

**FREE TRADE OR FREE EXPRESSION:  
ARTISTIC REPRESENTATIONS OF  
SPORTS TEAMS AND THEIR  
TRADEMARKS**

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Degas lived in Paris and painted its dancers. Monet lived in Giverny and painted water lilies. Bruegel lived in Belgium and painted lowland peasants. Audubon roamed North America and painted its birds. Moore is a painter who lives in Alabama; he paints football.

– Daniel Moore<sup>1</sup>

Expressive speech lies at the core of “the freedom of speech,” preserved under the First Amendment of the United States Constitution.<sup>2</sup> The same document providing that “Congress shall make no law...abridging the freedom of speech,” also empowers Congress to secure exclusive rights over certain “expressive speech” to authors and inventors.<sup>3</sup> Courts and legislatures found another category, commercial speech, which does not enjoy the full panoply of the First Amendment’s protections.

Commercial speech breathes life into federal trademark law, deriving its strength from the Commerce Clause and the lesser protections afforded to “false,” “misleading,” and “deceptive” speech. Thus, federal trademark law carves out exceptions to ensure that the First Amendment continues to preserve the freedom of speech. In sports, the line between commercial and cultural, competitive and expressive, and trade and speech rights are difficult to draw. This article analyzes a recent court decision permitting an Alabama artist, under certain conditions, to paint historical scenes from University of Alabama football without violating the school’s trademarks.<sup>4</sup>

“Marks,” “trade names,” and “commercial names” have increasingly become symbols with independent economic and cultural value, identifying more than just products, services, or companies.<sup>5</sup>

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<sup>1</sup> The Univ. of Ala. Bd. of Trs. v. New Life Art, Inc., 683 F.3d 1266 (11th Cir. 2012).

<sup>2</sup> U.S. CONST. amend. I.

<sup>3</sup> See *id.*; U.S. CONST. art. I, § 8, cl. 8 (“To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”).

<sup>4</sup> *New Life Art*, 683 F.3d at 1266.

<sup>5</sup> See, e.g., Logorama, VIMEO, <http://vimeo.com/10149605> (last visited Dec. 27, 2012); see also Lanham (Trademark) Act § 45, 15 U.S.C. §§ 1051-1127 (2013); Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 397-98 (1990) (“[I]deograms that once

The United States Court of Appeals for the Eleventh Circuit (“Eleventh Circuit”) recently faced a difficult question regarding how to apportion the rights to use the symbols of one powerhouse Southeastern Conference (“SEC”) football team: The University of Alabama Crimson Tide (“Crimson Tide”).<sup>6</sup> Defendant and artist, Daniel Moore, sought to paint historical scenes capturing the Crimson Tide’s players, jerseys, helmets, and other trademarked paraphernalia without the Crimson Tide’s prior authorization. Plaintiff and trademark owner, the Crimson Tide, sought to protect its intellectual property from “dilution” and “consumer confusion.”

Trademarks have become valuable commodities for organizations worldwide. Some researchers have valued the top one-hundred brands in the world at about \$2.4 trillion.<sup>7</sup> A large part of brand value lies in licensing to other manufacturers and service providers. When a brand’s inherent value grows, it “become[s] [a] communicative symbol[] standing for something besides the source or sponsorship of the product, in whose service [it] originated.”<sup>8</sup> Thus, both courts and legislatures struggle to develop trademark doctrines that protect popular brands without creating “a species of mutant copyright” that limits free expression.<sup>9</sup>

The dichotomy between protecting free expression and protecting free trade becomes more acute when considering sports

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functioned solely as signals denoting the source, origin, 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. . . . In a sense, trademarks are the emerging lingua franca: with a sufficient command of these terms, one can make oneself understood the world over, and in the process, enjoy the comforts of home.”).

<sup>6</sup> *New Life Art*, 683 F.3d at 1266.

<sup>7</sup> *Brandz™ Top 100 Most Valuable Global Brands 2012*, MILLWARDBROWN.COM, (Dec. 28, 2012) [http://www.millwardbrown.com/brandz/2012/Documents/2012\\_BrandZ\\_Top100\\_Report.pdf](http://www.millwardbrown.com/brandz/2012/Documents/2012_BrandZ_Top100_Report.pdf).

<sup>8</sup> Malla Pollack, *Your Image is My Image: When Advertising Dedicates Trademarks to the Public Domain—With an Example from the Trademark Counterfeiting Act of 1984*, 14 CARDOZO L. REV. 1391, 1393 (1993); see also 15 U.S.C. §§ 1051-1127; Logorama, *supra* note 5; Dreyfuss, *supra* note 5.

<sup>9</sup> *Compare* Trademark Dilution Revisions Act of 2006, 15 U.S.C. § 1051 (adopting a “likelihood of dilution” standard), *with* *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003) (declining to hold that similarity between marks without more constitutes trademark infringement).

symbols.<sup>10</sup> First, how should a court characterize sports teams' "products"? Is it limited to former players' jerseys, helmets, and other gear, or, is it broad enough to include a bare patch with the team's logo on it?<sup>11</sup> Second, what uses misappropriate the goodwill flowing to a "product"? Can a second-comer use sports teams' brands on any non-sports related item, or is a second-comer banned from placing sports teams' brands on any item, no matter how unrelated the item is to the sport?<sup>12</sup>

In *The University of Alabama Board of Trustees v. New Life Art, Inc.*, the Eleventh Circuit held that "art" received added protection from the First Amendment.<sup>13</sup> The question, then, becomes what is "art"? While this article will not seek to answer that philosophical question, it will attempt to give some analytic devices for providing a principled set of rules to answer these and similar questions. Primarily, this piece will focus on college football, but many of the analytic tools could be broadened to include other sports-related trademark and First Amendment issues.

Football and the First Amendment have enjoyed preeminence in the "deep south."<sup>14</sup> In college football, one conference, a stalwart

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<sup>10</sup> See Todd Thurheimer, Note, *Crimson Chaos: Sports Team Trademarks in Artwork and the Functionality Doctrine*, 7 J. INT'L. COMMERCIAL L. & TECH. 27 (2012) (citing Plunkett Research, Ltd., Sports Industry Overview, archived at <http://www.webcitation.org/5tqySMRep> (valuing the sports industry in America at \$414 billion)).

<sup>11</sup> Boston Prof'l Hockey Ass'n v. Dallas Cap & Emblem Mfg., Inc., 510 F.2d 1004 (5th Cir. 1975).

<sup>12</sup> University of Ga. Athletic Ass'n v. Laite, 756 F.2d 1535 (11th Cir. 1985).

<sup>13</sup> 683 F.3d at 1279.

