EUIPO, ECLI:EU:T:2018:27 (Jan. 24, 2018); R 2244/2016-2, Application of Brexit Drinks Ltd. (Jun. 28, 2017); R 2205/2015-5, Application of Constantin Film Produktion GmbH (Dec. 1, 2016); R 519/2015-4, Application of Josef Reich (Sept. 2, 2015); R-793/2014-2, Application of Ung Cancer (Feb. 23, 2015); R 2804/2014-5, Application of Square Enix Ltd. (Feb. 6, 2015); R 2889/2014-4, Application of Verlagsgruppe D. K. GmbH & Iny Klocke (May 28, 2015); Case T-54/13, Efag Trade Mark Co. v. OHIM, ECLI:EU:T:2013:593 (Nov. 14, 2013); Case T-417/10, Federico Cortés del Valle López v. OHIM, ECLI:EU:T:2012:120 (Mar. 9, 2012); Case T-232/10, Couture Tech Ltd v. OHIM, ECLI:EU:T:2011:498 (Sept. 20, 2011); R 168/2011-1, Application of Türpitz (Nov. 30, 2010); R 495/2005-G, Application of Jebaraj Kenneth (July 6, 2006); Scranage's Trademark Application [2008] ETMR 43; French Connection Ltd.'s Trademark Application [2007] ETMR 8; Basic Trademark SA's Trademark Application [2006] ETMR 24; Ghazilian's Trademark Application [2002] ETMR 57.

13. In the **United States**: Ned Snow, *Immoral Trademarks after Brunetti*, 58 HOUS. L. REV. 401 (2020); Niki Kuckes, *Iancu v. Brunetti: Free Speech Meets "Immoral and Scandalous" Trademarks in the Supreme Court*, 25 ROGER WILLIAMS U. L. REV. 80 (2020); Gary Myers, *It's Scandalous - Limiting Profane Trademark Registrations after Tam and Brunetti*, 27 J. INTELL. PROP. L. 1 (2019); Sonia K. Katyal, Brands Behaving Badly, 109 TRADEMARK REP. 819 (2019); Gary Myers, *Trademarks & the First Amendment after Matal v. Tam*, 26 J. INTELL. PROP. L. 67 (2019); Vicenc Feliu, *The F Word - An Early Empirical Study of Trademark Registration of Scandalous and Immoral*

Marks in the Aftermath of the In Re Brunetti Decision, 18 J. MARSHALL REV. INTELL. PROP. L. 404 (2019); Barton Beebe & Jeanne C. Fromer, *Immoral or Scandalous Marks: An Empirical Analysis*, 8 N.Y.U. J. INTELL. PROP. & ENT. L. 169 (2018); John Langworthy, *A Slanted View on the Morality Bars: Matal v. Tam, in re Brunetti, and the Future of Section 2(a) of the Lanham Act*, 2 BUS. ENTREPRENEURSHIP & TAX L. REV. 477 (2018); Clay Calvert, *Merging Offensive-Speech Cases with Viewpoint-Discrimination Principles: The Immediate Impact of Matal v. Tam on Two Strands of First Amendment Jurisprudence*, 27 WM. & MARY BILL RTS. J. 829 (2018); Niki Kuckes, *Matal v. Tam: Free Speech Meets Disparaging Trademarks in the Supreme Court*, 23 ROGER WILLIAMS U. L. REV. 122 (2018); Gold, *supra* note 10; Alex Weidner, *Examining the Impact of In re Brunetti on Section 2(a) of the Lanham Act*, 83 MO. L. REV. 1153 (2018); David C. Brezina, *The Slants Decision Understates the Value of Trademark Registration in Promoting Speech - Correctly Decided With a Conclusory Analysis*, 17 J. MARSHALL REV. INTELL. PROP. L. 380 (2018); Mark Conrad, *Matal v. Tam - A Victory for the Slants, a Touchdown for the Redskins, but an Ambiguous Journey for the First Amendment and Trademark Law*, 36 CARDOZO ARTS & ENT. L.J. 83 (2018); Andrew M. Lehmkuhl, *The Aftermath of Matal v. Tam: Unanswered Questions and Early Applications*, 87 U. CIN. L. REV. 871 (2018); Russ VerSteeg, *Historical Perspectives & Reflections on Matal v. Tam and the Future of Offensive Trademarks*, 25 J. INTELL. PROP. L. 109 (2017); Timothy T. Hsieh, *The Hybrid Trademark and Free Speech Right Forged from Matal v. Tam*, 7 N.Y.U. J. INTELL. PROP. & ENT. L. 1 (2017); Ned Snow, *Denying Trademark for Scandalous Speech*, 51 U.C. DAVIS L. REV. 2331 (2017); Rebecca Tushnet, *Registering Disagreement: Registration in Modern American Trademark Law*, 130 HARV. L. REV. 867 (2017); Clay Calvert, *Beyond Trademarks and Offense: Tam and the Justices' Evolution on Free Speech*, 2016 CATO SUP. CT. REV. 25 (2016–2017); Lisa P. Ramsey, *A Free Speech Right to Trademark Protection*, 106 TRADEMARK REP. 797 (2016); Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 92 NOTRE DAME L. REV. 381 (2016); Russ VerSteeg, *Blackhawk down or Blackhorse down: The Lanham Act's Prohibition of Trademarks That May Disparage & the First Amendment*, 68 OKLA. L. REV. 677 (2016); Marc J. Randazza, *Freedom of Expression and Morality-Based Impediments to the Enforcement of Intellectual Property Rights*, 16 NEV. L.J. 107 (2015); Ron Phillips, *A Case for Scandal and Immorality: Proposing Thin Protection of Controversial Trademarks*, 17 U. BALT. INTELL. PROP. L.J. 55 (2008); Regan Smith, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks Note*, 42 HARV. C.R.-C.L. L. REV. 451 (2007); Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(a) Trademark Law after Lawrence v. Texas*, 9 MARQ. INTELL. PROP. L. REV. 187 (2005); Cameron Smith, *Squeezing the Juice out of the Washington Redskins: Intellectual Property Rights in Scandalous and Disparaging Trademarks after Harjo v. Pro-Football Inc.*, 77 WASH. L. REV. 1295 (2002); Justin G. Blankenship, *The Cancellation of Redskins as a Disparaging Trademark: Is Federal Trademark Law an Appropriate Solution for Words that Offend*, 72 U. COLO. L. REV. 415 (2001); Jeffrey Lefstin, *Does the First Amendment Bar Cancellation of REDSKINS*, 52 STAN. L. REV. 665 (2000); Jendi B. Reiter, *Redskins and Scarlet Letters: Why Immoral and Scandalous Trademarks Should Be Federally Registrable*, 6 FED. CIR. B.J. 191 (1996); Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661 (1993); Theodore H. Jr Davis, *Registration of Scandalous, Immoral, and Disparaging Matter under Section 2(a) of the Lanham Act: Can One Man's Vulgarity Be Another's Registered Trademark*, 54 OHIO ST. L. J. 331 (1993). In **Europe**: Tobias Endrich-Laimböck & Svenja Schenk, *Then Tell Me What You Think About Morality: A Freedom of Expression Perspective on the CJEU's Decision in FACK JU GÖHTE (C-240/18 P)*, 51 INT'L REV. OF INTELL. PROP. & COMPETITION LAW 529 (2020); Christophe Geiger & Leonardo M. Pontes, *Trade Mark Registration, Public Policy, Morality and Fundamental Rights*, CENTRE FOR INT'L INTELL. PROP. STUD. (CEIPI) RSCH. PAPER NO 2017-01; Susan Snedden, *Immoral Trade Marks in the UK and at OHIM: How Would the Redskins Dispute Be Decided There?*, 11 J. INTELL. PROP. L. & PRAC. 270 (2016); Enrico Bonadio, *Brands, Morality and Public Policy: Some Reflections on the Ban on Registration of Controversial Trademark*, 19 MARQ. INTELL. PROP. L. REV. 43 (2015); Ilanah Simon Fhima, *Trade Marks and Free Speech*, 44 INT'L REV. OF INTELL. PROP. & COMPETITION L. 293 (2013); Teresa Scassa, *Antisocial Trademarks*, 103 TRADEMARK REP. 1172 (2013); Jonathan Griffiths, *Is there a right to an immoral mark?*, *in* INTELLECTUAL PROPERTY AND HUMAN RIGHTS 309 (Paul Torremans ed., 3d ed. 2015); Marco Ricolfi, *Trademarks and Human Rights*, *in*

litigation, their contributions do not venture beyond the boundaries of the interaction at issue.

Furthermore, restrictions on trademark use impacting their expressive function not only stem from trademark statutes, but sometimes also from public measures seeking to regulate consumption of certain goods.[14] This is the case, most notably, of legislation aimed at preventing use of marks that can mislead consumers as to the characteristics of the goods bearing them and/or induce customers, through the positive images conveyed by the marks, to purchase such goods when they pose a risk to health. Examples include measures restricting the use of marks in relation to tobacco products, such as health warnings, advertising bans, or, in more recent years, standardized packaging.[15] Right holders have challenged the validity of such measures on the basis, *inter alia*, that they effect an unjustified interference with their right to freedom of expression.[16] This form of interaction has also attracted scholarly commentary, for the most part in the United States.[17] However, very much like scholars addressing recoding and

INTELLECTUAL PROPERTY AND HUMAN RIGHTS 453 (Paul Torremans ed., 3d ed. 2015); Gordon Humphreys, *Deceit and Immorality in Trade Mark Matters: Does it Pay to Be Bad?*, 2 J. INTELL. PROP. L. & PRAC. 89 (2007).

14. That government-imposed restrictions on trademark use can impinge on right holders' freedom of expression has been recognized by both US and European courts. Since this line of case law constitutes the basis for one of the three forms of interaction between trademarks and speech identified in this Article, it will be addressed in extensive detail in Section II(C)(3). below.

15. Regulations requiring that tobacco products bear health warnings have been in effect since 1965 in the United States (The Cigarette Labelling and Advertising Act of 1965, Pub. L. No. 89-92), 1976 in France (Loi 76-616 du 9 Juillet 1976 Relative à la Lutte Contre le Tabagisme) or 2001 in the EU (Directive 2001/37, of the European Parliament and of the Council of 5 June 2001 on the Approximation of the Laws, Regulations and Administrative Provisions of the Member States Concerning the Manufacture, Presentation and Sale of Tobacco Products, 2001 O.J. (L 194) 26. Advertising bans have been regulated in the EU by means of several instruments, including: Council Directive 89/552 of Oct. 3, 1989, on the Coordination of Certain Provisions Laid Down by Law, Regulation or Administrative Action in Member States Concerning the Pursuit of Television Broadcasting Activities, 1989 O.J. (L 298) 23; or Directive 98/43, of the European Parliament and of the Council of 6 July 1998 on the Approximation of the Laws, Regulations and Administrative Provisions of the Member States Relating to the Advertising and Sponsorship of Tobacco Products, 1998 O.J. (L 213) 9 [hereinafter First Tobacco Products Directive]. Some European countries have recently adopted plain packaging legislation, such as France (Loi 2016-41 du 26 janvier 2016 de modernisation de notre système de santé), Ireland (Public Health (Standardised Packaging of Tobacco) Act 2015) or the UK (Standardised Packaging of Tobacco Products Regulations 2015).

16. In the **United States**: Cigar Assoc. of Am. v. FDA, 315 F. Supp. 3d 143 (D.D.C. 2018); RJ Reynolds Tobacco Co. v. FDA, 696 F.3d 1205 (D.C. Cir. 2012); Lorillard Tobacco Co. v. Reilly, 533 U.S. 525 (2001). In **Europe**: Case C-547/14, Philip Morris Brands S.A.R.L. v. Secretary of State for Health, ECLI:EU:C:2016:325 (May 4, 2016); Opinion of Advocate General Kokott in Case C-547/14, Philip Morris Brands S.A.R.L. v. Secretary of State for Health, ECLI:EU:C:2015:853 (Dec. 23, 2015); R. (on the application of British American Tobacco UK Ltd.) v. Secretary of State for Health [2004] EWHC 2493 (Admin); Opinion of Advocate General Fennelly in Case C-376/98, Germany v. European Parliament, ECLI:EU:C:2000:324 (June 15, 2000).

17. Sunil S. Gu, *Plain Tobacco Packaging's Impact on International Trade and the Family Smoking Prevention and Tobacco Control Act in the U.S. and Drafting Suggestions Notes*, 16 WASH. U. GLOB. STUD. L. REV. 197 (2017); Matthew J. Elsmore, *Trademarks, Tobacco, Health: Brokerage by Fundamental Rights?*, *in* The New Intellectual Property of Health Beyond Plain Packaging 69

registration cases, the aim of these authors is not to engage in a taxonomic analysis of the diverse scenarios where marks interact with speech in the search for the broader principles that govern this interaction.[18]

(Alberto Alemanno & Enrico Bonadio eds., 2016); Sergio Puig, *Tobacco Litigation in International Courts*, 57 HARV. INT'L L.J. 383 (2016); Farley & DeVaney, *supra* note 10; Tushnet, *More than a Feeling: Emotion and the First Amendment*, *supra* note 10; Richard J Bonnie, *Impending Collision between First Amendment Protection for Commercial Speech and the Public Health: The Case of Tobacco Control*, 29 J. L. & POL. 599 (2014); Sarah A. Hinchliffe, *Comparing Apples and Oranges in Trademark Law: Challenging the International and Constitutional Validity of Plain Packaging of Tobacco Products*, 13 J. MARSHALL. REV. INTELL. PROP. L 130 (2013); John D. Kraemer & Sabeeh A. Baig, *Analysis of Legal and Scientific Issues in Court Challenges to Graphic Tobacco Warnings*, 45 AM. J. OF PREVENTIVE MED. 334 (2013); Fhima, *supra* note 13; Nathan Cortez, *Do Graphic Tobacco Warnings Violate the First Amendment?*, 64 HASTINGS L.J. 1467 (2013).

18. This is not an easy argument to substantiate since authors' contributions are not framed within the taxonomy of cases proposed here. However, in explaining the aim of their contributions, some authors have made explicit reference to the scope of their pieces being limited to one form of interaction between marks and speech. First, in the recoding context, *see*, for instance: Dogan & Lemley, *Parody as Brand*, *supra* note 10, at 94 ("Our goal in this chapter is to understand why, and to think about what circumstances (if any) should lead courts to find [trademark] parody illegal"); Denicola, *supra* note 10, at 190-93 (1981) ("The remainder of this article will examine the extent to which trademark protection premised on misappropriation and dilution is consistent with the right of free expression."); Kozinski, *supra* note 2, at 966 ("I want to discuss some considerations that might define the proper scope of protection for trademarks serving not just as source identifiers, but also as part of the language"); Ramsey & Schovsbo, *supra* note 2, at 671 (2013) ("This article evaluates the different mechanisms that nations use to limit trade mark rights to promote … free speech"); Jacques, *supra* note 10, at 472 (2016) ("This article proposes that trade mark law should provide more room for the creation of trade mark parodies."); Sadurski, *supra* note 10, at 491 (2012) ("The aim of this article was to … argue… that in the conflicts of values illustrated by trademark … parody, the interests in freedom of speech should prevail"). Second, in the registration context, *see*, for instance: Myers, *Trademarks & the First Amendment after Matal v. Tam*, *supra* note 13, at 68 (2019) ("This article provides an analysis of the implications of *Tam* for trademark law, both in terms of eligibility for registration and in terms of the scope of trademark protection."); Myers, *It's Scandalous - Limiting Profane Trademark Registrations after Tam and Brunetti*, *supra* note 13, at 2 (2019) ("In light of *Tam* and *Brunetti*, … this article explores whether a statute … precluding the registration of vulgar, profane, and obscene marks might be drafted such that it constitutes a reasonable, viewpoint-neutral restriction on speech."); Conrad, *supra* note 13, at 89 ("This article will discuss what the court did and did not do in the *Tam* ruling."); Hsieh, *supra* note 13, at 1 ("This paper examines the holding of the Matal v. Tam case and predicts how the case will influence the behavior of trademark filings and the development of trademark law."). And third, in the context of health-furthering, trademark-restrictive measures, *see*, for instance: Sunil S. Gu, *Plain Tobacco Packaging's Impact on International Trade and the Family Smoking Prevention and Tobacco Control Act in the U.S. and Drafting Suggestions Notes*, 16 WASH. U. GLOB. STUD. L. REV. 197, 199 (2017) ("The note will then proceed to assess how U.S. courts dealt with [the constitutionality of a health-furthering, trademark-restrictive measure targeting tobacco products] under the First Amendment … Lastly, this note will also suggest how the FDA would effectively cope with potential challenges by tobacco manufacturers if it plans to introduce [a] new bill [encroaching on their First Amendment rights."); Cortez, *supra* note 17, at 1467 (2013) ("This Article considers several ambiguities that … cases [dealing with the constitutionality of health-furthering, trademark-restrictive measures under the First Amendment] have left unresolved and suggests how the FDA and courts should confront these questions during the next round of rulemaking and litigation"); Kraemer & Baig, *supra* note 17, at 334 (2013) ("The current paper describes the legal standards that will be used to assess the [compatibility with tobacco manufacturers' First Amendment rights of government-imposed health] warnings, and the empirical questions that must be answered in order to determine whether each standard has been met").

Against this backdrop, cases addressing the interaction between marks and speech have adopted two different postures: (a) "recoding" cases, where freedom of expression is invoked by the recoder as a defense to an infringement claim;[19] and (b) "ownership" cases, where speech is invoked by the owner or applicant to validate trademark rights.[20] The interaction between marks and speech is, thus, not unidirectional, but rather operates as a two-way street.

Acknowledging that the interaction between marks and speech goes both ways can contribute to the advancement of the field in five ways. First, it allows for a more precise understanding of this interaction. Second, a more accurate reading of the interaction between marks and speech can, in turn, lead to a more refined understanding of the opposing interests at stake in interaction cases. This could result in fairer adjudication. Third, the parallels identified in American and European approaches to the interaction between marks and speech can lead to more fruitful exchange between both jurisdictions in this area of law. Fourth, awareness of the full range of scenarios where both sets of rights interact serves to highlight the potential ramifications that courts' findings in one scenario could have in others. For instance, a finding that recoded uses of marks in infringement litigation ought to be afforded reinforced protection under freedom of expression as artistic speech could be irreconcilable with the characterization of applicants' speech as purely commercial in refusals of registration. After all, an applied-for mark could potentially be put to use by its would-be owner for any and all purposes, including to convey messages with an artistic or political component.[21]

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19. *See* case law cited *supra* note 8.

20. *See* case law cited *supra* notes 12 and 16.

21. This can occur where the right holder uses its mark not only to distinguish or promote its goods or services, but also to express its view on a broader topic and engage in public debate. This was the case, for instance, in the 'Benetton' advertisements saga decided by the Federal Constitutional Court of Germany. *See* Bundesverfassungsgericht [BverfGE] [Federal Constitutional Court] Dec. 12, 2000, 102 Entscheidungen des Bundesverfassungsgerichts [BVERFGE] 347; Bundesverfassungsgericht [BverfGE] [Federal Constitutional Court] Mar. 11, 2003, 107 Entscheidungen des Bundesverfassungsgerichts [BVERFGE] 275. The contentious ads showed different images dealing with issues of environmental, social and health concern, for instance, a picture of a person's naked behind with the words 'HIV Positive' stamped on the skin, or a dying AIDS patient surrounded by his grieving family. The apparel company's well-known mark consisting of the words 'UNITED COLORS OF BENETTON' contained in a green square was featured in a corner of the ads. In overturning the decision of the Federal Court of Justice upholding a ban on the publication of these ads pursuant to the Unfair Competition Act, the Federal Constitutional Court gave much weight to the robust protection afforded to political expression under the German Constitution. According to the court, this degree of protection is in no way affected by the fact that the socially relevant message is conveyed in an advertising context where the aim is not only to engage in public debate, but also to further the company's commercial interest in attracting consumers by building a particular brand image. In the words of the court:

> The advertisements draw the attention to socially and politically relevant issues and are also suitable for gaining public attention for these issues. The special protection that [the right to freedom of expression] provides particularly for this form of expression is not diminished by the fact that [the ads] . . . do not make any substantial contribution to the debate on the deplorable situations that they depict. The (mere) denouncement of an injustice can also be an important contribution to the free exchange of ideas. . . .

And fifth, understanding that the interaction between marks and speech operates as a two-way street provides a solid foundation for the reconceptualization of this interaction as competing forms of speech.[22] The repercussions of such a reconceptualization on the field could be far-reaching.

Proper engagement with this topic requires that we begin by exploring, in Section I, the expressive dimension of marks. This will be followed, in Section II, by explaining the diverse ways in which marks interact with speech with a view to dispelling the misconception that the relationship between both sets of rights is unidirectional. This will include (a) an introduction to the right to freedom of expression as protected under US and European law, (b) a discussion on the lack of scholarly work mapping the multi-faceted nature of the interaction between marks and speech, and (c) an overview of ownership cases where courts operating out of the United States and Europe have factored in the expressive interests of right holders/applicants to validate trademark rights. Section III will explore the theoretical underpinnings for the proposition that speech can validate trademark rights. Concluding remarks will follow in Section IV.

> The denouncing effect of the advertisements, which are critical of society, is not called into question by the advertising context.

Bundesverfassungsgericht [BverfGE] [Federal Constitutional Court] Dec. 12, 2000, 102 Entscheidungen des Bundesverfassungsgerichts [BVERFGE] 347, paras. 62-63 (Ger.).

22. Three authors have already advanced the notion of competing expression in interaction cases: Matthew Elsmore, Michael Spence and Justin Hughes. However, the way that they conceptualize competing expression in interaction cases, as well as the breadth of their contributions, differs from the one suggested here. As regardsElsmore, his analysis is constrained to cases where right holders have challenged the validity of health-furthering, trademark-restrictive cases on speech grounds. As a result, he does not propose that competing expression occurs between different trademark users, but rather between: (a) the right holder through trademark use; and (b) public authorities through use of the package space of tobacco products to insert health warnings. Elsmore, *supra* note 17, at 106-07. Admittedly, Spence's claim that recoding cases would be best addressed as competing forms of expression between the right holder and the recoder is more in line with the reconceptualization proposed here. However, because his analysis is limited to recoding cases, his proposal for reform is premised on an incomplete understanding of the various ways in which speech can validate trademark rights. Spence proposes that speech be mobilized to safeguard right holders' expressive autonomy by ensuring protection against compelled speech resulting from recoders' unauthorized use of their marks. An overview of what I have labelled ownership cases reveals, however, that right holders' speech claims not only stem from compulsions on speech, but also from restrictions on trademark use/registration. Consequently, Spence's reconceptualization of the interaction between marks and speech as competing expression barely has repercussions beyond recoding litigation (i.e., potentially only in challenges to the validity of health-furthering, trademark-restrictive measures requiring owners to include health warnings in the packaging of their goods, which could amount to compelled speech). Michael Spence, *Restricting Allusion to Trade Marks: A New Justification*, *in* TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH 324, 339–40 (Graeme B. Dinwoodie & Mark Janis eds., 2007). The same considerations apply to the work of Hughes, whose proposal to conceive of the interaction between intellectual property right (including trademarks) and speech as competing forms of expression is also restricted to the recoding context. Hughes, *supra* note 4, at 1007 et seq.

I.
TRADEMARKS AS EXPRESSIVE ARTIFACTS

The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) defines a trademark as "[a]ny *sign* … capable of distinguishing the goods or services of one undertaking from those of other undertakings".[23] Similar provisions can be found in the Lanham Act in the United States,[24] and in the EU Trade Mark Regulation (EUTMR) and the Trade Marks Directive (TMD) in Europe.[25] At their most basic, trademarks are signs. Signs, in turn, are units of language that convey information and, through their use, enable communication between two or more people. The words that I am writing right now are signs that allow me to communicate with you, the reader. The same is true of trademarks: they convey information and enable communication in the marketplace and in society at large.

The fundamental information conveyed by a mark is the commercial origin of goods or services.[26] For instance, the "Apple" mark represents a particular commercial origin, i.e. Apple, Inc. Use of this mark in the course of trade allows its owner to distinguish its goods from those of its competitors. Contemporary marks can be used to convey a wide range of meanings in addition to commercial origin, ranging from signaling information about quality or reputation to conveying lifestyle preferences that individuals can rely on to pursue their preferred identity projects.[27] Going back to the previous example, the "Apple" mark is loaded with additional meanings: it is synonymous with innovation, high quality, reliability, sleek design, and has come to symbolize a set of values, and

23. Agreement on Trade-Related Aspects of Intellectual Property Rights, Marrakesh Agreement Establishing the World Trade Organization, Art. 15, Apr. 15, 1994, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) (emphasis added).

24. 15 U.S.C. § 1127.

25. Regulation 2017/1001, of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark, Art. 4, 2017 O.J. (L 154) 1; Directive 2015/2436, of the European Parliament and of the Council of 16 Dec. 2015 to Approximate the Laws of the Member States Relating to Trade Marks, Art. 3, 2015 O.J. (L 336) 1.

26. Hanover Star Milling Co. v. Metcalf, 240 U.S. 403, 412 (1916) ("The primary and proper function of a trade-mark is to identify the origin or ownership of the article to which it is affixed."); Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 2 WIS. L. REV. 158, 158-59 (1981) ("The information conveyed through the use of a trademark generally relates … to the details of prospective commercial transactions—the source or quality of specific goods or services."); Keith Aoki, *How the World Dreams Itself to Be American: Reflections on the Relationship between the Expanding Scope of Trademark Protection and Free Speech Norms*, 17 LOY. L.A. ENT. L.J. 523, 531 (1997) ("Trademarks are traditionally viewed as a source identifier. They are words and designs whose purpose is to distinguish the goods or services of one company from the goods or services of another company.").

27. The ability of contemporary trademarks to convey very diverse meanings and, thus, to perform functions other than source-identification has been widely acknowledged in the literature and case law. Jerre B. Swann Sr., *An Interdisciplinary Approach to Brand Strength*, 96 TRADEMARK REP. 943 (2006); Swann, Aaker & Reback, *supra* note 2; Kozinski, *supra* note 2.

even a lifestyle that is hip, sophisticated, stylish, design-conscious, and creative.[28] Because they provide consumers with a wealth of useful information about the goods to which they are affixed, these additional meanings—which are crucial to building brand image—are extremely valuable to right holders.[29] So much so that firms are often willing to devote vast amounts of resources to develop and maintain them, usually by means of costly promotional activities.[30]

How can signs, including trademarks, develop such complex meanings? Meaning of signs is the result of a social consensus, whereby individuals agree that sign "x" will carry meaning "y."[31] For example, the word "tree" symbolizes

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28. Grainne M. Fitzsimons et al., *Automatic Effects of Brand Exposure on Motivated Behavior: How Apple Makes You "Think Different,"* 35 J. CONSUMER RSCH. 21, 24 (2008) ("Apple has labored to cultivate a strong brand personality based on the ideas of nonconformity, innovation, and creativity"); Traci H. Freling et al., *Brand personality appeal: conceptualization and empirical validation*, 39 J. ACAD. OF MKTG. SCI. 392, 392 (2011) ("[Apple's brand personality, as projected through its products] advertisements is … young, hip and easy to use"); Clarinda Rodrigues & Paula Rodrigues, *Brand love matters to Millennials: the relevance of mystery, sensuality and intimacy to neo-luxury brands*, 28 J. OF PROD. & BRAND MGMT. 830, 833-34 (2019) ("brands such as Apple … have positioned themselves … as neo-luxury brands, [associated with] quality, creativity, innovation and authenticity", as well as with "sophistication [and] uniqueness").

29. Swann et al. have described in very persuasive terms the diverse ways in which the additional meanings conveyed by contemporary brands serve right holders' interests. In their own words:

> For their owners, therefore, strong brands are far more than a simple "investment." Rather, as a consequence of their bond with consumers, they: (i) allow access to consumers' minds; (ii) make advertising less expensive or more impactful (or both); (iii) enable a manufacturer to communicate more directly with a consumer, cushioning any vagaries of distribution; (iv) assist in attaining channel power; (v) provide a more efficient and credible means of extending into related goods, and give rise to licensing opportunities; (vi) serve as certificates of "authenticity"; (vii) afford resilience; and (viii) constitute an asset-brand equity-that is frequently a company's most valuable single property.

Swann, Aaker & Reback, *supra* note 2, at 807.

30. Reza Motameni & Manuchehr Shahrokhi, *Brand equity valuation: a global perspective*, 7 J. OF PROD. & BRAND MGMT. 275, 275 (1998) ("To create a brand from scratch requires huge investments. … Empirical research has shown that massive sums spent on advertising … translate … into … brand awareness, image, and loyalty"); Swann, *supra* note 27, at 957, 969 (2006) ("the cost to create a new brand is huge"; "Changes [in the mental clusters that exist for strong brands] have occurred as a result of enormous investments in brand information, and they possess … substantial benefits for consumers"). This has also been acknowledged by the US Supreme Court in the following terms: "Companies spend huge amounts to create and publicize trademarks that convey a message." Matal v. Tam, 137 S. Ct. 1744, 1760 (2017).

31. In his influential study on the semiotics of trademark law, Barton Beebe explains Saussure's view on the arbitrariness of meaning in symbols in the following terms: "Saussure held that, at least in spoken and written language, the relation between the sign's signifier and its signified is 'arbitrary.' By this he meant that there is no natural connection between the concept of a book and the sound or appearance of the word 'book' …. Their relation is established and sustained by convention alone: 'It is because the linguistic sign is arbitrary that it knows no other law than that of tradition, and because it is founded upon tradition that it can be arbitrary.'" Barton Beebe, The Semiotic Analysis of Trademark Law, 51 U.C.L.A. L. REV. 621, 634 (2004), quoting FERDINAND DE SAUSSURE, COURSE IN GENERAL LINGUISTICS 74 (Charles Bally & Albert Sechehaye eds., Roy Harris trans. 1990) (1916) at 74.

the "woody perennial plant" found in nature only insofar as English speakers have agreed as much.[32] Put differently, there is no necessary correlation between the word "tree" and the meaning "woody perennial plant." Rather the relation between word and meaning is contingent on social convention and, as such, is arbitrary. Because social consensus is not static, meaning in signs is subject to constant transformation.[33] For instance, until the second half of the 20th century, the signifier "gay" acted solely as an adjective meaning "light-hearted and carefree."[34] In the 1960s, however, with the advent of the gay rights movement, that same signifier developed new meaning as a noun to refer to "a homosexual, especially a man", or as an adjective to describe someone's "homosexual[ity], especially a man['s]."[35] Consequently, the precise meaning that the word "gay" conveys can, in contemporary English, fluctuate from one meaning to the other on the basis of context.

The same is true of marks, the meanings of which may evolve over time depending on how they are used.[36] Going back to the previous example, the "Apple" mark performs a source-identifying function when it is used to differentiate electronic goods originating from the company Apple Inc. from the like products of its competitor Samsung Electronics Co. Ltd., marketed under the "SAMSUNG" mark. But marks also perform an advertising function when they are used to "convey[] a particular image to the … consumer of the goods or services in question."[37] For instance, Apple Inc.'s use of its "Apple" mark on advertisements featuring renowned artists working on "Apple"-branded

32. The Oxford English Dictionary Home Page, www.oxforddictionaries.com (last visited Oct. 30, 2020).

33. Building on Saussure's study of semiotics, Raber & Budd explain the historical contingency of meaning in signs in the following terms: "Signs are arbitrary creations …. Language is determined by a community of speakers who share and sustain it historically by means of convention and tradition. … Like any social institution, language admits the possibility of change." Douglas Raber & John M Budd, *Information as sign: semiotics and information science*, 59 J. OF DOCUMENTATION 507, 512 (2003). *See also* Richardson, *supra* note 10, at 200 ("From a modem linguistic perspective, the notion that any meaning is 'inherent' in words is impossible: meaning is a product of social discourse.").

34. *Id*.

35. *Id*.

36. Jason Bosland, *The Culture of Trade Marks: An Alternative Cultural Theory Perspective*, 10 MEDIA & ARTS L. REV. 99, 108 (2005) ("trade mark language is constructed and transformed through the production and consumption of trade marks in everyday life. … [T]rade mark language … is in a constant process of change and evolution."). *See also* Deven Desai, *From Trade Marks to Brands*, 64 FLA. L. REV. 981, 986 (2012) at 1041-42; Gangjee, *supra* note 2, at 58.

37. Datacard v. Eagle Technologies [2011] EWHC 244 Pat [272]. At the EU level, the CJEU has defined the advertising function of marks as "that of using a mark for advertising purposes designed to inform and persuade consumers." Case C-129/17, Mitsubishi v. Duma Forklifts, ECLI:EU:C:2018:594, ¶ 37 (July 25, 2018). See also Joined Cases C-236/08 to C-238/08, Google France v. Louis Vuitton, ECLI:EU:C:2010:159, ¶¶ 91-92 (Mar. 23, 2010). According to Fhima, "contemporary trade marks … have a wider range of functions. In particular, their use in advertising allows their owners to build a reputation and image around the mark." Fhima, *supra* note 13, at 293.

computers conveys an image of high quality, creativity, and style.[38] Marks also perform an expressive function when they are used to express allegiance to a certain idea, whether by the mark owner, consumers of branded goods, or third parties wishing to comment on/parody the values embodied by the mark. For example, the "Apple" mark performs an expressive function when consumers purchase and use "Apple"-branded products with a view to expressing their adherence to a creative and stylish lifestyle.

Courts and commentators writing in both the legal and marketing fields have widely acknowledged that marks perform an expressive function. For instance, Dreyfuss has argued that "ideograms that once functioned solely as signals denoting the source, origin, and quality of goods, have become … indicators of the status, preferences, and aspirations of those who use them."[39] According to McGeveran, "many uses of trademarks in today's culture go far beyond the boundaries of … commerc[e] …. They can involve political expression, artistic works, parodies, or criticism."[40] In its recent decision in *Matal v. Tam*, the United States Supreme Court held that:

> [T]rademarks often have an expressive content. Companies spend huge amounts to create and publicize trademarks that convey a message. It is true that the necessary brevity of trademarks limits what they can say. But powerful messages can sometimes be conveyed in just a few words. Trademarks are . . . speech.[41]

The list goes on.[42] These examples serve two purposes. First, they show just how widespread the consensus is regarding the ability of marks to convey

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38. Commenting on this series of ads (entitled 'Behind the Mac'), a reporter for the online publication "AppleInsider" describes them as follows: "A type of customer testimonial, the ads are expertly crafted to show, not tell, Mac's ability to augment, enhance and facilitate the creative process." AppleInsider Staff, *New 'Behind the Mac' ad features Kendrick Lamar, Gloria Steinem, Billie Eilish, more,* APPLEINSIDER (Nov. 10, 2020) https://appleinsider.com/articles/20/11/10/new-behind-the-mac-ad-features-kendrick-lamar-gloria-steinem-billie-eilish-more.

39. Dreyfuss, *supra* note 2, at 397.

40. McGeveran, *Four Free Speech Goals for Trademark Law, supra* note 10, at 1211.

41. Matal v. Tam, 137 S. Ct. 1744, 1769 (2017).

42. Desai has advanced that "Consumers often buy branded goods not for their quality but as badges of loyalty, ways to express identity, and items to alter and interpret for self-expression". Desai, *supra* note 36, at 986. Elsmore is "astonish[ed] [by] the role of trademarks as proxy mechanisms for consumers to advertise themselves and their values, and the marked products, through displaying trademark". Elsmore, *supra* note 17, at 101. Gangjee has argued that "brand image may also provide the resources for both individual as well as collective identity projects. Since consumers fabricate their identities within a market context, brands signal social identity or status." Gangjee, *supra* note 2, at 35. According to Richardson:

> Now trade marks do more than 'sell' goods and services, let alone distinguish their "origin"—still the only true function of trade marks according to trade mark law. Like them or not, trade marks tell stories. Their expressiveness is the basis of commercial activity, the trader-author the conduit of meaning, and the market audience the monitor and arbiter of taste.

expressive meaning. Second, they illustrate the diversity of ways individuals can use marks for expressive purposes to pursue their preferred identity projects.[43] Going back to the electronic goods example, Apple Inc. expresses its belief in the desirability of leading a creative and stylish lifestyle by manufacturing, branding, and offering for sale electronic goods that maximize functionality without compromising on design.[44] Consumers can express their adherence to such a lifestyle through the purchase and use of "Apple"-branded goods. In contrast to these types of expressive uses, a third party may modify—or recode—Apple Inc.'s "iPhone" mark to read "iClone," altering its original meaning to comment on the deceitful marketing practices of multinational companies such as Apple Inc., which are often said to employ sophisticated communication strategies to

Richardson, *supra* note 10, at 196; Jacques has claimed that "[c]onsumers do not buy goods and services to merely satisfy their needs, but they *consume* trade marks for the messages they convey." Jacques, *supra* note 10, at 473 (emphasis in the original). Ricolfi has advanced that "brands may convey –and do convey– not only messages about the origins of the goods and their quality but also other messages, about lifestyles, values, attitudes towards society and the like". Ricolfi, *supra* note 13, at 470. Dogan and Lemley believe that "brands . . . convey information *about* the consumer and allow members of the public to communicate to each other. By selling branded products, producers enable us to brand ourselves." Dogan & Lemley, *Parody as Brand, supra* note 10, at 106 (emphasis in the original). According to Sakulin:

> [C]onsumers seem to purchase and "consume" the communicative value or status of trademarks. If and to the extent that certain trademarks communicate status, success, or (sexual) appeal, many consumers may be induced to buy trademarked goods and services in part or mainly because of the additional value offered by the trademark.

WOLFGANG SAKULIN, TRADEMARK PROTECTION AND FREEDOM OF EXPRESSION 11 (2011). Spence advocates for the "recognition that a mark is a form of speech. Trade mark owners work hard to ensure that their mark communicates, not only the trade origin of goods, but also a whole range of associated values." Michael Spence*, The Mark as Expression/The Mark as Property,* 58 CURRENT LEGAL PROBS. 491, 504 (2005); Keller, writing in the marketing field, believes that "for many people, … [brands] serve the function that fraternal, religious and service organizations used to serve –to help people define who they are and then help them communicate that definition to others". KEVIN L. KELLER, STRATEGIC BRAND MANAGEMENT: BUILDING, MEASURING, AND MANAGING BRAND EQUITY 8 (1998) (paraphrasing Daniel Boorstein).

43. This diversity has also been noted by Sonia K. Katyal, *supra* note 7, at 878 ("Each of these audiences—whether consumers of luxury goods … or artist/activists …—oppositional or otherwise, all integrate and respond to particular brands as part of their process of self-expression.").

44. For instance, Apple's press release covering the launch of its higher-end Apple Watch model in collaboration with French fashion powerhouse Hermès features testimonies from senior executives at both companies claiming to be "united by the same vision, the uncompromising pursuit of excellence and authenticity, and the creation of objects that remain as relevant and functional as they are beautiful." In the words of Apple's chief design officer at the time, Jonathan Ive: "Apple and Hermès make very different products, but they reflect the deep appreciation of quality design. … Both companies are motivated by a sincere pursuit of excellence and the desire to create something that is not compromised. *Apple Watch Hermès is a true testament to that belief*" (emphasis added). Press Release, Apple, Apple and Hermès Unveil the Apple Watch Hermès Collection, Apple (September 9, 2015), https://www.apple.com/newsroom/2015/09/09Apple-and-Herm-s-Unveil-the-Apple-Watch-Herm-s-Collection/.

magnify the innovative features of their newly-released goods to lure consumers into buying them.[45]

II.
THE INTERACTION BETWEEN TRADEMARKS AND FREEDOM OF EXPRESSION

Although they do so in different manners, and for different purposes, these examples show that individuals are able to express themselves through trademark use. But are all individuals really able to use marks expressively in any and all instances? More importantly, should they be able to do so? These are the fundamental questions that have occupied courts and scholars dealing with the interaction between marks and speech since the 1970s.[46]

To assist in answering these questions, I propose making a preliminary distinction between a *de facto* and *de jure* ability to use a mark for expressive purposes. The previous section explored the expressive capabilities of trademarks in *de facto* terms, describing how different individuals—right holders, consumers, and recoders—can, in principle, rely on the plurality of meanings that marks convey to express themselves through their sale, consumption, or recoding. However, this may not necessarily be the case as a matter of law, where legal barriers may prevent certain individuals from using marks for expressive purposes. Let us now turn to look at some of these barriers.

Trademark rights constitute the most obvious barrier to expressive use of marks by non-owners, and often are invoked by right holders seeking an injunction before the courts.[47] This is particularly true where a third party uses a recoded version of a reputed mark for parodic or critical purposes, which easily lends itself to infringement actions on likelihood of confusion and, more often,

45. *See*, Jason Martuscello, *13 Strategies Apple Uses to Get Customers to Upgrade iPhones*, BEESY (Apr. 20, 2018), https://beesystrategy.com/13-strategies-apple-uses-to-get-customers-to-upgrade-iphones/ ("How does Apple convey they are the most innovate iPhone? It is simple, they tell you! Innovation, like art, is in the eye of the beholder. It is a perception. Apple fuels this innovation perception by directly communicating every year 'this is the best iPhone we have ever created.'").