<sup>14</sup> See, e.g., *Curtis Publ'g Co. v. Butts*, 388 U.S. 130 (1967) (establishing a recklessness standard in a defamation case involving public figures, but not the public officials Crimson Tide coach Bear Bryant and Georgia Bulldogs coach Wally Butts); *New York Times Co. v. Sullivan*, 376 U.S. 254 (1964) (establishing the actual malice standard in a defamation case arising out of an advertisement inaccurately describing events in Montgomery, Alabama); JOHN REED & DALE VOLBERG REED, 1001 THINGS EVERYONE SHOULD KNOW ABOUT THE SOUTH 2-6 (1996) (defining the deep south as South Carolina, Georgia, Alabama, Mississippi and Louisiana); *While Gap Narrows, Professional Football Retains Lead Over Baseball as Favorite Sport*, HARRISINTERACTIVE.COM (Jan. 20, 2011), <http://www.harrisinteractive.com/NewsRoom/HarrisPolls/tabid/447/mid/1508/articleId/675/ctl/ReadCustom%20Default/Default.aspx>. Seven of the fourteen schools currently in the SEC reside in "deep south" states. However, note that Texas A&M and the University of Missouri are new entrants to the SEC. Therefore, a far larger percentage of schools hailed from the "deep south" prior to the general expansion and

of “deep south” culture, stands apart on the football field: the SEC.<sup>15</sup>

SEC football, primarily composed of “deep south” teams, dominates southern culture for many reasons.<sup>16</sup> First, it is one of the most stable conferences outside of the Ivy League. In this era of conference re-organization, the SEC has added only four new teams in the last twenty years and has not lost a single team since 1966. In contrast, the Big East has become fractured; a dispute currently brews over which teams will get to use the “Big East” moniker.<sup>17</sup> Second, all but one SEC school is a public university.<sup>18</sup> Thus, the schools quite literally belong to the public. Third, the traditions run deep.<sup>19</sup> Generations of fans form their allegiances to SEC schools before they even attend high school, let alone college. Indeed, huge numbers of NFL players hail from states with SEC schools.

Despite the importance of football in the “deep south,” few professional teams have ever played in states with SEC teams.<sup>20</sup>

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reorganization of power conference like the SEC. Of the traditional SEC schools, Tennessee, arguably a “deep south” state itself, Kentucky and Florida are the other states represented.

<sup>15</sup> *Championship History*, NAT’L COLLEGIATE ATHLETIC ASS’N, <http://www.ncaa.com/history/football/fbs> (last visited Feb. 17, 2013). Since 1998, the SEC has won eight national championships. Indeed, the only time an SEC team has lost in the national championship game was when Louisiana State University (LSU), an SEC team, played Alabama, an SEC team, in 2011.

<sup>16</sup> See, e.g., *Curtis Publ’g Co.*, 388 U.S. at 130 (involving a defamation claim regarding a newspaper report about the Crimson Tide and University of Georgia coaches); *Auburn Univ. v. Moody*, 2008 WL 4877542, at \*1 (M.D. Ala. 2008) (“Fall means football which no person residing in Alabama can easily ignore.”).

<sup>17</sup> *What’s in a Name? Battle of “Big East” Moniker Likely to Occur Between Two Groups*, SPORTS BUSINESS DAILY, (Dec. 27, 2012), <http://www.sportsbusinessdaily.com/Daily/Issues/2012/12/27/Colleges/Big-East.aspx>.

<sup>18</sup> Vanderbilt University is the sole private institution in the SEC.

<sup>19</sup> Adam Duerson, *Road Trip: University of Mississippi*, SL.COM, (Sept. 27, 2004), [http://sportsillustrated.cnn.com/2004/sioncampus/09/22/road\\_trip0923/](http://sportsillustrated.cnn.com/2004/sioncampus/09/22/road_trip0923/) (“I went [to the University of Mississippi] a lot when I was in middle school and as a kid. [We would] play pickup football in our best clothes and our parents would come looking for [us]. They’d find [us] all muddy and sweaty. People always think of it as a place for alumni and students, but some of my best memories from there are as a kid.”).

<sup>20</sup> The New Orleans Saints and Atlanta Falcons are the only non-Florida NFL franchises more than ten years old. The Tennessee Titans franchise is more than ten years old, but the franchise did not move to Tennessee until the 1998 – 1999 season. See *Franchise Homes*, TITANSONLINE.COM, [http://www.titansonline.com/team/history/franchise\\_homes.html](http://www.titansonline.com/team/history/franchise_homes.html) (last visited Dec. 27,

Even now, Alabama, Kentucky, Mississippi, Missouri, South Carolina, and Arkansas field eight SEC teams (more than half the conference) but no professional franchises, and the seating capacity for SEC teams stadiums often exceeds those of NFL stadiums.<sup>21</sup> “Deep south” communities identify with their respective schools.<sup>22</sup> They take pride in the universities’ prestige, history, and prowess both on and off the field.

Alabama typifies both the “deep south” and the SEC.<sup>23</sup> The state has two powerhouse SEC football schools: the University of Alabama and Auburn University, both public universities. One of the two schools has won the college football national championship for each of the last four years. No NFL team plays in Alabama, but an abundance of NFL players hail from the state. Indeed, one Alabama court described “Alabama football [as] a secular religion.”<sup>24</sup>

The Crimson Tide’s on-field success has translated into significant brand value. For instance, Crimson Tide gear can cost as much as \$850.00 for a Joe Namath signed helmet, to \$400.00 for a pair of Crimson Tide cowboy boots, to \$70.00 for a Crimson Tide sweatshirt.<sup>25</sup> The Crimson Tide’s brand consists of a stylized “A,” the jerseys’ crimson color, the font of the lettering, and an elephant mascot. To protect these valuable commodities, the Crimson Tide, like other owners of valuable brands, has two

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2012). Texas A & M, added to the SEC in 2012, adds two NFL franchises that had not existed in the SEC in the prior eighty years.

<sup>21</sup> Don Kausler, Jr., *Seating Capacity of 101,821 Makes Bryant-Denny the Nation’s Fifth-Largest Football Stadium*, AL.COM, (Aug. 4, 2010), [http://www.al.com/sports/index.ssf/2010/08/seating\\_capacity\\_of\\_101821\\_mak.html](http://www.al.com/sports/index.ssf/2010/08/seating_capacity_of_101821_mak.html) (listing the stadiums for Alabama, Georgia, LSU, and Tennessee among the ten largest college football stadiums. Indeed, eight of the top 25 largest football stadiums by seating capacity house SEC teams).

<sup>22</sup> See, e.g., CLAY TRAVIS, *DIXIELAND DELIGHT: A FOOTBALL SEASON ON THE ROAD IN THE SOUTHEASTERN CONFERENCE* (2007).

<sup>23</sup> The University of Alabama has twenty-three SEC titles, the next best team, The University of Tennessee, has thirteen. See *Post-Game Notes*, ROLLTIDE.COM, (Dec. 1, 2012), <http://www.rolltide.com/sports/m-footbl/recaps/120112aac.html>; *All-Time SEC Champs*, UTSPORTS.COM, <http://www.utsports.com/fans/sec-championships.html>.

<sup>24</sup> *Price v. Time, Inc.*, 416 F.3d 1327, 1329 (11th Cir. 2005).

<sup>25</sup> *Over \$60, ALABAMA FAN SHOP*, [http://shop.rolltide.com/COLLEGE\\_Alabama\\_Crimson\\_Tide/pricerange2/over\\_\\$60/pg/1/ps/48/so/highest\\_price](http://shop.rolltide.com/COLLEGE_Alabama_Crimson_Tide/pricerange2/over_$60/pg/1/ps/48/so/highest_price) (last visited Dec. 31, 2012).

overarching interests in its trademarked brands: protections from “confusion” and “dilution.”

Trademark law developed in order to protect businesses from the danger of having their products and services, identified by a brand, “confused” with inferior or otherwise non-endorsed products or services. For example, entity “A” decides to manufacture a car and affix the “Buick” label on the front of the car. Consumers may “confuse” entity A’s car with “Buick” labeled cars manufactured by General Motors. Thus, without trademark law, entity A’s “Buick” would harm General Motor’s reputation by misleading (or “confusing”) consumers into believing that entity A’s car is manufactured by General Motors.

The more likely a trademarked brand is to identify the maker, the more “inherently distinctive” (suggestive, arbitrary or fanciful) it is.<sup>26</sup> “Generic” marks, like “zipper,” “yo-yo” or “cellophane,” on the other hand, identify a genus of products or services rather than a particular business’s product or service. “Descriptive” marks, like “ever-ready” batteries, are neither “generic” nor “inherently distinctive,” but they may acquire a “secondary meaning.”<sup>27</sup> Ever-ready batteries may describe the characteristic of a long-lasting battery. However, if the company distinguishes its trademarked brand as identifying a particular make of batteries, it has acquired “secondary meaning”: identifying the battery manufacturer. Trademark law protects “secondary meaning.” For instance, a consumer thinks of a particular product when using generic marks, but the consumer likely thinks of no particular manufacturer in such instances. Thus, these generic marks receive no trademark protection.<sup>28</sup>

Even distinctive marks are not deleted from the catalog of available words and images a person can use. For instance, just because “Apple” owns a distinctive trademark, does not mean that it can require a local grocer to rename the green and red fruits in her store. “Apple” in that context is used descriptively, rather than as a “source identifier.” The term is not likely to confuse a consumer, and, thus, it does not infringe on the distinctive “Apple” trademark.

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<sup>26</sup> See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

<sup>27</sup> See *id.*

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

As a corollary to “confusion,” trademark law developed a doctrine to protect “famous” marks from “dilution.” For example, entity “A,” rather than manufacturing cars, produces headache medicine that it calls “Buick.” A reasonable consumer or potential consumer would not likely confuse medicine labeled “Buick,” a term that generally signifies a make of cars, with General Motors’ products. However, the “Buick” mark would, according to “dilution theory,” become less valuable and thus “lessen[ing of] the capacity of a famous mark [in this case, Buick,] to identify and distinguish goods or services.”<sup>29</sup> In other words, in the long run, Buick’s mark may become so diluted that consumers would be less likely to associate “Buick” with General Motors’ cars and thus, be more susceptible to confusion as to who makes cars labeled “Buick.”

The danger under a “dilution theory,” particularly a “likelihood of dilution” theory (a dispute between the Courts and Congress too broad to discuss in this article),<sup>30</sup> is brought to light when trademarked brands signify cultural value as much as commercial value. For example, when fans put on their Crimson Tide paraphernalia, it is unclear whether they bought it because of “brand loyalty” or “school spirit.”

It is difficult for courts to develop a principled way to distinguish between infringing and non-infringing activity. For example, courts might or might not see a difference between an avid fan who paints her face with a Crimson Tide “A,” one who paints faces with a Crimson Tide “A” for money, and a person sewing the emblem on a hat.

The *New Life* Court suggests, without holding, that the source of federal trademark law, the Commerce Clause of the United States Constitution, may help courts find a limiting principle.<sup>31</sup> More explicitly, it relies upon the First Amendment to

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<sup>29</sup> Lanham (Trademark) Act § 45, 15 U.S.C. § 1127 (2013).

<sup>30</sup> *Compare* *Moseley v. Victoria Secret Catalogue, Inc.*, 537 U.S. 418 (2003) (unanimously holding that a trademark plaintiff must show “actual dilution” of the trademark as evidence that a mark has lost its capacity to identify and distinguish goods or service sold), *with* Trademark Dilution Revision Act of 2006, 15 U.S.C. § 1051 (overturning *Moseley* and permitting a “likelihood of dilution” standard rather than actual evidence of a mark’s lost capacity to identify and distinguish goods or services sold).

<sup>31</sup> *See New Life Art*, 683 F.3d at 1272-75 (11th Cir. 2012) (discussing validity of prior licensing agreements as they would apply now).



limit the application of federal trademark law that implicates “free expression” interests. By that count, *New Life*, is an easy case. Paintings are traditional art works, which fit squarely within the First Amendment’s “free expression” definition.

This Article will discuss the Court’s response as well as other ways the Court could consider the distinctions between free expression and free trade at issue in *New Life*.

Part I will review the history and the outcome of *New Life Art*. Part II will discuss the historical development of a balance between sports brand owners and artists in trademark doctrine. Part III will set forth the balance, first discussed in *Rogers v. Grimaldi*, between the First Amendment right to free expression and the Lanham (Trademark) Act protection of free trade as well as its shortcomings in cases involving sports symbols. Part IV will propose an adjustment to trademark doctrine that may minimize the need to turn to a First Amendment exception articulated under *Rogers v. Grimaldi* and its progeny.

#### I. THE UNIVERSITY OF ALABAMA BD. OF TRUSTEES V. NEW LIFE ART, INC.

In *New Life Art*, the Eleventh Circuit held that an alumnus and local artist, Daniel A. Moore (“Moore”), did not need permission from the University in order to portray its uniforms in his paintings, prints, and calendars.<sup>32</sup> The Court remanded to the District Court for further factual findings on whether Moore needed permission to place the Tide’s trademarked Brands on “mundane” products, holding that Moore had waived his First Amendment argument as they applied to “mundane” products on appeal.<sup>33</sup>

The Court stretched the trademark question into a First Amendment question by holding:

[W]e need not in this case settle upon a precise evaluation of the strength of the mark or the degree of likelihood of confusion. . . . [W]e conclude that the First Amendment interests in artistic expression so clearly outweigh whatever consumer confusion that might exist on these facts that we

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<sup>32</sup> See *id.* at 1278.