46. Early decisions in this regard include: Dallas Cowboy Cheerleaders, Inc. v. Pussycat Cinema Ltd., 604 F.2d 200 (2d Cir. 1979); Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183 (E.D.N.Y. 1972). Early scholarship on the topic includes: Kozinski, *supra* note 22; Langvardt, *supra* note 10; Dreyfuss, *supra* note 2; Shaughnessy, *supra* note 10; Dorsen, *supra* note 10; Denicola, *supra* note 10.

47. This is expressed in very eloquent terms by Judge Kozinski writing for the majority in both New Kids on the Block v. News Am. Publ'g, Inc., 971 F.2d 302, 306 (9th Cir. 1992) ("the primary cost of recognizing property rights in trademarks is the removal of words from (or perhaps non-entrance into) our language") and Mattel, Inc. v. MCA Recs., Inc., 296 F.3d 894, 900 (9th Cir. 2002) ("Were we to ignore the expressive value that some marks assume, trademark rights would grow to encroach upon the zone protected by the First Amendment"). *See also* Yankee Publ'g, Inc. v. News Am. Publ'g, Inc., 809 F. Supp. 267, 275-76 (S.D.N.Y. 1992) ("Because the trademark law regulates the use of words, pictures, and other symbols, it can conflict with values protected by the First Amendment. The grant to one person of the exclusive right to use a set of words or symbols in trade can collide with the free speech rights of others.").

dilution grounds.[48] Thus, an individual who wishes and is—*de facto*—able to engage in expressive use of a mark might be precluded from doing so on legal grounds. This begs the question of the extent to which trademark rights are intended to preclude expressive use of marks by third parties, especially in light of their fundamental right to freedom of expression as recognized in constitutional and human rights instruments.[49] In recoding cases, invocation of free speech by defendants often results in courts engaging in a balancing exercise whereby owners' proprietary interests are pitted against defendants' speech. In such cases, speech is understood to operate as a defense to the exclusive rights granted to right holders, shielding most unauthorized expressive uses from liability.[50]

However, owners' exclusive rights are not the only legal constraint to expressive use of marks. Some of the fundamental provisions found in trademark statutes worldwide seek to police who can make use of certain signs as trademarks and for what purposes.[51] In so doing, they erect legal barriers preventing certain individuals from making use of marks to express their preferred messages. For instance, by precluding certain signs from accessing the trademark register altogether, the absolute ground for refusal of descriptive signs ensures that one single individual, such as the would-be trademark owner, does not appropriate the communicative potential of such signs.[52] The absolute ground for refusal of marks that have become generic—i.e. a mark that no longer identifies a given commercial origin but rather has become synonymous with the class of goods—raises similar concerns.[53] The generic mark is removed from the register to allow other firms trading in the class of goods to use it without fear of infringing on the owner's exclusive rights.[54] These restrictions serve to foster competition in the marketplace.

At the same time, however, they prevent applicants/owners from registering/continuing to own descriptive/generic signs and, consequently, from using them in the manner that best suits their interests, including their expressive

48. *See* case law cited *supra* note 8.

49. U.S. Const. amend. I; Convention for the Protection of Human Rights and Fundamental Freedoms (European Convention on Human Rights, as amended), Art 10.

50. *See* excerpts extracted from the case law cited *supra* note 6.

51. McGeveran, *Four Free Speech Goals for Trademark Law, supra* note 10, at 1210.

52. 15 U.S.C. § 1052(e); EUTMR, Art 7(1)(c); TMD, Art 4(1)(c). Supporting this view, *see* Case C-108/97, Windsurfing Chiemsee v. Boots, ECLI:EU:C:1999:230, ¶ 25 (May 4, 1999); Joined Cases C-53/01 to C-55/01, *Linde and Others*, ECLI:EU:C:2003:206 ¶ 73 (Apr. 8, 2003); Case C-191/01, OHIM v. Wrigley, ECLI:EU:C:2003:579 ¶ 31 (Oct. 23, 2003); Sakulin, *supra* note 42, at 57; McGeveran, *Four Free Speech Goals for Trademark Law, supra* note 10, at 1210; Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 COLUM. J.L. & ARTS 187, 191-92 (2004).

53. 15 U.S.C. § 1064(3); EUTMR, Art 7(1)(d); TMD, Art 4(1)(d).

54. New Kids on the Block v. News Am. Publ'g, Inc., 971 F.2d 302, 306 (9th Cir. 1992); Sakulin, *supra* note 42, at 57; Rebecca Tushnet, *Why the Customer Isn't Always Right: Producer-Based Limits on Rights Accretion in Trademark*, 116 YALE L.J. POCKET PART 352, 353 (2007); Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 793 (2004); Leval, *supra* note 52, at 191-92.

interests. These are instances where the expressive interests of all other traders (in addition to consumers' interest in having access to product information and, broadly considered, the interest of all market participants in maximized efficiency) clearly outweigh those of the trademark applicant/owner.[55] This likely explains why no challenges have been raised on free speech grounds to the validity of decisions denying registration to descriptive marks/removing generic marks from the register.

The same is not true of the absolute grounds for refusal of marks that are immoral, disparaging, or scandalous in the United States or contrary to public policy or morality in Europe.[56] In recent years, refusals from trademark offices to register signs that are liable to offend the public, most often unsavory terms, have been challenged on grounds that they contravene the fundamental right to freedom of expression of trademark applicants.[57] Applicants argue that their inability to communicate their preferred messages in the course of trade—i.e. through the exclusive use of their preferred signs resulting from registration—runs counter to their speech rights. This can happen in three ways.

First, refusals of registration encumber applicants' ability to use their applied-for signs in relation to their goods in exclusive terms—in Europe, where unregistered marks enjoy very limited protection, refusals of registration will go as far as to prevent applicants from using their applied-for signs in exclusive terms.[58] Exclusivity plays a fundamental role in allowing signs to further the communicative needs of traders when operating in the course of trade, most notably, the ability of signs to clearly signal commercial origin—which is only possible where exclusive use is guaranteed.[59] If two or more traders were to brand their competing goods using the same sign, consumers looking to buy such goods would very likely be confused as to the commercial source of each of them. Second, the inability of unsuccessful applicants to use their applied-for signs in exclusive terms would severely impact their advertising strategy. Uses of marks for promotional purposes in advertising campaigns and other marketing channels

55. Sakulin, *supra* note 42, at 192-93 ("Seen from the perspective of freedom of expression, this ground for refusal is one of the most important limitations of the grant of trademark rights. It applies to descriptive signs as well as to … generic signs. The public interest, which underlies [these grounds for refusal] is … [the protection] of the freedom of commercial expression of third-party traders to communicate with consumers by means of descriptive signs.").

56. These grounds for refusal are regulated in 15 U.S.C. § 1052(a); EUTMR, Art 7(1)(f); TMD, Art 4(1)(f).

57. *See* case law cited *supra* note 12.

58. The expressive constraints imposed on applicants by refusals of registration are more stringent in Europe than in the United States, where common law marks (i.e., unregistered) are deserving of a substantial degree of protection as a result of use.

59. There is wide support for this proposition in the literature. *See, e.g.*, Dreyfuss, *supra* note 2, at 400 ("exclusivity is essential to an efficient marketplace. Without an unambiguous signal for goods, consumers would have no way to apply their past experience to future purchasing decisions"); Gangjee, *supra* note 2, at 29 ("Granting exclusive rights to a mark preserves its ability to reliably signal origin. This ability reduces consumer search costs and protects producer goodwill.").

are often so onerous that unsuccessful applicants would lack the incentive to make the required investment on the rejected signs if other traders were also allowed to use them. In the words of the EUIPO Grand Board of Appeals in *Jebaraj Kenneth*:

> While it is true to say that a refusal to register does not amount to a gross intrusion on the right of freedom of expression, since traders can still use trade marks without registering them, it does represent a restriction on freedom of expression in the sense that businesses may be unwilling to invest in large-scale promotional campaigns for trade marks which do not enjoy protection through registration because the Office regards them as immoral or offensive in the eyes of the public.[60]

And third, applicants' inability to use their applied-for signs in exclusive terms would, in turn, preclude them from building a brand image around these signs.[61] This could lead to the signs not evolving in such a way as to convey the additional meanings that the applicants wish to communicate in the marketplace.[62]

Furthermore, the impact of restrictions on trademark use on the expressive interests of right holders not only stem from trademark statutes but may also stem from public measures seeking to regulate the consumption of certain goods. Since the 1960s, legislation aimed at furthering public health has been implemented in certain industries—most notably, the tobacco, alcohol, and food industries—through advertising bans, health warnings, and, more recently, plain packaging.[63] The rationale behind these measures is to reduce the appeal that unhealthy products have to consumers by reducing/eliminating the advertising that the trademark performs and by better informing consumers of the risks that consumption of these products poses to their health.[64] Tobacco manufacturers

60. R 495/2005-G, Application of Jebaraj Kenneth, ¶ 15 (July 6, 2006). *See*, in similar terms, Bonadio, *supra* note 13, at 56; Scassa, *supra* note 13, at 1190–92. By contrast, Kapff, Griffiths, and Ricolfi have argued that free speech can hardly be said to be curtailed as a result of refusals of registration, since applicants are still able to market their goods using the contentious sign. Philipp von Kapff, *Fundamental Rights in the Practice of the European Trade Mark and Designs Office (OHIM)*, *in* RESEARCH HANDBOOK ON HUMAN RIGHTS AND INTELLECTUAL PROPERTY 273, 303 (Christophe Geiger ed., 2015); Griffiths, *supra* note 13, at 448–49; Ricolfi, *supra* note 13, at 471.

61. According to Dreyfuss: "Th[e] absence [of exclusivity in the use of a mark] would reduce suppliers' incentives to invest in quality-producing and brand-differentiating activities as the benefits of the investment could not be captured through repeat sales to loyal customers." Dreyfuss, *supra* note 2, at 400-01.

62. I have explored in further detail the rationale for invoking speech protection in refusals of registration elsewhere: Alvaro Fernandez-Mora, *Inconsistencies in European Trade Mark Law: The Public Policy and Morality Exclusions*, 4 INTELL. PROP. Q. 271, 284–85 (2020).

63. *See*, for a list of relevant examples of health-furthering, trademark-restrictive measures, *supra* note 15.

64. This has been acknowledged by regulators, courts, and scholars. For instance, in its proposed rule to introduce combined health warnings (i.e., consisting of both text and images) for tobacco products in the United States, the FDA explained that "new required warnings are designed to clearly and effectively convey the negative health consequences of smoking on cigarette packages and in cigarette advertisements, which would help both to discourage nonsmokers, including minor children, from initiating cigarette use and to encourage current smokers to consider cessation to greatly reduce the serious risks that smoking poses to their health." Proposed Rules, Department of Health and

have very often challenged the validity of these measures on grounds that they contravene their fundamental rights to (intellectual) property and/or freedom of expression.[65] As regards the latter right, these measures interfere with owners' ability to communicate their preferred messages in the marketplace. This can occur in two ways. First, because they impose restrictions on the manner in which marks can be used (and sometimes even on the types of marks that can be used, as with plain packaging), these measures hinder marks' ability to perform their functions.[66] Admittedly, the fundamental aim of health-furthering, trademark-restrictive measures is to target the advertising function of marks by reducing the appeal that certain signs have on consumers, especially fanciful logos.[67] However, the spillover effect of these measures often has an impact on marks' ability to perform their original function (with the ensuing increase in consumers' search costs and the decrease in market efficiency),[68] as well as to develop and convey expressive meaning, thus precluding right holders and other categories of users from using them for communicative purposes. Second, by forcing manufacturers to showcase their marks alongside the unappealing content of health warnings,

Human Services (HHS), Food and Drug Administration (FDA), Required Warnings for Cigarette Packages and Advertisements, 75 Fed. Reg. 69524 (Friday, November 12, 2010). In the EU, the latest Tobacco Products Directive also recognizes this when it holds that "The labelling and packaging of [tobacco] products should display sufficient and appropriate information on their safe use, in order to protect human health and safety, should carry appropriate health warnings and should not include any misleading elements or features." Directive 2014/40/EU of the European Parliament and of the Council of 3 April 2014 on the approximation of the laws, regulations and administrative provisions of the Member States concerning the manufacture, presentation and sale of tobacco and related products, OJ L 127 at Recital 42. In *Reynolds*, the United States Court of Appeals for the District of Columbia Circuit also found "that the graphic warnings are intended to encourage current smokers to quit and dissuade other consumers from ever buying cigarettes." RJ Reynolds Tobacco Co. v. FDA, 696 F.3d 1205, 1218 (D.C. Cir. 2012). This has also been noted by scholars, for instance, by Enrico Bonadio, *Bans and Restrictions on the Use of Trademarks and Consumers' Health*, 4 INTELL. PROP. Q. 326, 330 (2014).

65. For property-based challenges, *see* R. (on the application of British Am. Tobacco UK Ltd.) v. Sec'y of State for Health [2016] EWCA Civ 1182; R. (on the application of British Am. Tobacco (UK) Ltd.) v. Sec'y of State for Health [2016] EWHC 1169 (Admin); Case C-547/14, Philip Morris Brands S.A.R.L. v. Sec'y of State for Health, ECLI:EU:C:2016:325 (May 4, 2016); Case C-491/01 Sec'y of State for Health v. British Am. Tobacco (Investments) Ltd. et al, ECR I-11453 (2010). For speech-based challenges, *see* case law cited *supra* note 8.

66. Bonadio, *supra* note 64, at 339-40.

67. *Id.* at 338 ("These measures aim . . . to correctly inform consumers and curb the promotional impact of the relevant brands.").

68. *Id.* at 339-40 ("The main problem surrounding [plain packaging] measures . . . lies in the fact that it is not possible to curb the promotional effects of packaging without 'touching' some distinctive elements of the brand: indeed, the two elements of trade marks (promotional and distinctive) overlap. If governments adopt measures aimed at neutralising the promotional effects of brands, it is inevitable that doing this will also lower their (abstract) distinctiveness."). In similar terms, Ricketson has argued in relation to plain packaging that "[i]n terms of strict trade mark theory, the marks are stripped of all their advertising or promotional capacity while retaining a bare shred of their function of denoting origin". Sam Ricketson, *Plain Packaging Legislation for Tobacco Products and Trade Marks in the High Court of Australia*, 3 QUEEN MARY J. INTELL. PROP. L. 224, 230 (2013).

their marks go on to become associated with a negative image.[69] This interferes with right holders' freedom of expression as a form of compelled speech, i.e. they are required to communicate a message with which they do not wish to be associated.

Before looking at these barriers in more detail, and to ensure a proper understanding of the conflicting interests at stake, it is helpful to explain the legal protection afforded to freedom of expression under US and European law.

A. The Right to Freedom of Expression

In Europe, the fundamental right to freedom of expression is enshrined in Article 10(1) of the European Convention of Human Rights (ECHR).[70] It provides as follows: "Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers."[71] In the United States, the First Amendment to the Constitution provides that "Congress shall make no law . . . abridging the freedom of speech."[72]

Freedom of expression lies at the very heart of democratic societies. It allows individuals to express their views and engage in debate without fear of censorship by the State or other individuals and, in so doing, allows societies to progress and flourish.[73] Its prominent role in society explains why the European Court of Human Rights (ECtHR) and the US Supreme Court have interpreted this right

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69. This was acknowledged by Heydon, J. in his dissenting opinion in the constitutional challenge to the validity of plain packaging legislation in Australia in the following terms:

> [Plain packaging] legislation *compels* the presence on the cigarette] packets of the [government's] … *messages* ….
>
> In effect, the [government] has … command[ed tobacco manufacturers] as to how [they] are to use what is left of [their] property … with a view to damaging [their businesses] by making the products [they] sell *unattractive* ….

JT Int'l SA v. Australia [2012] HCA 43 ¶ 225-26 (Austl.) (emphasis added). It should be noted that despite Heydon, J.'s language being evocative of restrictions on speech, the court's analysis did not venture beyond the compatibility of the impugned legislation with the right to (intellectual) property.

70. European Convention for the Protection of Human Rights and Fundamental Freedoms, opened for signature Nov. 4, 1950, 213 U.N.T.S. 221 (entered into force Sept. 3, 1953). In the EU, this right is also protected by virtue of the Charter of Fundamental Rights of the European Union art. 11, Dec. 18, 2000, 2000 O.J. (C364) 1 (hereinafter EU Charter).

71. ECHR art. 10(1).

72. U.S. CONST. amend. I.

73. "According to the Court's well-established case-law, freedom of expression constitutes one of the essential foundations of a democratic society and one of the basic conditions for its progress and each individual's self-fulfilment. … [This right affords robust protection to speakers in the interests] of pluralism, tolerance and broadmindedness, without which there is no 'democratic society'." Tammer v. Estonia, App. No. 41205/98, ¶ 59 (Feb. 6, 2001). *See also*, in similar terms, Zana v. Turkey, App. No 18954/91, ¶ 51 (Nov. 25, 1997). "'Those who won our independence believed … that public discussion … should be a fundamental principle of the American government.'" N.Y. Times Co. v. Sullivan, 376 US 254, 270 (1964) quoting Whitney v. California, 274 U.S. 357, 375 (1927) (Brandeis, J., concurring).

widely.[74] This is not to say that the scope of protection afforded to individuals under freedom of expression in each jurisdiction is equivalent. Any comparative exercise involving speech protection in the United States must be undertaken with caution.[75] This is due to the peculiarity of First Amendment doctrine within the political and legal landscape of the United States, where it is heavily relied upon to rein in government action in all its forms. Accordingly, not only is the manner in which speech rights can be relied upon to challenge public measures in the United States often different from other jurisdictions, including Europe, but the scope of protection afforded to individuals in the United States is often broader.[76]

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74. The US Supreme Court "consider[s free speech] case[s] against the background of a profound national commitment to the principle that debate on public issues should be uninhibited, robust, and wide-open, and that it may well include vehement, caustic, and sometimes unpleasantly sharp attacks on government and public officials." N.Y. Times Co. v. Sullivan, 376 U.S. 254, at 270 (1964). For its part, the ECtHR has acknowledged that the protection afforded under freedom of expression "is applicable not only to 'information' or 'ideas' that are favourably received or regarded as inoffensive or as a matter of indifference, but also to those that offend, shock or disturb." Tammer, App. No. 41205/98, ¶ 59 (Feb. 6, 2001); Zana, App. No 18954/91, ¶ 51 (Nov. 25, 1997). Fhima has also read the latter decision as proof that "The right [to freedom of expression] has been construed widely by the Strasbourg court." Fhima, *supra* note 13, at 295.

75. This has also been noted by Gangjee & Burrell, *supra* note 3, at 21 ("the exceptional nature of First Amendment jurisprudence, in part attributable to a strong suspicion of Government, suggests that it may be too firmly rooted for a successful legal transplant"). The High Court of England and Wales has also cautioned against too heavily relying on US First Amendment doctrine upon assessment of the proportionality limb of the test mandated under Article 10 ECHR, in R. (on the application of British Am. Tobacco UK Ltd.) v. Sec'y of State for Health [2004] EWHC 2493 (Admin). In weighing whether a domestic advertising ban on tobacco products effected a disproportionate interference with tobacco manufacturers' right to freedom of expression under the ECHR, the court advanced that:

> [T]he First Amendment to the U.S. Constitution is expressed in broad terms and does not have a 'justification' provision such as Article 10(2) of our Convention. … With the very greatest of respect to that distinguished [Supreme] Court, it was dealing with the United States Constitution rather than our Convention. While it is instructive, in general terms, to see how another respected jurisdiction has dealt with a related but confined problem, the balance between State legislation and federal legislation in the United States is a subject of renowned complexity. Decisions on such matters can have limited effect on our consideration of the balance to be struck in considering a restriction of a limited Convention right and the measure of a discretion to be afforded to Parliament and ministers under our own rather different constitutional system.

Id. at ¶ 36. In *Reynolds*, the United States Court of Appeals for the District of Columbia Circuit also relied on the comparatively robust protection afforded to free speech in the United States to justify its finding that pictorial health warnings affect an unjustified interference with tobacco manufacturers' First Amendment rights. After listing over 30 countries where similar restrictions had passed constitutional muster, the court "not[ed] that the constitutions of these countries do not necessarily protect individual liberties as stringently as does the United States Constitution." RJ Reynolds Tobacco Co. v. FDA, 696 F.3d 1205, 1209 (D.C. Cir. 2012).