<sup>33</sup> *Id.* at 1279 (“[C]ups, . . . flags, towels, t-shirts . . .”).

must necessarily conclude that there has been no violation of the Lanham Act with respect to the paintings, prints, and calendars.<sup>34</sup>

#### *A. Factual and Procedural Background*

Moore painted historical paintings of the Crimson Tide football team since 1979, at times pursuant to a licensing agreement with the University. Moore also produced prints, calendars, mugs, towels, and other products bearing either Moore's prints or the Tide's Brands. In 2002, the Tide required Moore to seek permission to "depict the University's uniforms because they are trademarks."<sup>35</sup> When the parties could not agree on what permission Moore needed, the Crimson Tide brought suit in the United States District Court for the Northern District of Alabama ("District Court") for breach of contract, trademark infringement, and unfair competition.

The District Court found that though the Crimson Tide's marks were merely descriptive (a low level of distinctiveness), an issue of fact existed as to whether Moore's depictions, as placed on "mundane" products like t-shirts and mugs, would likely cause consumers confusion.<sup>36</sup> However, the court found that the public interest in free expression, as it related to Moore's calendars, prints, and paintings, outweighed any likely consumer confusion.<sup>37</sup>

#### *B. Analysis*

As a threshold matter, The Crimson Tide's jerseys and helmets do not easily fit the trademark definition of highly "distinctive." The Crimson Tide elephant mascot does not appear on uniforms. In fact, the uniform consists of just two colors: crimson and white. No names, not even the school's name, appear on the uniforms. Even the font of the numbers is block and has no unique shape or contour. The Crimson Tide's jersey is one of the least distinctive jerseys in college football. Because trademark

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<sup>34</sup> *Id.* at 1270.

<sup>35</sup> *Id.* at 1269.

<sup>36</sup> *Id.* at 1280.

<sup>37</sup> *Id.* at 1279.

protection expands as the mark becomes more distinctive, the Crimson Tide likely has a relatively thin trademark.

Despite the relative weakness of the mark, the Eleventh Circuit relied on the Second Circuit opinion in *Rogers v. Grimaldi* and balanced the Crimson Tide's trademark interests with Moore's First Amendment rights.<sup>38</sup> In First Amendment jurisprudence, courts generally grant works of art heightened protection.<sup>39</sup> So, the Eleventh Circuit easily found that an artist's right to paint a football player outweighed a team's right to distinguish its goods. The Eleventh Circuit is silent on why it resorted to the First Amendment rather than traditional trademark law to decide this case. The District Court's decision revealed that even relatively thin trademarks used to signify sports teams (particularly SEC football teams) still enjoy broad protections.<sup>40</sup>

The Eleventh Circuit did not disturb that position. This is critical because the text of the Lanham Act proscribes the use of a mark that causes confusion "as to the affiliation, connection, or association . . . as to the origin, sponsorship, or approval of . . . goods, services, or commercial activities."<sup>41</sup> In *Laite*, an Eleventh Circuit precedent cited by the District Court in *New Life*, the court held that "confusion" need not relate to the origin of the challenged product. Rather, "confusion" may relate to the public's knowledge that the trademark, which is "the triggering mechanism" for the sale of the product, originates with the plaintiff.<sup>42</sup> The confusion, referred to in *Laite*, sounds more like "dilution" than "confusion." Dilution cases analyze whether a

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<sup>38</sup> *Id.* at 1277 ("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."); see also *E.S.S Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 918–19 (6th Cir. 2003).

<sup>39</sup> *New Life Art*, 683 F.3d at 1277.

<sup>40</sup> *The Univ. of Ala. Bd. of Trs. v. New Life Art, Inc.*, 677 F. Supp. 2d 1238, 1246 (N.D. Ala. 2009) (citing *University of Georgia Athletic Ass'n v. Laite*, 756 F.2d 1535 (11th Cir. 1985) (*University of Georgia Bulldog Brand*); *Boston Prof'l Hockey Ass'n v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004 (5th Cir. 1975); *Bd. of Supervisors of LSU v. Smack Apparel Co.*, 550 F.3d 465 (5th Cir. 2008) (*L.S.U. purple and yellow colors*)).

<sup>41</sup> Lanham (Trademark) Act § 43 (a)(1)(A), 15 U.S.C. § 1125 (2013).

<sup>42</sup> *Laite*, 756 F.3d at 1546 (citing *Boston*, 510 F.2d at 1004).

“famous” mark loses its distinctiveness by virtue of the subsequent mark, with little regard to consumer confusion or the source of origin that the mark signifies.<sup>43</sup> *Laite* also expresses concerns over “free-riding,” that is enjoying benefits from a mark’s goodwill without having first contributed to its value.<sup>44</sup>

Thus, applied here, the benefit of the “fame” of the mark should go to the mark’s owner, unless, so reasons the Eleventh Circuit, a right to free expression is at stake.<sup>45</sup>

### C. Conclusion

The Eleventh Circuit’s analysis attempts to maintain the balance of earlier precedents. Unfortunately, logical inconsistencies emerge as one considers potential subsequent cases. Critically, the Eleventh Circuit sought rather than avoided a constitutional question: whether the First Amendment precludes trademark protection.<sup>46</sup> The court could have answered the question using trademark law and not the U.S. Constitution. Furthermore, it does not discuss a separate constitutional question; given the constitution’s proscription on patents and copyrights reserved for unlimited times, is a trademark right to exclude purely or primarily expressive use of a mark essentially an end-around copyright and patent laws’ term limitations?<sup>47</sup> Lastly, the issue of dilution, ever present in trademark cases implicating the First Amendment, was not analyzed.

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<sup>43</sup> See, e.g., *Ty Inc. v. Perryman*, 306 F.3d 509, 511–13 (7th Cir. 2002) (discussing dilution by blurring, dilution by tarnishment, and “free riding” not expressly adopted therein).

<sup>44</sup> *Laite*, 756 F.3d at 1546.

<sup>45</sup> *New Life Art*, 683 F.3d at 1266.

<sup>46</sup> See, e.g., *Lyng v. Northwest Indian Cemetery Protective Ass’n*, 485 U.S. 439, 445 (1988) (citing *Three Affiliated Tribes of Ft. Berthold Reservation v. Wold Eng’r, P.C.*, 467 U.S. 138, 157–58 (1984); *Jean v. Nelson*, 472 U.S. 846, 854 (1985); *Gulf Oil Co. v. Bernard*, 452 U.S. 89, 99 (1981); *Ashwander v. TVA*, 297 U.S. 288, 346–48 (1936) (Brandeis, J. concurring)).

<sup>47</sup> See generally *Eldred v. Ashcroft*, 537 U.S. 186 (2003) (discussing the First Amendment protections built into copyright law and holding that term extensions do not constitute perpetual copyrights prohibited by the U.S. Constitution).