76. This has been acknowledged by ERIC BARENDT, FREEDOM OF SPEECH 54 (2d ed. 2007) ("[The] US approach to free speech issues differs considerably … [from] the jurisprudence in many other countries and jurisdictions. . .[F]reedom of speech is more strongly protected against Government regulation in the United States, than it is, say, in Germany and under the ECHR"). *See also*: echoing Barendt's views and applying them to the interaction between trademarks and speech,

In spite of these differences, freedom of speech plays an equally pivotal role in the promotion of democratic values in both jurisdictions that justifies its robust protection.[77]

The central role that freedom of expression plays in the regulation of public activity in both jurisdictions opens the door to the sorts of parallels that allow for comparative analysis. This is especially true where the analytical frameworks employed by decision makers operating out of different jurisdictions bear resemblance, as is the case for the interaction between marks and speech. The way speech protection is relied upon by different expressive users of marks is strikingly similar on both sides of the Atlantic. First, in recoding litigation, both US and European courts have recourse to freedom of expression to insulate defendants' unauthorized use of plaintiffs' marks.[78] Second, in trademark registration, both US and European courts hear appeals on the compatibility of refusals of registration with applicants' speech rights.[79] And third, as regards challenges to the validity of health-furthering, trademark-restrictive measures, both US and European courts assess whether the encroachments they effect on right holders' speech rights are justified.[80] What is, however, different in each jurisdiction is the scope of protection afforded to the speaker under freedom of expression. This explains why similar analytical frameworks have led to

Gangjee & Burrell, *supra* note 3, at 21; and building on Gangjee and Burrell's work, *see* Katyal, *supra* note 7, at 928.

77. Compare, for instance, the reasoning of the ECtHR in Zana v. Turkey with that of the US Supreme Court in N.Y. Times Co. v. Sullivan in *supra* note 74.

78. Amongst others, in the **United States**: VIP Prods. L.L.C. v. Jack Daniel's Props., 953 F.3d 1170 (9th Cir. 2020); Ebony Media Operations L.L.C. v. Univision Commc'ns, Inc., No. 18-cv-11434-AKH (S.D.N.Y. Jun. 3, 2019); Louis Vuitton Malletier S.A. v. My Other Bag, Inc., 156 F. Supp. 3d 425 (S.D.N.Y. 2016); Univ. of Ala. Bd. of Trs. v. New Life Art, Inc., 683 F.3d 1266 (11th Cir. 2012); Smith v. Wal-Mart Stores, Inc., 537 F. Supp. 2d 1302 (N.D. Ga. 2008); E.S.S. Entm't. 2000 Inc. v. Rock Star Videos Inc., 547 F.3d 1095 (9th Cir. 2008); Nissan Motor Co. v. Nissan Comput. Corp., 378 F.3d 1002 (9th Cir. 2004); World Wrestling Fed'n Ent., Inc. v. Big Dog Holdings, Inc., 280 F. Supp. 2d 413 (W.D. Pa. 2003); Mattel, Inc. v. MCA Recs., Inc., 296 F.3d 894 (9th Cir. 2002); Anheuser-Busch, Inc. v. Balducci Publ'ns, 28 F.3d 769 (8th Cir. 1994); *Yankee Publ'g*, 809 F. Supp. 267; Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc., 886 F.2d 490 (2d Cir. 1989); Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989); L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26 (1st Cir. 1987). In **Europe**: Gof's-Amsterdam 13 september 2011, IES 2012, 15 m.nt. Herman MH Speyart (Mercis BV/Punt.nl BV) (Neth.); Rb.'s-Gravenhage 4 mai, 2011 NJF 2011, 264 (Nadia Plesner/Louis Vuitton) (Neth.); Bundesgerichtshof [BGH] [Federal Court of Justice] Apr. 7, 2005, Neue Juristische Wochenschrift [NJW] 2856 (2005) (Ger.)

79. Amongst others: Iancu v. Brunetti, 139 S. Ct. 2294 (2019); Matal v. Tam, 137 S. Ct. 1744 (2017); Case C-240/18, Constantin Film Produktion ('FACK JU GÖHTE') v. EUIPO, ECLI:EU:C:2019:553 (Feb. 27, 2019); French Connection Ltd.'s Trademark Application [2007] ETMR 8.

80. Amongst others: RJ Reynolds Tobacco, 696 F.3d at 1205 (D.C. Cir. 2012); Lorillard Tobacco Co. v. Reilly, 533 U.S. 525 (2001); Case C-547/14, Philip Morris Brands S.A.R.L. v. Sec'y of State for Health, ECLI:EU: C:2016:325 (May 4, 2016); Opinion of Advocate General Fennelly in Case C-376/98, Germany v. European Parliament, ECLI:EU:C: 2000:324 (June 15, 2000).

contrasting outcomes—especially in ownership cases, where applicants/owners in the United States have been more successful than in Europe.[81]

Despite constituting the cornerstone of free societies, the right to freedom of expression is not without limits.[82] In Europe, Article 10(2) ECHR qualifies the scope of the right by providing that "[t]he exercise of these freedoms . . . may be subject to such . . . restrictions . . . as are prescribed by law and are necessary in a democratic society."[83] Interference with freedom of expression might, thus, be justified, provided that the following requirements are cumulatively met: (a) the measure must be prescribed by law, (b) the measure must pursue a legitimate aim, and (c) the measure must be "necessary" in a democratic society, in the sense that the interference responds to a "pressing social need," is accompanied by "relevant and sufficient reasons," and is "proportionate."[84] As regards the latter requirement (i.e. "necessity"), a fundamental part of the inquiry revolves around determination of the margin of appreciation to be afforded to the public authority.[85] This varies in accordance with the type of speech interfered with.[86] Political and artistic expression, which are deemed to be of utmost importance for the proper functioning of a democratic society, are worthy of heightened protection and, thus, any interference will be strictly scrutinized.[87] According to the ECtHR, encroachments on political and artistic expressions are "narrowly interpreted and the[ir] necessity . . . must be convincingly established."[88] At the other end of the

81. These divergences are explored in Sections II(C)(3) and II(C)(2) below.

82. "This freedom is subject to the exceptions set out in Article 10(2), which must, however, be construed strictly." Tammer v. Estonia, App. No. 41205/98, ¶ 59 (Feb. 6, 2001).

83. ECHR art. 10(2).

84. Mouvement Raëlien Suisse, App. No. 16354/06 (July 13, 2012); VgT Verein Gegen Tierfabriken v. Switzerland, App. No. 24699/94 (June 28, 2001); Casado Coca v. Spain, App. No. 15450/89 (Feb. 24, 1994); Markt Intern Verlag GmbH and Klaus Beermann v. Germany, App. No. 10572/83 (Nov. 20, 1989); Zana v. Turkey, App. No 18954/91, ¶ 51 (Nov. 25, 1997).

85. "[U]nder Article 10 of the Convention, the Contracting States enjoy a certain margin of appreciation in assessing whether and to what extent an interference with the freedom of expression guaranteed under that provision is necessary. However, this margin goes hand in hand with European supervision …. In exercising its supervisory function, the Court's task is not to take the place of the national courts, but rather to review … whether the decisions they have taken pursuant to their power of appreciation are compatible with the provisions of the Convention relied on." Axel Springer AG v. Germany, App. No. 39954/08, ¶¶ 85-86 (Feb. 7, 2012). *See also*, in similar terms: Tammer, App. No. 41205/98, ¶ 60 (Feb. 6, 2001); Mouvement Raëlien Suisse, App. No. 16354/06, ¶ 59-60 (July 13, 2012).

86. "The breadth of such a margin of appreciation varies depending on a number of factors, among which the type of speech at issue is of particular importance." Mouvement Raëlien Suisse, App. No. 16354/06, ¶ 61 (July 13, 2012).

87. "[T]here is little scope under Article 10(2) of the Convention for restrictions on political speech or on debate on matters of public interest". Ceylan v. Turkey, App. No. 23556/94, ¶ 34 (July 8, 1999). *See*, in similar terms, Wingrove v. The United Kingdom, App. No., ¶ 58 17419/90 (Nov. 25, 1996).

88. VgT Verein Gegen Tierfabriken, App. No. 24699/94, ¶ 66 (June 28, 2001); Hertel v. Switzerland, App. No. 25181/94, ¶ 46 (Aug. 25, 1998); Handyside v. The United Kingdom, App. No. 5493/72, ¶ 49 (Dec. 7, 1976).

spectrum lies commercial expression, which the ECtHR has held to be deserving of less protection.[89] Under this category of expression, "the Court must confine its review to the question whether the measures [interfering with speech] are justifiable in principle and proportionate."[90]

In the United States, courts have also applied different thresholds of protection depending on the category of speech interfered with.[91] Three levels of scrutiny have been identified. First, a lower-level scrutiny imposing a reasonableness test applies to "purely factual and uncontroversial" disclosure requirements imposed by the government.[92] Under a reasonableness test, the interference with speech must simply be "reasonably related to the State's interest" and not "unjustified or unduly burdensome" to pass constitutional muster.[93] Second, intermediate-level scrutiny mandates that the encroachment on speech "directly advance . . . the [substantial] governmental interest asserted, and . . . it is not more extensive than is necessary to serve that interest."[94] Interferences with commercial speech (including speech uttered through trademark use) are commonly scrutinized under intermediate-level scrutiny.[95] And third, strict

89. "Whilst there is little scope under Article 10 § 2 of the Convention for restrictions on political speech … States have a broad margin of appreciation in the regulation of speech in commercial matters or advertising." Mouvement Raëlien Suisse, App. No. 16354/06, ¶ 61 (July 13, 2012).

90. Markt Intern Verlag GmbH and Klaus Beermann v. Germany, App. No. 10572/83, ¶ 33 (Nov. 20, 1989). *See also*, in similar terms, Casado Coca v. Spain, App. No. 15450/89, ¶ 50 (Feb. 24, 1994).

91. Bolger v. Youngs Drug Prods. Corp., 463 U.S. 60, 64-65 (1983) ("[T]he Constitution accords less protection to commercial speech than to other constitutionally safeguarded forms of expression"). *See*, in similar terms, Cent. Hudson Gas & Elec. Corp. v. Public Serv. Comm'n of N.Y., 447 U.S. 557, 562-63 (1980). *See also* Sorrell v. IMS Health Inc., 564 U.S. 552, 579 (2011) ("the government's legitimate interest in protecting consumers from 'commercial harms' explains 'why commercial speech can be subject to greater governmental regulation than noncommercial speech.'"), quoting Cincinnati v. Discovery Network, 507 U.S. 410, 426 (1993).

92. Zauderer v. Off. of Disciplinary Couns. of Sup. Ct. of Ohio*,* 471 U.S. 626, 651 (1985).

93. *Id.* at 651. In *Zauderer*, the government's interest in mandating the disclosure of the information sought to protect consumers from misleading information conveyed by the manufacturer. This justification has since been broadened to include other interests. *See* Am. Meat Inst. v. U.S. Dept. of Agric., 760 F.3d 18, 22-23 (D.C. Cir. 2014).

94. RJ Reynolds Tobacco Co. v. FDA, 696 F.3d 1205, 1217 (D.C. Cir. 2012) (quoting Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y., 447 U.S. 557, 566 (1980)).

95. *Cent. Hudson Gas*, 447 U.S. at 566; *RJ Reynolds Tobacco*, 696 F.3d at 1213; Lorillard Tobacco Co. v. Reilly, 533 U.S. 525, 554-55 (2001); Matal v. Tam, 137 S. Ct. 1744, 1763-64 (2017). It should be noted that courts have applied heightened scrutiny in cases involving encroachments on commercial speech where the challenged measure engages in "viewpoint discrimination", an "egregious form of content [based] discrimination … which is presumed impermissible". Rosenberger v. Rector & Visitors of Univ. of Va., 515 U.S. 819, 829-30 (1995). For instance, in Sorrell v. IMS Health Inc., the Supreme Court held that "[c]ommercial speech is no exception" to the rule according to which "[t]he First Amendment requires heightened scrutiny whenever the government creates 'a regulation of speech because of disagreement with the message it conveys.'" 564 U.S. 552, 566 (2011) (quoting Ward v. Rock Against Racism, 491 U.S. 781, 791 (1989)). These cases are also discussed by Justice Kennedy in his concurring opinion in Matal, 137 S. Ct. 1744, 1767. In his view, given that the disparagement clause of the Lanham Act engages in viewpoint discrimination, its constitutionality

scrutiny, which requires the government to prove that its actions are "narrowly tailored to achieve a compelling government interest"—applies to restrictions on noncommercial speech.[96]

In light of the above, determination of the type of speech involved in trademark is crucial when assessing restrictions on expressive use of marks and whether such restrictions comport with freedom of expression. In Europe, speech limited to proposing business transactions or promoting goods and services is often deemed commercial expression.[97] As a result, most conventional uses of marks by right holders will fall within commercial expression.[98] These are uses where the mark is signaling the origin, quality, or other characteristics of goods or services, whether for purposes of informing or attracting consumers. This was precisely the finding of the ECtHR in *Dor v. Romania*, a case involving the compatibility of freedom of expression with the refusal to register the sign "CRUCIFIX" on misleading grounds.[99] The European Union Intellectual Property Office (EUIPO) has also characterized the category of speech interfered with in refusals of registration as commercial.[100] The Court of Justice of the European Union (CJEU) and its Advocates General (AG) have done the same in cases where the interference with owners' speech results from health-furthering, trademark-restrictive measures.[101] This is in contrast with recoding cases, where courts from different European jurisdictions have characterized recoders' speech parodying a reputed mark as artistic and, thus, deserving of reinforced protection under freedom of expression.[102] Unfortunately, decision makers do not seem to be aware of these differences in reasoning and, consequently, have not attempted to justify them. This could prove problematic for the overall consistency in the field. In particular, the finding that marks can convey artistic meaning in recoding cases might be difficult to reconcile with the finding that applied-for marks

ought to be assessed under strict scrutiny even if trademarks are deemed commercial speech in all instances. *Id.*

96. *RJ Reynolds Tobacco*, 696 F.3d at 1213.

97. Casado Coca v. Spain, App. No. 15450/89 (Feb. 24, 1994); Markt Intern Verlag GmbH and Klaus Beermann v. Germany, App. No. 10572/83 (Nov. 20, 1989).

98. Fhima, *supra* note 13, at 295 ("Cases where trademarks and free speech clash will generally involve commercial speech and may not involve any political or artistic element").

99. Dor v. Romania, App. No. 55153/12 (Aug. 25, 2015).

100. R 2804/2014-5, Application of Square Enix Ltd. (Feb. 6, 2015); R 495/2005-G, Application of Jebaraj Kenneth (July 6, 2006).

101. Case C-547/14, Philip Morris Brands S.A.R.L. v. Secretary of State for Health, ECLI:EU:C:2016:325, ¶ 155 (May 4, 2016); Opinion of Advocate General Kokott in Case C-547/14, Philip Morris Brands S.A.R.L. v. Secretary of State for Health, ECLI:EU:C:2015:853, ¶ 233 (Dec. 23, 2015); Opinion of Advocate General Fennelly in Case C-376/98, Germany v. European Parliament, ECLI:EU:C:2000:324, ¶ 153 (June 15, 2000).

102. Rb.'s-Gravenhage 4 mai, 2011 NJF 2011, 264 (Nadia Plesner/Louis Vuitton) (Neth.), para. 4.8; Bundesgerichtshof [BGH] [Federal Court of Justice] Apr. 7, 2005, Neue Juristische Wochenschrift [NJW] 2856 (2005) (Ger.) (for an English translation of the decision, *see* Violet Postcard 38 INT'L REV. OF INTELL. PROP. & COMPETITION L. 119, 121–22 (2007)).

amount to commercial speech since the potential uses of a registered mark by its owner could include artistic—and even political—ones.[103]

In the United States, the debate as to whether trademark use deserves protection under the First Amendment as commercial or noncommercial expression has been undecided since *Matal v. Tam*.[104] In that landmark decision, the Supreme Court invalidated a provision of the Lanham Act which provided the basis for refusal of registration of disparaging signs on First Amendment grounds.[105] The Court was also asked to rule on whether marks ought to be characterized as commercial speech in all instances, or whether some marks have an expressive component conveying meaning beyond source identification—in which case they would deserve reinforced protection under the First Amendment.[106] This was relevant to the case since the applied-for sign "THE SLANTS" "not only identifies the band but expresses a view about social issues."[107] Avoiding the issue, however, the Court saw no need to answer this question since the disparagement exclusion could not even withstand the intermediate level of scrutiny that applies to commercial speech.[108] It is regrettable that the Court remained silent on this issue, opening the door to speculation and uncertainty. In contexts other than registration, US courts have found that government-imposed restrictions on use of marks by their owners fall within commercial expression,[109] while many unauthorized uses of recoded marks by parodists/commentators have been deemed to be noncommercial.[110] Like their European counterparts, United States courts have not provided justification for these differences, further threatening the consistency of the field.

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103. The potential for owners' trademark usage to convey messages beyond commercial source was explored in detail in *supra* note 21.

104. Matal v. Tam, 137 S. Ct. 1744 (2017). For a thought-provoking discussion of the legal repercussions that can ensue from the characterization of trademark use as commercial or political speech under First Amendment doctrine, *see* Tushnet, *Truth and Advertising: the Lanham Act and Commercial Speech Doctrine, supra* note 10.

105. Matal, 137 S. Ct. at 1765.

106. *Id.* at 1763–64.

107. *Id.* at 1764.

108. *Id.*

109. Cigar Assoc. of Am. v. FDA, 315 F. Supp. 3d 143, 164 (D.D.C. 2018); RJ Reynolds Tobacco Co. v. FDA, 696 F.3d 1205, 1212 (D.C. Cir. 2012) (note that the Court leaves the door open to tobacco manufacturers' speech not being commercial); Lorillard Tobacco Co. v. Reilly, 533 U.S. 525, 553–54 (2001).

110. Smith v. Wal-Mart Stores, Inc., 537 F. Supp. 2d 1302 (N.D. Ga. 2008); Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792 (9th Cir. 2003); Mattel, Inc. v. MCA Recs., Inc., 296 F.3d 894 (9th Cir. 2002); Dr. Seuss Enters. L.P. v. Penguin Books USA, Inc., 109 F.3d 1394 (9th Cir. 1997). The anti-dilution provisions of the Lanham Act contain a list of exclusions insulating defendants from liability, including for noncommercial uses of marks. 15 U.S.C. § 1125. This explains why US courts have sometimes engaged in analysis of the nature of defendants' speech in recoding cases.

B. The Interaction Between Trademarks and Freedom of Expression in the Literature

The most striking finding when one conducts research on the interaction between trademarks and freedom of expression is the lack of comprehensive studies covering all instances where marks interact with speech. An overview of this literature reveals a tendency to focus on the expressive interests of one subset of trademark users at a time, often third party recoders who face infringement actions before the courts.[111] But the focus is not limited to third party recoders. Commentators have also explored the extent to which the expressive interests of trademark applicants are deserving of protection in refusals of registration.[112] Comparatively little attention has been devoted to cases where speech rights have been invoked by right holders to challenge the validity of health-furthering, trademark-restrictive measures.[113] Admittedly, the aim of these authors is not to engage in a taxonomical analysis of the diverse scenarios where trademarks interact with speech with a view to mapping the multi-faceted nature of this interaction.[114] However, their narrow focus on one subset of interaction cases at a time has led to an impoverished understanding of the interaction between marks and speech.

Efforts at categorizing the diversity of judicial approaches to the interaction between marks and speech in the literature are, thus, not only scarce, but also limited in both their taxonomical relevance and territorial scope. Take, for instance, Fhima's thorough overview of European case law on the topic. It is difficult to see the criteria that guide Fhima's taxonomy, which sometimes arranges cases on the basis of trademark doctrines (e.g. grounds for invalidity, infringement, or defenses), on specific use contexts (e.g. internet), or even on procedural categories (e.g. interim relief cases).[115] While practical in the sense that it enables her to exhaustively review all relevant cases on the matter, Fhima's taxonomy proves of limited value when identifying general patterns that would allow for a better understanding of prevalent approaches to the interaction between marks and speech. Similar assessments can be made of other authors' approaches to the topic. Although ambitious in taxonomical scope, Sakulin's doctoral thesis on the topic fails to engage with cases where speech has been relied upon by applicants/right holders to challenge the validity of measures of public law restricting trademark registration/use.[116] This is surprising in light of his thorough analysis of all grounds of refusal of registration through the lens of their impact on the fundamental right to freedom of expression, including of signs that

111. *See* literature cited *supra* note 10.

112. *See* literature cited *supra* note 13.

113. *See* literature cited *supra* note 17.

114. *See* discussion in *supra* note 18.