## II. SPORTS-RELATED TRADEMARK CASES

The difficult question of why consumers purchase items with sports emblems was discussed as early as 1975 in *Boston Professional Hockey Association v. Dallas Cap & Emblem Mfg. Inc.*<sup>48</sup> In *Boston*, and its progeny, sports teams' marks became goods. Thus, any item confusingly similar to the marks was also confusingly similar to the goods.<sup>49</sup>

*Laite*, however, extended the reasoning in *Boston* further.<sup>50</sup> In *Laite*, the defendant brewed beer and placed the "University of Georgia Bulldog" on the label. The defendant argued "that no confusion could result from the sale of 'Battlin' Bulldog Beer' because the cans contain[ed a] disclaimer" and "no one actually believes that the University of Georgia has gone into the brewing business." Inherent in both of those arguments was the reasoning that protection of the "University of Georgia Bulldog" should be limited to those goods and services that a reasonable consumer believes the university can or would provide.

The Court, however, rather presciently reasoned that Georgia should benefit from the value of licensing. The University of Georgia's brand had a value that could not be easily disclaimed. Thus, even though the University of Georgia may not brew beer, it has the right to license its name to a brewery, and a disclaimer would have to demonstrate that the university had not licensed the defendant's brewery.

Other courts have rejected this reasoning.<sup>51</sup> These courts held that a consumer dons a sports or university clad "soft good" to express himself or herself, not because of the licensor or the manufacturer.<sup>52</sup> Some courts have attempted to fit this motivation into an "aesthetic functionality" doctrine,<sup>53</sup> meaning a consumer

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<sup>48</sup> See generally *Boston*, 510 F.2d at 1004.

<sup>49</sup> See Stephanie Frank, *Showing Your School Spirit: Why University Color Schemes and Indicia Do Not Deserve Trademark Protection*, 92 B.U.L. REV. 329, 333-34 (2012) (noting disagreement over this reasoning).

<sup>50</sup> See generally *Laite*, 756 F.2d at 1535.

<sup>51</sup> See *Int'l Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir. 1980); *Univ. of Pittsburgh v. Champion Prods., Inc.*, 566 F. Supp. 711 (W.D. Pa. 1983).

<sup>52</sup> See *id.*

<sup>53</sup> See *id.*

purchases soft goods bearing sports or university marks “to show his or her allegiance” to that sports team or university.<sup>54</sup>

More recently, cases begun to coalesce around the principle that a sports team or university may protect its interest in the licensing value of its mark, adopting the *Laite* approach.<sup>55</sup>

With these broader trademark rights, impositions on speech are more likely to occur. Thus, courts will increasingly have to consider the analysis first applied in *Rogers v. Grimaldi*, weighing First Amendment speech value with commercial value.

### III. FIRST AMENDMENT ANALYSIS

*New Life Art* relied on *Rogers* to carve out an exception for those subsequent users who make an expressive use of the mark “as a product in itself.”<sup>56</sup> The Eleventh Circuit concluded that those subsequent users who use the “idea, concept, or communication embodied” in the mark itself are not bound by trademark law, echoing Supreme Court language establishing the idea expression dichotomy in copyright law.<sup>57</sup> This is the appropriate conclusion, but the First Amendment paradigm is a problematic framework within which to come to this conclusion.

To be clear, the *Rogers* test is that the subsequent use of a mark does not violate the Lanham (Trademark) Act “unless the [use of the mark] has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, [but it] explicitly misleads as to the source or the content of the work.”<sup>58</sup> *Rogers* and its progeny do not clearly define “artistic relevance.” Generally, the plaintiffs in *Rogers* and its progeny either concede that the

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<sup>54</sup> See *Univ. of Pittsburgh*, 566 F. Supp. at 721.

<sup>55</sup> See, e.g., *LSU*, 550 F.3d at 465; *Univ. of Kansas v. Sinks*, 644 F. Supp. 2d 1287 (D. Kan. 2008); *Texas Tech Univ. v. Speigleberg*, 461 F. Supp. 2d 510 (N.D. Tex. 2006); John Grady & Steve Mcelvey, *Trademark Protection of School Colors: Smack Apparel and Sinks Decisions Trigger Color-ful Legal Debate for the Collegiate Licensing Industry*, 18 J. LEGAL ASPECTS SPORT 207, 233–35 (2008).

<sup>56</sup> *New Life Art*, 683 F.3d at 1277

<sup>57</sup> *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991).

<sup>58</sup> *Rogers*, 875 F.2d at 999; see also *E.S.S. Entm't 2000 v. Rock Star Videos*, 547 F.3d 1095 (9th Cir. 2008); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 925 (6th Cir. 2003); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002); *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993); *Louis Vuitton Mallatier v. Warner Bros. Entm't, Inc.*, No. 11 Civ. 9436 (ALC) (HBP) (S.D.N.Y. June 20, 2012).

defendant's work is artistic, or the defendant's work is a traditional form of artwork (e.g. a portrait, a video game, or a movie). That said, why is a hat, a shirt, a painted face, a boot, a snow-globe, or any other trinket likely to have a football team's logo on it not artistically relevant?

Alternatively, as discussed in relation to parodies in the Ninth Circuit, just calling an item "artistically relevant" does not necessarily answer whether it infringes on another's copyright.<sup>59</sup> That is to say, in the context of *New Life Art*, if Moore's paintings and prints are "artistically relevant," it is difficult to determine why his mugs are not considered sculptures merely able to hold liquid. Moreover, artists may take seemingly "mundane" products and attempt to transform them into products with "artistic relevance." Without knowing what constitutes "artistic relevance," litigants will have to battle over this question in nearly every case, unless a principled rule of law emerges.

One reason a principled rule of law has not emerged is that this is essentially a fact question, as suggested by the Ninth Circuit in *Dr. Seuss Enterprises, LP v. Penguin Books, Inc.*<sup>60</sup> However, before getting to the factual question, courts can lay out some important boundaries. For instance, while likelihood of confusion is a fact question, the courts have described categories of distinctiveness to help guide the analysis of the appropriate protection afforded certain marks. Just as courts determine the level of distinctiveness of a mark before determining how much of its commercial use has been appropriated, courts should also determine the level of the expressive value of such a mark before determining how artistically relevant it is to the offending work. A separate parallel framework must be developed, however, to ascertain the cultural and social value of such marks before determining whether they are "artistically relevant" to an allegedly infringing use because trademark law does not inherently set forth First Amendment principles. This could lead

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<sup>59</sup> *Dr. Seuss Enters., LP v. Penguin Books, Inc.*, 109 F. 3d 1394, 1405 (9th Cir. 1997) (citing McCarthy on Trademarks, § 31.38[1], at 31-216 (rev. ed.1995)) (a parody of the O.J. Simpson case put into rhyme form and published as "The Cat NOT in the Hat!").

<sup>60</sup> *See id.*

to a mishmash of decisions that make the lack of a rule of law seem more desirable.