115. Fhima, *supra* note 13.

116. Sakulin, *supra* note 42.

are contrary to public policy or morality. Sakulin's concern lies systematically with the protection of the speech interests of third parties wishing to make unauthorized use of trademarks for expressive purposes, including recoders.[117] In the sole instance where he engages with the argument that freedom of expression not only serves to limit trademark rights, but may also validate them, he dismisses it as far-fetched in a brief and unpersuasive argument.[118]

Furthermore, Sakulin's monograph is limited in jurisdictional reach, mainly covering European case law.[119] Regrettably, this is very often the case in trademark literature. There appears to be an Atlantic divide, with most authors focusing on either European or US case law on the topic.[120] Some, such as Christophe Geiger, focus even further by singling out one European jurisdiction (in his case, France).[121] To continue with Europe, Senftleben's analysis of the doctrinal tools that already incorporate speech concerns within the trademark system ultimately seeks to carve out space for unauthorized expressive uses of marks by non-owners, notably recoders and competitors.[122] His focus is on recoding cases. Rahmatian concedes that marks interact with speech in both infringement and registration litigation.[123] However, he fails to extract any relevant conclusions from this finding after dismissing the relevance of speech-based challenges to refusals of registration in rather cursory terms.[124]

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117. *Id.* at 21 ("this book will not examine the question of whether the rules of trademark law may limit the freedom of expression of a prospective trademark rights holder himself. Instead, the focus of this research is on exploring the conflict between trademark holders' rights and the free expression rights of third parties who may want to use the former's trademarks.").

118. *Id.* at 21–22 ("In my opinion, there is a severe dogmatic problem when assuming that the grant, refusal or, limitation of trademark rights may impair the freedom of expression of the relevant trademark right holder. First, a (potential) trademark right holder always remains free to use a sign in trade, as he does not need a trademark right in order to use the sign. Second, and most importantly, however, trademark rights grant a right holder the exclusive right to prevent third parties from using a sign, which is the antithesis of freedom of expression, which grants a right to non-exclusive use of a sign in order to e.g., inform consumers. Not being granted such a right to prevent can never affect the freedom of expression of a right holder. Therefore, I will not deal with this alleged freedom of expression of trademark right holders."); *id.* at 67 ("In my opinion, it is conceptually wrong to deduce a trademark right from freedom of expression. Freedom of expression provides the right holder with a freedom and such a freedom can never be extended to a right to prohibit third parties (!) to speak").

119. *Id.* at 22–23.

120. Exceptions to this rule include: Snedden, *supra* note 13; Bonadio, *supra* note 13; Ramsey and Schovsbo, *supra* note 22; Teresa Scassa, *supra* note 13; Dreyfuss, *Reconciling Trademark Rights and Expressive Values: How to Stop Worrying and Learn to Love Ambiguity, supra* note 10; Weckström, *supra* note 10.

121. Geiger, *supra* note 10.

122. Martin Senftleben, *Free Signs and Free Use – How to Offer Room for Freedom of Expression within the Trademark System, in* RESEARCH HANDBOOK ON HUMAN RIGHTS AND INTELLECTUAL PROPERTY 354 (Christophe Geiger ed., 2015).

123. Rahmatian, *supra* note 10.

124. *Id.* at 348 ("in the context of trade mark law, th[e] problem area [of speech-based challenges to registration] seems to have little practical relevance and is rather confined to some bizarre fringe cases.")

In the United States, Farley and DeVaney engage in a joint analysis of recoding and ownership (only analyzing challenges to health-furthering, trademark-restrictive measures) cases to illustrate the courts' inconsistent application of First Amendment protection in each instance.[125] Although they identify some of the principles that govern each set of cases, their aim in doing so is not to propose a taxonomy of interaction cases, but rather to denounce the comparatively reduced protection afforded to recoders' speech rights in infringement litigation when compared to those of right holders in ownership cases.[126] Tushnet also explores recoding cases alongside owners' challenges to the validity of health-furthering, trademark-restrictive measures.[127] However, the aim of her piece is not to address instances where marks interact with speech, but rather to show, through exploration of different scenarios (some of which operate outside the boundaries of trademark law, such as defamation), how First Amendment doctrine has been applied inconsistently in cases lying at the intersection between facts and emotions.[128] Gold seeks to extract lessons from the Supreme Court's findings in *Matal v. Tam* and *Iancu v. Brunetti* with a view to assessing the constitutionality of the Lanham Act's anti-dilution provisions under the First Amendment.[129] Far from proposing a taxonomy of interaction cases, her aim is to mobilize the precedents set in registration cases to shield recoders' expressive uses of marks from the threat of dilution actions.[130] Leval explores different trademark doctrines that already incorporate speech concerns (e.g. descriptiveness) to argue that the interaction between marks and speech goes beyond invocation of First Amendment protection as a constitutional safeguard to infringement actions.[131] Unfortunately, the lessons that he extracts from this exercise are rather limited since he does not go on to study other scenarios where marks interact with speech in the search for the broad principles that govern this interaction.[132] Instead, and to avoid excessive reliance on constitutional

125. Farley and DeVaney, *supra* note 10.

126. *Id.* at 292 ("Tobacco firms argue strenuously for robust First Amendment rights when challenging government regulations, and then seek to suppress others' assertion of speech rights by using their assertion of trademark rights as a sword. When these disputes are examined side-by-side, we see that strong speech rights emerge from clear doctrine in the tobacco regulation cases, but that speech rights are vulnerable in the disorderly doctrine that has emerged in the trademark speech cases.").

127. Tushnet, *More than a Feeling: Emotion and the First Amendment*, *supra* note 10.

128. *Id.* at 2396-415.

129. Gold, *supra* note 10.

130. *Id.* at 489 ("This Note argues firstly that because the free-speech harms of dilution laws outweigh the purported benefits, dilution laws fundamentally violate the First Amendment. Secondly, in the aftermath of Tam and Brunetti, courts are more willing to critically evaluate trademark law's constitutionality and are thus likely to recognize that dilution law does not comport with free-speech principles.").

131. Leval, *supra* note 52.

132. *Id.* at 188 ("The question I explore is whether … the trademark laws rather represent an integrally complete, multifaceted body of rules, designed to balance a trademark owner's interest in exclusive use of the mark in commerce against society's interest in free expression.").

adjudication in infringement cases, he urges courts to mobilize the in-built speech levers provided by trademark doctrines to balance owners' interests against those of recoders.[133]

Against this backdrop, conventional wisdom posits that the relationship between marks and speech is unidirectional and that trademark rights chill expression. For instance, McGeveran begins his study of the interaction between marks and speech arguing that "Trademarks constrain the use of language."[134] In more poetic terms, Dreyfuss begins one of her pieces by discussing the topic and asserting that "Trademarks and free expression are on a collision course."[135] According to Ramsey and Schovbo, "The European Union, United States, and other nations have expanded trademark rights in various ways that may threaten other public interests, such as . . . freedom of expression."[136] The list goes on.[137]

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133. *Id.* at 189 ("The trademark law itself is fashioned to protect free-speech interests that may justify uses of a trademark by persons other than its owner. … Where the trademark law, by its own terms, protects the unauthorized use of another's trademark, there is no need to turn to the Constitution to justify a judgment in the alleged infringer's favor."). *Id.* at 209 ("Avoiding unnecessary constitutional adjudication is not merely a matter of form or etiquette. It has serious practical consequences: … (d) excessive reliance on the Constitution, in place of recognizing the free speech-protecting policies of the trademark law, will sometimes produce undesirable rulings.").

134. McGeveran, *Four Free Speech Goals for Trademark Law, supra* note 10, at 1205.

135. Dreyfuss, *supra* note 10, at 262. In another piece, Dreyfuss warns that "if courts continue to permit trademark owners to extend their control, a framework for identifying and protecting core expressive interests will need to be developed." Dreyfuss, *supra* note 2, at 399.

136. Ramsey and Schovsbo, *supra* note 22, at 672.

137. Lemley contends that "The expansive power that is increasingly being granted to trademark owners has frequently come at the expense of freedom of expression." Lemley, *supra* note 10, at 1710. McGeveran has advanced that "The ever-expanding scope and strength of trademark rights has caused justifiable fears of a threat to free expression". William McGeveran, *Rethinking Trademark Fair Use*, *supra* note 10, at 49; According to Denicola, "The struggle to extend the scope of trademark protection . . . has . . . raised for the first time the possibility of genuine conflict between trademark law and the first amendment." Denicola, *supra* note 10, at 160. In Jacques' view, "as EU trade mark law moves towards stronger protection for trade mark owners . . ., a more robust EU framework is necessary to best preserve freedom of expression." Jacques, *supra* note 10, at 481. Farley and DeVaney argue that "structuring a framework to protect the freedom of expression of trademark appropriators could temper trademark law's chilling effect on speech." Farley & DeVaney, *supra* note 10, at 327. Partridge conceptualizes of interaction cases involving parodic uses of recoded marks as the weighing of the "competing interests of artistic expression on the one hand and trademark protection on the other." Partridge, *supra* note 10, at 890. In similar terms, Sadurski conceives of recoding cases as entailing "the balancing of competing values: those which are behind trademark protection and those which support freedom of speech." Sadurski, *supra* note 10, at 457. In Baxter's view, "Because the Lanham Act fails to adequately address First Amendment protection for commercial parodies and courts have interpreted the Act inconsistently, Congress needs to balance these two competing concepts." Baxter, *supra* note 10, at 1210. Dorsen believes that "In creating a trademark claim for satiric appropriation by recognizing claims for harm to reputation in the defamation sense of "reputation," the courts' decisions compromise the first amendment." Dorsen, *supra* note 10, at 949. According to Sakulin, "protection [against dilution] may conflict … with the freedom of third parties who want to use trademarks as social, cultural or political communicators, e.g. in art, criticism, parody, or satire. It is here that the core conflict with freedom of expression … comes into play." Sakulin, *supra* note 42, at 12. In Cantwell's view, "anti-dilution provision[s] … directly conflict with the free speech guarantees incorporated in the First Amendment." Michael K. Cantwell, *Confusion, Dilution, and Speech: First*

A possible explanation for the misconception that the interaction between marks and speech is unidirectional may be historical. The vast majority of interaction cases to date have dealt with infringement actions launched by right holders seeking to enjoin unauthorized third party use of their marks for expressive purposes.[138] The scope of protection afforded to right holders has continued to expand through the adoption of anti-dilution provisions in trademark statutes worldwide.[139] In the face of increasing pressure from owners to protect their marks against blurring, tarnishment, and, in Europe, free riding, courts began to have recourse to freedom of expression as a reactive tool to accommodate the expressive needs of recoders.[140] Speech-infused rationales soon sparked a wave of optimism amongst scholars wishing to curb the ever-expansive claims of overzealous right holders.[141] In their search for a middle ground that would incentivize owners' investment in the brand dimension of trademarks while ensuring other users' access to their expressive component, most commentators have relied on speech to suggest different ways of striking the right balance.[142]

Amendment Limitations on the Trademark Estate, 87 TRADEMARK REP. 48, 52 (1997). Katyal explores "the growing set of case law regarding the conflicts between the transnational brand, activist movements, and freedom of speech." Katyal, *supra* note 77, at 934.

138. *See* case law cited *supra* note 88. The reader will notice that most recoding cases to date have originated in the United States. This likely explains why American authors have shown a comparatively higher interest on the topic than their European counterparts.

139. Anti-dilution provisions are contained in: 15 U.S.C. § 1125(c); EUTMR, Art 9(2)(c); TMD, Art 10(2)(c).

140. Geiger, *supra* note 10, at 317 ("courts are increasingly relying on freedom of expression as a ground for permitting the use of trade marks for purposes of parody or criticism."); Leval *supra* note 52, at 187–88 ("In the last quarter century, we have witnessed a new aggressiveness on the part of advertisers, social commentators and wisecrackers in the use of other people's trademarks. … In dealing with such [recoding] cases, courts often treat them as instances of conflict between trademark rights and the First Amendment."). For an illustrative list of cases where courts have mobilized free speech to balance defendants' expressive interests against plaintiffs' trademarks rights, *see* excerpts cited *supra* note 66.

141. Although ultimately critical of mobilizing free speech principles to constrain trademark rights (especially outside of the United States), Burrell and Gangjee's piece on the topic lends support to this proposition when they state that "United States academics have led the way in arguing that we should look to freedom of expression principles to curb the expansion of trade mark law. Increasingly, however, commentators in other jurisdictions are taking this suggestion seriously." Gangjee & Burrell, *supra* note 3, at 544 (2010). *See also* literature cited *supra* note 10. *See*, in similar terms: Dogan & Lemley, *The Trademark Use Requirement in Dilution Cases*, *supra* note 10, at 544 (2007) ("Numerous scholars … have pointed out the ways in which broad dilution protection can choke off speech"); Griffiths, *supra* note 13, at 426 ("Commentators have observed that the enhancement of trade mark rights, particularly as weapons against "dilution", has increased the potential for conflict with the interests of parodists, protestors and other cultural commentators."); Fhima, *supra* note 13, at 294(2013) ("The potential conflict between free speech and trade mark law has long been acknowledged in the United States. There is also a growing awareness of the issue amongst academic circles in Europe."). *See also* Geiger, *supra* note 10, at 324 (2007) ("it seems to us that the invocation of freedom of expression in order to justify [unauthorized] uses [of recoded marks] is not without benefit.").

142. McGeveran, *Rethinking Trademark Fair Use*, *supra* note 10, at 49 ("In response [to fears that the expansion of trademark rights can threaten speech], concerned scholars generally focus on perfecting the substance of legal rules that balance free speech against other goals."). Relevant

Conversely, conceptualizing the role of freedom of expression in trademark litigation as a defense, by default, has held the narrative captive. This Article seeks to dispel this misconception by showing that the interaction between marks and speech operates as a two-way street, where freedom of expression can simultaneously limit and validate trademark rights. To this end, the following section will look at the role that speech plays in validating trademark rights in both Europe and the United States. Evidence to this effect can be found in the growing body of case law.[143] Applicants and right holders are invoking freedom of expression to challenge the validity of measures encroaching on trademark registration or use, respectively. Before exploring these cases, however, the comprehensive aspiration of this piece mandates that we begin by reviewing the courts' approach to the interaction between marks and speech in recoding litigation. In the interest of brevity, this analysis will place emphasis on the courts' unidirectional conceptualization of this interaction. On all other aspects of the interaction, I defer to other authors' exhaustive coverage of the case law.[144]

C. The Interaction Between Trademarks and Freedom of Expression as a Multi-Faceted Legal Problem: Rethinking the Role of Speech in Trademark Law

1. The Interaction Between Trademarks and Speech in Recoding Litigation

a. Europe

Courts from different European jurisdictions have reached inconsistent outcomes in recoding litigation. As I will go on to explore, this is often the result of different courts adopting divergent thresholds for determining what amounts to a protected expressive use of a mark under Article 10 ECHR.

The stricter thresholds imposed in the UK and France have led courts to side with plaintiffs after a finding that defendants' recoded uses were not expressive.[145] Judging from French case law, recoders will only be able to rely on

examples of authors' attempts at striking the right balance in recoding cases can be found in the excerpts cited *supra* note 18 in relation to scholarship addressing recoding litigation.

143. *See* case law cited *supra* notes 12 (for speech-based challenges to refusals of registration) and 16 (for cases addressing the compatibility of health-furthering, trademark-restrictive measures with freedom of expression). *See also* Bonadio, *supra* note 13, at 56 ("U.K. and EU judges and examiners, in particular, increasingly refer to Article 10 ECHR when it comes to refusing registration of signs which are considered contrary to public policy and morality."); Griffiths, *supra* note 13, at 427 ("It has increasingly been accepted that any refusal to register a mark on public policy/morality grounds constitutes an interference with the applicant's right to freedom of expression and, therefore, calls for justification under Article 10(2) of the ECHR.").

144. *See* literature cited *supra* note 10.

145. Ate My Heart, Inc. v. Mind Candy Ltd. [2011] EWHC 2741; Miss World Ltd. v. Channel 4 Television Corp. [2007] EWHC 982; Cour d'Appel [CA] [regional court of appeal] Paris, 5 ch., Dec.

a speech defense when their unauthorized use of plaintiffs' marks is purely noncommercial, i.e., where it does not identify the origin of goods or services offered for profit in the course of trade.[146] There is room to argue that the High Court of England and Wales does not require such a high bar for determination that a recoded use is deserving of protection under freedom of expression. Although we lack precedent to this effect, the court has seemed open to shielding fundamentally noncommercial recoded uses from infringement, i.e., where the defendant, despite using the recoded mark on goods or services offered for sale, primarily seeks to convey his parodic/critical message.[147]

In contrast, the courts of Germany and the Netherlands have applied a more generous threshold which has often shielded defendants from infringement after a finding that their uses were expressive.[148]

11, 2015, 14/32109 (Fr.); Cour d'Appel [CA] [regional court of appeal] Rennes, 2 ch., Apr. 27, 2010, 09/00413 (Fr.).

146. In cases where recoders' unauthorized use of plaintiffs' marks is commercial, French courts have denied relief to defendants on the basis that, unlike copyright law, trademark statutes do not provide a speech-based defense to infringement. Cour d'Appel [CA] [regional court of appeal] Paris, 5 ch., Dec. 11, 2015, 14/32109 (Fr.); Cour d'Appel [CA] [regional court of appeal] Rennes, 2 ch., Apr. 27, 2010, 09/00413 (Fr.). This is in contrast with cases where recoders' use of marks "do not manifestly seek to promote the marketing of products or services . . . for the profit of [defendant], but rather fall within purely controversial use which is alien to business life and competition between commercial enterprises." Cour d'Appel [CA] [regional court of appeal] Paris, 4 ch., Nov. 16, 2005, 04/12417 (Fr.) (for an English translation of the decision, *see* Esso Plc v. Greenpeace France [2006] ETMR 53, 670). *See also*, in similar terms, Cour d'Appel [CA] [regional court of appeal] Paris, 14 ch., Feb. 26, 2003, 02/16307 (Fr.) (for an English translation of the decision, *see* Association Greenpeace France v. SA Société ESSO [2003] ETMR 66, 845). For a finding that defendant's noncommercial use of a recoded mark can constitute an abuse of the right to freedom of expression that gives rise to infringement, *see* Cour de cassation [Cass.] [supreme court for judicial matters] 1e civ., Apr. 8, 2008, Bull. civ. I, No. 104 (Fr.).

147. *Ate My Heart, Inc.*, [2011] EWHC 2741, [45]-[47]; *Miss World Ltd.*, [2007] EWHC 982, [31]-[42]. In both cases, the High Court acknowledges, in dicta, the likelihood that recoded use of reputed marks could trigger the protection afforded under freedom of expression in fact patterns approximating those of the renowned South African case of *Laugh It Off Promotions CC v. South African Breweries (Finance) BV t/a Sabmark Int'l* 2006 (1) SA 144 (CC) (i.e., involving the sale of T-shirts bearing a clearly parodic recoded version of the 'Carling' mark for beer).

148. Oberlandesgericht Hamburg [OLG] [Hamburg Higher Regional Court] Jan. 5, 2006, Gewerblicher Rechtsschutz und Urheberrecht, Rechtsprechungs-Report [GRUR-RR] 231 (2006) (Ger.); Bundesgerichtshof [BGH] [Federal Court of Justice] Apr. 7, 2005, Neue Juristische Wochenschrift [NJW] 2856 (2005) (Ger.); Rb.'s-Gravenhage4 mai, 2011 NJF 2011, 264 (Nadia Plesner/Louis Vuitton) (Neth.) (although this case involved infringement of a registered design, the court's balancing of plaintiff's right to [intellectual] property against recorder's freedom of expression is illustrative for trademark purposes too); Gof's-Amsterdam 13 september 2011, IES 2012, 15 m.nt. Herman MH Speyart (Mercis BV/Punt.nl BV) (Neth.). We find precedents to the contrary in these jurisdictions. *See*, in Germany, discussing both the AOL Logo and Violet Postcard cases, Oberlandesgericht Hamburg [OLG] [Hamburg Higher Regional Court] Aug. 9, 2010, Gewerblicher Rechtsschutz und Urheberrecht, Rechtsprechungs-Report [GRUR-RR] 382 (2010) (Ger.). The Dutch courts also refused to insulate defendant's allegedly recoded use of a reputed mark on speech grounds Rb.'s-Amsterdam 3 april, 2003, KG 2003, 108 (Joanne Kathleen Rowling/Uitgeverij Byblos BV) (Neth.). In this case, however, as the court rightly points out, it is difficult to *see* the parodic intent underlying defendant's unauthorized use of plaintiff's mark.

b. United States

It is no easy endeavor to systematize the different rationales employed by US courts in recoding cases. There are three reasons for this. First, the volume of decisions dealing with the interaction between marks and speech in recoding cases has resulted in courts adopting a wide range of approaches to resolving this form of interaction.[149] Second, as the amendment of the Lanham Act in 2006 to broaden the "fair use" defense in dilution cases led to a shift in judicial approaches to recoding cases involving blurring and tarnishment causes of actions.[150] And third, the approaches adopted by US courts to resolving recoding cases vary significantly depending on whether plaintiff's infringement claim is grounded on likelihood of confusion or on dilution grounds. This has resulted in a rather complex framework, whereby the tension between owners' exclusive rights and recoders' speech interests is resolved differently depending on a variety of factors. At the risk of oversimplifying, I propose classifying court decisions in recoding cases in accordance with two factors: (a) whether defendant's recoded use of plaintiff's mark is or is not deserving of protection under the First Amendment and (b) whether plaintiff's infringement claim is grounded on "likelihood of confusion" or on dilution.