The Tenth Circuit began to use language closer to First Amendment parlance by stating that, in a right of publicity case, celebrities, by virtue of their celebrity, become part of the public vocabulary.<sup>61</sup> This seems like a “marketplace of ideas” theory of First Amendment.<sup>62</sup> After making a “public vocabulary” determination, drawing analogies to the rights of publicity cases, courts, then, would analyze whether the allegedly infringing work has presented a set of ideas by using the mark, and the more it looks like a conversation in the “public vocabulary” the more artistically relevant it becomes. Again, however, this promises to vary rules in different jurisdictions and undermine the very benefit of federal trademark law in the first place.

Therefore, the issue under a First Amendment carve out rule, even under *New Life Art’s* analysis, is that future litigants learn nothing about whether their work is artistically relevant and therefore non-infringing. Courts should, as the Supreme Court did in *Dastar*, analyze precisely what about marks it is protecting. Absent that initial analysis, the *New Life Art* approach is lacking. For trademark protection is not simply protecting copying, but also the commerce derived from copying. If courts, and subsequent litigators, do not know what brand value is protected, they will not know how it can be used. Courts should weigh the expressive and commercial interests at stake in each case; however, how to strike those balances seems persistently nebulous. To address this, courts may have to use a trademark analysis as discussed below.

#### IV. BRAND LOYALTY

Rochelle Cooper Dreyfuss, and later Judge Alex Kozinski, cite an important distinction in brand values.<sup>63</sup> Dreyfuss writes, “ideograms that once functioned solely as signals denoting the source, origin, and quality of goods, have become products in their own right, valued as indicators of the status, preferences, and

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<sup>61</sup> *Cardtoons v. Major League Baseball Players*, 95 F. 3d 959, 972 (10th Cir. 1996).

<sup>62</sup> *See generally* *Lamont v. Postmaster Gen.*, 381 U.S. 301, 308 (1965) (Brennan, J., concurring).

<sup>63</sup> Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960 (1993); Dreyfuss, *supra* note 5.



aspirations of those who use them.”<sup>64</sup> So, recently, companies cross-branded (See, e.g. “Eddie Bauer Ford Explorer, Star Wars McBurgers, the King Ranch Ford F150 (250, etc), Scouts co-branded Pinewood Derby cars with Jeff Gordon/NASCAR and Chevrolet, and even a collaboration between Comedy Channel’s Stephen Colbert and Ben and Jerry, which resulted in producing ‘Stephen Colbert’s Americone Dream ice cream.’”).<sup>65</sup>

Star Wars does not indicate the source, origin, or quality of hamburgers, but it does have value as an indicator of status, preferences, and aspirations of those who eat Star Wars hamburgers. The same can be said for the other examples listed.<sup>66</sup>

The question, then, courts must consider is whether unauthorized cross branding offends the relevant brand owner’s trademark rights. As a threshold matter, trademark has, for the purposes of this article, two main branches of analysis: “confusion” and “dilution.”

Under a confusion theory, trademark infringement misleads (or is likely to mislead) a consumer into believing that the plaintiff is the source of the good or service. Under this theory, the “aesthetic functionality” doctrine or Dreyfuss’ “expressive genericity” theory may allay concerns over “free expression” expressed in *Rogers*.

Under a dilution theory, trademark infringement does not mislead as to the source of the good or service but rather causes a “subliminal” connection between the affected mark and an individual or entity previously unaffiliated with the mark. Thus, dilution theory prevents even the possibility of “confusion” by protecting the uniqueness and thereby the distinctiveness of the mark.<sup>67</sup> Statutorily, dilution occurs by “tarnishing” the reputation

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<sup>64</sup> Dreyfuss, *supra* note 5 at p. 397.

<sup>65</sup> Mark Riffey, *Cross-branding. Good enough for Starbucks and Hershey. How 'bout you?*, RESCUE MARKETING, INC. (July 23, 2007), <http://www.rescuemarketing.com/cross-branding-good-enough-for-starbucks-and-hershey-how-bout-you/>.

<sup>66</sup> These pose no legal problem because they are all licensed. Licensing has a huge impact on the legal framework of these issues. However, they are beyond the scope of this article, and perhaps beyond the scope of any judge acting pursuant to precedent, not agreement. That said, the value of licensing cannot be ignored. See Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 179 n. 100 (1982) (discussing the enormous costs involved in licensing).

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

of the mark owner by associating the mark with scandalous or unsavory matters.<sup>68</sup> It also occurs by “blurring” the associations made with the name (Star Wars McBurgers, if unauthorized, would be dilution by blurring).

*A. Addressing Free Expression Concerns under a Likelihood of Confusion Paradigm*

The Sixth Circuit held that an artist’s photographs and posters of the Rock & Roll Hall of Fame & Museum’s building, “a unique and inherently distinctive symbol of the freedom, youthful energy, rebellion and movement of rock and roll music,” was likely not trademark infringement.<sup>69</sup> It used an analysis more closely resembling “aesthetic functionality” by reasoning “a picture of the Museum on a product might be more readily perceived as ornamentation than as an identifier of source.”<sup>70</sup>

The limitations to this rationale lie in the prevailing theory for aesthetic functionality, criticized in *Rogers*. Namely, when it comes to aesthetic or ornamental features, courts often simply require the subsequent user to find an alternative aesthete or ornament.<sup>71</sup> The “no alternative” formulation is rooted in the purpose of trademark law to foster competition. Those who cannot piggyback off the goodwill of others must instead formulate alternatives that compete in the marketplace. As Dreyfuss explains, and with which *Rogers* seems in accord, “plenary authority over [words] puts in jeopardy the public’s ability to avail itself of the powerful rhetorical capacity of trademarks.”<sup>72</sup> Indeed, it seems, at least in the context of the symbols at issue in *New Life Art*, the same logic applies to marks other than just word marks.

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<sup>68</sup> See, e.g., *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205 (2d Cir. 1979) (providing a good, analogous rationale for finding infringement when a pornographic film, “Debbie Does Dallas,” “impugn[s] . . . and injures plaintiff’s business reputation.”).

<sup>69</sup> *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 750 (6th Cir. 1998).

<sup>70</sup> *Id.* at 755.

<sup>71</sup> *Rogers*, 875 F.2d at 999–1000 (“[T]his ‘no alternative’ standard provides insufficient leeway for literary expression . . . ‘we’ cannot indulge the facile assumption that one can forbid particular words without running a substantial risk of suppressing ideas in the process.”) (quoting *Cohen v. California*, 403 U.S. 15, 26 (1971)).

<sup>72</sup> See *id.*; Dreyfuss, *supra* note 5 at p. 397.