In "likelihood of confusion" cases, US courts have often held that recoders' unauthorized use of plaintiffs' marks for expressive purposes is entitled to such limited protection under the First Amendment that the Lanham Act will prevail upon a finding of confusion.[151] This is most common where recoders' use is for

149. *See* case law cited *supra* note 8. Dogan & Lemley also note that "courts have struggled with the evaluation of parody under trademark law. While many trademark courts have protected parodies, there are a surprising number of cases that hold obvious parodies illegal." Dogan & Lemley, *Parody as Brand*, *supra* note 10, at 94. Taking their criticism of the diversity of approaches adopted by US courts further, these authors contend that "[D]espite increasing attention to speech interests in recent years, the law's treatment of parody reflects too much uncertainty … In particular, given the flexibility of likelihood of confusion analysis, parodists' fate is usually determined by the subjective judgment of courts, whose treatment of parody often seems to turn on instinct rather than trademark principles." *Id.* at 94.

150. Anti-dilution provisions were first introduced in the United States by virtue of the Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, § 3, 109 Stat. 985 (1995). The Act already sought to reconcile the expressive interests of defendants with right holders' expanded causes of action by recognizing, *inter alia*, a "fair use" (in comparative advertising) and "noncommercial use" defenses. *Id.* In 2006, Congress passed legislation to amend the dilution provisions. Among other changes, the Trademark Dilution Revision Act (TDMR) broadened the fair use exclusion from comparative advertising to parody, criticism and commentary, provided that defendant's use is not "as a mark" (i.e., to identify goods or services). Pub. L. No. 109-312, § 2, 120 Stat. 1730, 1731 (2006). For a detailed exploration of the changes brought about by the Revision Act, *see* Dogan & Lemley, *The Trademark Use Requirement in Dilution Cases, supra* note 10.

151. Hard Rock Cafe Licensing Corp. v. Pac. Graphics, Inc., 776 F. Supp. 1454, 1462 (W.D. Wash. 1991); Schieffelin & Co. v. Jack Co. of Boca, Inc., 725 F. Supp. 1314, 1323–24 (S.D.N.Y. 1989); Mut. of Omaha Ins. Co. v. Novak, 836 F.2d 397, 402–03 (8th Cir. 1987); Tommy Hilfiger Licensing v. Nature Labs, L.L.C., 221 F. Supp. 2d 410, 415 (S.D.N.Y. 2002); Planned Parenthood

origin-signaling purposes;[152] the rationale is that speech rights are not intended to insulate defendants from infringement in instances of commercial fraud, i.e., where consumers are deceived as to the commercial origin of the goods or services bearing the recoded mark.[153] Given courts' reluctance to grant broad speech protection to recoders in "likelihood of confusion" cases, there are numerous instances where courts have refused to shield defendants' unauthorized use from infringement on First Amendment grounds.[154] We can find, however, many cases where US courts considered the expressive interests of recoders upon assessment of "likelihood of confusion."[155] This usually results in plaintiffs' infringement actions being dismissed.[156]

In dilution cases, the "fair use" provision of the Lanham Act mandates that courts conduct their infringement analysis irrespective of First Amendment protection whenever the defendant's recoded use is "as a trademark" (i.e., to identify the source of goods or services).[157] This analysis has sometimes led courts

Fed'n of Am., Inc. v. Bucci, 42 U.S.P.Q. 2d (BNA) 1430, 1440–41 (S.D.N.Y. 1997); Yankee Publ'g, Inc. v. News Am. Publ'g, Inc., 809 F. Supp. 267, 275–76 (S.D.N.Y. 1992); Parks v. LaFace Recs., 329 F.3d 437, 447 (6th Cir. 2003); Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394, 1405–06 (9th Cir. 1997).

152. *Planned Parenthood*, 42 U.S.P.Q. 2d (BNA) at 1440–41; *Yankee Publ'g*, 809 F. Supp. 276.

153. World Wrestling Fed'n Ent., Inc. v. Big Dog Holdings, Inc., 280 F. Supp. 2d 413, 430 (W.D. Pa. 2003); *Tommy Hilfiger Licensing*, 221 F. Supp. 2d at 415.

154. *Hard Rock Cafe*, 776 F. Supp. 1454; *Mut. of Omaha Ins. Co.*, 836 F.2d 397; Gucci Shops, Inc. v. RH Macy & Co., 446 F. Supp. 838 (S.D.N.Y. 1977); Harley Davidson, Inc. v. Grottanelli, 164 F.3d 806 (2d Cir. 1999); Wendy's Int'l, Inc. v. Big Bite, Inc., 576 F. Supp. 816 (S.D. Ohio 1983); *Parks*, 329 F.3d 437 ; Am. Dairy Queen Corp. v. New Line Productions Inc, 35 F. Supp. 2d 727 (D. Minn. 1998); *Planned Parenthood*, 42 U.S.P.Q. 2d (BNA) 1430; *Dr. Seuss Enters., L.P.*,109 F.3d 1394; Gen. Foods Corp. v. Mellis, 203 U.S.P.Q. 261 (S.D.N.Y. 1979); Dallas Cowboy Cheerleaders, Inc. v. Pussycat Cinema Ltd., 604 F.2d 200 (2d Cir. 1979). We also find precedents in the case law of recoding cases where, despite First Amendment protection not being available, the parodic intent underlying defendant's use was found not to be liable to confuse consumers: Hormel Foods Corp. v. Jim Henson Prods., Inc., 73 F.3d 497 (2d Cir. 1996); *World Wrestling Fed'n Ent. Inc.*, 280 F. Supp. 2d at 430, 439 (the Court's reasoning is not clear, for it begins its analysis of consumer confusion holding that "Parody . . . is not an affirmative defense," and yet concludes with a finding that defendant's "parodies . . . entitle its . . . merchandise to First Amendment protection"); *Tommy Hilfiger Licensing*, 221 F. Supp. 2d 410 ; Anheuser-Busch Inc. v. L. & L. Wings, Inc., 962 F.2d 316 (4th Cir. 1992) (procedural constraints prevented the Court from ruling on whether defendant was entitled to First Amendment protection); Universal City Studios, Inc. v. Nintendo Co., Ltd., 746 F.2d 112 (2d Cir. 1984); Jordache Enters. Inc. v. Hogg Wyld Ltd, 828 F.2d 1482 (10th Cir. 1987) (in the last two cases, the courts did not rule on whether defendant was entitled to First Amendment protection as a result of its parodic intent but took it into consideration when assessing likelihood of confusion).

155. Anheuser-Busch, Inc. v. Balducci Publ'ns, 28 F.3d 769 (8th Cir. 1994); Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989); Univ. of Ala. Bd. of Trs. v. New Life Art, Inc., 683 F.3d 1266 (11th Cir. 2012); Mattel, Inc. v. MCA Recs. Inc., 296 F.3d 894 (9th Cir. 2002); Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc., 886 F.2d 490 (2d Cir. 1989).

156. E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095 (9th Cir. 2008); *Univ. of Ala. Bd. of Trs.*, 683 F.3d 1266; *Mattel*, 296 F.3d 894; *Yankee Publ'g*, 809 F. Supp. 267; *Rogers*, 875 F.2d 994; *Cliffs Notes, Inc.*, 886 F.2d 490.

157. 15 U.S.C. § 1125(c)(3)(A). This is discussed in Starbucks Corp. v. Wolfe's Borough Coffee, Inc., 588 F.3d 97, 111–13 (2d Cir. 2009).

to find against the defendant,[158] but not always.[159] By contrast, where defendants' unauthorized use is not "as a trademark", courts will shield such use from infringement in recognition of their First Amendment rights (as mandated under the "fair use" defense).[160]

Regardless of the outcome, these cases all illustrate how courts on both sides of the Atlantic have conceptualized the interaction between marks and speech in unidirectional terms, in the sense that speech protection (when available) is understood to operate as a limit to trademark rights.[161]

2. The Interaction Between Trademarks and Speech in Ownership Cases (I): Refusals of Registration

a. Europe

Trademark offices and appellate courts have split on what role the protection afforded under Article 10 ECHR ought to play in the registration context.[162] The UK Appointed Person, the General Court (GC), and the EUIPO Boards of Appeal have reached contrasting outcomes in similar scenarios involving challenges to refusals of registration on public policy or morality grounds.[163] While the UK Appointed Person has repeatedly acknowledged that freedom of expression is

158. Louis Vuitton Malletier S.A. v. Hyundai Motor Am., 10 Civ. 1611 (PKC) (S.D.N.Y. 2012); Jews For Jesus v. Brodsky, 993 F. Supp. 282 (D. N.J. 1998); Panavision Int'l, L.P. v. Toeppen, 945 F. Supp. 1296 (C.D. Cal. 1996); Deere & Co. v. MTD Products, Inc., 41 F.3d 39 (2d Cir. 1994). Before the adoption of the broader fair use exclusion by virtue of the TDMR in 2006, courts sometimes found against defendants despite their recoded uses not being 'as a mark', *e.g. Dallas Cowboy Cheerleaders, Inc.*, 604 F.2d 200; Coca-Cola Co. v. Gemini Rising, Inc., 346 F. Supp. 1183 (E.D.N.Y. 1972).

159. We find precedents in the case law of courts finding against plaintiff even when recoder's use is 'as a mark' on grounds that the obvious parodic intent underlying defendant's use prevents any dilutive harm: Louis Vuitton Malletier S.A. v. Haute Diggity Dog L.L.C., 507 F.3d 252 (4th Cir. 2007); *Jordache Enters., Inc,* 828 F.2d 1482.

160. 15 U.S.C. § 1125(c)(3)(A) & 3(C). Case law in this regard includes: VIP Prods. L.L.C. v. Jack Daniel's Props., 953 F.3d 1170 (9th Cir. 2020); Ebony Media Operations L.L.C. v. Univision Commc'ns, Inc., No. 18-cv-11434-AKH (S.D.N.Y. Jun. 3, 2019); Louis Vuitton Malletier S.A. v. My Other Bag, Inc., 156 F. Supp. 3d 425 (S.D.N.Y. 2016). Prior to the broadening of the "fair use" defense in 2006 (to cover parody, commentary, and criticism), courts adjudicating dilution actions often took into consideration defendants' First Amendment rights by means of applying the "noncommercial use" exclusion that could already be found in the Federal Trademark Dilution Act as adopted in 1995. Notable decisions in this regard include: Nissan Motor Co. v. Nissan Comput. Corp., 378 F.3d 1002 (9th Cir. 2004); Smith v. Wal-Mart Stores, Inc., 537 F. Supp. 2d 1302 (N.D. Ga. 2008); *Mattel*, 296 F.3d 894; L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26 (1st Cir. 1987).

161. For further evidence of the conceptualization of speech as a defense in recoding cases in both the United States and Europe, *see* excerpts cited *supra* note 6.

162. I have written extensively on this topic elsewhere, with a focus on the uncertainty ensuing from the inconsistent interpretation of these exclusions by European decision makers: Fernandez-Mora, *supra* note 62.

163. These grounds of refusal are regulated in the EUTMR, Art. 7(1)(f); TMD, Art. 4(1)(f).

implicated in refusals of registration,[164] most decisions from the GC have denied this possibility.[165] The EUIPO Board of Appeals are split on the matter, with some following the GC's position,[166] and others factoring in applicants' speech interests in their registration decisions.[167]

To complicate things further, in its decision in *Constantin Film Produktion v. EUIPO*, the GC appeared to reject the possibility of freedom of expression ever being implicated in trademark law broadly considered—and not just in the registration context—when it held that "there is, in the field of art, culture and literature, a constant concern to preserve freedom of expression which does not exist in the field of trade marks."[168] This is problematic. Quite apart from the possible sweeping implications it could have in the field, this finding is at odds with respect to: (a) the recitals to the EUTMR and TMD, which provide that both instruments "should be applied in a way that ensures full respect for fundamental rights and freedoms, and in particular the freedom of expression;"[169] (b) the case law of the ECtHR acknowledging that applicants' speech can be interfered with as a result of refusals of registration;[170] and (c) the European case law addressing the compatibility of health-furthering, trademark-restrictive measures with Article 10 ECHR.[171]

Fortunately, on appeal, the CJEU ended this controversy when it held that "contrary to the General Court's finding . . ., freedom of expression . . . must . . . be taken into account when applying [the public policy and morality exclusions]."[172] By harmonizing one aspect of the interaction between marks and speech that had been highly contested in Europe, the Court's finding that Article

164. Amongst others: Scranage's Trademark Application [2008] ETMR 43; French Connection Ltd.'s Trademark Application [2007] ETMR 8.

165. Case T-69/17, Constantin Film Produktion v. EUIPO, ECLI:EU:T:2018:27 (Jan. 24, 2018); Case T-417/10, Federico Cortés del Valle López v. OHIM, ECLI:EU:T:2012:120 (Mar. 9, 2012); Case T-54/13, Efag Trade Mark Co. v. OHIM, ECLI:EU:T:2013:593 (Nov. 14, 2013). The sole exception to this is Case T-232/10, Couture Tech Ltd v. OHIM, ECLI:EU:T:2011:498 (Sept. 20, 2011), where the GC seemed ready to accept applicant's free speech argument.

166. R-793/2014-2, Application of Ung Cancer (Feb. 23, 2015); R 168/2011-1, Application of Türpitz (Nov. 30, 2010).

167. R 2244/2016-2, Application of Brexit Drinks Ltd. (Jun. 28, 2017); R 519/2015-4, Application of Josef Reich (Sept. 2, 2015); R 2889/2014-4, Application of Verlagsgruppe D. K. GmbH & Iny Klocke (May 28, 2015); R 495/2005-G, Application of Jebaraj Kenneth (July 6, 2006).

168. Case C-240/18, Constantin Film Produktion ('FACK JU GÖHTE') v. EUIPO, ECLI:EU:C:2019:553 ¶ 56 (Feb. 27, 2019), citing Case T-69/17, Constantin Film Produktion v. EUIPO, ECLI:EU:T:2018:27 ¶ 29 (Jan. 24, 2018).

169. EUTMR, Recital 21; TMD, Recital 27.

170. Dor v. Romania, App. No. 55153/12 (Aug. 25, 2015).

171. *See* European case law cited *supra* note 16. These cases will be discussed in further detail in Section II(C)(3)(a) below.

172. Case C-240/18, Constantin Film Produktion ('FACK JU GÖHTE') v. EUIPO, ECLI:EU:C:2019:553 ¶ 56 (Feb. 27, 2019).

10 ECHR is implicated in trademark registration is a welcome development.[173] As I have argued elsewhere, it is regrettable that the CJEU failed to build on this finding and left the more substantial questions raised by the interaction between marks and speech in the registration context unanswered.[174] For current purposes, however, the Court's finding that applicants' Article 10 ECHR rights are triggered by refusals of registration constitutes proof of speech's ability to validate trademark rights in Europe.

b. United States

In *Matal v. Tam*, the lead member of a dance-rock band was denied registration of the sign "THE SLANTS"—a derogatory term for people of Asian descent—on grounds that it contravened the disparagement clause of the Lanham Act.[175] In *Iancu v. Brunetti*, appellant was the owner of a clothing business.[176] His application for registration as a federal trademark of the sign "FUCT"—that can be pronounced as either four letters, i.e., F-U-C-T, or the offensive term "fucked"—was not allowed on the register because of immoral or scandalous grounds.[177] Both decisions were overturned on appeal to the Supreme Court.[178] Importantly, the challenges raised by both applicants were not circumscribed to the validity of the US Patent and Trademark Office's decisions denying registration to their applied-for signs, but went beyond to question the constitutionality of all three grounds for refusal under the First Amendment.[179]

In finding for appellants in both cases, the Supreme Court relied on the doctrine of viewpoint discrimination, according to which the "government may not discriminate against speech based on the ideas or opinions it conveys."[180]

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173. The controversy in the literature as to whether trademark applicants' speech rights are triggered in refusals of registration was discussed in *supra* note 60.

174. Notably, the Court remained silent on: (a) why speech protection is implicated in refusals of registration; and (b) how its finding that speech protection is implicated in refusals of registration builds into the test developed to determine when an applied-for sign is morally objectionable and, thus, unregistrable. For a more detailed discussion of this topic, *see* Fernandez-Mora, *supra* note 62, at 294–98.

175. Matal v. Tam, 137 S. Ct. 1744 (2017). For the decision of the Trademark Trial and Appeal Board denying registration to the applied-for mark in application of the disparagement clause of the Lanham Act, *see In Re* Tam, 108 U.S.P.Q.2d (BNA) 1305 (T.T.A.B. 2013).

176. Iancu v. Brunetti, 139 S. Ct. 2294 (2019).

177. *Id.* For the decision of the Trademark Trial and Appeal Board denying registration to the applied-for mark in application of the scandalous or immoral clause of the Lanham Act, *see In re* Brunetti, 2014 TTAB LEXIS 328 (T.T.A.B. 2014).

178. Matal, 137 S. Ct. 1744; Iancu, 139 S. Ct. 2294.

179. In Matal, the applicant challenged the constitutionality of the disparagement clause of the Lanham Act. Matal, 137 S. Ct. 1744. In *Iancu*, the applicant questioned the compatibility with the First Amendment of the Lanham Act's scandalous or immoral clause. Iancu, 139 S. Ct. 2294.

180. Iancu, 139 S. Ct. 2294. It should be noted that viewpoint discrimination is not the only claim discussed by the Supreme Court in its decisions, especially in *Tam*. However, as explained by Justice Kagan writing for the majority in *Brunetti*, viewpoint discrimination constitutes the central claim in

Applying this doctrine in *Tam*, the court found that "the disparagement clause discriminates on the bases of 'viewpoint,' . . . [i]t denies registration to any mark that is offensive to a substantial percentage of the members of any group. . . . Giving offense is a viewpoint."[181] In *Brunetti*, the Supreme Court explored this rationale further when it held that:

> [T]he [Lanham Act] . . . distinguishes between two opposed sets of ideas: those aligned with conventional moral standards and those hostile to them [i.e., immoral signs]; those inducing societal nods of approval and those provoking offense and condemnation [i.e., scandalous signs]. The statute favors the former, and disfavors the latter.
> The . . . viewpoint bias in the law results in viewpoint-discriminatory application. . . . [T]he PTO has refused to register marks communicating "immoral" or "scandalous" views about (among other things) drug use, religion, and terrorism. But all the while, it has approved registration of marks expressing more accepted views on the same topics.[182]

Because they contravene the constitutional protection afforded to free speech under the First Amendment, the grounds for refusal of registration of disparaging, scandalous, or immoral signs were struck from the Lanham Act.[183]

The repercussions of these decisions are far-reaching. Not only do they open the floodgates for registration as trademarks of signs which convey the most profane and hateful of messages, but they set a high constitutional bar for any

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both cases, as well as the ground on which all eight justices (Justice Gorsuch did not take part in the decision in *Tam*) agreed upon in *Tam*—there was disagreement between the justices as to whether the exclusions amount to a condition on a government benefit, or ought to be regarded simply as an interference with free speech. *Id.* at 2298-99. For the sake of precision, the reader should also be aware that the reasoning put forward in each of the two four-judge opinions in *Tam* is slightly different also as regards viewpoint discrimination, even if they end up reaching the same conclusion. This is also acknowledged by Justice Kagan in *Iancu*. *Id.* at 2299. The situation in Europe is quite different where the ECtHR has repeatedly held that restrictions on speech that conveys certain messages, in particular hate speech, can effect a proportionate interference with the right to freedom of expression enshrined in Article 10 ECHR. See Leroy v. France, App. No. 36109/03 (ECtHR, 2 October 2008); Féret v. Belgium, App. No. 15615/07 (July 16, 2009); Sürek v. Turkey (No. 1), App. No. 26682/95 (July 8, 1999); Balsytė-Lideikienė v. Lithuania, App. No. 72596/01 (Nov. 4, 2008).