Litigation over the word “Olympic” seems the most potent example of the shortcomings of the “no alternatives” approach to “aesthetic functionality.”<sup>73</sup> In *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee*, a non-profit (SFAA) seeking “to combat homophobia and to work for the health and tolerance of gay and lesbian persons” coordinated an event it called the “Gay Olympic Games” in August 1982.<sup>74</sup> It is important to remember that views on homosexuality have evolved over the last thirty years.<sup>75</sup> So, the goal of assimilating homosexuals into the mainstream was still, and to some degree remains, a more expressive than ministerial activity. These were politically charged statements and would likely be deemed to have a high expressive value.

The SFAA planned to make the “Gay Olympic Games” embody many of the ideals developed in the modern-day Olympics: geographic diversity, athletic competition, and goodwill to ultimately “create a more realistic image of homosexual men and women to move into the mainstreams of their respective societies.”<sup>76</sup> The SFAA was a charitable organization. Therefore, though it did sell products with the Olympics word mark, and participated in the stream of commerce, it primarily organized the “Gay Olympic Games” because of its ideals. It seems perfectly suited for a claim that it used the expressive rather than the commercial use of the word “Olympic.”

The court had little precedent to guide it towards an analysis of the protection warranted to the expressive value of a word. First, the Court could find the word “Olympic” generic, but “generic” means a term that refers to the genus of which the

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<sup>73</sup> *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522 (1987).

<sup>74</sup> *International Olympic Comm. v. San Francisco Arts & Athletics*, 789 F.2d 1319, 1320 (9th Cir. 1986) (Kozinski, J. dissenting).

<sup>75</sup> See *Bowers v. Hardwick*, 478 U.S. 186 (1986) (overruled by *Lawrence v. Texas*, 539 U.S. 558 (2003)); see also Lawrence K. Altman, *New Homosexual Disorder Worries Health Officials*, NEW YORK TIMES (May 11, 1982), <http://www.nytimes.com/1982/05/11/science/new-homosexual-disorder-worries-health-officials.html?pagewanted=all> (characterizing AIDS as “GRID” (gay-related immunodeficiency)).

<sup>76</sup> *Int’l Olympic Comm. v. San Francisco Arts & Athletics*, 219 U.S.P.Q. 982, 985 (N.D. Cal. 1982).

particular product or service is a species.<sup>77</sup> “Olympic” simply is not that broad. There is no question that the Olympics are a certain type of athletic event, distinct from the Super Bowl, the Stanley Cup, or the World Series. Thus, the majority easily dismissed the generic argument.

The USOC and the IOC have used the word “Olympic” since at least 1896, when Baron Pierre de Coubertin of France started the modern Olympics. The mission of the IOC is to, *inter alia*, promote sports ethics, sports competition, athlete health, sports that serve humanity and peace, and the development of sports for all.<sup>78</sup> SFAA was not precisely a Lanham Act case, but rather analyzed under the Amateur Sports Act.<sup>79</sup> This is important because the Court was not statutorily bound, though it may have been constitutionally bound, to consider the commercial value of the word “Olympic.” Brennan, in dissent, pointed out that the expressive content of a word like “Olympic” should not be discounted.<sup>80</sup> He, therefore, reached the constitutional question. Because of the Amateur Sports Act, the constitutional question was inevitable; however, this anomaly also makes it of little precedential value to courts considering the issue in the future.

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<sup>77</sup> See, e.g., *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 193–94 (1985) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976)).

<sup>78</sup> The Organisation, OLYMPICS.ORG, <http://www.olympic.org/about-ioc-institution> (last visited Jan. 30, 2013).

<sup>79</sup> *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 567 (1987).

<sup>80</sup> *Id.* at 570 (“When we look at particular words, it is not their translation into statements of equivalence that we should seek but an understanding of the possibilities they represent for making and changing the world . . . . Such words do not operate in ordinary speech as restatable concepts but as words with a life and force of their own. They cannot be replaced with definitions, as though they were parts of a closed system, for they constitute unique resources, of mixed fact and value, and their translation into other terms would destroy their nature. Their meaning resides not in their reducibility to other terms but in their irreducibility . . . . They operate indeed in part as gestures, with a meaning that cannot be restated.”) (quoting J. White, *When Words Lose Their Meaning* 11 (1984)) (When we look at particular words, it is not their translation into statements of equivalence that we should seek but an understanding of the possibilities they represent for making and changing the world . . . . Such words do not operate in ordinary speech as restatable concepts but as words with a life and force of their own. They cannot be replaced with definitions, as though they were parts of a closed system, for they constitute unique resources, of mixed fact and value, and their translation into other terms would destroy their nature. Their meaning resides not in their reducibility to other terms but in their irreducibility. . . . They operate indeed in part as gestures, with a meaning that cannot be restated.)

Most cases though do not involve Congress' attempt to reserve a word for a particular private entity. Generally, a word or image that is otherwise protectable may be "rhetorically unique" within its context and thus be considered expressively generic though not commercially or, to use Dreyfuss' phrase, competitively generic.<sup>81</sup> Thus, the expressively generic approach rather than the aesthetic functionality or First Amendment approaches of courts now seems favorable.

First, according to Dreyfuss, the Court must determine whether the mark at issue has an expressive component.<sup>82</sup> Rather than invent new tests, the Court can easily determine this by analyzing whether the mark is descriptive but has acquired a "secondary meaning." For example, while "Olympic" is undoubtedly not generic, it is also clearly descriptive. If it has not acquired "secondary meaning," the analysis is over and there is no trademark protection. If it has acquired "secondary meaning," the Court must define where the expressive meaning ends and where the commercial meaning begins. That is, where in the public's mind does the primary significance of the mark cease to be the source of the product rather than the product itself?<sup>83</sup>

Under *Boston* and its progeny, the value of the mark as a product in its own right should inure solely to the benefit of the mark owner. The United States Supreme Court has long identified the source of Congress' power to regulate copying, under Article I, Section 8, Clause 8 of the United States Constitution. Congress, however, cannot regulate trademarks under that clause.<sup>84</sup>

Justice Scalia's analysis in *Dastar* warns of this limitation by reasoning that the touchstone for trademark stems from its commercial value and not from its expressive value. The *New Life Art* court valiantly attempted to reconcile, though not expressly,

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<sup>81</sup> Dreyfuss, *supra* note 5 at p. 418.

<sup>82</sup> *Id.*

<sup>83</sup> *Cf.* Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 211 (2000).

<sup>84</sup> *See, e.g.*, The Trade-Mark Cases, 100 U.S. 82 (1879) (holding that the Copyright Clause does not empower Congress to protect or regulate trademarks). Congress responded to the Trade-Mark Cases by passing the Trade Mark Act of 1881, the predecessor to the current Lanham Act (federal trademark statute), based on its Commerce Clause power. However, the U.S. Supreme Court has consistently warned against the danger of trademark law becoming a "species of mutant copyright law." *See Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003).