181. Matal, 137 S. Ct. at 1763.

182. Iancu, 139 S. Ct. at 2296. This language was also employed by Justice Kennedy in his dissenting opinion in Matal, 137 S. Ct. at 1766 ("an applicant may register a positive or benign mark but not a derogatory one. The law thus reflects the Government's disapproval of a subset of messages it finds offensive, the essence of viewpoint discrimination."). In *Brunetti*, the Supreme Court rejected the Government's additional argument that the morality/scandalous exclusion could be construed as viewpoint-neutral (instead of viewpoint-discriminatory) if it were to refuse registration only to signs whose "mode of expression" is shocking or offensive, regardless of the views they express. This would allow restricting the scope of the exclusion to signs that are "'vulgar'—meaning 'lewd', 'sexually explicit or profane.'" Iancu, 139 S. Ct. at 2301-02. According to the Court, this reading is incompatible with the wording of the provision as drafted by Congress, which is overly broad in its ban on certain marks on the basis of their content.

183. As regards the disparaging clause, *see* Matal, 137 S. Ct. at 1751. In relation to the scandalous or immoral clause, *see* Iancu, 139 S. Ct. at 2297.

future attempt by Congress to reinstate the exclusions.[184] More importantly, these decisions set a precedent, which cannot be overturned except by the Supreme Court, for the ability of speech to validate trademark rights in the United States. When compared to the decision of the CJEU in *Constantin Film Produktion*,[185] *Tam* and *Brunetti* demonstrate how the disparate degrees of protection afforded under freedom of expression on each side of the Atlantic are conducive to different outcomes.[186] This is so despite the similarities in the analytical frameworks employed, i.e., despite decisionmakers of both jurisdictions acknowledging that applicants can rely on their speech rights to validate their registration claims.

3. The Interaction Between Trademarks and Speech in Ownership Cases (II): Health-Furthering, Trademark-Restrictive Measures

a. Europe

In 1998, the EU adopted the Tobacco Products Advertising Directive imposing advertising and sponsorship bans on tobacco products.[187] The Directive was challenged by Germany and by tobacco manufacturers on several grounds, including the Directive's incompatibility with Article 10 ECHR.[188] Unfortunately, the Court failed to engage with this claim when it annulled the Directive on grounds of improper legal basis under the EC Treaty.[189]

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184. *See* Katyal, *supra* note 13 (discussing the growing evidence that signs that consist of slurs and other hateful messages are being granted access to the federal trademark register).

185. Case C-240/18, Constantin Film Produktion ('FACK JU GÖHTE') v. EUIPO, ECLI:EU:C:2019:553 (Feb. 27, 2019). The findings of the CJEU in relation to the degree of protection afforded to trademark applicants under Article 10 ECHR were explored in the previous subsection.

186. Matal, 137 S. Ct. 1744; Iancu, 139 S. Ct. 2294. The different approaches to freedom of expression adopted in the United States and Europe were explored in Section II(A) above, including support for the proposition that speech enjoys broader protection in the United States than it does in Europe. *See supra* note 76.

187. First Tobacco Products Directive.

188. Case C-376/98, Germany v. European Parliament, ECLI:EU:C:2000:544 (Oct. 5, 2000).

189. *Id.* at ¶ 118. It is worth noting that the CJEU was given a second chance to assess the compatibility with freedom of expression of the reformulated advertising ban Directive several years later in Case C-380/03, Germany v. European Parliament, ECLI:EU:C:2006:772 (Dec. 12, 2006). Unfortunately, however, the relevance of this decision for purposes of the argument advanced here is somewhat limited for four reasons. First, the reformulated Directive did not contain any form of advertising ban impinging directly on trademark use (such as a prohibition on the use of trademarks of tobacco products in relation to other goods). *See* Directive 2003/33, of the European Parliament and of the Council of 26 May 2003 on the Approximation of the Laws, Regulations and Administrative Provisions of the Member States Relating to the Advertising and Sponsorship of Tobacco Products, 2003 O.J. (L 152) 16. Instead, it prohibited more conventional forms of advertising, such as in printed media (Article 3) and radio (Article 4), which affect trademark use only indirectly. Second, it is unclear from the decision whether the expressive concerns of tobacco manufacturers were at issue in this case in addition to those of journalists. While the claimant's (Germany) speech-based challenge to the Directive seemed broad enough to incorporate tobacco manufacturers' freedom of commercial

Guidance can, however, be found in the opinion of AG Fennelly.[190] The AG applied the ECtHR's proportionality test to interferences with commercial expression.[191] Under this test, a measure encroaching on speech will be valid when the public authority has "reasonable grounds for adopting [it] . . . in the public interest. In concrete terms, it should supply coherent evidence that the measure will be effective in achieving the public interest objective invoked—in these cases, a reduction in tobacco consumption relative to the level which would otherwise have obtained—and that less restrictive measures would not have been equally effective."[192] Because the EU had furnished evidence of "a correlation both between tobacco advertising and the taking up of smoking . . ., and between the banning of advertising and reductions in average per capita tobacco consumption," the AG found the advertising ban to legitimately encroach on manufacturers' speech.[193] Admittedly, most advertising bans do not directly impinge on trademark use, but rather forbid commercial communication between undertakings and consumers through the use of different means, including trademarks.[194] This explains why the AG's reasoning does not specifically address, upon analysis of the advertising ban on tobacco products, restrictions on trademark use. However, to the extent that marks can be said to perform an advertising function that is liable to be directly affected by other trademark-restrictive measures, such as health warnings or plain packaging, the rationale of the AG is relevant to our discussion.[195]

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expression ("the prohibition on advertising covers any indirect effect on the sale of tobacco products of any form of commercial communication"), the Court only made explicit reference to journalists' speech interests. Case C-380/03, Germany v. European Parliament, ECLI:EU:C:2006:772 ¶ 132 (Dec. 12, 2006). Third, the Court seemed skeptical of the ban's ability to interfere with freedom of expression when it began its analysis with the following caveat: "even assuming that the measures laid down in . . . the Directive prohibiting advertising and sponsorship have the effect of weakening freedom of expression indirectly." *Id.* at ¶ 156. And fourth, the Court adopted such a deferential approach towards the assessment of restrictions on the freedom of commercial expression that its analysis is extremely succinct and lacking in nuance. *Id.* at ¶ 154-56.

190. Opinion of Advocate General Fennelly in Case C-376/98, Germany v. European Parliament, ECLI:EU:C:2000:324 (June 15, 2000).

191. *Id.* at ¶ 158-59.

192. *Id.* at ¶ 159.

193. *Id.* at ¶ 162.

194. This has also been noted by Fhima, *supra* note 13, at 312. There are, however, two types of advertising bans that impinge directly on trademark use: (a) bans that prohibit the use of marks already associated with other goods on tobacco products; and (b) bans that prohibit the use of marks already associated with tobacco products on other goods. As we will go on to see, these types of bans were also discussed by AG Fennelly in his opinion.

195. As demonstrated by the following excerpt from the AG's opinion, where he comments on the justifications put forward by the EU legislature for the adoption of the Directive, the fundamental issues raised by this case can be very easily extrapolated to measures that directly impinge on trademark use:

> The case made for the Advertising Directive is that consumption of tobacco products is dangerous for the health of smokers, that advertising and sponsorship promote such consumption and that the comprehensive prohibition of those forms of expression will result in a reduction in tobacco consumption and, thus, improved public health.

Regardless of the outcome of this debate, the applicability of AG Fennelly's reasoning to restrictions directly targeting trademark use can hardly be questioned in light of his next finding. The challenged Directive included two additional prohibitions: (a) on the use of marks associated with other goods on tobacco products and (b) on the use of marks associated with tobacco products on other goods.[196] According to the AG, these restrictions on trademark use effected an interference with tobacco manufacturers' freedom of commercial expression which the EUhad failed to justify on public health grounds.[197] This finding was thus premised on the notion that trademark use implicates freedom of expression. This is expressly recognized by the AG: "the application of . . . a brand or mark to a product also constitutes an exercise of freedom of commercial expression."[198]

AG Fennelly's opinion constitutes the most robust precedent in EU law of speech protection being mobilized by trademark owners to validate their exclusive rights. First, it constitutes an acknowledgment, within the EU's highest judicial body, of the communicative role that marks play in the marketplace and, hence, of their entitlement to protection under the fundamental right to freedom of expression when their use is threatened by measures of public law.[199] And second, by finding the prohibition on trademark use invalid for lack of evidence of the health benefits derived from such measure that would justify the encroachment on freedom of expression, the AG's opinion is a valuable precedent for the role of speech as validating trademark rights in the EU.

In 2016, the CJEU was once again given the opportunity to address the compatibility of trademark-restrictive measures with freedom of expression in a challenge that tobacco manufacturers brought regarding the legality of the latest Tobacco Products Directive.[200] The Directive mandates, *inter alia*, that packages of tobacco products (a) bear enlarged health warnings covering 65% of their front and back surfaces (a considerable increase from the 30% required by the previous Directive of 2001) and (b) do not feature any misleading information, such as use

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Opinion of Advocate General Fennelly in Case C-376/98, Germany v. European Parliament, ECLI:EU:C:2000:324, ¶ 156 (June 15, 2000).

196. First Tobacco Products Directive, arts. 3(3)(a) and 3(3)(b). These provisions are discussed by AG Fennelly in Opinion of Advocate General Fennelly in Case C-376/98, Germany v. European Parliament, ECLI:EU:C:2000:324, ¶ 176 (June 15, 2000).

197. Opinion of Advocate General Fennelly in Case C-376/98, Germany v. European Parliament, ECLI:EU:C:2000:324, ¶ 176 (June 15, 2000).

198. *Id.* ¶ 176. Griffiths, *supra* note 13, at 447-48, has conceded that restrictions on trademark use will likely be deemed by the ECtHR to interfere with freedom of expression ("Even if one does not accept any of the more elaborate claims made for the use of a mark as a form of expression, a mark undoubtedly provides information of some use to consumers. As such, it seems quite likely that, in the eyes of the Strasbourg Court, the use of a mark by its proprietor will fall within the scope of protected "expression" under Article 10 [ECHR]."). This has also been noted by Ricolfi, *supra* note 13, at 472.

199. This has also been noted by Fhima, who believes that "[t]his decision is interesting because the Advocate General was prepared to apply ECHR principles directly in order to protect the use of trade marks in speech." Fhima, *supra* note 13, at 313.

200. Case C-547/14, Philip Morris Brands S.A.R.L. v. Secretary of State for Health, ECLI:EU:C:2016:325 (May 4, 2016).

of the expressions 'low-tar', 'ultra-light', 'without additives', or 'slim'.[201] The manufacturers' claim that the Directive was incompatible with their fundamental right of freedom of expression was restricted to the second requirement regarding misleading information.[202]

The Court began by acknowledging that the ban on misleading information "constitutes . . . an interference with a business's freedom of expression and information."[203] An interference, however, that must be deemed proportionate since: (a) it is narrow in scope, in the sense that it does not "prohibit . . . the communication of all information about the product, [but] . . . only the inclusion of certain elements and features";[204] and (b) pursues a legitimate health objective, where "human health protection . . . outweighs the [expressive] interests put forward by [tobacco manufacturers]."[205] Although the Court does not say this in explicit terms, it seems to reach its decision by applying the lower level of scrutiny afforded to freedom of commercial expression, since claimants "rely, in essence . . ., on the freedom to disseminate information in pursuit of their commercial interests."[206]

Regrettably, the Court's proportionality assessment is rather cursory.[207] Judging by the high degree of protection afforded under the EU Charter and the ECHR to the right to health on the one hand (as acknowledged by the court),[208] and the right to freedom of expression on the other,[209] it is striking that the CJEU failed to engage in a more nuanced balancing exercise here. Instead, by way of adopting a highly deferential approach to review of the acts of the EU legislature, the Court appears to consider its proportionality test satisfied so long as the challenged measure pursues the promotion of health.[210] According to the Court: "Given that it is undisputed that tobacco consumption and exposure to tobacco smoke are causes of death, disease and disability, the [challenged] prohibition . . . contributes to the achievement of that objective in that it is *intended* to prevent the promotion of tobacco products and incitements to use them."[211] This prevents the Court from engaging in sophisticated analysis of the colliding interests at stake, notably by requiring proof of the attainment of the health objective pursued. Furthermore, it would have been useful for the Court to explore further whether

201. *Id.* at ¶ 138-42.

202. *Id.* at ¶ 137.

203. *Id.* at ¶ 148.

204. *Id.* at ¶ 151.

205. *Id.* at ¶ 156.

206. *Id.* at ¶ 155.

207. *Id.* at ¶ 153-62.

208. *Id.* at ¶ 157.

209. The crucial role that freedom of expression plays in democratic societies was discussed in Section II(A) above, including evidence from the ECtHR in *supra* note 73.

210. *Id.* at ¶ 156.

211. *Id.* at ¶ 152 (emphasis added).

the scope of the prohibition was indeed narrow.[212] It can be easily argued that the type of information that manufacturers are precluded from communicating on the packaging is precisely the type which is of most value to them, i.e., information that seeks to attract consumers by informing them of some characteristic of the product that they may be particularly interested in. Therefore, the fact that all other information is still available for use on the packaging appears to be of little use in practice.

The opinion of AG Kokott offers further guidance.[213] Importantly, even though the referring court had limited its question to the compatibility with speech of the prohibition on the use of misleading information, the AG also analyzed whether the restrictions imposed by enlarged health warnings were compatible with Article 10 ECHR.[214] In doing so, the AG arguably acknowledged both that (a) traders' interest in expressing their opinions through trademark use merits protection under the fundamental right to freedom of expression and (b) that health warnings interfere with said freedom. However, she failed to explain how they interfere, notably by removing space on the package that could otherwise be devoted to trademark use, or by requiring tobacco manufacturers to convey a health-related message against their will, or possibly both.

She begins her proportionality analysis by conceding that freedom of expression calls for the application of a stricter test than that which applies to other freedoms, such as the freedom to conduct a business. However, she goes on to conclude that the requirements contained in the Directive effect a proportionate interference with freedom of expression for two reasons: (a) they promote public health, "which has been recognised as having a particularly high importance" and (b) they impact commercial expression, which is deserving of limited protection under the ECHR.[215] In her own words: "[T]he dissemination of opinions and information which—as in this case—are intended to pursue solely business interests generally warrants less protection as a fundamental right than other expressions of opinion in the economic sphere or even political expressions of opinion."[216]

Even though the AG and the CJEU recognize that the challenged measures interfere with tobacco manufacturers' freedom of commercial expression, they both fail to apply the proportionality test mandated under Article 10 ECHR in such instances.[217] This is in contrast with the nuanced assessment undertaken by

212. *Id.* at ¶ 151.

213. Opinion of Advocate General Kokott in Case C-547/14, Philip Morris Brands S.A.R.L. v. Secretary of State for Health, ECLI:EU:C:2015:853 (Dec. 23, 2015).

214. *Id.* at ¶ 211.

215. *Id.* at ¶ 233.

216. *Id.* at ¶ 233.

217. As discussed in Section II(A) above, the ECtHR has developed a proportionality test in cases involving restrictions on freedom of commercial expression in, *inter alia*: Markt Intern Verlag GmbH and Klaus Beermann v. Germany, App. No. 10572/83, ¶ 33 (Nov. 20, 1989). *See also*, in similar terms, Casado Coca v. Spain, App. No. 15450/89, ¶ 50 (Feb. 24, 1994).

AG Fennelly in *Germany v European Parliament*.[218] Despite this shortcoming, both the Court's decision and the AG's opinion constitute valuable precedent on the role of speech as amenable to the validation of trademark rights in Europe.[219]

b. United States

Courts in the United States have also acknowledged that owners' speech rights can be interfered with by government-mandated restrictions on trademark use.[220] Because of the broader scope of protection afforded to individuals under the First Amendment as compared to Europe, we find precedents in the United States of health-furthering, trademark-restrictive measures being struck down on speech grounds.[221]

In *Lorillard Tobacco Company v. Reilly*, the Supreme Court partially upheld tobacco manufacturers' speech claims against a Massachusetts regulation which imposed advertising and sale restrictions on tobacco products.[222] Among other prohibitions, the challenged measure (a) banned all advertising within a 1,000-foot radius of schools or playgrounds and (b) imposed restrictions on indoor, point-of-sale advertising.[223] Because the regulation under scrutiny targeted speech that "propos[es] a commercial transaction", the Court went on to apply intermediate scrutiny.[224] The burden of proof imposed on the regulatory authority under this standard is considerably high in that the measure must "directly advance" the substantial governmental interest asserted, and must not be "more

218. Opinion of Advocate General Fennelly in Case C-376/98, Germany v. European Parliament, ECLI:EU:C:2000:324 (June 15, 2000).

219. An additional precedent in this regard can be found in the decision of the High Court of England and Wales in R. (on the application of British American Tobacco UK Ltd.) v. Secretary of State for Health [2004] EWHC 2493 (Admin). This case involved a speech-based challenge to the validity of the British advertising ban on tobacco products. Although the Court eventually sided with the government, its detailed discussion of whether the measure effected a proportionate interference with tobacco manufacturers' freedom of expression constitutes further evidence of the ability of speech to validate trademark rights in Europe.

220. Cigar Ass'n of Am. v. FDA., 315 F. Supp. 3d 143 (D.D.C. 2018); RJ Reynolds Tobacco Co. v. FDA, 696 F.3d 1205 (D.C. Cir. 2012); Lorillard Tobacco Co. v. Reilly, 533 U.S. 525 (2001).

221. *See, e.g.*, *RJ Reynolds Tobacco Co.*, 696 F.3d at 1205; partially in *Lorillard Tobacco Co.*, 533 U.S. at 525.

222. *Lorillard Tobacco Co.*, 533 U.S. at 525.

223. *Id.* at 534-35. The measure under scrutiny also regulated sales practices by tobacco manufacturers and retailers, notably the bar of self-service displays and the requirement that tobacco products only be accessible to salespeople. It is unclear how these restrictions relate to trademark use, or even impinge on manufacturers' ability to communicate (the latter was noted by the Court, too). *Id.* at 569. Insofar as claimants' First Amendment rights were curtailed by sales restrictions, the Court concluded that they complied with constitutional requirements. *Id.* at 567-70.

224. *Id.* at 554-55. The Court did not explore how the regulations encroached on manufacturers' speech since the defendant "ha[d] assumed for purposes of summary judgment that petitioners' speech is entitled to First Amendment protection." *Id.* at 555.

extensive than is necessary to serve that interest."[225] In this case, the regulatory authority was unable to meet this burden and justify the constitutionality of either advertising ban.[226] The ban on advertising within 1,000 feet of schools or playgrounds proved controversial.[227] After careful consideration of the evidence furnished by the government, the Court concluded that the impugned measure was able to advance the public interest pursued of reducing underage consumption of the tobacco products under analysis.[228] The defendant, however, was unable to furnish evidence that the outdoor advertising ban was no more extensive than necessary to serve that interest.[229] This led the Court to side with plaintiff after finding that "[t]he broad sweep of the regulations indicates that the [government] did not 'carefully calculate the costs and benefits associated with the burden on speech imposed' by the regulations."[230] Because of the high school density in metropolitan areas, the regulation effectively amounted to a near-complete ban on all forms of advertising in several geographical areas within Massachusetts.[231] Additionally, the Court had no difficulty in striking down the provisions of the regulation imposing restrictions on indoor advertising because the regulator had failed to demonstrate both that it advanced the public interest pursued and that it was tailored to that interest.[232]

A decade later, in *R.J. Reynolds Tobacco Company v. FDA*,[233] tobacco manufacturers successfully challenged the validity of a proposed Food and Drug Administration (FDA) regulation promulgating a set of pictorial health warnings that would be affixed to cigarette packages.[234] The FDA had issued this regulation under the statutory directive of The Family Smoking Prevention and Tobacco Control Act, which imposed combined health warnings—consisting of both text and images—covering 50% of the front and back surfaces of cigarette

225. *Id.* at 554 (quoting Cent. Hudson Gas & Elec. Corp. v. Public Serv. Comm'n, 447 U.S. 557, 566 (1980)).

226. *Id.* at 566-67. As discussed in *supra* note 223, the Court did not reach the same conclusion in relation to sales restrictions.

227. *Id.* at 556-66.

228. *Id.* at 556-61. It is worth noting that the Court's analysis was restricted to smokeless tobacco and cigars since plaintiffs' challenge in relation to cigarettes had been successful on grounds that federal law (the Federal Cigarette Labelling and Advertising Act, 15 U.S.C. § 1333) pre-empted the regulation. *Id.* at 550-51.

229. *Id.* at 561-66.

230. *Id.* at 561 (quoting Cincinnati v. Discovery Network, 507 U.S. 410, 417 (1993)).

231. *Id.* at 561-66.

232. *Id.* at 566-67.

233. RJ Reynolds Tobacco Co. v. FDA, 696 F.3d 1205 (D.C. Cir. 2012). *But see* Disc. Tobacco City & Lottery, Inc. v. U.S., 674 F.3d 509, 524-27 (6th Cir. 2012), where tobacco manufacturers' facial challenge to the validity of the same Act was unsuccessful as regards, *inter alia*, the compatibility of the required pictorial health warnings with the First Amendment.

234. Proposed Rules, Department of Health and Human Services (HHS), Food and Drug Administration (FDA), Required Warnings for Cigarette Packages and Advertisements, 75 FR 69524 (Nov. 12, 2010).

packages.[235] The Court of Appeals for the District of Columbia Circuit was easily satisfied that the challenged regulation compelled the plaintiffs to express the FDA's views towards the health risks posed by tobacco products and, thus, interfered with their First Amendment rights.[236] According to the Court, "[t]his case contains elements of compulsion [to express certain views] and forced subsidization [of speech to which plaintiffs object]."[237] To determine whether this interference was constitutional, the Court first had to elucidate the applicable level of scrutiny.[238] The FDA argued for the application of lower-level scrutiny because the proposed health warnings constituted factual information about the health risks derived from smoking.[239] However, the Court instead found that the graphic component of the proposed health warnings consisted of "inflammatory images" that "are unabashed attempts to evoke emotion (and perhaps embarrassment) and browbeat consumers into quitting."[240] The Court thus went on to apply intermediate scrutiny.[241] Because the FDA was unable to furnish convincing evidence that the proposed images would "directly advance" the governmental interest in reducing smoking prevalence, the challenged regulation was held to be unconstitutional.[242] According to the Court:

> FDA has not provided a shred of evidence—much less "substantial evidence" …—showing that the graphic warnings will "directly advance its interest" in reducing the number of Americans who smoke. FDA makes much of the "international consensus" surrounding the effectiveness of large graphic warnings, but offers no evidence showing that such warnings have directly caused a material decrease in smoking rates in any of the countries that now require them. …
> The … [FDA] estimated the new warnings would reduce U.S. smoking rates by a mere 0.088%, …, a number the FDA concedes is "in general not statistically distinguishable from zero." … Indeed, because it had access to "very small data sets," FDA could not even reject the statistical possibility that the Rule would have no impact on U.S. smoking rates.[243]

In a more recent decision, *Cigar Association of America v. FDA*, the court found that the FDA's enlarged health warnings for cigars were constitutional on the grounds, *inter alia*, that they effected a justified encroachment on cigar

235. *RJ Reynolds Tobacco Co.*, 696 F.3d at 1205.

236. *Id.* at 1211-12.

237. *Id.* at 1211.

238. *Id.* at 1211-17.

239. *Id.* at 1212-13.

240. *Id.* at 1216-17.

241. *Id.* at 1217. However, this is in clear contrast to the decision of the 6thCircuit in *Discount Tobacco*. Upon assessing the constitutionality of the pictorial health warnings mandated under the Act on their face (i.e. in the abstract, before the FDA had issued the proposed images challenged in *RJ Reynolds*), the Court applied lower-level scrutiny. *Disc. Tobacco City & Lottery, Inc.*, 674 F.3d at 558-61.

242. *RJ Reynolds, Tobacco Co.*, 696 F.3d at 1234-37.

243. *Id.* at 1219-20.

manufacturers' First Amendment rights.[244] Compared to *Reynolds*, the proposed health warnings in this case were considerably less intrusive on manufacturers' speech rights because they consisted of text rather than images and only covered 30% of the front and back surfaces of packages.[245] It was precisely on this basis that the Court decided, after acknowledging that the proposed health warnings interfered with manufacturers' speech, to assess the constitutionality of the required warnings under a standard of lower-level scrutiny, i.e., scrutiny which applies to purely factual and uncontroversial information. Under this standard, the regulatory authority must show that the proposed measure is "reasonably related" to the pursued aim and is not "unjustified or unduly burdensome."[246] According to the Court, whereas the graphic health warnings in *Reynolds* had been "controversial" and "inflammatory," the textual warnings required for cigars were "unambiguous and unlikely to be misinterpreted by consumers."[247] The FDA effectively demonstrated that (a) informing consumers of the health risks derived from smoking cigars constitutes a substantial government interest[248] and (b) the provision of accurate information on the health risks associated with smoking in the form of health warnings "in a size, format, and manner that consumers will readily notice and retain" satisfies the "means-end fit" requirement under the lower-level scrutiny standard.[249]

A comparison between these three cases reveals the fundamental repercussions derived from which standard of scrutiny is applied. In intermediate scrutiny, the evidentiary requirements are rather strict—so much so that it seems unlikely that the government will be able to meet the required burden of proof in the near future.[250] As noted by the court in *Reynolds*, because variations in smoking rates over time are heavily dependent on a myriad of factors, researchers will have a hard time gathering robust evidence of reductions in smoking prevalence that are the direct result of one factor alone, for instance, enlarged health warnings.[251] In contrast, in lower-level scrutiny, the burden of proof required is significantly lower. In *Cigar Association of America*, the court relied on prior case law to describe the applicable burden of proof as follows: "'[C]onstitutionality under [lower-level scrutiny] does not hinge upon some quantum of proof that a disclosure will realize the underlying purpose. A

244. Cigar Assoc. of Am. v. FDA, 315 F. Supp. 3d 143 (D.D.C. 2018).

245. *Id.* at 153-54.

246. Zauderer v. Off. of Disciplinary Couns. of Sup. Ct. of Ohio, 471 U.S. 626, 651 (1985).

247. *Cigar Assoc. of Am.*, 315 F. Supp. 3d at 166.

248. *Id.* at 167-71.

249. *Id.* at 171-72.

250. As the Court of Appeals for the District of Columbia Circuit put it in *Reynolds*: "The government bears the burden of justifying its attempt to restrict commercial speech …, and its burden is not light." RJ Reynolds, Tobacco Co. v. FDA, 696 F.3d 1205, 1218 (D.C. Cir. 2012).

251. *Id.* at 1219 ("But the raw numbers don't tell the whole tale. FDA concedes it cannot directly attribute *any* decrease in the Canadian smoking rate to the graphic warnings because the Canadian government implemented other smoking control initiatives, including an increase in the cigarette tax and new restrictions on public smoking, during the same period.") (Emphasis in the original).

common-sense analysis will do. And the disclosure has to advance the purpose only slightly.'"[252] Most measures restricting trademark use will pass constitutional muster under this standard of review, regardless of whether or not they contribute to the attainment of the alleged health objective. These differences underscore that much of the discussion in cases dealing with the interaction between trademarks and speech turns on the assessment of what type of speech is involved and, consequently, on what level of scrutiny is to be applied. Despite their contrasting outcomes, these cases constitute very valuable precedents for the role of speech in validating trademark rights in the United States.

III.
THE 'SCHOOL OF SPEECH IN TRADEMARK LAW': THEORETICAL FOUNDATIONS FOR THE PROPOSITION THAT SPEECH CAN VALIDATE TRADEMARK RIGHTS

The work of a small number of legal scholars also provides a solid theoretical foundation for the proposition that speech can validate trademark rights, in particular the works of Justin Hughes, Jason Bosland, and Michael Spence.[253]

The contributions of these authors are best framed within a broader debate which lies at the intersection between intellectual property law and cultural studies: the extent to which intellectual property rights serve to lock up meaning in cultural goods.[254] Cultural studies scholars addressing the interaction between

252. *Cigar Assoc. of Am.*, 315 F. Supp. 3d at 171 (citing Nat'l Elec. Mfrs. Ass'n v. Sorrell, 272 F.3d 104, 115 (2d Cir. 2001)).

253. Hughes, *supra* note 4; Bosland, *supra* note 36; Spence, *supra* note 42. I have pondered long and hard as to whether I should include Megan Richardson (with her seminal piece on the topic, *Trade Marks and Language*, *supra* note 10) in this group. However, her interest in justifying anti-dilution protection for trademarks with an expressive component is not premised on a reconceptualization of the interaction between marks and speech. This is in contrast with the rationales put forth by the other three authors to justify broad trademark protection, which ultimately seek to further the expressive interests of different trademark users, whether they be right holders, consumers of branded goods or users of cultural artefacts. Instead, Richardson's support for anti-dilution statutes is premised on utilitarian notions of incentive maximization akin to those underpinning copyrights and patents. By advancing that there is significant value attached to the expressive component of marks, she conceives of reinforced trademark protection as a means to incentivize investment in the creation of expressive meaning. And while her theory challenges the widespread misconception that broad trademark protection can reduce the pool of available words in our language (in line with Bosland's proposition), her aim in doing so is different to Bosland's. Her concerns do not lie with the expressive interests of users of cultural artefacts (although one could argue that they will benefit indirectly from her proposal), but rather with the creation of an incentive structure that can maximize right holders' investment in trademarks. Also, her pushback is not directed so much towards cultural studies scholars as it is towards the historically induced mistrust of registered trademarks, which are said to diminish the pool of available words in our language.

254. Relevant contributions to this debate include: Gangjee, *supra* note 2; Desai, *supra* note 36; Sonia Katyal, *Semiotic Disobedience*, 84 WASH. U. L. REV. 489 (2006); Dan Hunter, *Culture War*, 83 TEX. L. REV. 1105 (2005); LAWRENCE LESSIG, FREE CULTURE: HOW BIG MEDIA USES TECHNOLOGY AND THE LAW TO LOCK DOWN CULTURE AND CONTROL CREATIVITY (2004); Keith Aoki, *Adrift in the Intertext: Authorship and Audience "Recoding Rights"*, 68 CHI.-KENT L. REV. 805 (1993); Rosemary

cultural production and intellectual property rights are often critical of most forms of ownership over cultural goods.[255] In those scholars' view, ownership over intangibles through the grant of intellectual property rights often leads to valuable meanings embodied in protected cultural artifacts being locked away or monopolized by their rights holders to the detriment of the general interest.[256] In the trademark context, this concern translates into the inability of third parties to effectively participate in the cultural discourse revolving around marks that convey expressive meanings to the extent that owners' exclusive rights can be invoked to prevent recoded uses of their marks.[257] In other words, trademark laws are said to run counter to cultural production by shielding the meaning of marks from appropriation through dialogic practice.

It is against this backdrop in the cultural studies literature that Justin Hughes and Jason Bosland (and, to a lesser extent, Michael Spence, for his pushback is directed towards critics of anti-dilution statutes generally) propose an alternative reading of the role that trademark laws play in cultural production and dialogic practice. According to these authors, reinforced trademark protection of the type so often criticized by cultural studies scholars better serves the public interest than allowing for indiscriminate recoding of expressive marks.[258]

In the case of Hughes, his pushback is directed towards critics of broad intellectual property rights who believe in the need for greater "recoding freedom" to ensure that social meaning is not locked-up by right holders.[259] Importantly, even though he writes of "recoding freedom", the backbone of such concept is

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J Coombe, *Objects of Property and Subjects to Politics: Intellectual Property Laws and Democratic Dialogue*, 69 TEX. L. REV. 1853 (1991).

255. Coombe, *supra* note 254, at 1855 ("intellectual property laws stifle dialogic practices-preventing us from using the most powerful, prevalent, and accessible cultural forms to express identity, community, and difference."); Hunter, *supra* note 254, at 1120 ("without . . . limitations [to their scope] the expansion of intellectual property must eventually lead to a kind of intellectual and cultural paralysis."); Katyal, *supra* note 254, at 497 ("intellectual property . . . creates boundaries that enfranchise certain types of speech at the expense of others."); Gangjee, *supra* note 2, at 57 (the "brand propertisation [model] is therefore not only inaccurate in presuming single author brand creation, but also deeply troubling since it marginalises consumer agency and reinforces the exploitation of their immaterial labour through the instrumentality of trade mark law.").

256. Bosland explains this phenomenon in the following terms: "It has long been recognised that intellectual property rights, depending on how they are framed, can be used to prohibit access to, and the use of, many cultural forms: stories, images, logos and other communicative devices become 'locked-up' in the hands of private owners." Bosland, *supra* note 36, at 100. In Hughes' words: "The … argument [put forth by proponents of greater recoding freedom] is that some forms of intellectual property we recognize as defending realms of personal expression (copyright, trademark, the right of publicity) may suppress personal expression by putting important cultural symbols off limits to non-owners." Hughes, *supra* note 4, at 930.

257. In Bosland's words: "for most cultural theorists, the 'public interest' in the cultural aspects of trade marks is seen as best served by the outright avoidance of trade mark rights." Bosland, *supra* note 36, at 101.

258. Hughes, *supra* note 4; Richardson, *supra* note 10; Bosland, *supra* note 36; Spence, *supra* note 22; Spence, *supra* note 42.

259. Hughes, *supra* note 4, at 926-29.

arguably speech. His argument centers on recoding freedom as the freedom to express oneself through an altered version of a cultural object protected by an intellectual property right.[260] Hughes argues that most recipients of a cultural product are mere listeners, not recoders—which would appear to be the underlying assumption of proponents of greater "recoding freedom".[261] Therefore, by placing all their emphasis on recoders, cultural studies scholars fail to account for the interests of a vast number of individuals who identify with the meaning conveyed by the mark.[262] Hughes advances that the interests of listeners in the cultural object remaining stable over time also need to be taken into consideration when attempting to delimitate the content of intellectual property rights.[263] Safeguarding their interests (expressive and otherwise) requires granting broad exclusive rights to the right holder so as to ensure that the meaning(s) conveyed by the mark can remain stable.[264]

Bosland pushes back against critics of broad trademark protection who believe that strong trademark rights lock-up extremely valuable cultural artifacts.[265] He argues that, in addition to serving source-identifying and persuasive functions, marks are imbued with cultural significance.[266] They can transcend their core functions and develop into cultural artifacts that are incorporated into ordinary public discourse, allowing individuals to express themselves through their use. Therefore, he rejects the notion that trademark rights lock-up valuable cultural artifacts and stifle dialogic practice.[267] In his view, trademark protection creates quite the opposite effect: it facilitates dialogic practice by allowing signs to develop into cultural artifacts with meaning that can be relied upon for expressive purposes.[268] As he rightly points out, without the protection afforded to marks by intellectual property laws, there would be no cultural goods in certain signs in the first place.[269] Accordingly, insufficient trademark protection would ultimately go against the public interest that cultural

260. *Id.* at 924-26.

261. *Id.* at 926-28.

262. This includes other intellectual property rights since Hughes' inquiry is not limited to trademarks. *Id.*

263. *Id.* at 926. Hughes takes this argument further to propose that even recoders themselves rely on the cultural object retaining some stability in order for the recoding acts to be successful. *Id.* at 941.

264. *Id.* at 926, 1005-06, 1010. Building on Hughes' work, Desai has reflected on the difficulties derived from the inherent tension between recoding and stability of meaning in expressive marks. Desai, *supra* note 19, at n.35.

265. Bosland, *supra* note 36, at 100-06.

266. *Id.* at 106-08.

267. *Id.* at 100, 103.

268. *Id.* at 100, 104.

269. *Id.* at 104 ("The discourse of trade mark ownership therefore facilitates trade mark language. It is precisely because trademarks are owned that they are valued as such powerful expressive devices. Without this ordering in the form of 'ownership', it would be near impossible for trade mark meaning to develop. By investing a trade mark with meaning and using it as a cultural tool, the public can express, for example, approval or criticism at the ideological stance of a trade mark owner.").

studies scholars seek to protect by removing many cultural signs from dialogic practice altogether. For Bosland therefore, the grant of broad rights to trademark owners—especially those recognized in anti-dilution statutes—is the best way to ensure that meaning in expressive marks can remain stable over time by preventing fragmentation resulting from excessive recoding acts.[270]

Finally, Spence's pushback is aimed against supporters of broad trademark protection based on their characterization of trademark rights as property rights.[271] He argues that a paradigm shift from a property-centric to a speech-centric understanding of trademark law best suits trademark purposes.[272] This shift allows for a better delimitation of the content of trademark rights. For Spence, marks are a form of speech that entitle owners to communicate a variety of messages through their use, including, but not limited to, trade origin.[273] As part of their right to free speech, trademark owners ought to be afforded protection against certain forms of compelled speech.[274] This would be the case where a third party seeks to recode the meaning conveyed by a mark through parodic or artistic use; otherwise, right holders would be precluded from ensuring that the meanings conveyed by their marks remained stable over time.[275] This would, in turn, prevent them from developing their expressive autonomy as realized through use of their marks.[276] Spence believes that the best way to grant protection to owners against compelled speech is through anti-dilution measures.[277] It is relevant to note that Spence is the only one of the three who explicitly rejects the widespread notion that freedom of speech can only be invoked as a defense in trademark law, that is, to limit the exclusive rights of owners.[278] In his view, freedom of speech also serves to validate trademark rights. In his own words:

> This [that freedom of expression can validate trade mark rights] is a surprising claim. Free speech is usually thought of as only limiting, and not grounding, trade mark rights: practitioners think that free speech issues are only relevant when . . . [a trade mark owner] wants to prevent an artist from using [his] trade mark in a protest work. But I hope to show that free speech, or at least a respect for expressive autonomy, is the best justification for the [expanded] scope of the trade mark protection against [dilution] afforded by [trade mark statutes].[279]

270. *Id. at* 110.
271. Spence, *supra* note 42.
272. *Id.* at 491.
273. *Id.* at 504-05.
274. *Id.* at 506.
275. *Id.* at 505.
276. *Id.* at 496, 500, 504.
277. *Id.* at 506.
278. *Id.* at 496.
279. *Id.* at 496.

Against this backdrop, it would appear that the portrayal by cultural studies scholars of the effect that trademark protection has on cultural production and expressive freedom is incomplete and, as a result, inaccurate. Far from locking-up valuable meaning in cultural artifacts, trademark rights promote cultural production and further the expressive interests of individuals in a variety of ways. It is only through the exclusive rights granted to trademark owners that distinctive signs go from signaling commercial sources to becoming cultural artifacts that convey expressive meanings. Expressive meanings can, in turn, be relied upon not only by recoders (as the work of cultural studies scholars would suggest), but also by right holders, consumers of branded goods and users of cultural artefacts generally. However, all these communicative projects can only be deployed insofar as the expressive meanings conveyed by a mark remain stable over time. This is also true of third party recoding, since the new meaning conveyed by the recoded sign originates in the mark. It would, therefore, be inaccurate to conceptualize each and every effort by trademark owners to preserve the expressive meanings conveyed by their marks as conducive to locking-up valuable meaning in cultural artifacts.

This can be easily illustrated by reference to health-furthering, trademark-restrictive measures, where owners' inability to continue using their marks freely on the packaging of their goods can have a severe impact on the expressive (and other) meanings conveyed by the mark. This, in turn, will prevent all other expressive users from pursuing their identity projects through use of the mark, whether they are aligned with, or critical of, those of the right holder. In this context, owners' efforts to retain package space can hardly be said to run counter to cultural production and expressive freedom. Quite the contrary: safeguarding trademark use through the protection afforded to right holders under freedom of expression serves to further both goals.

IV.
CONCLUSION

In the absence of comprehensive studies covering the diverse scenarios in which marks and speech interact, the emphasis placed by commentators on recoding cases has led to the misconception that the interaction between both sets of rights is unidirectional in the sense that trademark rights chill expression. This Article has sought to redress this misconception by engaging in taxonomical analysis of recoding and ownership cases on both sides of the Atlantic. This study has revealed that the interaction between marks and speech is best understood as a two-way street, where freedom of expression can both limit and validate trademark rights.

Acknowledging that the interaction between marks and speech goes both ways can contribute to the advancement of the field in five ways. First, it allows for a more precise understanding of this interaction; one that is not driven by a normative agenda that seeks to mobilize the protection afforded by freedom of

expression to curb trademark rights. Second, a more accurate reading of the interaction between marks and speech can, in turn, lead to a more refined understanding of the opposing interests at stake in interaction cases. This could result in fairer adjudication. Third, the parallels identified in American and European approaches to the interaction between marks and speech can lead to more fruitful exchange between both jurisdictions in this area of law. Fourth, awareness of the full range of scenarios where both sets of rights interact serves to highlight the potential ramifications that courts' findings in one scenario could have in others. And fifth, understanding that the interaction between marks and speech operates as a two-way street provides a solid foundation for the reconceptualization of this interaction as competing forms of speech. The repercussions of such a reconceptualization on the field could be far-reaching. Notably, acknowledgement that right holders' expressive interests are deserving of protection in ownership cases can lead to infringement scenarios where courts are asked to balance the speech interests of the recoder against both the proprietary and expressive interests of the mark owner. Inversely, the recognition that non-owners use marks for expressive purposes in recoding litigation can lead to ownership cases where courts are asked to factor in not only the speech rights of the trademark owner, but also those of consumers and potential recoders. The implications that such a rebalancing of rights would have in interaction cases lie, however, beyond the scope of this Article, and will be best addressed in future pieces.