*Boston* (holding that the infringing use was in connection with the sale of goods because “the registered mark is, in effect, the product itself”) with *Dastar* (“origin of goods’ [does not refer] to the author of any idea, concept, or communication embodied in those goods”). The Eleventh Circuit can and likely should hold that *Boston*, to the extent that it conflicts with *Dastar*, has been overruled. This, then, frees the Eleventh Circuit to hold that marks are only products in themselves to the extent they fit within a dilution theory and not under a “likelihood of confusion” analysis.

*B. Addressing Free Expression Concerns Under a Dilution Paradigm*

This brings us to the final issue absent from *New Life Art*: dilution theory. That is, the protection of the fame of the Brand.<sup>85</sup> Robert C. Denicola accurately predicted that the common law tort of misappropriation would expand in the confines of “trademark law.”<sup>86</sup> Here, the argument must drift into matters of policy. For purposes of this article, the potential rules will be laid out and left for policy makers to rule on. Dilution theory requires, as it should in these cases, an analysis of the mark itself, for that is the source of the protection.<sup>87</sup> As discussed above, the cultural identification between the University of Alabama, the “deep south,” and football are undeniable and, thus, an analysis of the factors articulated in the Lanham Act would clearly demonstrate that the Crimson Tide’s marks are famous.

Undoubtedly, the source of the marks’ fame comes from the work of the mark owner. The source of the fame also derives from

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<sup>85</sup> See *Moseley v. Victoria’s Secret Catalogue*, 537 U.S. 418 (2003) (holding that the plaintiff must prove “actual dilution” (actual harm) to the famous mark to recover damages), overruled by Trademark Dilution Revision Act of 2006 (requiring proof only of a “likelihood of dilution” (potential harm) to the famous mark to recover damages).

<sup>86</sup> Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 172 (1982) (citing *Int’l News Serv. v. Assoc. Press*, 248 U.S. 215 (1918) (holding that taking news materials authored by another and re-transmitting it, despite attribution, was actionable)).

<sup>87</sup> See Lanham (Trademark) Act § 43(c).

other things and, as discussed in *Cardtoons*, becomes part of the “public vocabulary”<sup>88</sup>

To the extent the Tide’s fame derives from its endorsement of goods and provision of services, marks should gain protection. Many fans, however, likely do not care as much about the school’s endorsement of their gear as they care that they are endorsing the school. This “loyalty” is the consumer’s endorsement of the product or service embodied by the trademarked brand rather than a consumer’s decision to purchase a product because the trademarked brand indicates source or origin.

Ultimately, under a dilution a theory, “loyalty” becomes the touchstone of the analysis because “fame” in and of itself is not an accurate measure of the consumer’s purchasing decision. For instance, the face-painting consumer likely does not care whether the Crimson Tide endorses the painter’s skills or expertise. She paints her face to indicate her “loyalty” to the color, letter, or school. On the other hand, sports paraphernalia, books, and other items directly related to the Crimson Tide may retain less expressive value and become more identifiable as commercial and thereby deserving of trademark protection. That is, if a consumer believes the University of Alabama endorses a book, he or she may be buying the book because of the academic reputation of the University of Alabama; whereas, if he or she buys a keychain bearing the Crimson Tide’s stylized “A,” he or she likely is ignorant of and/or does not care whether the school endorses the product. Furthermore, if the relevant brand is already in the “public vocabulary,” dilution becomes less of a concern. The public must be provided broad rights to discuss the culturally significant brand.

“Loyalty” is not a perfect analytic lynchpin. It runs the risk of becoming tautological.<sup>89</sup> That is to say, those who are loyal to a

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<sup>88</sup> Cf. *Univ. of Pittsburgh*, 566 F. Supp. at 721 (“The relevant product market for the consumer in this case is soft goods which allow the consumer to show his or her allegiance to Pitt. There is no evidence that the consumer cares who has made the soft goods or whether they were made under license.”).

<sup>89</sup> Cf. *Nat’l Football League Props., Inc. v. Dallas Cap & Emblem Mfg., Inc.*, 37 N.E.2d 247, 350 (Ill. App. 1975) (relying on survey finding that a majority of consumers believe the team sponsored an item that contained the team’s logo on it); see also Stacey L. Dogan & Mark A. Lemley, *The Merchandising Right: Fragile Theory or Fait Accompli?*, 54 EMORY L. REV. 461, 477 (2005).

team will likely purchase items sponsored by that team. If a false designation of sponsorship appears on certain items, the consumer is duped into purchasing items it thought were sponsored by the team, and the team loses out. Licensing value is important, but not the focus of a “loyalty” analysis. Instead, teams should lose protection when the consumer is loyal because of their own expression. That is, what drives the consumer’s purchasing decision? Is it the source and origin of the trademarked item or loyalty to the trademark itself? The former receives trademark protection while the latter does not.

## V. EPILOGUE

Courts exist in the real world, and the real world of modern-day college sports involves licensing. Again, modern-day college licensing starts with the Crimson Tide. In 1981, a small licensing company signed legendary head coach Paul “Bear” Bryant to a licensing agreement.<sup>90</sup> That company, then, signed the Crimson Tide on to a licensing deal.<sup>91</sup> Now, the Collegiate Licensing Company, acquired by IMG Worldwide in 2007, licenses trademarks for almost 200 colleges, universities, bowl games, athletic conferences, the NCAA, and other NCAA-affiliated entities, or 80% of the \$4.6 billion retail market for collegiate licensed merchandise.<sup>92</sup> That market includes everything from automobile products (e.g. tire covers, air fresheners, etc.) to clothes to food to “collectibles.”<sup>93</sup>

Courts cannot, with one fell swoop, risk eliminating such a huge part of the economy, university budgets, and contracts by calling into question the scope of the licenses United States merchandisers hold. They need not, however, invoke the First Amendment in order to place boundaries around the last bastions of expressions left available to those who want to use college-owned marks. Applying the “loyalty” paradigm in this context largely achieves the same purpose. Courts should be permitted to

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<sup>90</sup> *About CLC*, CLC.COM, <http://www.clc.com/About-CLC.aspx> (last visited Jan. 30, 2013).

<sup>91</sup> *Id.*

<sup>92</sup> *Id.*

<sup>93</sup> *Licensee Search*, CLC.COM, <http://www.clc.com/Licensing-Info/Client-License-List.aspx> (last visited Jan. 30, 2013).



require heightened “loyalty” when the brand is the subject of numerous licensing deals. This has the added benefit of avoiding the constitutional question of whether the First Amendment, applied to both commercial and expressive speech, protects certain types of “expressive speech” and not others. I leave other commentators to discuss the fallout from a legal rule that threatens such a lucrative market. For now, we must conclude that courts should attempt first to stretch familiar trademark doctrine to protect expressive activity rather than relying primarily on the First Amendment. Otherwise, far more cases may become constitutional First Amendment cases than originally intended.

